

CASE COMMENTS

SOWING THE SEEDS: THE FIRST SUBSTANTIVE UK DECISION ON ESSENTIALLY DERIVED VARIETIES

NADOR COTT PROTECTION S.A.S. ('NCP') v (1) ASDA STORES LIMITED ('ASDA'), (2) INTERNATIONAL PROCUREMENT AND LOGISTICS LIMITED ('IPL') [2026] EWHC 553 (PAT)

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Introduction

One of the aims of plant breeding is to discover new desirable and favourable traits in plants by, for example, introducing new genetic variations to existing plant breeds. Every new plant variety is by nature, therefore, derived to some degree from earlier varieties. Plant breeders can apply for a Plant Breeder's Right ('PBR') (also known as a Plant Variety Right) to protect any new discoveries against the risk of plagiarism. PBRs give the owner exclusive control over the production and commercial exploitation of a protected variety. In order to qualify for a PBR, a plant variety should be distinct, uniform, stable and new.

PBRs tend to be the subject of litigation far less often than other intellectual property rights, such as patents, trade

marks, copyright and designs. However, on 12 March 2026, in a dispute concerning varieties of mandarin oranges, the UK Patents Court handed down the first substantive judgment in the UK providing guidance on two questions: first, what it means for a plant variety to be '*essentially derived*' from a protected variety pursuant to section 7(3) of the Plant Varieties Act 1997 ('PVA'); and second, what constitutes a '*reasonable opportunity*' to exercise UK PBRs pursuant to section 6(3) PVA, which in certain circumstances extends the protection afforded by PBRs to also protect against the unauthorised use of harvested material. These concepts, and the legislation that gives rise to them, have only been subject to judicial interpretation and application a limited number of times in courts around the world, and never before in the UK.

Facts, Allegations and Trial

'Nadorcott' is a mandarin variety originally created in Morocco in the 1980s. 'Tang Gold' (also known as 'Tango') was later created at the University of California, Riverside. Tang Gold was created from Nadorcott budwood using irradiation techniques. NCP owns rights to the Nadorcott plant variety, including a UK PBR (UK PBR no 28016). NCP alleges that Tang Gold is a 'dependent variety' of Nadorcott and has sought to enforce its rights against UK retailer Asda and its procurement arm, IPL, for importing and selling Tang Gold fruit in the UK.

Asda denies that Tang Gold is a dependent variety. In defending the proceedings, Asda also relies on the limitation set out in section 6(3) PVA. Asda's position is that even if Tang Gold were considered a dependent variety, NCP had, in any event, lost any right of action with respect to the harvested material – that is, the mandarin fruit – because they had previously had a 'reasonable opportunity', before the harvested material was obtained, to exercise their rights in relation to unauthorised use of propagating material, yet had failed to do so. PBRs are designed to protect propagating material, with protection extending to harvested material *only* when rights over propagating material could not reasonably be exercised at an earlier stage.

The trial, under the UK Shorter Trials Scheme, focused on matters of statutory interpretation. Related litigation over these varieties has been running for several years in Spain and South Africa and remains pending.

Matters of Statutory Interpretation

With these concepts having not previously been the subject of judicial interpretation by the UK courts, the parties' submissions on statutory interpretation centred on the history and policy behind the legislation governing Essentially Derived Varieties ('EDVs'), EU implementation, and Explanatory Notes published by the International Union for the Protection of New Varieties of Plants ('UPOV'). UPOV administers the International Convention for the Protection of New Varieties of Plants ('UPOV Convention'), which provides a legal framework for plant variety protection implemented by its members, including the UK. The UPOV Explanatory Notes are considered to be influential guidance on how the UPOV Convention should be applied.

