

## **Report Q204**

in the name of the Spanish Group  
by Raúl BERCOVITZ ALVAREZ, Pedro MERINO BAYLOS, Irache PEREIRA TOÑA,  
Eduardo ZAMORA, Xavier FÀBREGA SABATÉ, Oriol RAMÓN, Antoni ROMANÍ LLUCH,  
Rosa MARTÍNEZ BRINES, Anna JARQUES FARRÉS, Enrique ARMIJO CHÁVARRI,  
Isidro José GARCÍA EGEA and Maria Eugenia MATEU

### **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 Spanish legislation expressly provides for liability for contributory infringement within the patent and the trademark law.

##### **PATENTS**

Article 51 of the Spanish Patent Act specifies such liability for indirect or contributory infringement.

*“Article 51: The right to prevent unauthorised parties from using patents*

- 1) *The patent also grants its holder the right to prevent third parties from providing, or offering to provide, resources to implement patented inventions related to any essential element thereof by parties unauthorised for such use, without the owner’s consent, when such third party knows of the situation or it is made clear that such resources could be used to implement the invention and are aimed at this purpose.*
- 2) *The provisions in the previous section are not applicable when the resources referred to therein are products that are normally available in the market, unless the third party encourages the person providing such resources to commit any of the actions prohibited in the previous article.*
- 3) *Any persons performing the actions stipulated in letters a) to c) in the following article are not considered authorised parties to use the patented invention, as defined in section 1.”*

##### **TRADEMARKS**

Spanish Trademark Act 17/2001 of December 7 provides for liability for contributory infringement under article 34.3.f). Pursuant to said article, the trademark owner may prohibit third parties from ‘affixing the sign to wrappers, packaging, labels or other means of identifying or embellishing the good or service, preparing or supplying them, or making, manufacturing, offering, marketing, importing, exporting or stocking any of those means under the sign, if there exists the possibility that said means may be used to commit any act, which in accordance with the aforementioned subparagraphs, would be prohibited.’

In the field of Author's Right and Industrial Design a result similar to liability for contributory infringement may be reached through the liability which may be imposed on some "intermediaries".

In fact, as a consequence of the implementation of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights, the Spanish Acts on Patents (art. 63.3), Trademarks (art. 41.3), Protection of Industrial Design (art. 53.3) and on Author's Right (arts. 138 y 139) entitle the owner of any IPR for using civil remedies against those intermediaries "whose services are required by a third party with a view to infringing patent rights [or other IPRs, depending on the Act]" and it follows "even if the acts of such intermediaries do not amount themselves to an infringement"; and this is without prejudice to what is provided under the Act 34/2002, of 11 July, on Services of the Information Society and Electronic Commerce. Thus, at least theoretically and when applicable, such intermediaries could incur both in contributory infringement and direct infringement acts. The Spanish courts will be the ones who, when interpreting such provision, shall define the concept of "intermediary" as well as the scope of the expression "with a view to infringing".

### **INDUSTRIAL DESIGN**

The Spanish Act 20/2003, of 7 July, on Legal Protection of Industrial Design does not provide anything on this issue.

### **AUTHOR'S RIGHT**

Royal Decree-Law 1/1996, of 12th April, approving the Revised Text of the Intellectual Property Law ("IPL"), does not expressly consider the liability for contributory infringement.

However, the "intermediaries" as well as those who eliminate any efficient technological measure to prevent or restrict actions, intended to protect works or services, that have not been authorized by the holders of the relevant intellectual property rights (circumvention acts or preparatory actions) would be considered contributory infringers.

The liability of the intermediaries is mainly established in articles 138, 139.h) y 141.6) IPL. The contents were introduced into the IPL through the Act 23/2006, of 7th July, that incorporates into the Spanish legislation Directive 2001/29/CE of the European Parliament and Council related to the harmonization of certain aspects of author's rights and related rights into the information society.

