



GARRIGUES

Enforcement practices for PVRs in the EU

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COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

General provisions

- **UPOV Convention** (Union for the Protection of New Varieties of Plants).
- **Council Regulation (EC) No 2100/94** of 27 July 1994 on Community plant variety rights (Regulation 2100/94).
- **Uniform effect of Community plant variety rights** (Art. 2): Community plant variety rights shall have uniform effect within the territory of the Community and may not be granted, transferred or terminated in respect of the abovementioned territory otherwise than on a uniform basis.
- **National property rights for plant varieties** (Art. 3): This Regulation shall be without prejudice to the right of the Member States to grant national property rights for plant varieties.
 - **Watch out!** Cumulative protection is prohibited (art. 92):
 - Any variety which is the subject matter of a Community plant variety right shall not be the subject of a national plant variety right or any patent for that variety.
 - Where the holder has been granted another right as referred to in the abovementioned paragraph for the same variety prior to grant of the Community plant variety right, he shall be unable to invoke the rights conferred by such protection for the variety for as long as the Community plant variety right remains effective.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Conditions governing the grant of Community PVRs

- **Object of Community PVRs** (Art. 5): Varieties of all botanical genera and species, including, inter alia, hybrids between genera or species, may form the object of Community plant variety rights.
- **'Variety'** shall be taken to mean a plant grouping within a single botanical taxon of the lowest known rank, which grouping, irrespective of whether the conditions for the grant of a plant variety right are fully met, can be:
 - defined by the expression of the characteristics that results from a given genotype or combination of genotypes,
 - distinguished from any other plant grouping by the expression of at least one of the said characteristics, and
 - considered as a unit with regard to its suitability for being propagated unchanged.
- A plant grouping consists of entire plants or parts of plants as far as such parts are capable of producing entire plants, both referred to hereinafter as **'variety constituents'**.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Conditions governing the grant of Community PVRs

❖ Certain aspects of the definition of variety:

(i) Plant grouping within a single botanical taxon of the lowest known rank

- A variety may not, for example, consist of plants of more than one species.
- The definition that a variety means a “plant grouping” clarifies that the following, for example, do not correspond to the definition of a variety:
 - a single plant; (however, an existing variety may be represented by a single plant or part(s) of a plant, provided that such a plant or part(s) of the plant could be used to propagate the variety);
 - a trait (e.g. disease resistance, flower color);
 - a chemical or other substance (e.g. oil, DNA); and
 - a plant breeding technology (e.g. tissue culture).

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Conditions governing the grant of Community PVRs

❖ Certain aspects of the definition of variety:

(ii) Irrespective of whether the conditions for the grant of a breeder's right are fully met

- The definition of a “variety” is wider than “protectable variety”.
- Varieties of common knowledge which are not protected may, nevertheless, still be varieties which correspond to the definition of variety.
- In general, the authorities do not examine whether a “candidate variety” corresponds to the definition of a variety. Authorities are required to examine whether the application for a breeder's right meets the requirements for the grant of a breeder's right including, in particular, whether the candidate variety is distinct, uniform and stable (DUS). A variety which fulfills the DUS criteria will meet the definition of variety.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Conditions governing the grant of Community PVRs

❖ Certain aspects of the definition of variety:

(iii) Defined by the expression of characteristics resulting from a given genotype or combination of genotypes

- The notion of “combination of genotypes” covers, for example, synthetic varieties and hybrids.

(iv) Considered as a unit with regard to its suitability for being propagated unchanged

- The UPOV Convention does not limit the means by which a variety can be propagated unchanged:
 - In the case of some varieties, such as vegetatively propagated, self-pollinated and some cross-pollinated varieties, a variety may be propagated unchanged from the plants of the variety itself.
 - In the case of some other varieties, for example hybrids and synthetic varieties, the variety may be propagated unchanged by a cycle of propagation that may involve plants other than those of the variety. Such a cycle of propagation may involve a simple cross of two parent lines (e.g. simple hybrid), or may involve a more complex cycle of propagation (e.g. three-way hybrids, synthetic varieties etc.).

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Conditions governing the grant of Community PVRs

- **Protectable varieties** (Art. 6): Community plant variety rights shall be granted for varieties that are:
 - a) distinct;
 - b) uniform;
 - c) stable; and
 - d) new.

- **Distinctness** (Art. 7): A variety shall be deemed to be distinct if it is clearly distinguishable by reference to the expression of the characteristics that results from a particular genotype or combination of genotypes, from any other variety whose existence is a matter of common knowledge on the date of application determined (whether it was the object of a plant variety right or entered in an official register of plant varieties or an application for the granting was file).

