

Legislative Decree No. 455 of November 3, 1998*

**Adaptation to the Provisions of the 1991 Act of the International Convention for
the Protection of New Varieties of Plants**

THE PRESIDENT OF THE REPUBLIC,

Having regard to Articles 76 and 87 of the Constitution;

Having regard to Article 3 of Law No.110 of March 23, 1998, on the Ratification and implementation of the International Convention for the Protection of New Varieties of Plants, adopted in Paris on December 2, 1961, and revised in Geneva on November 10, 1972, October 23, 1978, and March 19, 1991;

Having regard to Law No. 620 of October 14, 1985, on the Ratification and Implementation of the International Convention for the Protection of New Varieties of Plants of December 2, 1961, as revised in Geneva on November 10, 1972, signed in Geneva on October 23, 1978;

Having regard to Presidential Decree No. 391 of April 18, 1994;

Having regard to the decision of the Council of Ministers adopted at its meeting on October 30, 1998;

On the proposal of the President of the Council of Ministers and the Minister for Industry, Commerce and Handicraft, in agreement with the Ministers of Agriculture, Foreign Affairs, Finance, the Treasury, the Budget and Economic Planning;

ISSUES the following Decree:

Article 1

Breeder's Rights

(1) The rights in a new plant variety shall be granted by means of a patent issued in accordance with this Decree.

(2) New plant varieties shall be governed by the provisions contained in Articles 2584 to 2591 of the Civil Code and in Royal Decree No. 1127 of June 29, 1939, and subsequent additions and amendments thereto, and also by the regulations approved by Royal Decree No. 244 of February 5, 1940, and subsequent additions and amendments thereto, provided that they do not conflict with the provisions of this Decree.

* The Legislative Decree No. 455 was adopted on November 3, 1998

Translation: by the Office of the Union in cooperation with the national authorities

Article 2

Economic Rights and Moral Rights

- (1) The rights arising from the breeding of new plant varieties shall be transferable and inheritable, except for the right to recognition of authorship.
- (2) The right to recognition of authorship may be claimed after the death of the breeder by a person whom he has designated for that purpose. In the absence of any such designation, or following the death of the person designated, the said right may be claimed by the spouse and by descendants down to the second generation, in their absence or after their death by the parents and other direct descendants, and in their absence or after their death also by relations down to and including the fourth generation.

Article 3

Definitions

- (1) For the purposes of this Decree, "breeder" means:
 - (a) the person who has bred, discovered or developed a variety;
 - (b) the person who is the employer of the aforementioned person or who has commissioned his work;
 - (c) the successor in title to the persons mentioned in the above subparagraphs.
- (2) "Variety" means a plant grouping within a single botanical taxon of the lowest known rank, which grouping, regardless of whether the conditions for the grant of breeders' rights are fully met, may be:
 - (a) defined by the expression of the characteristics resulting from a given genotype or combination of genotypes;
 - (b) distinguished from any other plant grouping by the expression of at least one of the said characteristics, and
 - (c) considered a unit with regard to its suitability for being propagated unchanged.

Article 4

Conditions of Protection

- (1) The breeder's right shall be granted where the variety is:
 - (a) new;
 - (b) distinct;
 - (c) uniform and
 - (d) stable.

Article 5

Novelty

(1) The variety shall be deemed to be new if, on the filing date of the application for breeders' rights, propagating or harvested material of the variety has not been sold or otherwise disposed of to others, by or with the consent of the breeder, for the purpose of exploitation of the variety:

- (a) on Italian territory, earlier than one year before that date, and
- (b) on the territory of any other State in which the application has been filed, earlier than four years or, in the case of trees or vines, earlier than six years before the said date.

Article 6

Distinctness

(1) The variety shall be deemed to be distinct if it is clearly distinguishable from any other variety whose existence is a matter of common knowledge at the time of the filing of the application.

(2) In particular, another variety shall be deemed to be common knowledge if:

- (a) an application has been filed in any country for the grant of breeders' rights or for the entry of the said other variety in the official register of varieties, provided that the application leads to the grant of breeders' rights or to the entry of the said other variety in the official register;
- (b) it may be found in public collections;
- (c) it is described in publications.

Article 7

Uniformity

(1) The variety shall be deemed to be uniform if, subject to the variations that may be expected owing to the particular features of its sexual reproduction and vegetative propagation, it is sufficiently uniform in those of its characteristics that are relevant to its protection.

Article 8

Stability

(2) The variety shall be deemed to be stable if its relevant characteristics remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.

Article 9

Filing of the Application

(1) The breeder may choose the member State of the Union for the Protection of New Varieties of Plants (hereinafter referred to as UPOV) with whose authority he wishes to file his first application for the breeder's right.

