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Indirect patent and utility model infringement

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On 1 July 2005 new provisions of the Austrian Patents Act (Sec. 22, para 3-5) and of the Austrian Utility Models Act (Sec. 4a) entered into force, according to which the patent and/or utility model owner will be enabled to enforce his exclusive right also against indirect infringement. The purpose of the introduction of this legal instrument is to facilitate the enforcement for the owner, since hereby the owner of a protective right may address directly to the supplier of infringing means and is no longer limited to proceedings against the direct patent infringer (who is often unknown or not yet infringing). Accordingly, acts of infringement can, so to speak, be tackled at their roots.

In fact, it has already been possible to take legal actions against accomplices, instigators and assistants of the infringer up to now. However, according to Section 1301 Austrian Civil Code such assistants were only regarded as offenders if they had consciously supported the acts of infringement or if they had knowingly accepted the intended breach of law of a third party, i.e. so far conditional intent has been a prerequisite for taking legal actions against instigators and/or assistants of the infringer. The introduction of indirect patent and/or utility model infringement henceforth allows to take legal actions against those who are offering or delivering, respectively, a substantial element of the subject-matter of the invention, provided that the circumstances allow the conclusion that those objects are suited and designed for the use of the invention – without necessarily having to prove the resulting patent infringement or the intent of the indirect patent infringer, respectively. Thus, by means of the institute of indirect patent and/or utility model infringement also an alleviation of the burden of proof has been introduced, whereby it is sufficient, if an independent skilled person may doubtlessly conclude that the offered and/or delivered objects are especially suited and designed for the use of the invention.

As opposed to direct patent and/or utility model infringement which include a wider range of elements of offence, a patent and/or utility model is only indirectly infringed if the infringing elements are offered and/or delivered. Accordingly, for example the production of elements being substantial for the invention does not constitute an indirect patent infringement. The offer and/or delivery must take place in the jurisdiction of the Patents and/or Utility Models Act, hence in Austria, whereby exporting on basis of the production or on basis of the import to foreign purchasers does not satisfy the prerequisites for indirect patent and/or utility model infringement.

In addition, the offer or delivery of the object must be directed to addressees who are not authorized to use the invention, i.e. offering or delivering to a licensee or to a prior user, does not constitute an act of infringement. However, according to Sec. 22 (5) Patents Act and Sec. 4a (3) Utility Models Act persons who conduct infringing acts not on a commercial scale, i.e. for private use only, are considered unauthorized users as well. Consequently, the owner of a patent may forbid – in contrast to the hitherto existing legal situation – the offer or the delivery of infringing means for private use.

A patent and/or utility model is only indirectly infringed if the means being offered and/or delivered refer to a substantial element of the invention, whereby all features of the claim are to be considered substantial elements (no matter whether it is a feature of the introductory or of the characterizing part of the claim), unless it is an element which does not contribute at all to the technical teaching (for example nails, screws or the like).

Offering and/or delivering of such products which are generally available in trade is also explicitly excluded from indirect acts of infringement in Sec. 22 (4) Patents Act and Sec. 4a (2) Utility Models Act, unless the offer and/or delivery is carried out consciously (=intentionally) in order to instigate direct patent infringement (as it has already been regarded as infringing act).

In case of an indirect infringement the legal consequences are the same as in case of direct infringement, i.e. the patent and/or utility model owner may claim a cease and desist order, publication of the judgement, adequate monetary compensation and/or in case of culpable infringement he may claim damages or recover of profit as well as rendering of account and of information about the origin and distribution channels of the infringing objects.