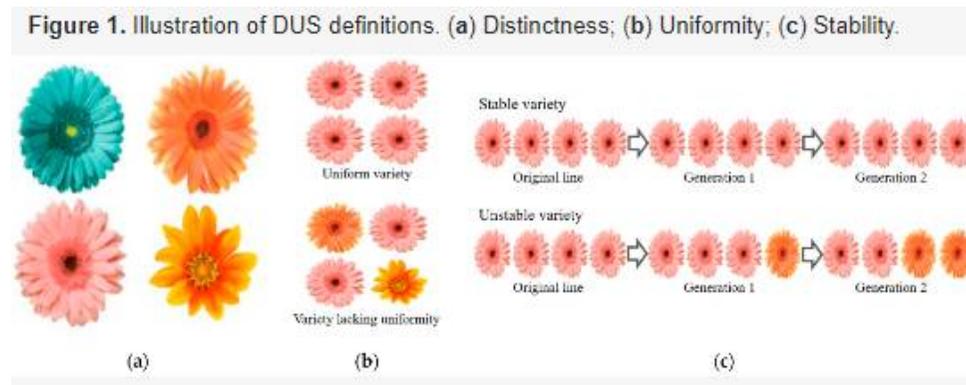
Apart from morphological characteristics, for instance colour or shape, the distinctness could be based on physiological characteristics such as disease resistance.

To assess this requirement, candidate varieties have to be compared with existing varieties, the characteristics of which are close to those of the candidate.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Conditions governing the grant of Community PVRs

- **Uniformity** (Art. 8): A variety shall be deemed to be uniform if, subject to the variation that may be expected from the particular features of its propagation, it is sufficiently uniform in the expression of those characteristics which are included in the examination for distinctness, as well as any others used for the variety description.
- **Stability** (Art. 9): A variety shall be deemed to be stable if the expression of the characteristics which are included in the examination for distinctness as well as any others used for the variety description, remain unchanged after repeated propagation or, in the case of a particular cycle of propagation, at the end of each such cycle.



<https://www.mdpi.com/2073-4425/12/8/1127/html>

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Conditions governing the grant of Community PVRs

- **Novelty** (Art. 10): A variety shall be deemed to be new if, at the date of application determined, variety constituents or harvested material of the variety have not been sold or otherwise disposed of to others, by or with the consent of the breeder, for purposes of exploitation of the variety:
 - a. earlier than one year before the abovementioned date, within the territory of the Community;
 - b. earlier than four years or, in the case of trees or of vines, earlier than six years before the said date, outside the territory of the Community.

Novelty has nothing to do with the characteristics of the candidate variety. It is a notion linked to its commercial history.



COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Entitlement to Community PVRs

- **Persons entitled** (Art. 11): The person who **bred**, or **discovered and developed** the variety, or his successor in title.
 - If two or more persons bred, or discovered and developed the variety jointly, entitlement shall be vested jointly in them or their respective successors in title.
 - Entitlement shall also be invested jointly in the breeder and any other person, if the breeder and the other person have agreed to joint entitlement by written declaration.
 - If the breeder is an employee, the entitlement to the Community plant variety right shall be determined in accordance with the national law applicable to the employment relationship in the context of which the variety was bred, or discovered and developed.

- **Entitlement to file an application** (Art. 12): An application may be filed by any natural or legal person, or any body ranking as a legal person under the law applicable to that body, provided they are:
 - a) nationals of one of the Member States or nationals of a member of the UPOV, or are domiciled or have their seat or an establishment in such a State;
 - b) nationals of any other State who do not meet the requirements laid down in (a) in respect of domicile, seat or establishment, in so far as the Commission, after obtaining the opinion of the Administrative Council referred to in Article 36, has so decided.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Rights of the holder of a Community PVR and prohibited acts

- **Rights of the holder** (Art. 13.2): The following acts in respect of **variety constituents**, or **harvested material** of the protected variety, shall require the authorization of the holder:
 - a) **production or reproduction** (multiplication);
 - b) conditioning for the purpose of propagation;
 - c) offering for sale;
 - d) selling or other marketing;
 - e) exporting from the Community;
 - f) importing to the Community;
 - g) stocking for any of the purposes mentioned in (a) to (f).

- Art. 13.3: These provisions shall apply in respect of **harvested material** **only** if this was obtained through the unauthorized use of variety constituents of the protected variety, and unless the holder has had reasonable opportunity to exercise his right in relation to the said variety constituents.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

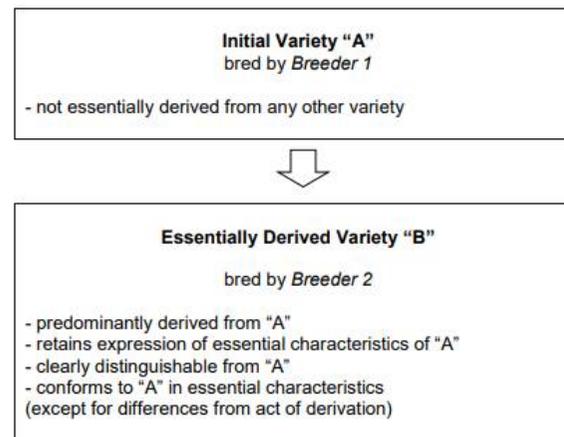
Derogation from Community PVR: Farmers' privilege