Article 10

National Treatment

(1) The provisions of this Decree shall apply, subject to reciprocity, to natural persons or legal entities residing or having their registered offices within the territory of one of the member States of UPOV.

(2) Natural persons or legal entities not residing or having their registered offices within the territory of one of member States of UPOV shall be covered by the provisions of this Decree, subject to reciprocity, by virtue of bilateral agreements.

Article 11

Right of Priority

(1) The breeder of a new plant variety, or his successor in title, may claim a right of priority by virtue of a first application filed earlier in a member State of UPOV for the purpose of obtaining the breeder's right in that variety.

(2) Such a right of priority may be claimed only if the application for the breeder's right is filed and the priority claim made earlier than 12 months from the filing date of the first application.

(3) The breeder shall be allowed a period of two years after the expiry of the priority period within which to furnish any information, document or material required for the purposes of the examination provided for in Article 18.

(4) Events occurring within the period provided for in paragraph (2), such as the filing of another application or the publication or use of the variety that is the subject

of the first application, shall not constitute a ground for rejection of the subsequent application. Such events shall likewise not give rise to any third-party right.

Article 12

Provisional Protection

(1) During the period between publication of the application for the grant of the breeder's right and the grant of that right, the breeder shall be entitled to equitable remuneration from any person who, in the course of the said period, has engaged in acts which, once the rights have been granted, require the breeder's authorization.

Article 13

Content of the Breeder's Right

(1) The following acts in relation to reproductive or vegetative propagating material of the protected variety shall require authorization by the breeder:

- (a) production or reproduction;
- (b) processing for the purpose of propagation;
- (c) offering for sale, selling or any other form of marketing;
- (d) exporting or importing;
- (e) stocking for any of the above purposes.

(2) The breeder's authorization shall be required for any of the acts mentioned in paragraph (1) in relation to harvested material, including whole plants and parts of plants obtained through unauthorized use of propagating material of the protected variety, unless the breeder has had reasonable opportunity to exercise his right in relation to the said propagating material. Use shall be presumed unauthorized in the absence of proof to the contrary.

(3) The provisions of paragraphs (1) and (2) shall also apply to:

- (a) varieties that are essentially derived from the protected variety, where the protected variety is not itself an essentially derived variety;
- (b) varieties that are not clearly distinguishable from the protected variety in accordance with Article 6;
- (c) varieties whose production requires repeated use of the protected variety.

(4) For the purposes of subparagraph 3(a), a variety shall be considered essentially derived from another variety ("the initial variety") when:

- (a) it is mainly derived from the initial variety, or from a variety that is itself mainly derived from the initial variety, while retaining the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety;

(b) it is clearly distinguishable from the initial variety and, except for differences that result from the derivation, it conforms to the initial variety in the expression of the essential characteristics resulting from the genotype or combination of genotypes of the initial variety.

(5) Essentially derived varieties may be obtained, for example, by selecting a natural or induced mutant or a somaclonal variant, by selecting a variant individual from plants of the initial variety, by back-crossing or by transformation with the aid of genetic engineering.

Article 14

Exceptions to the Breeder's Right

(1) The breeder's right shall not extend to acts done privately and for non-commercial purposes, acts done for experimental purposes, acts done for the purpose of breeding other varieties and, except where the provisions of Article 13(3) apply, acts referred to in Article 13(1) and (2) in relation to such other varieties.

Article 15

Duration of the Breeder's Right

(1) The breeder's right granted under this Decree shall last for 20 years from the date of grant. For trees and vines the rights shall last for 30 years from the said date.

(2) Rights shall be effective as from the date on which the application, with supporting evidence attached, is made accessible to the public.

(3) In relation to persons to whom the application has been notified by the breeder together with supporting evidence, the rights shall be effective as from the date of notification.

Article 16

Exhaustion of the Breeder's Right

(1) The breeder's right shall not extend to acts in relation to material of the protected variety, or of a variety covered by Article 13(3), that has been sold or otherwise marketed by the breeder or with his consent on the national territory, or any material derived from the said material, unless such acts involve further propagation of the variety in question or involve the export of material of that variety, the breeder thereby consenting to the reproduction of the variety in a State that does not protect varieties of the plant genus or species to which the variety belongs, except where the exported material is destined for consumption.

(2) For the purposes of paragraph (1), "material" means, in relation to a variety:

- (a) propagating material of any kind;
- (b) harvested material, including whole plants and parts of plants;
- (c) any product made directly from harvested material.

