

Report Q204

in the name of the Mexican Group
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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.?*

No.

- 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?*

NA.

- 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.

NA.

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

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?*
Yes, at least in connection with patent and copyright law. Contributory infringement rules referenced to trademarks law are unclear. Concerning Copyright Law, contributory infringement is particularly urgent.
- 8) *If so, what should be the conditions for holding an act to be a contributory infringement of an IPR?*
It should be no condition imposed at all. Contributory infringement should be opened not only when a contributory infringer offers or supplies means to perpetrate infringement, but also when induces or assists the direct infringers to violate the law.
- 9) *Should the conditions be different for different kinds of IPRs? Why?*
No. Rules just need to be broad enough to cover all array of possibilities.
- 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?*
Yes.
 - *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?*
Yes.
- 11) *Should the legal consequences be different for different kinds of IPR? Why?*
No.

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

The scope of contributory Infringement rules should be as broad as possible. They should not only encompass patents, but should be extended to any other rights, like copyrights, that might be violated when third parties carry indirect acts of infringement. In Copyright Law, contributory infringement should not be restricted to when third parties offer or supply tangible means to the direct infringement to inflict a copyright infringement. Intermediary indirect infringement has a special connotation and an importance, in particular when the third parties induce or assist the direct infringers to violate the law. WIPO treaty standards should be enhanced. Likewise, intermediary liability should be balanced with a fair system of safe harbors protecting Internet intermediaries.

Summary

Mexican patent, trademark and copyright laws do not provide contributory infringement rules, applicable in connection with the offering or supply of means for working inventions, enabling the use of trademarks or making works of authorship or even inducing or assisting direct infringers to violate the laws. The Mexican group would support that pertinent IP laws are amended so that measures and remedies become available against all possible acts that qualify as contributory infringement, including the inducement and assistance for breaking the law.

Résumé

Les lois mexicaines des brevets d'inventions, marques de fabrique, droits d'auteurs n'établissent pas de règles contre la contribution à la contrefaçon applicables en relation avec l'offre ou le suministro des moyens pour travailler avec des inventions qui permettent l'emploi des marques de fabrique ou des oeuvres d'auteurs ou même qui amènent ou assistent les infracteurs directs à violer les lois. Le groupe mexicain appuierait que les lois de la propriété intellectuelle soient amendées pour qu'il y ait des mesures et des réparations disponibles contre tout possible acte qui puisse qualifier comme une infraction contributive y inclus la tentation et l'assistance pour enfreindre la loi.

Zusammenfassung

Die mexikanischen Gesetze zum Schutz von Patent-, Marken und Urheberrechten sehen im Zusammenhang mit dem Angebot oder dem Vertrieb von Mitteln für Arbeits-Erfindungen keine Strafen für an einer Verletzung beteiligten Personen vor, wenn sie die Verwendung von Marken oder die Schaffung von Werken erlauben und legen somit den Personen direkt nahe und unterstützen sie, das Gesetz zu verletzen. Die mexikanische Gruppe würde eine Ergänzung der entsprechenden IP Gesetze daher unterstützen, so dass Massnahmen und Rechtsmittel gegen alle Handlungen zur Verfügung stehen, welche als Beihilfe zur Verletzung eingeordnet werden können, einschliesslich die Veranlassung und Unterstützung bei der Verletzung des Gesetzes.