- **Farmers' privilege** (Art. 14): Notwithstanding Article 13.2, and for the purposes of safeguarding agricultural production, **farmers are authorized to use for propagating purposes in the field, on their own holding, the product of the harvest** which they have obtained by planting, on their own holding, propagating material of a variety other than a hybrid or synthetic variety, which is covered by a Community plant variety right.
- The provisions of this farmers' privilege shall only apply to agricultural plant species of fodder plants, cereals, potatoes and oil and fibre plants.
- Conditions to give effect to the 'farmers' privilege' are, *inter alia*: (*vid.* Commission Regulation (EC) No 1768/95 of 24 July 1995 implementing rules on the agricultural exemption)
 - Small farmers shall not be required to pay any remuneration to the holder.
 - Other farmers shall be required to pay an equitable remuneration to the holder, which shall be sensibly lower than the amount charged for the licensed production of propagating material of the same variety in the same area.
 - Relevant information shall be provided to the holders on their request, by farmers and by suppliers of processing services (CJEU solved several cases concerning the scope of these information rights; *vgr.* Schulin case C-305/00 and Brangewitz case C-336/02).

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Derogation from Community PVR: Essentially derived varieties

- **Essentially derived variety** (Art. 13.6): A variety shall be deemed to be essentially derived from another variety, referred to hereinafter as ‘the initial variety’ when:
 - a. it is **predominantly derived from the initial variety**, or from a variety that is itself predominantly derived from the initial variety;
 - b. it is **distinct** in accordance with the provisions of Article 7 **from the initial variety**; and
 - c. except for the differences which result from the act of derivation, **it conforms essentially to the initial variety** in the expression of the characteristics that results from the **genotype or combination of genotypes** of the initial variety.



COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Derogation from Community PVR: Essentially derived varieties

❖ Certain aspects of the definition of essentially derived variety:

(i) Predominantly derived from the initial variety

- The requirement of predominant derivation from an initial variety means that a variety can only be essentially derived from one initial variety.
- The intention is that a variety should only be essentially derived from another variety when it retains virtually the whole genotype of the other variety.
- The phrase “while retaining the expression of the essential characteristics” requires that the expression of the essential characteristics conforms to and be derived from the initial variety.
- “Essential characteristics”: heritable traits that are determined by the expression of one or more genes, or other heritable determinants; morphological, physiological, agronomic, industrial and biochemical characteristics; etc.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Derogation from Community PVR: Essentially derived varieties

❖ Certain aspects of the definition of essentially derived variety:

(ii) Clearly distinguishable from the initial variety

- Essential derivation is concerned only with varieties that are clearly distinguishable, in accordance with Article 7, from the initial variety and which are accordingly protectable.

(iii) Conformity with the initial variety in the expression of the essential characteristics

- A judgment on the question on the degree of conformity must be reached on the basis of the essential characteristics which result from the genotype of the initial variety.
- The derived variety must retain almost the totality of the genotype of the initial variety and be different from that variety by a very limited number of characteristics.

COMMUNITY PLANT VARIETY RIGHTS: LEGAL FRAMEWORK

Exhaustion of Community PVRs

- **Exhaustion** (Art. 16): The Community plant variety right shall not extend to acts concerning any material of the protected variety, or of a variety covered by the provisions of Article 13.5, which has been disposed of to others by the holder or with his consent, in any part of the Community, or any material derived from the said material, **unless such acts:**
 - a) involve further propagation of the variety in question, **except where such propagation was intended** when the material was disposed of; or
 - b) involve an export of variety constituents into a third country which does not protect varieties of the plant genus or species to which the variety belongs, except where the exported materials is for final consumption purposes.





ENFORCEMENT TOOLS AVAILABLE TO PBR TITLE-HOLDERS

ENFORCEMENT TOOLS AVAILABLE TO PBR TITLE-HOLDERS

Infringement, provisional protection and statute of limitation

- **Infringement** (Art. 94): Whosoever effects one of the acts set out in Article 13 (2) without being entitled to do so, in respect of a variety for which a Community plant variety right has been granted (...) may be sued by the holder to enjoin such infringement or to pay reasonable compensation or both.
- **Provisional protection - acts prior to grant of Community PVRs** (Art. 95): The holder may require reasonable compensation from any person who has, in the time between publication of the application for a Community plant variety right and grant thereof, effected an act that he would be prohibited from performing subsequent thereto.
- **Statute of limitation** (Art. 96): Claims pursuant to Articles 94 and 95 shall be time barred after three years from the time at which the Community plant variety right has finally been granted **and** the holder has knowledge of the act and of the identity of the party liable or, in the absence of such knowledge, after 30 years from the termination of the act concerned.

