

The **i**NTERPATENT newsletter



LET'S MEET IN STOCKHOLM!

We are delighted to announce that, as Member of the *International Trade Mark Law and Practice Team*, **Manuela Bruscolini** will attend the **38th MARQUES Annual Conference in Stockholm from 24 to 27 September**, a unique networking opportunity to connect with brand professionals and industries from Europe and across the globe.

This year's Annual Conference sessions will cover diverse topics including: litigation and public opinion; working in areas outside your comfort zone; understanding local traditions; navigating consumer values; successful online enforcement; how to demonstrate market realities before EUIPO; visual disclaimers in designs; and the latest EU case law on trade marks and designs.

There will also be workshops on artificial intelligence, trade secrets, co-branding, copyright in IP enforcement and amicus curiae briefs.

Manuela will be happy to discuss the most recent developments in Intellectual Property in Italy and in Europe as well as explore ways to build or consolidate cooperation with colleagues and associates from all over the world and she is very much looking forward to connecting with old and new IP friends.

For a possible meeting please contact [Manuela Bruscolini](mailto:m.bruscolini@interpatent.com) at m.bruscolini@interpatent.com.

In the meantime, safe travels to you all!

ITALIAN 'VOUCHER 3i' - ALSO OPEN TO EU AND EEA COMPANIES - HELPS START-UPS AND MICROENTERPRISES TO PROTECT THEIR INVENTIONS

With decree dated 8 August 2024 published on 4 September 2024, the Ministry of Enterprises and Made in Italy enacted a new edition of the so-called 'Voucher 3i - Investing in Innovation' fund aimed at supporting innovation of start-ups and microenterprises by financing the purchase of consultancy services for patenting.

For a total amount available of **9 million euro**, these services include:

- a) *prior art searches and patentability assessment* (1,000.00 euro per voucher),
- b) *drafting of a patent application and filing thereof at the Italian Patent and Trademark Office* (3,000.00 euro per voucher), and

c) extension of an Italian patent application abroad (4,000.00 euro per voucher).

Voucher 3i is part of a larger initiative by the Italian government contained in Law 206/2023 effective 11 January 2024 (the so-called **Made in Italy Act**) and introducing measures intended for stimulating the growth of national strategic supply chains, fighting infringement and establishing new skills related to 'Made in Italy'.

The procedural aspects of Voucher 3i will be defined in a separate decree still to be enacted by the Ministry of Enterprises and Made in Italy.

Already at this stage, however, it is interesting to note that entitled to benefit from the financial incentives of Voucher 3i are not only Italian resident start-ups and microenterprises, but also **start-ups and microenterprises residing in any of the EU**

Member States or countries belonging to the European Economic Area (EEA), provided that they have a production site or branch in Italy.

Each applicant start-up or microenterprise is allowed to apply for and obtain **only one voucher for only one of the services listed above**, and also on condition that they did not obtain any previous Voucher 3i within the period 2019-2021.

Our patent attorneys at Interpatent will be glad to provide you with more detailed information as to the full criteria for eligibility for this benefit.



EUIPO SME FUND – VOUCHER 1 (IP SCAN), VOUCHER 2 (TRADEMARKS & DESIGNS) AND VOUCHER 3 (PATENTS) ARE BACK!

Just a brief note to inform you that on 16 September the EUIPO reopened Voucher 1, Voucher 2 and Voucher 3 of the **SME Fund 'Ideas Powered for Business'**, which had been temporarily closed due to exhaustion of funds.

Here is a brief summary of the four SME Fund Vouchers:

- **Voucher 1: IP Scan** – maximum amount 1,350 euro per beneficiary – **cannot be used for Italy** as the Italian Patent and Trademark Office does not provide this service
- **Voucher 2: Trademarks and Designs** – maximum amount 1,000 euro per beneficiary
- **Voucher 3: Patents** – maximum amount 3,500 euro per beneficiary for patent applications before IP

offices of EU Member States and 2,000 euro per beneficiary for European patent applications

- **Voucher 4: Community Plant Varieties** – maximum amount 1,500 euro per beneficiary

The above Vouchers can be requested by any small or medium-sized enterprises (SMEs) established in one of the EU Member States or in Ukraine, in territories that are under the effective control of the Ukrainian government at the time the voucher request is submitted.

Our staff at Interpatent are available for any more information about the activities covered by the Vouchers as well as for any further assistance you may need in this respect.

SOUR GRAPES: THE IMPACT OF FRUIT MARKETING ON THE NOVELTY REQUIREMENT OF PLANT VARIETY PATENTS

A decision issued by the Court of Bari on 1 August 2024 has stressed a key principle of **plant variety protection**, namely that of the **novelty requirement**.

In this respect, it is worth remembering that unlike

invention patents, where absolute novelty is required (i.e. the invention is new if it is not comprised in the state of the art), a plant variety in order to be deemed new **must not have been commercially exploited before the relevant grace period**.



