

## Question Q204P

**National Group:** Finland

**Title:** **Liability for contributory infringement of IPRs – certain aspects of patent infringement**

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### Questions

The Groups are invited to answer the following questions under their national laws

#### I) Analysis of current legislation and case law

1. a) *Is it a separate condition for the supply or offering of means to qualify as contributory patent infringement that the means supplied or offered were suitable to be put to a use that would infringe the patent?*

Yes, this follows from Section 3 (2) of the Finnish Patents Act. [English translation of Patents Act](#)

- b) *If yes to a), is it relevant that the means are also suitable to be put to other uses not related to the invention?*

Yes, if the means are also suitable to be put to other uses not related to the invention, the means are regarded as staple commercial products. In such case, it would be an additional condition for the offering or supply to qualify as contributory infringement that the supplier of the means attempts to induce the supplied person to infringe the patent.

2. a) *Is it a condition for the supply or offering of means to qualify as contributory patent infringement that the person supplied intended, at the time of supply or offering, to put the means to an infringing use?*

No. Under Section 3 (2) of the Finnish Patents Act it is a condition for contributory infringement that the supplier knows or that it is evident from the circumstances, that the means are suitable and intended for infringing the patent. The Finnish Patents Act does not explicitly deal with the matter from the supplied person's point of view, but the requirement of the means being

suitable and intended for infringing the patent would normally also mean that the supplied person has an intention to infringe the patent.

If the means are staple commercial products, it is an additional condition for the offering or supply to qualify as contributory infringement that the supplier attempts to induce the supplied person to infringe the patent.

*b) If yes to a), is the element of intention a separate condition to any condition of suitability for an infringing use?*

See a).

*c) If yes to a) is it a condition for the supply or offering of means to qualify as contributory patent infringement that the supplier was aware, at the time of supply or offering, that the person supplied intended to put the means to an actually infringing use?*

See a).

3. *If it is a condition for the supply or offering of means to qualify as contributory patent infringement that the means relate to an essential, valuable or central element in the invention or that the means relate to an essential, valuable or central element in the product or service that constitutes direct infringement, what is the test for determining whether an element is essential, valuable or central?*

Section 3 (2) of the Finnish Patents Act includes the requirement that the offered or supplied means must relate to an essential element of the invention. There is no Finnish court practice as to how the essentiality of such element is to be determined. In Finnish jurisprudence it has been regarded that there is a close connection between the patent claims and the essentiality, and accordingly the patent claims (interpreted in light of the description) are to be regarded the starting point in assessing whether the supplied means related to an essential element of the invention.

4. *To the extent the means supplied or offered are staple commercial products, is it an additional condition for the supply or offering of means to qualify as contributory patent infringement that the supplier provides any instruction, recommendation or other inducement to the person supplied to put the goods supplied or offered to an infringing use?*

Yes, if the means are staple commercial products, it is a requirement of Section 3 (2) of the Patents Act that the supplier attempts to induce the supplied person to infringe the patent.

5. *a) Is injunctive relief available against acts of contributory infringement?*

Yes, the same remedies are available as with regard to direct infringement.

*b) If yes to a), may injunctive relief be directed against the manufacture of the means per se or the supply of the means per se?*

No, the injunctive relief must be more specified (see c) below).

*c) If no to b), must the injunction be limited to manufacture or supply of the means in circumstances which would amount to contributory infringement?*

Yes. It is interesting to note that the acts prohibited under the provisions on contributory infringement are the offering and supply only. Manufacture is not explicitly mentioned as a prohibited act which is the case with regard to direct infringement. Because of the necessity to be able to cease infringements as early as possible, and the interpretation that supply may include manufacture as a pre-stage of supply, it would seem possible that also injunctive relief is available against manufacture, at least in situations where the means (other than staple commercial products) are suitable and intended for infringing the patent.

d) *If yes to c), how in practice should this limitation be included in injunction orders, for example:*

*i) may claims for injunctive relief be directed for example against the abstract or hypothetical situation that the means are supplied in circumstances where the supplier is aware that the person supplied intends to put the means to an infringing use, and/or*

Yes, referring to an abstract situation would be the normal way to formulate the claim for injunctive relief.

*ii) must claims for injunctive relief be directed against particular shipments of means for which the supplied person's intent and the supplier's knowledge has been proven?*

No.