ENFORCEMENT TOOLS AVAILABLE TO PBR TITLE-HOLDERS

Directive 2004/48/EC on the enforcement of intellectual property rights

- **General obligation** (Art. 3): Member States shall provide for the measures, procedures and remedies necessary to ensure the **enforcement** of the intellectual property rights covered by this Directive. Those measures, procedures and remedies shall be **fair and equitable** and shall not be unnecessarily complicated or costly, or entail unreasonable time-limits or unwarranted delays. Those measures, procedures and remedies shall also be **effective, proportionate and dissuasive** and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse.
- **Evidence** (Art. 6): Member States shall ensure that, on application by a party which has presented reasonably available evidence sufficient to support its claims, and has, in substantiating those claims, specified evidence which lies in the control of the opposing party, the competent judicial authorities may **order that such evidence be presented** by the opposing party, subject to the protection of confidential information.
- **Measures for preserving evidence** (Art. 7): Member States shall ensure that, even before the commencement of proceedings on the merits of the case, the competent judicial authorities may, on application by a party who has presented reasonably available evidence to support his claims that his intellectual property right has been infringed or is about to be infringed, **order prompt and effective provisional measures to preserve relevant evidence** in respect of the alleged infringement, subject to the protection of confidential information.

ENFORCEMENT TOOLS AVAILABLE TO PBR TITLE-HOLDERS

Directive 2004/48/EC on the enforcement of intellectual property rights

- **Right of information** (Art. 8): Member States shall ensure that, in the context of proceedings concerning an infringement of an intellectual property right and in response to a justified and proportionate request of the claimant, the competent judicial authorities may order that information on the origin and distribution networks of the goods or services which infringe an intellectual property right be provided by the infringer and/or any other person who was found in possession of/be using/be providing the infringing goods or services used in infringing activities.
- **Provisional and precautionary measures** (Art. 9): Member States shall ensure that the judicial authorities may, at the request of the applicant: (a) issue against the alleged infringer an interlocutory injunction intended to prevent any imminent infringement of an intellectual property right, or to forbid, on a provisional basis and subject, where appropriate, to a recurring penalty payment where provided for by national law, the continuation of the alleged infringements of that right, or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the rightholder; (b) order the seizure or delivery up of the goods suspected of infringing an intellectual property right so as to prevent their entry into or movement within the channels of commerce.
- **Corrective measures** (Art. 10): Without prejudice to any damages due to the rightholder by reason of the infringement, and without compensation of any sort, Member States shall ensure that the competent judicial authorities may order, at the request of the applicant, that appropriate measures be taken with regard to goods that they have found to be infringing an intellectual property right.

ENFORCEMENT TOOLS AVAILABLE TO PBR TITLE-HOLDERS

Directive 2004/48/EC on the enforcement of intellectual property rights

- **Injunctions** (Art. 11): Member States shall ensure that, where a judicial decision is taken finding an infringement of an intellectual property right, the judicial authorities may issue against the infringer an injunction aimed at prohibiting the continuation of the infringement. Where provided for by national law, non-compliance with an injunction shall, where appropriate, be subject to a recurring penalty payment, with a view to ensuring compliance.
- **Damages** (Art. 13): Member States shall ensure that the competent judicial authorities, on application of the injured party, order the infringer who knowingly, or with reasonable grounds to know, engaged in an infringing activity, to pay the rightholder damages appropriate to the actual prejudice suffered by him as a result of the infringement.
- **Publication of judicial decisions** (Art. 15): Member States shall ensure that, in legal proceedings instituted for infringement of an intellectual property right, the judicial authorities may order, at the request of the applicant and at the expense of the infringer, appropriate measures for the dissemination of the information concerning the decision, including displaying the decision and publishing it in full or in part. Member States may provide for other additional publicity measures which are appropriate to the particular circumstances, including prominent advertising.



**PVRs ENFORCEMENT WITH
REFERENCE TO EU CASE-LAW**

PVRs enforcement with reference to EU case-law

Scope of the breeder's right

▪ NADORCOTT CASE (C-176/18): MAIN FACTS

1

Key milestones on Nadorcott's protection

- **August, 22nd 1995:** Nadorcott variety submitted for plant variety protection before the Community Plant Variety Office (CPVO). The application was published on **February, 26th 1996**.
- **February, 15th 2006:** The CPVO definitively granted a Community plant variety right in respect of the mandarin tree variety Nadorcott, following an appeal with suspensive effect that was brought against the first decision on its grant (decision which took place on October, 4th 2004 and was published on December, 15th 2004).

2

Acts undertaken by the defendant

- **2005:** The defendant (allegedly) acquired plants of the Nadorcott variety from a nursery (provisional protection period).
- **2005 and 2006:** Some of the referred plants were (allegedly) planted in the spring of 2005 (provisional protection period) and others in the spring of 2006 (definitive protection period) and in subsequent years.