Thus, article 138 of IPL establishes that urgent actions or precautionary measures can be applied for "against the intermediaries whose services are requested by a third party with a view to infringing intellectual property rights [...]".

This possibility is also set out in articles 139.h) and 141.6 IPL, when talking about the action for injunction and about precautionary measures, respectively.

However, article 138 points out (as opposed to the other two articles) that urgent actions and precautionary measures can be applied for against such intermediaries "even though the actions of such intermediaries do not represent an infringement by themselves".

The three articles mentioned above add that the possibility of acting against the intermediaries is set out without prejudice to the provisions of Act 34/2002, of 11 June, on Services of Information Society and Electronic Commerce "LSSICE"). Articles 13 to 16 LSSICE establish the liability system of operators and providers of access, the providers that make temporary copies of the data requested by users, the providers of data hosting or storage services and the providers of services that provide links to contents or search engines.

On the other hand, the liability with respect to circumvention and preparatory actions is foreseen in article 160 IPL, and was also introduced in the IPL through Act 23/2006 mentioned above.

Paragraph 1 of article 160 IPL establishes that the holders of intellectual property rights may exercise the actions foreseen by the Act *“against those who, knowingly or having reasonable grounds to know it, avoid any efficient technological measure”*.

Paragraph 1 of such article 160 IPL expands the scope of action of the holder of the right when stating that *“the same actions can be brought against those who manufacture, import, distribute, sell, rent, advertise for selling purposes or hold for commercial purposes any device, product or component, as well as against those who render any services that, in connection with any efficient technological measure:*

- a) *Are the object of promotion, advertising or marketing with a view to circumvent the protection, or*
- b) *Their purpose or commercial use is limited and outside the protection, or*
- c) *Are mainly conceived, produced, adapted or made in order to allow or facilitate the circumvention of the protection.*

Finally, paragraph 3 of article 160 IPL offers the definition of technological measure as *“any technique, device or component that, under normal operating conditions, is aimed at preventing or restricting actions, related to protected works or services, that have not been authorized by the holders of the relevant intellectual property rights”*.

However, according to the provisions of its paragraph 4, the rule set out in article 160 IPL is not applicable to the technological measures used to protect computer software, that are regulated by articles 95 to 104 LPI.

### **PLANT VARIETIES**

The regulations applicable to plant varieties, mainly the Plant Varieties Act, 3/2000, of 7th January, does not establish an express rule that provides for an specific liability for the offer or supply of means that make possible the production or reproduction of the breed material of the protected variety or any other of the conducts that, following article 12.2 of the aforementioned Act, require the authorization of the owner of the variety. There is neither a similar provision nor a parallel one to article 51 of the Spanish Patent Act, 11/1986, of 20<sup>th</sup> March.

In this respect, we must point out that, in the particular case of plant varieties, and, in view of the special nature of the object of the owner’s right (precisely the “breed material of the protected variety”), whose offer or supply could or could not amount to a contributory infringement of the protected right, is precisely the object of the protected right, because it is inferred from the Act that the acts carried out on a specimen of the variety must be regarded as carried out on its breed material, as the latter is incorporated in such specimen in an inseparable way; the specimens of the plant variety keep their breed material with them for reproduction purposes.

Therefore, it is not possible to differentiate between “direct infringement” and “contributory infringement”, because, being the object of the exclusive right precisely the necessary elements for its implementation (that is to say, the “breed material”), its offer (article 12.2.c) Act), sale (article 12.2.d) Act), and export (Art. 12.2.e) Act) are considered as exclusive rights of the owner, at the same level as “the production or reproduction (multiplication)” of the plant variety, that we could consider as the “direct” infringement; therefore, we can conclude that “contributory” infringement is not regulated as such, in an autonomous and differentiated way, but as a modality of direct infringement, with the same level of protection (art. 21 Act). The same applies to the criminal protection provided for this kind of industrial property by article 274.3 of the Criminal Code, which means that the acts of offer, sale, etc., of the breed material should be always punished as criminal offences against Industrial Property in the degree of authorship and not of complicity.