In 2018, the US company Sun World International LLC (hereinafter 'Sun World'), one of the largest and oldest breeders and sellers of fruit, and particularly grapevine, sued Gianni Stea Import-Export s.r.l. (hereinafter 'Gianni Stea'), an Italian company of the Puglia Region, for infringement of their Italian patent No. 1138 - applied for in 1983 and granted in 1994 and concerning the table seedless grape variety named 'Sugraone' - and infringement of their trade mark 'Superior Seedless' as well as for unfair competition.

Gianni Stea appeared in court, contested Sun World's claims as unfounded, requested that a third party be sued as sole liable for the matter at issue, and by way of counterclaim requested that a) the patent in question be declared invalid as lacking the requirement of novelty, b) the trade mark 'Superior Seedless' be declared lacking any distinctive character, c) Sun World be held liable for emulative conduct towards Gianni Stea, abuse of dominant position and other anti-competitive practices to be ascertained during the proceedings, and d) order Sun World to pay compensation for the pecuniary and non-pecuniary damages suffered and to be suffered by Gianni Stea.

Invalidity of the patent was requested by Gianni Stea on the basis that Sun World had been growing the 'Sugraone' variety in California and selling fruits thereof long before the beginning of the grace period allowed by law.

First of all, the Court of Bari identified Italian Presidential Decree No. 974/1975 as the legislative basis for ruling, which decree states in respect of novelty that *"Prior to the filing of the patent application, the plant variety must not, with the agreement of the breeder or his successor in title, have been the subject of commercial acts in Italy, nor, for more than four years, in any other State"* (Art. 1(3)) and *"[...] the fact that a new plant variety*

has been the subject of cultivation trials or has been entered, or has been presented for registration, in an official register may not be opposed to the breeder of the variety or his successor in title".

According to the plaintiff, the abovementioned 'commercial acts' capable of destroying novelty refer only to the commercialization of the propagation material of the variety and not to any other material from the plant, in particular, its fruits.

The Court, instead, considered that the grace period of four years for exploitation abroad which was allowed by the UPOV Convention to the breeder at that time (now extended to six years for trees and vines according to Art. 103 of the Italian IP Code currently in force) to carry out field tests in order to assess other requirements for patenting, namely stability and homogeneity, is intended to verify the quality of the fruits that are the very essence of the invented plant variety, which fruits can also be sold (and therefore monetised) during said grace period without the breeder suffering any prejudice for future patenting.

Therefore, **if the breeder makes a profit from exploiting a variety before patenting it and outside the grace period** referred to above, **by commercialising the propagation material or the fruits of the variety, or both, the novelty requirement is not met.**

Acknowledging that marketing of the fruits of the plant falls within those commercial acts that are detrimental to novelty is an important aspect to prevent abusive conduct and speculation by breeders who, after many years of marketing the product of a new variety abroad without commercialising the reproductive material thereof, could still obtain a patent for said variety in any country member to the UPOV Convention.

Of course, **the boundary between cultivation intended for crop trials and cultivation intended for fruit sale lies in the extent of the cultivation**, as cultivation intended for field trials and selection would involve limited cultivation areas and therefore limited quantities of fruits that can be produced and marketed.

In the case in question, from the official technical consultancy (OTC) requested by the Court it resulted that the marketing of grapes of the 'Sugraone' variety dates back to 1975 (i.e. much earlier than the opening of the four-year grace period on 14.09.1979) and that the quantity (acres) of cultivation in California are so significant that they cannot certainly be attributed to crop trials, let alone for a single variety.

Also, the fact that, in a past case held before the

EUIPO's Board of Appeal, Sun World itself, in the person of its Senior Vice President, stated that the mark 'Superior Seedless' used to distinguish the 'Sugraone' grape variety had acquired distinctive character as from 1975 proved that this variety was indeed being marketed already in 1975.

For the above reasons, the Court of Bari declared the invalidity of Italian Patent No. 1388 granted to Sun World International LLC on 13.12.1994 on an application filed on 14.09.1983.

All the remaining claims by Sun World and counterclaims by Gianni Stea, which are not handled in detail here, were dismissed.

This articulated decision sets boundaries to the power of big foreign multinationals and rejects conditions that would jeopardise the freedom of small entrepreneurs to cultivate and market their varieties and thus reduce their income.

ROMANIA NOW PART OF THE UP SYSTEM



After ratifying the Unified Patent Court Agreement (UPCA) last May, **on 1 September 2024 Romania joined the Unitary Patent (UP) system**, thereby bringing the territorial coverage of the Unitary Patent from the original 17 Member States to 18 Member States.

As a result, European patents for which unitary effect is registered after 1 September 2024 will cover Romania, whereas the territorial scope of protection of European patents with unitary effect registered prior to said date is still limited to 17 countries.

Romania's becoming part of the UP family opens up **new possibilities for investments by foreign companies in this country.**

The aim of this newsletter is to keep our Clients and Associates updated about developments in the sector of Intellectual Property in general and our firm in particular. In this way, we wish to provide a broader view of the tools that the field of trade marks, domain names, patents, designs and related rights offers to entrepreneurs to enhance and protect their efforts in researching and developing new solutions and ideas.



Members of FICPI and AIPPI

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