3

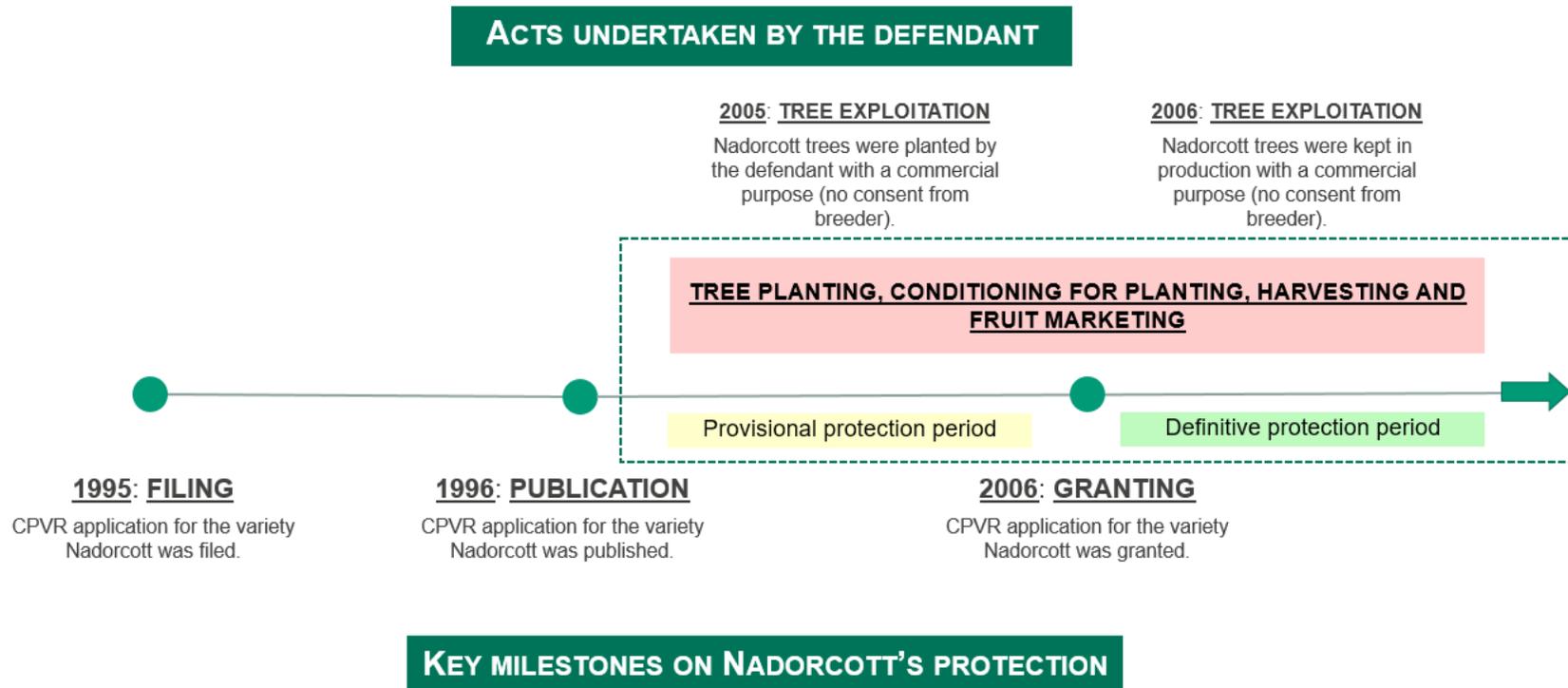
Claim brought by CVVP

- CVVP brought different legal actions against the defendant in respect of the acts undertaken by him (tree planting, conditioning for production, harvesting and fruit marketing) **prior to the granting of the Nadorcott variety protection** (art. 95 of Regulation 2100/94) **and after that date** (art. 94 of Regulation 2100/94):
 - Cessation of all those acts, including marketing of the fruit obtained from the trees of that variety, and compensation for the damage suffered as a result of the acts undertaken by the defendant both during and after the provisional protection period (depending on the different rights attached to each period).

PVRs enforcement with reference to EU case-law

Scope of the breeder's right

▪ NADORCOTT CASE (C-176/18): TIMELINE



PVRs enforcement with reference to EU case-law

Scope of the breeder's right

▪ NADORCOTT CASE (C-176/18): CJEU'S DECISION (RESTATEMENT OF INFRINGEMENTS)

- According to the Court:
 - The words '*production*' and '*reproduction*' used in Article 13.2 a) of Regulation 2100/94 refer to acts by which new variety constituents are generated (new individuals). [Para. 26 CJEU].
 - The harvested fruit might **only** be liable to be considered as propagating material for plants of that variety **if** the fruit itself can be used for further reproduction / multiplication. [Footnote 21 GA].
 - Consequently, the planting of Nadorcott variety and the harvesting of the fruits from plants of that variety may not be regarded as an 'act of production or reproduction (multiplication)' of variety constituents within the meaning of Article 13.2 a) of Regulation No 2100/94. [Para. 29 CJEU].
- The CJEU completely departed from the unanimous jurisprudence of the Spanish jurisdiction and now limits the list of infringements that Spanish case-law so far admitted in relation to plant breeders' rights.
- In particular, the thesis sustained by Spanish Courts for more than a decade does not longer apply; therefore, '*keeping the plants in production*' (when they were planted before the protection granting and kept in production after such granting) is no longer an infringement.