- 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?*

### **PATENTS**

The Spanish Patent Act (Article 51.1) does not expressly require that these material resources provided by a third party are later actually used by the recipient of such resources, therefore it can be concluded that this actual use is not required, even though it is required that the recipient must be a party non authorised to use the patent.

Obviously, a recipient duly authorised by the patent holder, in other words a licensee thereof (also in the case of compulsory licences), would be allowed to use the patent, when its actions are in accordance with the provisions of the pertinent licence agreement.

Bearing in mind the territoriality principle governing this matter, in our opinion, when the Patent Act refers to the fact that the recipient must be a person “*not authorised to use the patent*”, such reference to the patent can only be deemed to mean a patent with validity in Spain (in other words, a Spanish or European patent), therefore this use that could be made by the recipient must take place in Spain. The sanctions that have been imposed by Spanish Courts by analysing the “*ius prohibendi*” of the patent holder (Article 50) would support the previous thesis, even if only analogically.

The following additional requirements are also stipulated in the Spanish Patent Act:

- a) Resources for implementing the invention must be provided or offered to be provided;
- b) These resources must be related to an essential element of the invention; and
- c) The third party must be aware or the situation must make it obvious that the resources could be used to implement the invention and that they are aimed at such purpose.

### **TRADEMARKS**

A direct infringement is not expressly required. Pursuant to article 34.3.f) of the Spanish Trademark Act, only the ‘*possibility*’ that said means ‘*may be used*’ to commit a prohibited act is required, excluding the intentionality or the knowledge of the parties involved.

Article 34.3.f) does not provide anything regarding the territorial scope of the direct infringement that may be committed. However, having regard to the territorial nature of intellectual property rights (and the general principle of territoriality established under article 10.4 of the Spanish Civil Code), it seems that in accordance with the Trademark Act the contributory infringement of a trademark would have been committed if the possibility exists that the means are used in Spain to commit prohibited acts. In any case, this possibility may always exist, at least theoretically, when there is a Spanish trademark able to be infringed and the means are supplied within the Spanish territory, even if those means are aimed at being used or are finally used in a third country.

### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

### **AUTHOR’S RIGHT**

Articles 138, 139.b) and 141.6 IPL related to the *intermediaries* referred to in the previous point establish that an action may be brought against them provided that a third party requests their services IN ORDER TO INFRINGE intellectual property rights. The words “*to infringe*” seem to suggest the requirement that such infringement must actually take place, leaving aside situations of suitability or susceptibility of infringement such as those derived from other fields of industrial or intellectual property law (i.e. article 51 of the Patent Law), but they can also suggest that a mere intent of infringement suffices to apply the liability foreseen by the law.

Article 160 IPL on circumvention and preparatory actions requires that the circumvention of the efficient technological measure is made “knowingly” or “having sufficient grounds to know it”. In the remaining cases (those who carry out trade actions related to any device, product or component in connection with any efficient technological measure) it is required that such acts are carried out “for commercial purposes”.

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;*

#### **PATENTS**

The Spanish Patent Act (Article 51.1) refers to providing or offering resources “to implement the patented invention” and that “these resources could lead to the invention being implemented”, therefore it is in fact specifying that this requirement must be met.

#### **TRADEMARKS**

Although the Trademark Act does not expressly mention it, reference to the ‘possibility’ that the means be put into an infringing use implicitly implies their ‘suitability’ for said infringing use.

#### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

- *that the means relate to an essential, valuable or central element in the invention or product or service that constitutes direct infringement;*

#### **PATENTS**

The Spanish Patent Act also stipulates other requirements by stating that the aforementioned resources must be related to “an essential element of the patented invention”. The specific meaning of “essential element” must be deemed to mean a question that is subject to interpretation by the Courts on a case by case basis; however it seems clear that for this interpretation the Court must take into account the correct definition of the scope of protection for the patent in question.

