

Report Q204

in the name of the Italian Group

Liability for Contributory Infringement of IPRs

Questions

1) Analysis of current legislation and case law

- 1) *Does your national law provide for liability for contributory infringement of IPRs, in respect of the offering or supply of means for working an invention, for enabling illicit commercial use of a trademark, for making a copyrighted or design protected product, etc.?*

The Italian legal system doesn't provide expressly for a liability for the contributory infringement of the IPRs. These acts are regulated by the general principles of tort law. Some rules regarding the legal consequences of IPRs infringement provide for measures applicable (also) to the means used in order to infringe these rights.

- 2) *If so, is it a condition for such liability that the means supplied are actually used by another (the person supplied) for committing acts that amount to direct infringement of the IPR in the same country (or in another country where there is a corresponding IPR)? Are there any additional conditions that apply in such cases?*

In the Italian IPRs regulation, contributory infringement is an act not autonomously unlawful. As a consequence, it is unlawful to supply in Italy the means suitable for committing an IPRs infringement only if that means are actually used in the Italian territory for committing acts that amount to direct infringement.

- 3) *If it is not a condition for liability for contributory infringement that the means supplied are actually used by another (the person supplied) for committing acts that amount to direct infringement in the same country (or in another country where there is a corresponding IPR), is it then, on the other hand, a condition for such liability, for example*
- that the means offered and/or supplied were suitable to be put into an infringing use;*
 - that the means relate to an essential, valuable or central element in the invention or product or service that constitutes direct infringement;*
 - that the means offered and/or supplied were actually intended for such use on the part of the person supplied;*
 - that the means offered and/or supplied were intended to be put to that use in the country in which they were offered or supplied;*
 - that, at the time of offering and/or supply of the means, the suitability and intended use were known to the supplier or were obvious under the circumstances; or*
 - that, to the extent the means are staple commercial products, the supplier induces the person supplied to infringe directly?*

Are there other conditions? Please respond separately for patents, trademarks, designs, copyright etc., if the rules differ from each area of IPR to the other.

See answer 2.

4) *Are the rules concerning contributory infringement set out in the laws protecting IPR?*

See answer 1.

5) *If such protection is not set out in the laws protecting IPR, does it follow from generally applicable principles of e.g. tort law?*

See answer 1.

6) *What are the legal consequences of holding an act to be a contributory infringement of an IPR, in particular:*

- can the IPR owner obtain injunctive relief to the same extent as in case of direct infringement?*
- can the IPR owner obtain damages and other compensation to the same extent as in case of direct infringement, or only relative to the contributory infringer's contribution?*

When the contributory infringement is unlawful, the owner of the IPRs can sue the contributory infringer in order to obtain injunctive relief, astreints, measures of restitution, orders to publish the decision. The owner can sue him also for damages relative to the contributory infringer's contribution.

II) Proposals for substantive harmonisation

7) *Should measures generally be available against acts that qualify as contributory infringement of IPRs, as defined in these Working Guidelines?*

It could be useful to make generally available some measures against the acts defined in the Working Guidelines as contributory infringement of IPRs.

8) *If so, what should be the conditions for holding an act to be a contributory infringement of an IPR?*

The conditions for holding an act to be a contributory infringement of an IPR should be i) that the means supplied by the contributory infringer are only suitable for committing a direct IPRs infringement; b) (exclusively for obtain damages) that the contributory infringer knows (or should have known) the destination of these means.

9) *Should the conditions be different for different kinds of IPRs? Why?*

The conditions explained in the answer 8 should be the same for all the IPRs.

10) *What should be the legal consequences of holding an act to amount to contributory infringement of an IPR, in particular?*

- Should the IPR owner be able to obtain injunctive relief to the same extent as in case of direct infringement?*
- Should the IPR owner be able to obtain damages and other compensation to the same extent as in case of direct infringement, or only relative to the contributory infringer's contribution?*

IPRs owners should be able to obtain injunctive relief, damages and other compensation to the same extent as in case of direct infringement.

11) *Should the legal consequences be different for different kinds of IPR? Why?*

The legal consequences explained in the answer 8 should be the same for all the IPRs.

12) *Does your Group have any other views or proposals for harmonisation in this area?*

No other proposals for future harmonisation.

Summary

The Italian legal system doesn't provide expressly for a liability for the contributory infringement of the IPRs. These acts are regulated by the general principles of tort law. In the Italian IPRs regulation, contributory infringement is an act not autonomously unlawful. As a consequence, it is unlawful to supply in Italy the means suitable for committing an IPRs infringement only if that means are actually used in the Italian territory for committing acts that amount to direct infringement. When the contributory infringement is unlawful, the owner of the IPRs can sue the contributory infringer in order to obtain injunctive relief, astreints, measures of restitution, orders to publish the decision. The owner can sue him also for damages relative to the contributory infringer's contribution.

Résumé

La loi italienne ne prévoit pas expressément une responsabilité pour le concours dans la violation des droits de propriété intellectuelle. Cette conduite est régie par les principes généraux du droit de la responsabilité civile. Selon la loi italienne de la propriété intellectuelle le concours dans la violation de ces droits n'est pas un illicite autonome. Dans cette situation, la fourniture des moyens pour réaliser la violation des droits de propriété intellectuelle est illicite seulement si ces moyens sont effectivement utilisés dans le territoire italien pour des activités qui réalisent directement l'exploitation de la ressource protégée. Si le concours dans la violation des droits de propriété intellectuelle est illicite, le titulaire des droits peut demander au juge de prononcer une injonction de cesser cette conduite de concours. Il peut aussi demander des astreintes, les dommages-intérêts et la publication de l'arrêt.