

News

More research needed on contributory infringement

Delegates yesterday passed a Resolution recommending that all jurisdictions adopt rules on contributory infringement.

The Resolution builds on previous AIPPI work on patents, by addressing other IP rights such as trade marks and copyright, but does not cover issues arising from the internet. It stated that the principles and remedies for establishing contributory infringement should generally be the same for all types of IP right.

The delegates agreed that the principles should be harmonised and should include that the means supplied related to “a substantial element of the subject matter” of the protected right; that the means are for an infringing use and that “the suitability and intended use

were known to the supplier or obvious under the circumstances”. Delegates rejected a Canadian proposal to add a fourth, negative, condition covering staple products that do not have a substantial non-infringing use.

The Resolution said that injunctive relief should be available against contributory infringement not only if infringement is committed but also “if such actual infringement is likely to occur”.

One question that was not decided in the Resolution concerned territoriality, as the working committee believes that requires further study. It is likely therefore that at some point another Question will be framed on whether 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”.

Patent exhaustion and recycling

Delegates also debated a Resolution on how to define IP exhaustion for recycled goods. Question 205 acknowledged the increasing importance of recycling to improve the environment and

conserve resources and tried to define and differentiate the terms repair and reconstruction.

Although the considerations admitted that “no uniform criteria have emerged”, paragraph 3 stated that repair of a patented product “including maintenance work and minor interventions” is not infringement and so the principle of exhaustion applies. An attempt by the Peruvian group to add “using original and authorised parts” to the end of the definition did not succeed.

Reconstruction of a patented product defined as “changing or reproducing an essential component of such product” is infringement and so exhaustion does not apply.

The same principles were applied for designs, but paragraph 5, which looked at how the principles should apply to trade marks, created the most debate. After considering several proposals, it was decided to add the word “only” to the end of the phrase stating that a trade mark owner “may oppose further commercialisation of the goods under the trade mark for legitimate reasons”. Working committee chairman Trevor Cook of Bird & Bird explained that the addition was intended “to make it clear that there need to be legitimate reasons for opposing further commercialisation of the product”.

The Resolution looked only at patent, design and trade mark protection – it was decided that exhaustion of copyright should be the subject of further study. ■

Yesterday's Resolutions

Q204	Contributory Infringement of IPRs	Passed 80-3
Q205	Exhaustion of IPRs in Cases of Recycling and Repair of Goods	Passed



Panellists at yesterday's workshop dealing with the risks of infringement, sponsored by Knobbe Martens, outlined the various strategies for proving infringement or invalidity in the US, Europe and Japan. One difference is that while performing searches for existing patents may lead to a finding of wilful infringement in the US courts, patent searches in Germany and Japan are considered standard protocol and pose no risk for companies. Speakers also shared tips on the usefulness of obtaining legal opinions and when and how to challenge a patent's validity in each of the jurisdictions. The session was moderated by Daniel Altman of Knobbe Martens and panellists included Ryoichi Takaoka of Takaoka IP Law in Japan, Matthias Sonntag of Gleiss Lutz in Germany and Valentina Boyet of SAP in the US. ■