



INTELLECTUAL PROPERTY CONSIDERATIONS TO BE AWARE OF WHEN USING PRECISION BREEDING TECHNIQUES

Punita Shah (Partner)

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Contents

- What rights may exist
- What activities are an infringement of IP rights
- What action do you need to take?
- Protecting your innovation
- Corteva vs Inari- an example of overlapping IP rights

What IP rights may exist

- Patents relating to the genetic tools e.g. CRISPR
- Patents relating plant starting material e.g. seed
- Plant Variety Rights relating to plants and plant material including seed

Patents relating to plant material

- Excludes patents to specific plant varieties
- Excludes methods of breeding plants which rely on an essentially biological process (e.g. sexual crossing)
- Excludes products of an essentially biological process
- Genetically modified plants, plant material, and methods for genetically modifying plants are all patentable

Plant Variety Rights

- Also referred to as “Plant Breeders Rights”
- Single botanical taxon of lowest rank
- At least one characteristic which is distinct from other varieties e.g colour, shape,
- Characteristic is uniform (i.e. level of variation)
- Characteristics are stable, i.e. remain unchanged with repeated propagation

Searching for IP rights

- Use publicly available databases to search for patents and PVRs
- Use a professional IP attorney to assist with devising the search strategy based on proposed activities
- Use a professional to interpret the scope of relevant IP
- Consider searching in any jurisdictions where you may be commercially active

Infringement of a patent

- Product patent (e.g plant per se)
 - Making, keeping, selling, offering to sell, using or importing a patented product
- Process patent (e.g. method of producing a gene edited plant)
 - Making, keeping, selling, offering to sell, using or importing a product **directly** obtained by a patented process

What action do I need to take?

- Design around
- Geographical considerations
- Challenge IP rights
- Request a licence
- Take the risk

Protecting your own IP

- Consider all available IP rights
- Patents – must be novel, inventive, not a variety or essentially biological process
- Plant variety right – must have developed a distinct, stable, uniform variety
- Timing is important
- Who owns the IP?

Corteva v Inari

- **Corteva's IP Rights**

US Patent No. 8,575,434 to gene-editing technology in maize and soybeans for improved yield traits.

Plant Variety Protection (PVP) for proprietary maize and soybean varieties.

- **Inari's Actions**

Obtaining seed (via third party) from US depository institution without permission

Phytosanitary testing of seeds prior to export

Export of seeds to Belgium

Gene editing of seeds in Belgium, for commercial purposes

Corteva v Inari – is there infringement?

Patent - Making, keeping, selling, offering to sell, using or importing a patented product

- Obtaining seed - not Inari themselves, “purchasing” is not an infringing act
- Does phytosanitary testing amount to “using” if seeds haven't been grown?
- Claims define a “plant” – is export of seed a contributory infringement?
- Inducement of the depository institution to infringe by selling the seed to Inari

Plant variety right – selling, importing, exporting, propagating, using, conditioning or stocking, induce infringement

- Export of seeds to Belgium

Actions in Belgium i.e. performing gene editing - not covered by US patent or US PVR

HGF by numbers

HGF is one of Europe's largest intellectual property firms, bringing together patent attorneys, trade mark attorneys, IP solicitors and attorneys-at-law across 25 offices in seven European countries to provide a dynamic and complete IP solution.

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173

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130

Defending

209

Opposing

UKIPO 2023

2nd in Patents
2nd in Trade Marks



EUIPO 2023

27th For Trade Marks



WIPO 2023

122nd in Patents
18th in Trade Marks



EPO 2023

9th Largest filer in Europe in Patents



Patents

5,176

Filed 22/23 financial year

PCTs

431

Filed 22/23 Financial Year

Live Cases

22,014

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Thank you for your attention

Dr Janine Swarbrick

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