Article 17

Variety Denomination

- (1) The variety shall be designated by a denomination which shall be its generic designation.
- (2) The denomination must enable the variety to be identified. It may not consist solely of figures, except where that is an established practice for designating such a variety. It must not be liable to mislead or to cause confusion as to the characteristics, value or identity of the variety or the identity of the breeder. In particular, it must be different from any other denomination that designates, in the territory of a UPOV member State, an existing variety of the same plant species or of a closely related species, except where that other variety no longer exists or where its denomination has not acquired any particular significance.
- (3) Prior rights of third parties shall not be affected.
- (4) The denomination must be the same as that previously registered in one of the UPOV member States to designate the same variety.
- (5) A denomination filed and conforming to the requirements of paragraphs (1), (2), (3) and (4) shall be registered.
- (6) Once filed and registered, the denomination, together with any variations on it, shall be communicated to the competent authorities of the UPOV member States.
- (7) The registered denomination must be used for the variety, even after the expiry of the breeder's right in the variety, provided that acquired rights do not prevent such use as provided in paragraph (3).
- (8) It shall be permissible to associate a trademark, trade name or other similar designation with a registered variety denomination, provided that the denomination is always readily recognizable.

Article 18

Examination of the Application

- (1) The examination of an application for the grant of the breeder's right in new plant varieties is intended to establish:
 - (a) that the application and its attached documentation are in order as to form;

- (b) that denomination of the new plant variety conforms to the provisions of Article 17;
- (c) that the variety conforms to the provisions of Article 4; such conformity may be ascertained by growing the variety or carrying out other trials, or by taking into account the results of growing trials or other tests that have already been carried out.

Article 19

Nullity of the Breeder's Right

- (1) The breeder's right shall be declared null and void if it is established:
 - (a) that the conditions specified in Articles 5 and 6 were not fulfilled at the time of the grant of the breeder's right;
 - (b) that, where breeders' rights have been granted essentially on the basis of information and documents supplied by the breeder, the conditions specified in Articles 7 and 8 were not fulfilled at the time of the grant of the breeder's right;
 - (c) that the breeders' rights have been granted to a person not entitled to them, unless, prior to the declaration of nullity, the rights have been transferred to a person who is so entitled.
- (2) Breeders' rights may not be declared null and void on grounds other than those specified in paragraph (1).

Article 20

Lapse of the Breeder's Right

- (1) The breeder's right shall lapse if it is established that the conditions set forth in Articles 7 and 8 are no longer fulfilled.
- (2) The rights shall lapse if the breeder, having been called upon to do so by the competent authority:
 - (a) fails to submit within 30 days the information, documents or material considered necessary for verifying the maintenance of the variety;
 - (b) fails to pay such fees as may be payable to keep his rights in force;
 - (c) fails, where the denomination of the variety is cancelled after the grant of rights, to propose another suitable denomination.
- (3) In the cases provided for in subparagraphs 2(a) and (c), lapse shall be declared by the Italian Patent and Trademark Office (UIBM), on a proposal by the Ministry of Agriculture.

(4) Breeders' rights may not lapse for reasons other than those referred to in paragraphs (1) and (2).

Article 21

Compulsory Licensing

(1) Breeders' rights may be made the subject of non-exclusive compulsory licenses only in the public interest.

Article 22

Administrative Functions

(1) The administrative functions relating to the matters regulated by this Decree shall be exercised by the Italian Patent and Trademark Office of the Ministry of Industry, Commerce and Handicraft, which, for the purpose of the filing of applications, shall enlist the cooperation of Chambers of Commerce, Industry, Handicraft and Agriculture in accordance with Article 20 of Legislative Decree No. 112 of March 31, 1998.

(2) For the purposes of verifying compliance with the requirements specified in Article 18(1)(b) and (c), the Ministry of Agriculture shall issue a binding opinion in consultation with the Advisory Committee established under Article 18 of Presidential Decree No. 974 of August 12, 1975.

Article 23

Expropriation

(1) The expropriation provided for in Articles 60 *et seq.* of Royal Decree No. 1127 of June 29, 1939, shall take place, for new plant varieties, after the Ministry of Agriculture has been heard.

Article 24

Procedural Requirements

(1) A copy of the writ for any civil litigation and any appeal to the Committee referred to in Article 71 of Royal Decree No. 1127 of June 29, 1939, in relation to new plant varieties, shall be transmitted to the UIBM and to the Ministry of Agriculture by the person who brought the action.

(2) In the event of failure to furnish the said copy, the judicial authority and the aforementioned Committee may, at any stage in the proceedings, direct that it be furnished before ruling on the merits.

Article 25

Government License Fees

(1) The following amendments are made to Article 9, Title IV, of the Tariff mentioned in the table attached to Presidential Decree No. 641 of October 26, 1972, as most recently amended by the Ministry Finance Decree of December 28, 1995, published in Official Journal No. 303 of December 30, 1995.

- (a) In paragraph 1, the words "and for new plant varieties" and "Law No. 620 of October 14, 1985" are deleted;
- (b) In paragraph 2, the words "and special license concerning patents for new plant varieties" are deleted.