#### **TRADEMARKS**

No. The Trademark Act does not include any such provision.

#### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

- *that the means offered and/or supplied were actually intended for such use on the part of the person supplied;*

#### **PATENTS**

The Spanish Patent Act does not mention this requisite, therefore such intention is not required.

#### **TRADEMARKS**

The Trademark Act does not refer to this requirement. Intentionality on the part of the person supplied or to whom the means were offered is not required.

#### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

- *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;*

### **PATENTS**

There is nothing stated in the Patent Act regarding this matter, therefore such intention is not required.

### **TRADEMARKS**

The Trademark Act does not specify the territory where the possibility of committing the prohibited acts must exist. However, having regard to the principle of territoriality, it seems that such territory must be Spain given that the Trademark Act refers to acts prohibited under Spanish law, that is, to the infringement of trademarks whose rights of exclusivity extend to the Spanish territory.

### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

- *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*

### **PATENTS**

The Spanish Patent Act expressly provides that the patent holder may only prevent the contributory infringement when the provider knows (or the situation makes it obvious) that such resources:

- i) could lead to the invention being implemented; and
- ii) are designed for such purpose.

It should be noted that the aforementioned cases of suitability and purpose must both occur.

The Courts interpret, on a case by case basis, when this “knowledge” occurs or when the situation of being “obvious” arises, and even what these “situations” must be.

Moreover, nobody can deny the difficulty for the patent holder to prove that the aforementioned situation of “knowledge” has arisen or that the suitability and purpose of the aforementioned resources “were obvious under the circumstances”.

The definition of the scope of protection of the patent in question also plays an important role in this case.

### **TRADEMARKS**

No. The Trademark Act does not provide so.

### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

- *that, to the extent the means are staple commercial products, the supplier induces the person supplied to infringe directly?*

### **PATENTS**

The Spanish Patent Act (Article 51.2) states that a contributory infringement will not be considered to have taken place when the resources offered or provided are products normally found in the market, unless the offerer/provider thereof encourages the party receiving the resources to commit any of the direct acts of infringement stipulated by law. In the latter case, a situation of contributory infringement would take place that could be prevented by the patent holder.

### **TRADEMARKS**

No. The Trademark Act does not include any such provision.

### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

*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.*

### **PATENTS**

Rather than other requirements, we should mention additional considerations in Spanish regulations in this respect (Article 51.3, related to Article 52). Specifically, the parties that commit the following actions are not considered authorised recipients to use the patented invention in the sense of the contributory infringement analysed hereby:

- a) using the patent within a private context and for non-commercial purposes;
- b) using the patent for experimental purposes related to the object of the patented invention, in particular research and trials conducted for authorising generic drugs in Spain or abroad, and the resulting practical requirements, including preparing, obtaining and using the active ingredient for such purpose; and/or
- c) drugs made in pharmacies in *ex tempore* and in units by means of a medical prescription and actions related to drugs prepared in this manner.

This means that the patent holder may sue any person who provides or offers resources for implementing his patented invention to anyone who may then perform any of the aforementioned actions, even though the holder may not sue the person that later performs any of these actions because the Spanish Patent Act excludes such actions from the exclusive rights granted to the patent holder (in other words, even though there is no direct infringement there would still be contributory infringement).

### **TRADEMARKS**

There are no further requirements apart from the ones discussed above.

### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

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

### **PATENTS**

As it can be inferred from the replies to the previous points, the rules related to contributory infringement are determined in the Spanish Patent Act.

### **TRADEMARKS**

Yes, in the Trademark Act, as discussed above.

### **INDUSTRIAL DESIGN**

We refer to our answer to question 1) above.