PVRs enforcement with reference to EU case-law

Scope of the breeder's right

▪ NADORCOTT CASE (C-176/18): CONSEQUENCES

- Breeders will have to seriously reconsider whether to bring a variety on the market before its granting, since there are very small incentives for them to commercialize it during the provisional protection period –it may be counterproductive and such period might be really long–.
- In case they do so, licensed growers are unlikely to get a real advantage if the market is flooded with fruit obtained from non-licensed growers.
- This is particularly relevant in plant varieties like fruit trees since the reproduction material usually has a really long life (the trees keep producing harvested material for decades) and the harvested material (the fruit itself) concentrates the added value.
- The impact that the consolidation of such an interpretation might be highly counterproductive to the legal-economic system and will materially inhibit the early introduction of new and improved varieties –the development of which requires a great deal of effort, investment and years of testing– on the market, to the detriment of all those who participate in and benefit from the agricultural production chain.
- Not only the plant breeder's ordinary expectations may disappear (those based on a solid IP Law right), but also the economic interests of producers, traders and consumers may be seriously undermined.

PVRs enforcement with reference to EU case-law

Scope of the breeder's right

THE PLANT BREEDER HAS NEVER CONSENTED TO OR KNOWN OF ANY SUCH ACTS

Acts undertaken before the granting (provisional protection period)

Acts undertaken after the granting (definitive protection period)

a) Multiplication by the nursery; planting, crop and fruit marketing by the grower:

-  
 - Impossibility to act against grower, not even reasonable compensation.
-   
 - The breeder can never act against the trees or the fruit.
 - It can only be claimed reasonable compensation from the nursery (50% royalty in Spanish *case-law*) but, in practice, it is very difficult to find out which nursery carried out multiplication acts.

b) Grafting (multiplication), crop and fruit marketing by the grower:

- 
 - It can only be claimed reasonable compensation from the farmer (50% royalty)
-   
 - The breeder can never act against the trees or the fruit.

a) Multiplication by the nursery; planting, crop and fruit marketing by the grower:

-  
 - Impossibility to claim compensation from the grower.
-  
 - The breeder will not be able to act against the trees, but will be able to act against the fruit if he can prove that:
 - ✓ The trees have been multiplied after the grant without his consent.
 - ✓ He has had no reasonable opportunity to act against the trees.
-  
 - Bringing actions concerning the fruit in each campaign??

b) Grafting (multiplication), crop and fruit marketing by the grower:

-  
 - The only scenario in which *Ius Prohibendi* can be fully exercised: Compensation against the grower and action against the trees.
-  
 - Action against the fruit?

PVRs enforcement with reference to EU case-law

Exhaustion of Community PVRs

▪ KANZI CASE (C-140/10).

1

Facts

- Nicolaï is the breeder of the apple variety Nicoter (marketed under the Kanzi brand: quality criteria).
- To avoid alteration of the quality of the variety and of the brand: system equivalent to a selective distribution network (restrictions on the production of the tree and the production, conservation, selection and marketing of the fruit).
- Nicolaï assigns to Better3fruit the ownership of the PVR and Better3fruit grants to Nicolaï an exclusive license.
 - It was stated therein that Nicolaï "*shall not transfer or sell any licensed product unless the counterparty in question first subscribes in writing to the cultivation license (annex 6) or the marketing license (annex 7).*"
- Nicolaï sells 7,000 apple trees to Mr. Hustin, without observing the above commitment, and the latter supplies them to Mr. Goosens.

2

Normative
Ref. 30

- Recital 14 of Regulation 2100/94: "*(...) the introduction of the principle of exhaustion of rights must ensure that the protection is not excessive*".
- Art. 27 of Regulation 2100/94: "*The holder may invoke the rights conferred by the Community plant variety right against a person enjoying the right of exploitation who contravenes any of the conditions or limitations attached to his exploitation right*".

PVRs enforcement with reference to EU case-law

Exhaustion of Community PVRs

▪ KANZI CASE (C-140/10).

- Art. 104 of Regulation 2100/94: "*Actions for infringement may be brought by the holder. Persons enjoying exploitation rights may bring such actions unless that has been expressly excluded by agreement with the holder in the case of an exclusive exploitation right or by the Office pursuant to Articles 29 or 100 (2)*".
- The license contained conditions or restrictions according to which Nicolai did not have the right to assign any licensed product without the third party involved undertaking to respect such conditions or restrictions.
- The infringement of any clause of the license agreement cannot always result in the lack of the holder's consent. In particular, consent cannot be considered to be lacking where the licensee breaches a provision of the license agreement that does not affect the consent to commercialization and thus also does not affect the exhaustion of the right of the owner.
- However, in the COPAD case (C-59/08), it was stated that the license agreement does not amount to an absolute and unconditional consent of the trademark holder for the licensee to market the products of this trademark.

