



Congress Boston 2008
ADOPTED version
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Resolution

Question Q204

Liability for contributory infringement of IPRs

AIPPI

Observing that:

- a) Many jurisdictions acknowledge contributory infringement of IPRs; however, the term contributory infringement of IPRs has different meanings in various jurisdictions and may also depend on the type of IPR involved.
- b) For the purpose of this Resolution the term contributory infringement has been defined so as to comprise only the form of indirect infringement consisting in the offering or supply of means suitable for committing an act that is a direct infringement of an IPR; "contributory infringement" shall not include other acts known as indirect infringements, such as inducement or the provision of other assistance than the offering or supply of means for committing a direct infringement.
- c) Among the jurisdictions acknowledging contributory infringement, there is diversity as to which conditions must be met in order for an act to qualify as an act of contributory infringement.
- d) Among the jurisdictions acknowledging contributory infringement such conditions may differ for the various types of IPRs.
- e) One of the major issues with respect to contributory infringement is whether it is a condition for such infringement 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 jurisdiction (or in another jurisdiction where there is a corresponding IPR).
- f) In its Resolution Q 134A, AIPPI took the position that in respect of patents, indirect infringement does not presuppose that an act of infringement is actually committed by another (the direct infringer).
- g) Other important issues with respect to contributory infringement are whether it is a condition for such an infringement:

- 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;
 - that to the extent that the means are staple commercial products, the supplier induces the person supplied to infringe directly.
- h) In many jurisdictions injunctive relief against an act of contributory infringement is available to the same extent as against direct infringements; however, there is diversity as to whether this implies that an injunction can be obtained against the manufacturer and/or sale of the means *per se*.
- i) In many jurisdictions damages for contributory infringement are available to the IPR owner to the same extent as against direct infringers; in some jurisdictions, however, the amount of the damages is limited to an amount proportionate to the contribution made or offered.

Resolves that:

- 1) It is recommended that all jurisdictions adopt rules in their IP law concerning contributory infringement of IPRs and that the basic principles be harmonised.
- 2) The basic principles for establishing contributory infringement should generally be the same for all types of IPRs, while the particular nature of each particular type of IPR justifies certain differences in the detailed conditions for establishing contributory infringement.
- 3) The basic principles for contributory infringement should include that:
 - the means supplied or offered by the contributory infringer relate to a substantial element of the subject matter of the protected IPR;
 - the means supplied or offered by the contributory infringer are for an infringing use;
 - at the time of offering or supply, the suitability and intended use were known to the supplier or obvious under the circumstances.
- 4) It should not be a condition for an injunction against contributory infringement that an act of actual infringement is actually committed, if such actual infringement is likely to occur.

- 5) The remedies for contributory infringement should generally be the same for all types of IPRs.
- 6) Injunctive relief should, in principle, be available against contributory infringement of IPRs to the same extent as against direct infringement.
- 7) The IPR owner should be able to hold the contributory infringer liable in damages for any loss that is incurred as a result of the contributory infringement and is not otherwise recovered.
- 8) It is recommended that AIPPI continue the study of contributory infringement of IPRs, including but not limited to the conditions which must be met for an act to qualify as a contributory infringement and the relief available to the IPR owner in the case of a contributory infringement. Specifically, AIPPI should investigate, if it should be a condition for contributory infringement that the act of contributory infringement and the intended infringing use should take place in the same jurisdiction.