Essentially Derived Varieties

NCP's 'dependent variety' argument hinged on the correct interpretation of section 7(3) PVA, which is derived from Article 14(5) of the UPOV Convention. Having considered arguments from both sides on how the legislation should be interpreted, Mellor J summarised the requirements for a variety to be deemed to be essentially derived from an initial variety in accordance with section 7(3) PVA, as follows:

- (i) predominant derivation from either the initial variety or a variety that is itself predominantly derived from the initial variety;
- (ii) while retaining the expression of the essential characteristics resulting from the genotype or combination of genotypes of the initial variety;
- (iii) it is clearly distinguishable from the initial variety by one or more characteristics which are capable of a precise description; and
- (iv) except for the differences which result from the act of derivation, it conforms to the initial variety in the expression of the essential characteristics that result from the genotype or combination of genotypes of the initial variety.

The characteristics of the plant variety is a common thread through each of these requirements, and the task before the court was to determine what the essential characteristics of Nadorcott are, and whether those characteristics are retained by Tang Gold. Whilst both varieties share many

characteristics, such as fruit size, easiness to peel and surface roughness, the parties agreed that two significant differences exist between Nadorcott and Tang Gold as a result of the irradiation work carried out by the University of California: (1) Nadorcott produces viable pollen, which under cross-pollination will generate seeds in other compatible citrus varieties, whereas Tang Gold's pollen is essentially non-viable, resulting in the production of seedless fruit; and (2) when Nadorcott is cross-pollinated by pollen from other compatible citrus varieties, its fruit can form seeds, whereas Tang Gold remains seedless. Both are self-incompatible. Asda argued that these are essential characteristics of Nadorcott.

Drawing on the UPOV Explanatory Notes, Mellor J explained that 'essential characteristics' are those characteristics which are fundamental to the variety's value as a whole and which contribute to the variety's performance or value for use. Essential characteristics should also be relevant to one of the following: producers, sellers, suppliers, buyers, recipients, users of propagating or harvested material, and/or the value chain. Such characteristics may or may not be characteristics considered when determining whether the variety qualifies for a PBR (namely, distinct, uniform or stable) and/or used for the examination of value for cultivation and use.

Applying this analysis, Mellor J determined that, for mandarins, consumers value characteristics such as taste, juiciness, ease of peeling and the presence of very few or no seeds. As such characteristics are desirable for consumers, their significance resonates throughout the entirety of the distribution chain: from retailers and distributors to growers and farmers, all the way up to the suppliers of propagating material.

Considering the evidence before it, the court held that these characteristics are particularly relevant to users of propagating material – that is, growers and farmers. In Nadorcott, seediness and pollen viability drive commercial growing and farming practices, because Nadorcott growers wishing to produce seedless fruit need to prevent cross-pollination, and ensure self-pollination only. This is achieved by cultivation practices such as distancing plants sufficiently far away from other species, or by covering them with nets. Such practices are not a consideration, or indeed a requirement, for Tang Gold growers. Seediness and pollen viability are therefore not considered essential considerations for Tang Gold growers.

The judge ultimately concluded that seediness and pollen viability are essential characteristics of Nadorcott, which are not retained in Tang Gold. It followed that Tang Gold is not, therefore, essentially derived from Nadorcott and is not a dependent variety. Accordingly, the judge found no infringement of the Nadorcott UK PBR.

The impact of this judgment for UK PBRs holders is significant. In order to commercialise an EDV (that is, to carry out an act covered by the relevant legislation), it is necessary to obtain authorisation from the holder of a PBR subsisting in the initial variety. Accordingly, the concept of EDV can be a useful extension of the rights conferred by a PBR. One consequence of this judgment however, is that the scope of PBRs in the UK may be narrower than perhaps some breeders would like for the purpose of enforcement, given that any extension to the right with respect to EDVs will be limited. It is not automatic that a derived variety will be determined to be dependent, where it is predominantly derived from an initial variety. The expression of the essential characteristics of the initial variety must be retained in the derived variety to achieve EDV status. The UK court has adopted a holistic approach in making this assessment, taking into consideration the entire supply chain. Whether a variety is an EDV is to be determined on the facts on a case-by-case basis.

Interestingly, the judge observed that the concept of dependent varieties represents only a narrow extension of the UK PBR, and that it is possible that a different result may be obtained before a European court, as the wording of the EU Regulation on Community plant variety rights¹ differs from the UK legislation. It would, therefore, be prudent to see how different European courts land on this issue, and whether jurisdictions which are home to more plant breeders favour a wider interpretation.