PVRs enforcement with reference to EU case-law

Exhaustion of Community PVRs

▪ KANZI CASE (C-140/10).

- Article 27.2 of Regulation 2100/94 expressly makes it possible for the holder to invoke the rights conferred by such protection against a person who holds an exploitation license when the latter infringes any of the clauses of the license contract.
- If the referring court were to find that the protected material was transferred by the licensee in violation of a condition or restriction contained in the license contract and referring directly to the essential elements of the Community PVR, it would have to be concluded that such transfer of the material by the licensee to a third party took place without the consent of the holder, so that the right of the latter has not been exhausted.
 - On the other hand, the violation of any other contractual provisions in the license contract does not prevent the exhaustion of the right of the holder.
 - The Commission held that those inherent conditions whose violation would prevent exhaustion would be those relating to the acts described in 13.2 of Regulation 2100/94.

PVRs enforcement with reference to EU case-law

Statute of limitation

- JOSÉ CÁNOVAS PARDO CASE (C-186/18).

- Three interpretations have been proposed to the Court to enable it to answer the questions put to it.

- ✗ – **Time bar in full:** The first interpretation posits that, in such a situation, the limitation period laid down in Article 96 of Regulation 2100/94 covers the holder's actions, provided for in Articles 94 and 95 of that regulation, *in their entirety*, irrespective of the date of the infringing acts. Since the holder had knowledge of both the acts at issue and the identity of the party liable for them for more than three years, it forfeits all possibility of asserting its rights with regard to them.
- ✓ – **Time bar in part:** Under the second interpretation, actions brought by the holder are *time-barred in part* only. The effects of limitation apply only to acts committed more than three years before the actions provided for in Articles 94 and 95 of Regulation 2100/94 were brought.
- ✗ – **No time bar (*ongoing infringement doctrine*):** Under the third interpretation, the actions provided for in Articles 94 and 95 of Regulation 2100/94 are *not time-barred at all*, in the light of the fact that the infringement carried out in breach of the holder's rights were ongoing when those actions were initiated. The holder would be entitled to assert its rights with regard to all the acts at issue where the party liable for them (Pardo in the main proceedings) has not brought them to an end. That, in essence, is the view taken by the company Club de Variedades Vegetales Protegidas.

PVRs enforcement with reference to EU case-law

Statute of limitation

▪ JOSÉ CÁNOVAS PARDO CASE (C-186/18).

- The starting point or *dies a quo* is the date on which two conditions are met: (i) the Community PVR is granted; and (ii) the holder becomes aware of the act and of the identity of the party liable for it; and cannot be made conditional on the acts at issue having come to an end.
- Article 96 of Regulation 2100/94 must be interpreted as meaning that the three-year period starts to run either when the Community right is granted or when the holder becomes aware of the act and of the identity of the party liable for it, whichever occurs last, irrespective of the date on which the acts may have ceased.
- The wording of Article 96 of Regulation 2100/94 contains no reference or even allusion to the notions of duration of the infringement or of the ongoing nature of the act of infringement. [Para. 33 CJEU].
- Such an interpretation is supported by the legislative scheme of which Article 96 of Regulation 2100/94 is part:
 - Claims pursuant to Articles 94 and 95 of that regulation are brought, *inter alia*, in respect of the acts referred to in Article 13(2) thereof. Article 13(2) of the regulation relates to individually identified acts, so that the fact that an act may be ongoing is not conclusive for the purposes of setting the point from which time starts to run in respect of the period laid down in Article 96 of the regulation.

PVRs enforcement with reference to EU case-law

Statute of limitation

▪ JOSÉ CÁNOVAS PARDO CASE (C-186/18).

- Where the holder has allowed the three-year limitation period to expire, does it forfeit *in full* the right to require payment of reasonable compensation and/or compensation for damage in respect of past acts or does it retain that right in respect of the most recent acts, namely those committed during the last three years?
- Article 96 of Regulation 2100/94 provides for the time bar of an ‘act’, not the time bar of conduct conceived as a ‘set of acts’. The use of the singular suggests that, for the purposes of applying this article, acts infringing the holder’s rights should be considered *separately*.
- German, French and Belgian legal literature, among others, make clear that a patent infringement must be regarded as a ‘*series of infringements*’ and not as a ‘*continuing infringement*’.
- Article 96 of Regulation 2100/94 must be interpreted as meaning that, where the three-year period has expired as regards acts repeated over time, only acts committed more than three years before the actions provided for in Articles 94 and 95 of that Regulation were brought are time-barred. [Para. 80 GA]. Therefore, the holder retains the right to bring those actions in respect of acts committed during the last three years. [Para. 81 GA].

