

Report Q204

in the name of the Portuguese 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.?*

According to the Portuguese Industrial Property Act, the referred infringements of IPRs are punished as criminal offence: (i) Violation of the exclusive rights to the invention and to the utility model, (ii) violation of the exclusive rights conferred by models and designs, (iii) counterfeiting, imitation and illegal use of trademarks, and (iv) sale and distribution of counterfeited products.

On the other hand, the Criminal Act foresees that one can be punished as author of the crime if he / she offers or supplies the means for another to commit said crime.

- 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?*

Portuguese Law does not distinguish where the crime is committed. However, the law foresees that the supplier of means is only punishable in case the furnished means are effectively used for the commitment of the crime.

- 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.

Not applicable.

- 4) Are the rules concerning contributory infringement set out in the laws protecting IPR?
No. The rule concerning contributory infringement is set out in the Portuguese Criminal Act.
- 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?
The protection follows from the general criminal dispositions at the Portuguese Criminal Act.
- 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?
Yes.
 - 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?
The IPR owner will only be able to obtain compensation for damages that result directly from the supplier of means, i.e., only 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?
Yes, once the IPRs infringements are globally increasing and same are commonly committed by people / companies that are acting not only in one country.
- 8) If so, what should be the conditions for holding an act to be a contributory infringement of an IPR?
Although the general criminal rules applies, there should be a provision at the laws protecting IPR that states that one can be punished as author of the infringement if offers or supply means to other commit the infringement and if he/she has knowledge of the infringement and intention to contribute to said infringement.
- 9) Should the conditions be different for different kinds of IPRs? Why?
No. The kind of protection should be the same for all IPRs, thus allowing a certain harmonization in said rights. Being all IPR, there is no reason to defend different conditions for the infringement of said rights.
- 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?

In case of contributory infringement the IPR owner should be entitled to obtain injunctive relief 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?*

The IPR owner should be able to obtain damages and other compensation only relative to the contributory infringer's contribution.

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

Yes. As the different infringements have different consequences, the consequences for the contributor must depend on the consequences of the infringement.

When considering legal consequences one must bear in mind that often infringement of IPR may be directly linked with public health, public safety... Accordingly, the consequences of infringing a trademark will certainly not be the same as infringing a patent. If the consequences are not the same (namely in an economical perspective) thus the legal consequences should also be different.

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

No.

Summary

The offering or supply of means for working an invention, for enabling illicit commercial use of a trademark or for making a copyrighted or design protected product is punished under Portuguese law as a criminal offence. Portuguese law provides that a person can be punished as author of the crime if he offers or supplies the means for another to commit the said crime.

Portuguese law does not distinguish where the crime is committed. However, the law provides that the supplier of the means is only punishable if the means furnished are actually used for committing the crime.

Consequently, the intellectual property right owner is able to obtain compensation for damages that result directly from the supplier of the means, i.e. only relative to the contributory infringer's contribution.

Résumé

L'offre ou la fourniture de moyens pour mettre en œuvre une invention, pour permettre l'utilisation commerciale illicite d'une marque ou pour fabriquer un produit protégé par droit d'auteur ou dessins et modèles est punissable par la loi portugaise comme crime. La loi portugaise prévoit qu'une personne peut être punie comme auteur du crime si elle offre ou fournit les moyens permettant à un tiers de commettre ledit crime.

La loi portugaise ne définit pas le lieu où le crime est commis. Cependant, la loi prévoit que le fournisseur de moyens n'est punissable que si les moyens fournis sont effectivement utilisés pour commettre le crime.

Par conséquent, le titulaire du droit de propriété intellectuelle peut obtenir une compensation pour les dommages qui résultent directement du fournisseur de moyens, c'est-à-dire uniquement relativement à la contribution du contrefacteur par fourniture de moyens.

Zusammenfassung

Das Anbieten oder die Lieferung von Mittel zur Ausübung einer Erfindung, zur unerlaubten, gewerblichen Verwendung einer Marke, zur Herstellung eines urheberrechtlichen oder durch ein Geschmacksmuster geschützten Erzeugnis ist strafbar im portugiesischen Recht, da es als eine kriminale Verletzung betrachtet wird. Das portugiesische Recht hat vorgesehen dass man als Urheber der Verletzung bestraft werden kann falls er oder sie Mittel anbietet oder liefert welche erlauben dass andere die Verletzung begehen können.

Das portugiesische Recht unterscheidet andererseits nicht wo die Verletzung statt fand. Jedoch hat es vorgesehen dass jener der die Mittel liefert nur strafbar ist wenn die gelieferten Mittel tatsächlich gebraucht worden sind zum Begehen der Verletzung.

Infolgedessen kann dem Inhaber des geistigen Eigentums eine wirtschaftliche Entschädigung zur Verfügung stehen die direkt von demjenigen der die Mittel geliefert hat abstammt, d.h. nur in Bezug auf die mittelbare Verletzung des Verletzers.