

# **The Knowledge Requirement of Contributory Infringement: USA, Germany, and Switzerland**

by

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August, 2009

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## **SUMMARY**

Because the wording of contributory infringement in the German Patent Act is inspired by the codification of contributory infringement in the USA, this report traces the origins of contributory infringement in the United States of America from the late 19th century, to its present form. This evolution shows how the current U.S. contributory infringement provisions came into being, and they provide the roots that served as a basis for the German Patent Act's contributory infringement statute §10(1) PatG. The author proposes to interpret §10(1) PatG, and in particular the knowledge requirement, by looking at the legal history of U.S. contributory infringement. Specifically, the author suggests that the subjective elements in §10(1) PatG are not meant to indicate a double subjective intent, where both the intentions of a third party supplier of means, and the intentions of the recipient of the means are required. Because the third party supplier of the means is the only acting party, it is effectively irrelevant what the true intentions of the recipient are with

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<sup>1</sup> This article follows the citation guidelines in Darby Dickerson, *ALWD Citation Manual* (3rd ed., Aspen Publishers 2006) by the Association of Legal Writing Directors. Supervisors: Dr. T. Calame, Lenz & Staehelin, Zurich; Dr. T. Breimi, Isler & Pedrazzini, Zurich.

regards to whether or not the third party commits a wrong. Moreover, the third party can only ever judge the recipient's intent on the basis of objective, observable fact. For this reason, this author suggests that the recipient's intent should be considered an objective element. A few recent BGH court decisions are considered in view of the analysis. Finally, a brief review of the knowledge requirements for contributory infringement in Switzerland is provided.

## **INTRODUCTION**

The first U.S. patent act dates back to 1790, followed by various amendments and changes summarized into a single act in the general patent act revision of 1870. However, it was not until 1952 that patent infringement, direct and indirect, was codified in a statute<sup>2</sup>. Before 1952 it was left up to the courts to deal with how to enforce infringement when the patent owner brought an action<sup>3</sup>. In this article, the development of contributory infringement in the U.S. after 1870, and the birth of the patent misuse doctrine, which lead to a temporary *de facto* abolishment of contributory infringement, are summarized. The historical cases under common law provide insight into the structure of 35 U.S.C. §271, including the contributory infringement statute, and show why Congress felt that it was necessary to correct the judiciary in the public interest.

Because the German provisions on contributory infringement, §10(1) PatG were influenced by 35 U.S.C. §271(c), the U.S. background is used to provide a possible interpretation of the knowledge or intent requirement set out in §10(1) PatG. Specifically,

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<sup>2</sup> Giles S. Rich, *Infringement under Section 271 of the Patent Act of 1952*, 14 Fed. Circuit B.J. 117, 117 (2004).

<sup>3</sup> *Id.* at 117.

the report discusses objective and subjective intent elements, and the question of whether a double intent is required. The double intent, in the context of the discussion on contributory infringement in Germany, centers around the question whether, and to what extent, an alleged contributory infringer must know what the recipient of the means for the patent infringement intends with those means.

The report terminates with a section reviewing the knowledge requirements of contributory infringement in Switzerland, based on a few available Swiss Supreme Court decisions.

### **THE DEVELOPMENT OF CONTRIBUTORY INFRINGEMENT IN THE U.S.**

Direct infringement of a patent by making, selling or using a structure that *reads* on the claim developed naturally from the fact that patent applications require claim language to set out what the invention is, and what the scope of the patent monopoly is<sup>4</sup>. Indirect infringement, on the other hand, has its roots in the doctrine of joint tortfeasors<sup>5</sup>. "For harm resulting to a third person from the tortious conduct of another, one is subject to liability if he . . . knows that the other's conduct constitutes a breach of duty and gives substantial assistance or encouragement to the other so to conduct himself."<sup>6</sup> The idea is that someone who lends moral support to a tortfeasor, or knowingly provides substantial help to someone committing a tort without committing the tort himself, should be held liable for the damage created, as if he had participated in the tort<sup>7</sup>. For example, A and B are participants in a riot.

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<sup>4</sup> *Id.* at 121.

<sup>5</sup> *Id.* at 120.

<sup>6</sup> *Restatement (Second) of Torts* §876(b) (1979).

<sup>7</sup> *Id.*

Although B does not throw any rocks himself, B encourages A to throw rocks. If one of the rocks that A throws hit a third person C, then B is jointly and severally liable to C<sup>8</sup>.

Today, indirect infringement is the umbrella term for the separate actions of contributory infringement, essentially providing substantial assistance, and induced infringement, essentially encouragement, codified in 35 U.S.C. §271(b) and (c), respectively<sup>9</sup>. Historically, all indirect infringement was referred to as contributory infringement, in line with its torts origins introduced above.