### **AUTHOR'S RIGHT**

See the answer to question 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?*

### **PATENTS**

Due the affirmative answer to the previous question no reply is given to this question.

### **TRADEMARKS**

We do not answer this question, since question 4) above has been answered in the affirmative.

### **INDUSTRIAL DESIGN**

Besides from the indirect recognition mentioned in our answer to question 1) above, such legal protection might follow, eventually, from the Spanish Intellectual Property Act (LPI).

## **AUTHOR'S RIGHT**

See the answer to question 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?*

### **PATENTS**

In principle, the declaration that an act is a contributory infringement of a patent gives rise to exactly the same consequences as if it was a direct infringement, therefore in the same way as in this case and, in particular, (Article 63), the holder may take action to stop the infringing actions, claim compensation of the damages caused, seizure of the resources in question, assignment of the ownership thereof, petition that the required measures are adopted to avoid the continuing of the reported infringement and, when appropriate, publication of the judgement ruled against the infringing party, at his expense, if the Courts consider this must be imposed.

There is nothing to prevent the patent holder from petitioning and obtaining an interim injunction in the case of a contributory infringement, as defined in Article 51. However, the requirement of "*periculum in mora*" could be adapted, depending on whether the recipient of the resources did or did not actually use them to commit direct infringement actions.

The situation expressly included in the Act (Article 135) for the aforementioned *intermediaries*, whose services are used by a third party to infringe the patent, reinforces this possibility of an interim injunction being granted. For such purpose, for example, it could be petitioned that the allegedly infringing acts are provisionally ceased and the "*prima facie*" infringing objects as well as the resources exclusively used for producing them are withheld and seized (Article 134), provided such measures are objective, proportional and non-discriminatory.

No express provision of the Act prevents the patent holder from performing certain procedures to investigate the facts or other preliminary procedures.

### **TRADEMARKS**

Yes. Although the Trademark Act does not have any rules on provisional measures, its First Additional Provision refers, as regards jurisdiction and rules of procedure, to the rules set out in the Patent Act 11/1986, excepting those rules which are incompatible with the nature of distinctive signs.

Therefore, the owner of the infringed right can obtain provisional measures by virtue of articles 133 to 139 of the Patent Act. This possibility reinforces the faculty expressly provided in Article 41.3 of the Trademark Act of taking the necessary measures against *intermediaries* in order to avoid the continuation of the infringement.

### **INDUSTRIAL DESIGN**

By virtue of the First Additional Provision of Act 20/2003 ("*Jurisdiction and Rules of Procedure*") referring to the rules set out in Title XIII of the Patents Act 11/1986 (which are applicable in relation to the judicial filing of claims deriving from the Act on Legal Protection of Industrial Design and in relation to injunctive relief and provisional measures to the extent such rules are not incompatible with what is provided in this Act), nothing would impede that the design owner seeks injunctive relief, to the extent a contributory infringer is considered as a type of "*intermediary*".

By virtue of articles 134 and 135 of the Spanish Patents Act, injunctive relief may be obtained against the referred *"intermediaries"*, namely the retention and deposit of the *"means exclusively destined"* to the production of infringing objects (art. 134.2.in fine).

### **AUTHOR'S RIGHT**

Both article 138 and 141.6 of the IPL establish the possibility of applying for precautionary measures, even of an urgent nature, against the *intemediaries*. Such measures are limited to the suspension of the services rendered by the intermediary and would be subject to the same criteria as in cases of direct infringement.

In the event that the intermediaries fall within the definition of providers of services of the information society (according to the definition set out in the LSSICE), the temporary measures set out in article 41 LSSICE should also be taken into consideration.

- *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?*

### **PATENTS**

The Spanish Patent Act does not mention anything concerning contributory infringement in Article 51 for the purpose of compensation of damages, therefore the Courts decide depending on the circumstances involved, and which were alleged and proven by the parties, on whether such compensation is fair and, if deemed fair, they will also determine whether such damages had actually been caused and also will assess the amount of the relevant compensation. In this respect, we should point out that Spanish case law has not yet rendered any judgements related to this matter up to now.