A Reasonable Opportunity to Exercise Rights²

Although unnecessary given his finding on EDV, Mellor J addressed the ‘reasonable opportunity’ issue pursuant to section 6(3) PVA in case he was wrong on the dependency issue.

PBRs primarily protect propagating material. Section 6(3) PVA seeks to extend PBRs to harvested material. However, the extended protection is qualified. Harvested material (such as fruit or flowers) is protected *only* where the holder had *no reasonable opportunity*, before the harvested material was obtained, to exercise their rights against unauthorised use of propagating material. The provision is intended to address scenarios where propagating material is used abroad (where no rights exist) and harvested material is subsequently imported into a territory where the holder has a relevant PBR.

Section 6(3) PVA states:

The rights conferred on the holder of plant breeders’ rights by subsections (1) and (2) above shall also apply as respects harvested material obtained through the unauthorised use of propagating material of the protected variety, unless he has had a reasonable opportunity before the harvested material is obtained to exercise his rights in relation to the unauthorised use of the propagating material. (emphasis added)

Mellor J held that reference to ‘*his rights*’ refers to the UK national right, which is consistent with other similar references throughout the PVA. A broader reading (embracing all corresponding rights worldwide) would require clear statutory wording. In light of this, the judge held that ‘*unauthorised use*’ can only occur in a territory where the holder has a right and has not authorised use. Harvested material obtained in countries where NCP has no right (for example, Peru, Chile, Egypt) could not be said to result from unauthorised use and accordingly fell outside the scope of section 6(3) PVA.

The judge also held that ‘*exercising his rights*’ means actually enforcing them to the extent available (that is, preventing the obtaining of harvested material) and not merely asserting them.

Ultimately, whether a ‘*reasonable opportunity*’ existed is a fact-sensitive enquiry. Even had ‘*his rights*’ encompassed foreign rights (for example, NCP’s rights in Spain and South Africa), the judge would still have found that NCP had not

1) Regulation (EC) No 2100/94 of 27 July 1994, Article 13(6).

2) PVA, section 6(3).

had a reasonable opportunity to exercise them to prevent unauthorised propagation or harvesting. For instance, despite having commenced infringement proceedings against growers in Spain in 2008 and in South Africa in 2014, both sets of proceedings had been mired with delays and neither had resulted in a first instance decision to date. As a result, NCP had not yet managed to enforce its equivalent Spanish and South African rights against the alleged unauthorised use. Furthermore, Asda had refused to reveal the identity of its suppliers to NCP, limiting NCP's ability to enforce its rights against those growers.

The judge acknowledged that, had he found Tang Gold to be an EDV, NCP could likely have obtained an injunction to restrain further imports and monetary relief for prior imports/sales.

Impact

This is a landmark decision in UK jurisprudence, being the first time such issues have been considered by the UK courts. Mellor J's judgment is detailed, spanning some 70 pages, and contains much welcome guidance on how the court will approach matters of statutory interpretation relevant to PBRs.

This judgment clarifies that deriving a new plant variety from a protected one will not automatically infringe a PBR. The EDV gateway is narrow in the UK. Whether or not that gateway is met will depend upon a careful analysis of the essential characteristics of an initial variety and whether those characteristics are deemed to have been retained in any subsequent varieties.

It also clarifies that the section 6(3) PVA '*reasonable opportunity*' defence is territorial, requiring an assessment of the reasonable opportunity to assert the UK PBR. Right holders should act early and consider what rights they have internationally, and particularly in jurisdictions where competitors have their supply chains. If other international courts reach similar decisions, plant breeders should carefully consider their international strategies to ensure they have rights in the jurisdictions that are important to them. It is also prudent to gather evidence of UK acts if relief is ultimately sought in the UK.

This dispute will continue. NCP were granted leave to appeal during the consequential hearing which took place on 15 April 2026, while Asda's UK invalidity proceedings with respect to NCP's PBR remain pending.