### **I. The early cases: 1871 – 1895**

It is believed that the first case where contributory patent infringement was reported in a court decision is *Wallace v. Holmes* in 1871<sup>10</sup>. In this case about U.S. Patent No. 49984, the inventor made an improvement of an oil lamp, consisting of a burner and a glass chimney<sup>11</sup>. The invention's main feature was a change in the burner construction to keep the chimney cool<sup>12</sup>. The Defendant in this case manufactured and sold the improved burner without the glass chimney, but did exhibit the burner with the chimney in his sales room, because the burner without the chimney was "utterly useless."<sup>13</sup> The defendants argument was that by selling only the burner, they did not infringe the patent which was a combination

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<sup>8</sup> See *Restatement (Second) of Torts* §876(b) (1979); See also 74 Am. Jur. 2d *Torts* § 57 (2009) (joint and several liability).

<sup>9</sup> Rich, *supra* n. 2, at 129. The actions under 35 U.S.C. §271(f) are also considered indirect infringement, related to export, but outside the scope of this article. See Appendix 1.

<sup>10</sup> 29 F. Cas. 74 (C.C. Conn. 1871).

<sup>11</sup> *Id.* at 79.

<sup>12</sup> *Id.* at 79.

<sup>13</sup> *Id.* at 79-80.

of parts, including the glass chimney<sup>14</sup>. Because the burner and the chimney were useless without each other, and because the buyer and the seller knew and intended that the components would be used together, they could not escape liability and should be considered jointly liable, the court held<sup>15</sup>.

It cannot be, that, where, a useful machine is patented as a combination of parts, two or more can engage in its construction and sale, and protect themselves by showing, that, though united in an effort to produce the same machine, and sell it, and bring it into extensive use, each makes and sells one part only, which is useless without the others, and still another person, in precise conformity with the purpose in view, puts them together for use<sup>16</sup>.

The court also found that if only the combination were an infringement, the complainant would be reduced to go after individual lamp buyers, which would be unfeasible and costly<sup>17</sup>. At the same time, the defendant that produces and sells the burner would be getting away, although he knows that the burner will be used with a chimney and then infringe, because it cannot be used in any other way<sup>18</sup>.

The fact that the burner and the chimney were useless without each other, and for use in a patented invention was significant, distinguishing staple articles of commerce from non-staple articles. In *Saxe v. Hammond*, a defendant was found non-labile for contributory infringement because the articles sold were capable of other uses<sup>19</sup>. In *Snyder v. Bunnell*, the defendant was found non-labile for contributory infringement because the parts were

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<sup>14</sup> *Id.* at 80.

<sup>15</sup> *Id.* at 80.

<sup>16</sup> *Id.* at 80.

<sup>17</sup> *Id.* at 80.

<sup>18</sup> *Id.* at 80.

<sup>19</sup> 21 F. Cas. 593 (C.C. Mass. 1875).

considered staple articles with many uses outside of the patented invention<sup>20</sup>. It is comprehensible that the courts did not want the sale of common commodities to fall under the scope of contributory infringement, as this would have established a limited monopoly on such articles for use in the patent<sup>21</sup>.

## **II. A period of excessive rights for the patentees: 1896 – 1917**

Despite the reasonable arguments brought forward in the above cases, from 1896 to 1917, the courts held that it *was* contributory infringement to knowingly sell even staple articles for use in a patented combination, if the patentee had imposed contractual restrictions, for example through a licensing agreement<sup>22</sup>.

In *Henry v. Dick*, the Supreme Court stated that it was within the patentee's right to impose use restrictions, and impose a licensing condition that required the buyer to buy unpatented, standard ink for a rotary mimeograph (an early form of a copy machine) from the patentee<sup>23</sup>. Furthermore, the court considered the use of ink not acquired from the patentee as a direct infringement of the patent, necessary to bring a contributory infringement action against a third party ink supplier<sup>24</sup>. Because the defendant in this case knew about the ink-

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<sup>20</sup> 29 Fed. 47, 48 (C.C.N.Y. 1886).

<sup>21</sup> Rich, *supra* n. 2, at 122.

<sup>22</sup> *Id.* at 122.

<sup>23</sup> *Henry v. A.B. Dick Co.*, 224 U.S. 1, 24 (1912).

<sup>24</sup> *Id.* at 35-36 (non-compliance with the ink restriction is direct infringement); *Id.* at 12 (no contributory infringement action without direct infringement). Note however that indirect infringement under 35 U.S.C. §271(f)(2) involving the export of components, does not require a showing of direct infringement. See e.g. Robert A. Matthews, Jr., 2 *Annotated Patent Digest* § 10:141.

restriction in the third party's license yet sold the ink to the third party anyway, the court found the seller liable for contributory infringement<sup>25</sup>.