However, in the case of the *intermediaries* whose services are sought by a third party to infringe a patent, it is indeed clear that the Patent Act (Article 63.3) does not allow the patent holder to claim damages from these intermediaries, unless, obviously, the acts they perform are infringements in themselves.

### **TRADEMARKS**

Article 42 of the Trademark Act lays down that those who offer or supply means incorporating a trademark, if the possibility exists that these means are used to commit a prohibited act, will be bound in any case to respond of the damages caused to the owner of the exclusive trademark rights.

Therefore, **theoretically**, the owner of the trademark right can obtain damages in the event of a contributory infringement irrespective of whether the direct infringement has taken place or not. However, this rule may be more theoretical than real, because if the direct infringement does not take place, it will be difficult to affirm that an economic damage has been caused to the trademark owner. Moreover, it is doubtful whether an independent indemnity would incur in duplicity when damages were claimed both to the direct infringer and to the contributory infringer. This question has not been answered neither by the Spanish Courts nor by Spanish scholars.

On the other hand, article 41.3 of the Trademark Act implicitly excludes the possibility of claiming damages against the *"intermediary"* whose services are used by a third party to infringe trademark rights.

### **INDUSTRIAL DESIGN**

Article 53.3 of the Spanish Act on Legal Protection of Industrial Design does not provide for the possibility of the design owner to claim damages against *"intermediaries"*; thus, there is no provision in this special Act which expressly allows the filing of such a claim. A claim for damages might be tried, either by analogy with direct infringement or under other general legal rules, but it is not clear that such a claim would be successful. The Spanish Courts have so far not examined cases where such an issue was put at stake.

## **AUTHOR'S RIGHT**

The LPI does not include any provision with respect to the possibility that the intermediary must indemnify the holder of the author's rights for the damages caused. Article 138 only states as a general rule that the holder of the author's right may require the indemnity for the material and moral damages caused in connection with the "illicit activity". Taking into consideration that the intervention of the intermediaries as set out in articles 138, 139 and 160 IPL is considered illicit, in principle it does not seem that, either the intermediary or the party that carries out the circumvention and preparation actions, who are responsible for an illicit activity, are excluded from the liability to indemnify.

On its part, Title VII of the LSSICE establishes a sanctioning system for the providers of services of the information society who do not comply with its provisions.

## **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.

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

- that the means offered and/or supplied were suitable to be put into an infringing use; it should not be 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.
- that the means relate to an essential, valuable or central element in the invention or product or service that constitutes direct infringement;
- that the possibility exists that the means offered and/or supplied 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.

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

As a general rule, no. Only in those concrete cases where some special or peculiar feature may be clearly identified which could justify a different treatment of one kind of IPR with respect to other kinds.

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?*

The IPR owner should be able to obtain damages only when direct infringement finally took place and, also, only to the extent of the contributory infringer's contribution.

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

As a general rule, no. Only in those concrete cases where some special or peculiar feature may be clearly identified which could justify a different treatment of one kind of IPR with respect to other kinds.

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

No.

### **Summary**

For holding an act to be a contributory infringement of an IPR, the following conditions should be met:

- that the means offered and/or supplied were suitable to be put into an infringing use; it should not be a condition that the means supplied are actually used by another for committing a direct infringement.
- that the means relate to an essential, valuable or central element in the invention or product or service that constitutes direct infringement;
- that the possibility exists that the means offered and/or supplied 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.

As a general rule, the conditions and legal consequences should not be different for different kinds of IPRs, although justified exceptions may exist. The IPR owner should be able to obtain injunctive relief to the same extent as in case of direct infringement. The IPR owner should be able to obtain damages only when direct infringement finally took place and, also, only to the extent of the contributory infringer's contribution.

