

**Minutes of the plenary session  
of Tuesday September 9, 2008 of the Boston Congress:**

**Question Q 204**

**The responsibility for infringement of intellectual property rights by supply of means**

The meeting was opened by Mr. Donald McOdrum (Canada) who invited Mr. Gerd Jeakert (Germany) to give a presentation on a recent case in Germany on the question of the supply of means as regards patents.

Mr. Jeakert took the floor and spoke about an appeal case called “the radio-alarm decision”. He indicated that, pursuant to this case, it is enough to retain the responsibility for the supply of means, that only one element of the claim is supplied, provided that this element is not completely unimportant. But, if this condition is met, then the judge can prohibit the delivery of such an element even if it originates from overseas. His talk was followed by prolonged applause.

M.Nicolai Lindgreen (Denmark), Assistant to the Rapporteur General, then took the floor and recalled previous work of the AIPPI on the question. The problem of the supply of means had already been tackled by the AIPPI at the time of the Vienna Executive Committee meeting in 1997 and one resolution was adopted within the framework of question Q134A. However, because of the limited range of this resolution, the Programme Committee suggested studying this problem again. He also underlined that the definitions of infringement by supply of means given by the national legislations considerably vary and that it is advisable to refer to the orientation of work and the summary report for the definition of the infringement by supply of means. Finally, he noted that issues relating to private international law had been excluded from the study conducted by the AIPPI.

The Chairman Mr. McOdrum asked the Chairman of the Working Committee, Mr. Klaas Bisschop (the Netherlands), to introduce the resolution. Mr. Bisschop then presented the work completed by the Committee. The main difficulty was the very broad range of the question which related to all the IP rights and not just to patents to which the initial talk relating to German “radio-alarm” case is relevant. He set out in general the Resolution draft which starts with the recognition of the need to establish legal rules dealing with infringement by supply of means. The continuation of the resolution concerns principles which must be adopted to determine the possible responsibility and he stressed in this context the importance of the reference to the “substantial element of the protected intellectual property right”. He stressed that the responsibility for infringement by supply for means requires that the supplied means refers to or is linked with the essence of the protected creation. He stressed that, for this responsibility to be retained, it is not necessary that an act of infringement is committed. He finally noted that, from the point of view of sanctions, this kind of infringement must be treated like all the others, i.e. it has to lead to the same sanctions. He finished his talk stressing that the question required complementary studies from the AIPPI.

His intervention was warmly applauded and Mr. McOdrum thanked him cordially.

Mr. McOdrum proposed to open the debate with point 1 of the Resolution draft. In absence of comments, this point was submitted to the vote and was adopted. Point 2 was dealt with in the same way and was also adopted.

A proposal for an amendment of point 3 was raised on behalf of the Canadian group. Mr. Alfred Macchione observed that this article is not sufficiently precise and proposed to supplement it by the expression “the means supplied or offered are not used in a substantially non-infringing way”. Mr. Bisschop considered that this amendment was not useful because point 7 was dealing with a similar question. Mr. Luis Henrique Amaral (Brazil) criticised the amendment of the Canadian group because it would introduce a double negative. Mr. McOdrum submitted the amendment to the vote and it was rejected. Point 3 was therefore subjected to a vote and it was approved with a strong majority.

Points 4, 5 and 6 were successively proposed to the assembly, did not raise any comment and were all adopted.

Point 7 led the Canadian group to make a new comment. Mr. Macchione stressed that the text of this point would allow a double indemnity. He proposed to add to it “and if he were not otherwise compensated by the direct infringer or other infringers by supply of means”. Mr. Bisschop rejected this amendment because he saw there a risk of obliging the holder of an intellectual property right to pursue everyone engaged in the commission of the infringement. In the same way, this amendment suggested a differentiation in the evaluation of the damages which was not wished by the Working Committee. Mr. Lingreen also opposed this amendment. Mr. Pierre Véron (France) wondered whether the solution would lie in the introduction of the expression “like the result” or not. He also stressed that the drafting of point 7 gives rise to an uncertainty: does the infringer by supply of means have to be responsible only for “his share” of the infringement or does he have to take responsibility for the whole? Mr. Bisschop stressed that this point was lengthily discussed with the meeting of the Committee of Sunday, but that no opinion appeared to have a majority. This is why the Commission preferred to use text which does not settle this question. Mr. Véron replied that point 7 would then be voluntarily vague. Mr. Marcel Kereszety (Hungary) stressed that it is necessary to avoid the possibility of double indemnity. He thus approved the Canadian amendment. Mr. John Pegram (United States) noted that the discussion shows a real comprehension problem of this point and he suggested clarifying the draft by changing the word order. This suggestion was approved by the assembly which then adopted point 7.

Point 8 led to an intervention by the French group. Mr. Christian Nguyen (France) pointed out that the supply of means often raises problems of territoriality and that this question would deserve to be dealt within the resolution. This comment was approved by a Dutch delegate, who asked the Committee to take as a starting point the “radio-alarm” case quoted in the talk of Mr. Jeakert. Mr. Bisschop pointed out that this aspect of the supply of means was not dealt with in the group reports. Thus, the Committee did not have sufficient contributions to give a direction to its work. In addition, he stressed that the solution adopted by the German Courts in the “radio-alarm” case goes a long way in the protection of the patent rights whereas the draft resolution deals with all intellectual property rights and not only patents. Since the question was not truly studied by the AIPPI, it appears difficult to him to include a recommendation in the resolution. Mr. Bo Davidsson (Sweden) made a formal suggestion: he proposed to remove the second paragraph of point 8. Mr. Bisschop opposed this suggestion because that would lead to eliminate the future study of the jurisdiction issue. Mr. Luis Gayoso (Peru) wondered if it is useful to leave the expression “and/or” and if the simple one “and” would not be preferable. Mr. Nguyen asked for the resolution to deal with the territorial problem at least for patents, even if he recognized that other intellectual property rights would require additional thought. Mr. Bisschop observed that there is no reason to give advantage to an IP right and that the Committee only suggested to continue the study of the problem.

Mr. Pegram (United States) requested to keep the original drafting of point 8 and added that the territoriality problems vary much from the European to the North American countries. He also underlined the complexity of the question which deserves complementary studies. Mr. Thierry Sueur, Chairman of the Programme Committee indicated that his Committee will seriously take into account the suggestions of the French group. The Japanese group intervened to approve Mr. Pegram's comments and underlined the need to conduct additional studies. Japanese companies are often confronted to very varied situations, in particular when they export products, and Japanese IP specialists are quite conscious of the complexity of this question. The assembly voted on the French amendment which was rejected. Since the Committee accepted the observation of the Peruvian delegate, point 8 without "or" was subjected to a vote. This point was adopted with a strong majority.

Mr. McOdrum then submitted the whole resolution to the vote and it was adopted almost unanimously (only three votes against). Mr. McOdrum closed the meeting by thanking the Chairman and the members of the Working Committee.