### **III. The pendulum swings back: 1917 – 1931**

A few years later, in the *Motion Picture Case*, the Supreme Court overturned *Henry*<sup>26</sup>. In this case, the defendants invented a mechanism for film projectors that reduced stress and wear on the film<sup>27</sup>. The defendants restricted the use of the invention to moving pictures obtained from them<sup>28</sup>. The question faced by the court was again whether the violation of use restrictions on non-patented goods for use with the patented invention could amount to patent infringement<sup>29</sup>. The Court held that such restrictions were not supported by patent law, and not in line with public policy, returning to more restrictive interpretation of patent infringement<sup>30</sup>.

The Supreme Court initially remarked that the language of the patent statute itself related to the machine invented but "[has] nothing to do with the materials used in the operation of the machine."<sup>31</sup> Hence, the Court held, that patent law grants rights only in the new and useful features of the patent, as described in the claims, and does not allow the patentee to "extend the scope of its patent monopoly by restricting the use of it to materials

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<sup>25</sup> *Id.* at 49.

<sup>26</sup> *Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U.S. 502, 518 (1927).

<sup>27</sup> *Id.* at 505.

<sup>28</sup> *Id.* at 506.

<sup>29</sup> *Id.* at 508.

<sup>30</sup> *Id.* at 517.

<sup>31</sup> *Id.* at 512.

necessary in its operation."<sup>32</sup> The Court acknowledged that use restrictions could well be made through contracts, and would be subject to contract law, distinct from patent law and thus distinct from patent infringement<sup>33</sup>. Finally, the Court also pointed out the recent enactment of the Clayton Antitrust Act of 1914 in public policy support of its decision, although the Court explicitly did not rely on it<sup>34</sup>.

In summary, the law on contributory infringement<sup>35</sup> had come full circle: From first being recognized in *Wallace* and being quite narrowly interpreted in *e.g. Saxe* with respect to the scope of protection provided, the pendulum then swung to an excessively favorable interpretation for the patentee in *Henry*, until it went back to a more even-handed approach with the *Motion Picture* case.

#### **IV. The contributory infringement defense of patent misuse: 1931-1952**

While the doctrine of contributory infringement was entirely based on an assessment of the behavior by the alleged infringer, the doctrine of patent misuse developed as a *defense* against an action of contributory infringement, and focused on the behavior of the plaintiff<sup>36</sup>.

In the *Motion Picture* case, the court in essence stated that the rights granted to the patent holder were limited to what is stated in the claims<sup>37</sup>. However, contributory

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<sup>32</sup> *Id.* at 516.

<sup>33</sup> *Id.* at 514.

<sup>34</sup> *Id.* at 517.

<sup>35</sup> At that time contributory infringement was still synonymous with indirect infringement, although induced infringement is not addressed here. See also post-1952 developments.

<sup>36</sup> Rich, *supra* n. 2, at 125.

<sup>37</sup> *Motion Picture* at 510.

infringement, by its very nature, extends protection to something beyond the claims -- otherwise it were direct infringement. However, the important distinction between staple articles and non-staple articles was not made explicitly in the *Motion Picture* case.

The *Carbice* case of 1931 is regarded by many as the first patent misuse case, largely based on the arguments brought in the *Motion Picture* case<sup>38</sup>. In *Carbice*, the plaintiff had a combination patent on refrigeration packaging that was chilled by dry ice (solid carbon dioxide)<sup>39</sup>. The plaintiff only manufactured dry ice, but sold it on the condition that it was to be used only with transport packaging approved by them, as covered by their patent<sup>40</sup>. The defendant, Carbice Corporation, also sold dry ice, challenged the validity of the patent, and denied contributory infringement<sup>41</sup>. The court did not consider the validity of the patent, nor whether direct infringement as a basis for contributory infringement took place<sup>42</sup>. The court denied relief to the plaintiff because he was "attempting . . . to employ the patent to secure a limited monopoly of unpatented material used in applying the invention."<sup>43</sup> It is noteworthy that in this case, as opposed to the early contributory infringement cases, only the behavior of the plaintiff was taken into account in reaching a decision, and thus a new doctrine in patent

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<sup>38</sup> *Carbice Corp. of America v. American Patents Dev. Corp.*, 283 U.S. 27 (1931); See e.g. Rich, *supra* n. 2, at 120; See also Tom Arnold, *Contributory Infringement and Patent Misuse: The Enactment of §271 and its subsequent Amendments.*, 76 J. Pat. & Trademark Off. Soc'y. 357 (1994).

<sup>39</sup> *Carbice* at 29.

<sup>40</sup> *Id.* at 29-30.

<sup>41</sup> *Id.* at 30.

<sup>42</sup> *Id.* at 30.