6. *Is it a condition for the supply or offering of means to qualify as contributory patent infringement that the intended use of means for actual infringement is intended to take place in the country where the means are supplied or offered?*

Under Section 3 (2) of the Finnish Patents Act, it is a condition for the supply or offering of means to qualify as contributory patent infringement that the intended use for actual infringement takes place "in this country", i.e. in Finland.

7. *How is it to be determined where means are supplied or offered? For example:*

– *Supplier X conducts business in country A, X agrees to supply person Y with means for an infringing use in country B Are the means supplied in country A or B or in both?*

The Finnish Patents Act is based on the principle of territoriality. This means that only acts which occur within the territory of Finland may constitute an infringement of a Finnish patent. If there would be a claim for contributory infringement because of offering or supply of means, the Finnish Court would first have to assess whether the offering or supply occurred in Finland. The place of offering or supply may under Finnish law be determined on a number of factors. The offering would normally be regarded to have occurred at the place where the seller has actively promoted or offered its products. Supply on the other hand would, as a rule, be regarded to be the place at which the purchaser takes delivery of the goods on the basis of the agreed terms of delivery.

- *Supplier X undertakes to deliver means “free on board” in a harbour in country A in the same circumstances Are the means supplied in country A or B or in both?*

The supply is to be regarded to take place in country A, since under the terms of delivery, the delivery to the purchaser takes place in the harbour in country A.

- *Supplier X undertakes to deliver means “free on board” in a harbour in country B in the same circumstances Are the means supplied in country A or B or in both?*

The supply is to be regarded to take place in country B, since under the terms of delivery, the delivery to the purchaser takes place in the harbour in country B.

- *If the offer was made in country A but accepted in country B, are the means supplied in country A or B or in both?*

It is not possible under Finnish law to draw any conclusions about the place of supply (delivery) based on the mere existence of a sales agreement that has been made through the acceptance of an offer. The offering, on the other hand, seems to have occurred in country A.

8. *If means suitable for being incorporated into a patented product P are supplied by supplier X in country A to person Y, in circumstances where it was known to X (or it was obvious in the circumstances):*

- i) that Y intended to export the means to country B and complete product P in country B; and*
- ii) that Y intended to export the completed product P into country A,*

*would Y then be regarded as having intended to put the means to an infringing use in country A by importing and selling product P in country A, with the consequence that X could be held liable for contributory infringement in country A by supplying the means to Y?*

Yes, and in a practical case the patentee would have to prove that X was aware of the plans to use the product P in country A.

9. *a) Is the question of contributory infringement determined in accordance with the law of the country in which the means are:*

- i) offered; or*
- ii) supplied?*

No. If there was a claim for contributory infringement of a Finnish patent because of offering or supply of means, the Finnish Court would on the basis of the aforementioned principle of territoriality apply Finnish law and the Finnish Patents Act.

- b) What is the applicable law if the means are offered in country A but supplied in country B?*

See 9. a) above.

- c) Are there any other relevant principles to determine the applicable law?*

No.

## II) Proposals for substantive harmonisation

The Groups are invited to put forward their proposals for adoption of uniform rules, and in particular consider the following questions:

1. *In a harmonised system of patent law, what should be the conditions for an act of supply or offering of means to qualify as a contributory patent infringement?*

The Finnish AIPPI Group supports a harmonisation to increase legal security and to remove loopholes in the law. The Finnish AIPPI Group considers that a model which includes the following elements could be used as a starting point in the harmonisation work: 1) contributory infringement should require that the supplier knows or that it is evident from the circumstances, that the means are suitable and intended for infringing the patent; 2) if the means are staple commercial products, a further requirement should be that the supplier must attempt to induce the supplied person to infringe the patent to qualify as contributory infringement; and 3) the offered or supplied means must relate to an essential element of the invention.

2. *In a harmonised system of patent law, to what extent should injunctive relief be available to prevent contributory patent infringement?*

It is the recommendation of the Finnish AIPPI Group that injunctive relief should be available for contributory infringement to the same extent as with regard to direct infringement.

3. *In a harmonised system of patent law, how should it be determined where means are supplied or offered?*

In the view of the Finnish AIPPI Group, the place of offer or supply should be determined under the law applicable to the alleged contributory infringement claim. When determining the place of offering, regard should not only be given to where the active sales promotion takes place but also to where the sales promotion is directed. When determining the place of supply, it is the opinion of the Finnish AIPPI Group that the agreed terms of delivery shall play an important role in the assessment.