(2) The following Article *9bis* is inserted after Article 9 of the table attached to the Ministerial Decree referred to in paragraph (1):

"Art. *9bis*: (1) Patents for new plant varieties:

- (a) application fee, including fees for publication and provisional protection (prior to grant of patent): L. 350,000;
- (b) fees for maintaining the patent (year from the date of grant):

First	L. 150,000
Second	L. 200,000
Third	L. 250,000
Fourth	L. 300,000
Fifth	L. 350,000
Sixth	L. 400,000
Seventh	L. 450,000
Eighth	L. 500,000
Ninth	L. 550,000
Tenth	L. 600,000
Eleventh	L. 650,000
Twelfth	L. 700,000
Thirteenth	L. 750,000
Fourteenth	L. 800,000
Fifteenth	L. 850,000
Sixteenth	L. 900,000
Seventeenth	L. 950,000
Eighteenth	L. 1,000,000
Nineteenth	L. 1,050,000
Twentieth and thereafter	L. 1,100,000

(2) Fees for compulsory licenses for new plant variety patents:

- (a) for the application: L. 800,000;

- (b) for the grant: L. 2,700,000.
- (3) Fees for copies of certificates relating to new plant variety patents:
 - (a) for each patent: L. 120,000;
 - (b) for a registered letter: L. 50,000.
- (4) The application fee for a new plant variety, including the fees for publication and provisional protection, shall not be refundable."

Article 26

Tariffs

- (1) The advice and necessary technical controls provided for in Article 18 shall be subject to the payment of compensation according to the rates established by decree of the Ministry of Agriculture, in amounts commensurate with the actual cost of the service. The said compensation shall be paid into the State budget before being reallocated, by order of the Ministry of the Treasury, the Budget and Economic Planning, to the appropriate budget heading of the Ministry of Industry, Commerce and Handicraft.

Article 27

Financial Expenditure

- (1) The expenditure arising from the application of Article 22 of this Decree, which is estimated at L. 50 million per annum as from 1999, shall be covered by using the greater income amounts generated by virtue of the provisions of Article 25.
- (2) The Ministry of the Treasury, the Budget and Economic Planning is hereby authorized to introduce the necessary changes to the budget by ministerial decree.

Article 28

Scope of Application

- (1) Without prejudice to the provisions of Article 24 of Presidential Decree No. 974 of August 12, 1975, the provisions of this Decree shall extend to all plant genera and species one year after its entry into force.

Article 29

Transitional Provisions

- (1) Applications for breeders' rights filed prior to the date of the entry into force of this Decree shall be processed in accordance with the provisions thereof, provided

that the earlier provisions shall determine whether the applications are in order as to form.

(2) The provisions of Article 13(3) and (4) shall govern applications filed after the date of the entry into force of this Decree.

Article 30

Extension of the Term of Rights Granted

(1) The provisions of Article 15 shall apply to new plant variety patents granted in accordance with Presidential Decree No. 974 of August 12, 1975, that have not expired or lapsed by the date of the entry into force of this Decree.

(2) Licensees and those who, on the date of the entry into force of this Decree, have made a serious and genuine commitment to the use of the new plant varieties covered by the breeder's right shall be entitled to obtain a compulsory license, free of charge and non-exclusive, for a longer period. This entitlement shall not be available to infringers of rights that have not yet lapsed.

Article 31

Register of Industrial Property Agents

(1) The provisions on the profession of certified on industrial property agent and on the compilation of a Register of such agents, as provided for in Decree No. 342 dated May 30, 1995, of the Ministry of Industry, Commerce and Handicraft, shall apply to this Decree.

Article 32

Entry into Force

(1) This Decree shall enter into force on the ninetieth day following the date of its publication in the Official Journal of the Italian Republic.

(2) During that period the Ministry of Industry, Commerce and Handicraft, together with the Ministry of Agriculture, shall adopt the implementing regulations.

(3) On the date of entry into force of the regulations referred to in paragraph (2), the following legislation shall cease to be valid:

(a) Presidential Decree No. 974 of August 12, 1975, as amended by Presidential Decree No. 338 of June 22, 1979, except Articles 14, 15, 16, 17, 18 and 19;

(b) Law No. 620 of October 14, 1985;

(c) Presidential Decree No. 391 of April 18, 1994.

This Decree, bearing the seal of the State, shall be entered in the Official Register of Legislative Enactments of the Republic of Italy. All persons concerned by it are required to comply and to ensure compliance with it.

Done at Rome on November 3, 1998.

(Signed)

SCALFARO

D'ALEMA (President of the Council of Ministers)

BERSANI (Minister of Industry, Commerce and Handicraft)

DE CASTRO (Minister of Agriculture)

DINI (Minister of Foreign Affairs)

VISCO (Minister of Finance)

CIAMPI (Minister of the Treasury, the Budget and Economic Policy).