

Question Q204P

National Group: AIPPI TURKEY

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, it is a separate condition according to Art. 74(1) D.L. 551 that supplied or offered means must be essential elements of the invention and shall be suitable to be put to a use that would infringe the patent. In addition, the act of offering is not considered to be direct or contributory infringement for product patents whereas it is considered to be infringement for process patents according to the current Turkish Patent Law, D.L. 551.

- 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?

It is irrelevant whether or not the means are also suitable to be put to other uses not related to the invention.

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?

The answer is YES. While the law does not explicitly mention intention, it requires that the person shall be aware that such elements and means are sufficient for putting the invention into use and further that they will be used to such effect or that the circumstances render such situation sufficiently evident.

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

The answer is NO as Art.74(1) D.L. 551 seeks two conditions, namely awareness on enablement and purpose of use. It is believed that awareness on both conditions does not necessarily correspond to an element on intention and further that the awareness condition is a weaker condition compared to an intention condition.

- 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?

Yes, the supplier shall be aware that the person supplied intended to put the means to an actually infringing use or the circumstances render such situation sufficiently evident.

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?

It is a requirement, to qualify as contributory patent infringement according to Art. 74(1) that the supply or offering of means must relate to an essential, valuable or central element in the invention. Nevertheless, we do not have a specific test defined in the law or its regulations or the case law that would allow us to determine whether an element is essential, valuable or central to qualify as contributory patent infringement.

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. Art 74(2) D.L. 551 requires that Art. 74(1) shall not apply when the elements or means referred to in Paragraph one are staple products, unless third parties induce the persons concerned to commit such prohibited act.

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

Yes, Art. 151 D.L. 551 mentions that a patent holder may request injunctive relief provided that a third party exploits the patent in Turkiye or is in serious and effective preparation for the exploitation of the patent. The term exploitation is defined as an exact exploitation or a partial exploitation in Art. 136(a) and 136 (b) so as to cover for contributory 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?

Yes, the injunctive relief may be directed to both manufacture and supply of the means. In fact, Art. 136(b) D.L. 551 reads as follows and allows prohibition of more acts;

“Selling, distributing or commercializing in any other way, or importing for such purposes of products or keeping them in possession for commercial purposes or using by applying such products, manufactured as a result of an

infringement, where the person concerned knows or should know that such products are imitations in whole or, in part.”

- 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?

N/A

- 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

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?

N/A

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?

There is no geographical restriction relating to the supply of means. However, the place for intended use of means for actual infringement shall be in Turkiye.

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?

It depends on where the actual sales took place.

- 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?

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The means are supplied 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?

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The means are supplied 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?

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The fact that an offer is accepted does not indicate that the supply took place. Hence, the answer is neither country A, nor country B. The act of offering or accepting such an offer is not an infringing activity for the case of product patents according to Art. 136 D.L. 551.

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, assuming that country A is Turkey in the present example, supplier X **in either case (i) and (ii)** would be held liable of contributory infringement according to Art. 136(a) and (b).*

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?

The determination is made according to where the means are supplied.

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

The applicable law is the law of country B where the means are supplied.

- 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?

For an act of supply or offering of means to qualify as a contributory patent infringement it is believed that;

- (i) such elements and means MUST relate to an essential part of the invention, and*
- (ii) such elements and means MUST be suitable for implementation of the patented invention, and*
- (iii) the person supplying such elements and means shall be aware that such elements and means are sufficient for putting the invention into use, and*
- (iv) the person supplying such elements and means shall be aware that they will be used for an infringement activity or that the circumstances render such situation sufficiently evident*

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

The extent of availability of injunctive relief shall be the same extent of availability of injunctive relief in cases of direct patent infringement.

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

No matter what rules are to be defined, it shall be noted that the right to a patent is a national right and limitation to a national borders shall be strictly observed. The contrary would result in jeopardizing the principle of reasonable degree of certainty for third parties.

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

Rules applying to direct infringement are deemed to be appropriate also for the contributory infringement. Therefore, no special rules are envisaged.

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?

The applicable law shall be the law of the country where actually the sales took place.

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

Harmonization shall take place in view of the fact that the patent right is a national right and can be enforced against acts conducted within the borders concerned.

Note: It will be helpful and appreciated if the Groups follow the order of the questions in their Reports and use the questions and numbers for each answer.