4. *Should special rules apply to offers transmitted via electronic devices or placed on the internet?*

It is the opinion of the Finnish AIPPI Group that the rules shall be general and applicable to all means of offering, including offers transmitted via electronic devices or placed on the Internet. In the drafting of such general rules, the specific features of e-commerce shall be taken into account.

5. *In a harmonised system of patent law, how should it be determined which country's law should apply to acts of offering or supplying means where persons or actions in more than one country are involved?*

It is the opinion and recommendation of the Finnish AIPPI Group that the law applicable to the direct infringement (i.e. the law of the country where the direct infringement occurs) shall be applicable to the contributory infringement (including acts of offering or supplying) as well.

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

No.

### **Summary**

The Finnish Patents Act provides for liability for contributory infringement. Such liability arises when a supplier offers or supplies means of working the invention to a person not entitled to exploit the protected invention in a situation where the supplier knows or where it is evident from the circumstances that the means are suitable and intended for working the invention. If the means are also suitable to be put to other uses not related to the invention (staple commercial products), it would be an additional condition for the offering or supply to qualify as contributory infringement that the supplier of the means attempts to induce the supplied person to infringe the patent.

A further prerequisite for the offering or supply to qualify as contributory infringement is that the means must relate to an essential element of the invention. According to Finnish jurisprudence, the patent claims are to be regarded the starting point in assessing whether the supplied means related to an essential element of the invention.

The Finnish Patents Act is based on the principle of territoriality. This means that only acts which occur within the territory of Finland may constitute an infringement of a Finnish patent. The place of offering or supply may under Finnish law be determined on a number of factors. The offering would normally be regarded to have occurred at the place where the seller has actively promoted or offered its products. Supply on the other hand would, as a rule, be regarded to have occurred at the place where the purchaser takes delivery of the goods on the basis of the agreed terms of delivery.

Injunctive relief is available under Finnish law against acts of contributory infringement in the same way as against direct infringement. The claim for injunctive relief must be specified and limited to manufacture or supply of the means in circumstances which would amount to contributory infringement.

The Finnish AIPPI Group supports a harmonisation to increase legal security and to remove loopholes in the law. The harmonisation should stipulate clear prerequisites for contributory infringement, allow injunctive relief and provide rules for determining where means are supplied or offered. With regard to determining the place of offering, the Finnish AIPPI Group considers that regard should not only be given to where the active sales promotion takes place but also to where the sales promotion is directed.

### **Résumé**

La loi finlandaise sur les brevets prévoit une responsabilité pour complicité de contrefaçon. Cette responsabilité intervient lorsqu'un fournisseur met à disposition ou fournit les moyens à une personne de mettre en œuvre l'invention protégée alors que cette même personne n'y est pas autorisée, et cela dans le cas où le fournisseur a connaissance du fait que les moyens fournis sont propres et destinés à mettre en œuvre l'invention ou que cela est indubitable compte tenu des circonstances présentes. Dans le cas où les moyens peuvent être utilisés pour d'autres usages qui ne sont pas en relation avec l'invention (composant, élément ou matière première entrant dans la composition d'un produit commercialisé), et afin que la mise à disposition ou la fourniture de moyens de mettre en œuvre l'invention relèvent de la complicité de contrefaçon, il est nécessaire en tant que condition supplémentaire que le

fournisseur qui fournit ou met ces moyens à la disposition de la personne récipiendaire tente de la faire contrevenir au droit attaché au brevet.

Un prérequis pour que la mise à disposition ou la fourniture de moyens soit qualifiée de complicité de contrefaçon est que les moyens doivent porter sur un élément essentiel de l'invention. Conformément à une jurisprudence constante des juridictions finlandaises, les revendications de brevet doivent servir de point de départ dans l'analyse permettant d'établir si les moyens fournis avaient un rapport avec un élément essentiel de l'invention.

La loi finlandaise sur les brevets se base sur le principe de territorialité (jus loci). Cela signifie que seuls les actes commis sur le territoire finlandais peuvent être considérés comme contrefaçon d'un brevet finlandais. Le Droit finlandais énonce que, le lieu de la mise à disposition ou la fourniture de moyens peut être défini sur la base de multiples facteurs. La mise à disposition sera généralement considérée d'une part comme étant intervenue sur le lieu où le vendeur aura offert ou promu de façon active ses produits et la fourniture de moyens d'autre part comme ayant été conclue sur le lieu de réception de la livraison des biens conformément aux conditions de livraison convenues.