### **Résumé**

Afin qu'un acte soit déclaré comme une infraction indirecte d'un droit de propriété industrielle ou intellectuelle (IPR), il est nécessaire:

- que les moyens matériels offerts ou fournis soient adaptés à leur utilisation dans un but infracteur; il n'est pas nécessaire que les moyens matériels fournis soient effectivement employés par une autre personne pour commettre des actes constituant une infraction directe.
- que les moyens matériels soient liés à un élément essentiel, principal ou particulièrement important de l'invention, du produit ou du service à travers laquelle/lequel se traduit la violation directe;
- qu'il existe la possibilité que les moyens matériels offerts ou fournis soient utilisés, dans un but infracteur, dans le pays dans lequel ils furent offerts ou fournis;
- que, au moment de l'offre ou de la fourniture des moyens matériels, leur adéquation pour être utilisés dans un but infracteur et la possibilité d'une telle utilisation soient connues par le fournisseur ou soient évidents, compte tenu des circonstances; ou

- que, dans la mesure où les moyens matériels seraient des produits se trouvant couramment dans le commerce, le fournisseur induise le destinataire des moyens à commettre une infraction directe.

En règle générale, les conditions et conséquences légales ne devraient pas être distinctes pour les différentes modalités de IPR, bien qu'il puisse exister des exceptions justifiées. Le titulaire du droit enfreint devrait pouvoir obtenir des mesures conservatoires de la même manière que dans des cas d'infraction directe. Le titulaire du droit devrait pouvoir obtenir des dommages et intérêts uniquement dans la mesure où l'infraction directe se serait produite et, par ailleurs, uniquement dans la mesure où le contrevenant direct aurait contribué à cette infraction.

### **Zusammenfassung**

Folgende Bedingungen müssen gegeben sein, damit eine Handlung als mittelbare Verletzung gegen den gewerblichen oder geistigen Rechtsschutz (IPR) gewertet werden kann:

- Die zur Verfügung gestellten oder gelieferten Sachmittel müssen für eine widerrechtliche Verwendung geeignet sein; nicht erforderlich werden darf, dass die gelieferten Sachmittel tatsächlich von einer dritten Person für Handlungen verwendet werden, die einen mittelbare Verletzung bedeuten.
- Die Sachmittel müssen mit einem wesentlichen, hauptsächlichen oder besonders wertvollen Element der Erfindung, des Produkts oder der Dienstleistung in Verbindung stehen, mittels dessen der direkte Verletzung ausgeführt wird;
- Es muss die Möglichkeit einer widerrechtlichen Verwendung in dem Land bestehen, in dem die Sachmittel zur Verfügung gestellt oder geliefert wurden;
- zu dem Zeitpunkt, zu dem die Sachmittel zur Verfügung gestellt oder angeboten wurden, müssen sie für eine widerrechtliche Verwendung geeignet gewesen sein; außerdem muss die Möglichkeit einer widerrechtlichen Verwendung dem Lieferanten bekannt oder unter den gegebenen Umständen offensichtlich gewesen sein;
- Je nachdem, inwieweit die Sachmittel handelsübliche Produkte sind, verleitet der Anbieter den Käufer dieser Sachmittel zu einem direkten Verletzung.

Allgemein gilt, dass sich die rechtlichen Anforderungen und Folgen nicht nach den Modalitäten des gewerblichen und geistigen Rechtsschutzes richten dürfen. Begründete Ausnahmen sind jedoch zulässig. Der Inhaber des Rechts, gegen das verstossen wurde, muss dieselben Vorsichtsmassnahmen wie bei direkten Verletzungen ergreifen können. Der Inhaber des Rechts darf nur Schadenersatz für den tatsächlich erfolgten direkten Verletzung erhalten, und dies nur in dem Masse, wie der Verursacher des indirekten Verletzungen tatsächlich am direkten Verletzung beteiligt gewesen ist.