PVRs enforcement with reference to EU case-law

Statute of limitation

- **JOSÉ CÁNOVAS PARDO CASE (C-186/18).**
 - Any interpretation to the contrary of Article 96 of Regulation No 2100/94, according to which the end of the three-year period laid down in that provision were to result in the prescription of all acts of infringement of the holder's rights, as maintained by Pardo in its written observations, would run counter to the objective of that provision.
 - Rules of prescription can refer only to claims in respect of acts which took place in the past and not those which could be undertaken in the future:
 - If claims pursuant to Articles 94 and 95 of Regulation 2100/94 were required to be declared time barred on the ground that that those relating to the 'initial act' at the source of the infringing course of action, the holder's Community plant variety right would be meaningless in respect of acts of infringement taking place after the period of prescription applicable to that initial act had elapsed.



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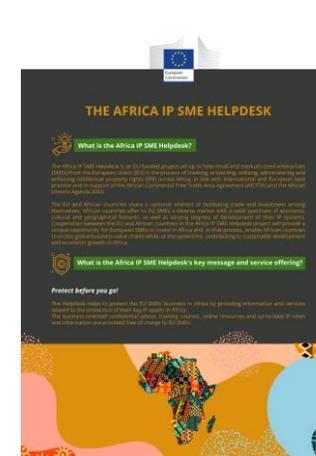
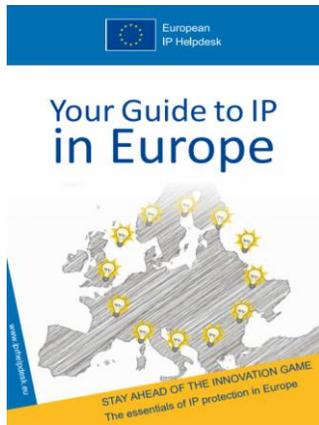


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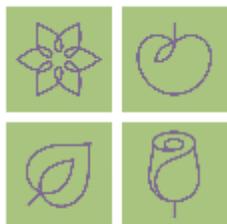


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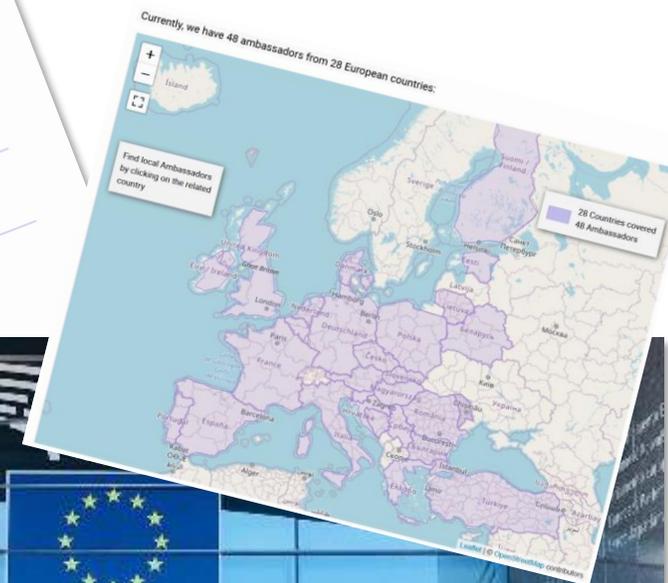


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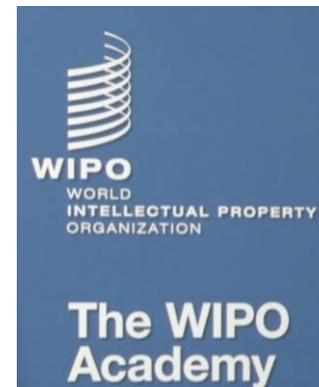
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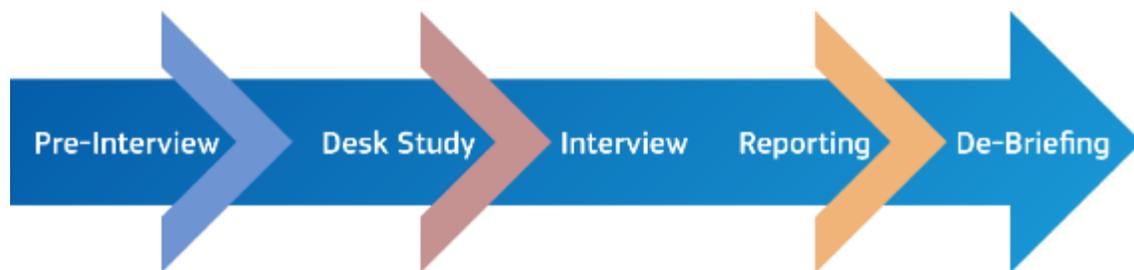
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