Le Droit finlandais admet le recours à des mesures conservatoires ordonnées par un tribunal (ou « par injonction ») pour faire face aux actes de complicité de contrefaçon comme il l'admet face aux actes directs de contrefaçon. La demande de mesures conservatoires doit être spécifiquement définie et limitée à la fabrication ou la fourniture de moyens dans des cas qui relèveraient de la complicité de contrefaçon.

Le Groupe finlandais de l'AIPPI se prononce en faveur d'une harmonisation afin d'accroître la sécurité juridique et de réduire les failles de la loi. L'harmonisation devrait clairement énoncer les prérequis définissant la complicité de contrefaçon, permettre le recours à des mesures conservatoires (ordonnées par un tribunal) et présenter les règles permettant de déterminer les cas où l'on peut considérer que les moyens sont mis à disposition ou fournis. Le Groupe finlandais de l'AIPPI considère qu'il convient, pour définir le lieu de mise à disposition, de s'attacher non seulement au lieu où la promotion active des ventes est effectuée, mais également au lieu où la promotion des ventes est destinée.

## **Zusammenfassung**

Die Haftung für mittelbare Verletzung ist in dem finnischen Patentgesetz vorgesehen. Solche Haftung entsteht, wenn ein Liefernder an einer Person, der zur Verwertung der geschützten Erfindung nicht berechtigt ist, Mittel zum Ausüben der Erfindung, in einer Situation, in der die Eignung und Verwendung der Mittel für Ausüben einer Erfindung der Liefernde bekannt oder unter den gegebenen Umständen offensichtlich ist, liefert oder anbietet. Sind die Mittel auch für andere, der Erfindung nicht betreffende Verwendungen geeignet (Haupthandelserzeugnisse), wäre eine zusätzliche Bedingung für Qualifizieren des Anbieten oder der Lieferung als die Haftung für mittelbare Verletzung, dass der Liefernde der Mittel versucht, den Beliefernden zu einer Verletzung des Patentes zu veranlassen.

Eine weitere Voraussetzung für Qualifizieren des Anbieten oder der Lieferung als die Haftung für mittelbare Verletzung ist, dass die Mittel ein wesentliches Element in der Erfindung betreffen. Nach der Finnischen Rechtsprechung liegen die Patentansprüche zugrunde für die Beurteilung, ob die gelieferten Mittel ein wesentliches Element in der Erfindung betreffen.

Das Finnische Patentgesetz gründet sich auf dem Territorialitätsprinzip. Das bedeutet, dass nur solche Handlungen, die auf Finnlands Gebiet stattfinden, eine Verletzung des finnischen Patents darstellen können. Der Ort des Anbieten oder der Lieferung kann unter dem Finnischen Recht nach mehreren Tatsachen bestimmt werden. Es ist gewöhnlich, dass das Anbieten in dem Ort erfolgt, in dem der Liefernde seine Produkte aktiv gefördert oder

angeboten hat. Dagegen betrachtet man die Lieferung üblicherweise an dem Platz erfolgt zu sein, an welchem der Einkäufer, aufgrund der verabredeten Lieferbedingungen, die Waren übernimmt.

Gemäß des Finnischen Rechts steht der Rechtsschutz durch einen Unterlassungsanspruch bei mittelbarer Verletzung auf der gleichen Weise zur Verfügung wie bei direkter Verletzung. Der Unterlassungsanspruch muss bezeichnet sein und auf die Herstellung oder Lieferung der Mittel unter Umständen, die auf eine mittelbare Verletzung gleichkommen, begrenzt sein.

Die Finnische AIPPI Gruppe unterstützt die Harmonisierung um Rechtssicherheit zu verstärken und um die Gesetzeslücke zu schließen. Die Harmonisierung sollte deutliche Voraussetzungen für die mittelbare Verletzung festlegen, die Rechtsschutz durch ein Unterlassungsanspruch zulassen und die Regeln zur Bestimmung für den Ort, da die Mittel angeboten oder angeliefert werden, zur Verfügung stellen. Angehend der Bestimmung des Orts des Anbietens legt die Finnische AIPPI Gruppe vor, dass nicht nur der Platz der aktiven Verkaufsförderung beachtet sein soll, sondern auch wohin die Verkaufsförderung gerichtet ist.