<sup>43</sup> *Id.* at 33-34.

law was established. However, the *Carbice* decision was in agreement with the contributory infringement law at the time. Although the distinction between patented and unpatented components was mentioned, the distinction between staple and non-staple articles was again not made explicitly.

## **V. Patent misuse eclipses contributory infringement**

Increasingly, however, the focus shifted away from the contributory infringement aspects to the patent misuse aspects, and the courts were primarily concerned with whether the patent owner was trying to extend his rights unfairly, against "public policy."<sup>44</sup> The pinnacle of the misuse-line of thinking was probably reached in the *Mercoïd Corp. v. Mid-Continent Investment Co.* cases in 1944, which all but abolished the contributory infringement doctrine<sup>45</sup>.

In the *Mercoïd* cases, the plaintiff Mid-continent was the patentee for a heating system<sup>46</sup>. The patentee licensed the heating system on an exclusive basis to Honeywell, who manufactured an unpatented switch used in the invention, and had the right to make, use, sell and sub-license the patent<sup>47</sup>. The switch in question had no uses other than in the patented invention<sup>48</sup>. Licenses granted for the use of the invention were conditioned on the usage of the Honeywell switches, and indeed, the patentee Mid-continent even determined its royalties

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<sup>44</sup> See generally *G.S. Suppicer Co. v. Morton Salt Co.*, 31 F. Supp. 876 (Ill. 1940); *B.B. Chemical Co. v. Ellis*, 314 U.S. 495 (1942) ; Rich, *supra* n.2 ; Arnold, *supra* n. 37.

<sup>45</sup> *Mercoïd Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661 (1944).

<sup>46</sup> *Id.* at 663.

<sup>47</sup> *Id.* at 663.

<sup>48</sup> *Id.* at 664.

based on the number of switches sold by Honeywell<sup>49</sup>. Mid-Continent brought an action against Mercoid because they knowingly manufactured and sold switches for use in the patent<sup>50</sup>. Despite the fact that the switch had no uses other than in the patent, the court found that "the instant case is a graphic illustration of the evils of the patent monopoly by private engagement," and focused on the fact that the switch was unpatented and not on the fact that it was not a staple of commerce<sup>51</sup>. The court went on to state that "[t]he result of this decision . . . is to limit substantially the doctrine of contributory infringement. What residuum may be left we need not stop to consider."<sup>52</sup>

Thus, at this point, patent misuse had effectively eradicated contributory infringement. Post-*Mercoid*, the mere act of bringing a law suit for contributory infringement was sometimes already considered a patent misuse<sup>53</sup>. "Where there is a collision between the principle of the *Carbice* case and the conventional rules governing either direct or contributory infringement, the former [p]revails."<sup>54</sup>

## **VI. The 1952 Patent Act and Section 271: Reviving contributory infringement**

The aim of the patent misuse doctrine had been to curtail the actions of over-reaching patentees who were using their patents to monopolize something other than the invention<sup>55</sup>. However, the courts after *Mercoid* interpreted misuse so broadly to effectively eliminate

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<sup>49</sup> *Id.* at 663.

<sup>50</sup> *Id.* at 664.

<sup>51</sup> *Id.* at 666.

<sup>52</sup> *Id.* at 669.

<sup>53</sup> Arnold, *supra* n. 37, at 365 (and references therein).

<sup>54</sup> *Mercoid* at 669.

<sup>55</sup> Rich, *supra* n. 2, at 133.

contributory infringement, and thus left many patented inventions unprotected<sup>56</sup>. Already in 1948, four years after *Mercoïd*, patent reforms were discussed in congressional hearings, but it was not until 1952 that a new patent act passed<sup>57</sup>. Although formally the doctrine of contributory infringement still existed, it was realized early on that only by making certain exceptions to the doctrine of patent misuse, the two doctrines could effectively coexist<sup>58</sup>. As Justice Black put it in the 1949 congressional hearings: "It is crystal clear, when you have thoroughly studied this subject, that the only way that you can make contributory infringement operative again as a doctrine, is to make some exceptions to the misuse doctrine and say that certain acts shall not be misuse."<sup>59</sup>

Of importance in the context of this paper are primarily 35 U.S.C. §271(c), and (d) which codify contributory infringement, and the exceptions to the patent misuse doctrine, respectively<sup>60</sup>. Note that 35 U.S.C. §271 was amended in 1984 and 1998 to add subsections (e) and (f), and subsections (d)(4)-(5), respectively<sup>61</sup>. These amendments, in particular those to subsection (d) were primarily concerned with antitrust issues and stated that product tying was not misuse per se<sup>62</sup>.

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<sup>56</sup> *Id.* at 133.

<sup>57</sup> Arnold, *supra* n. 37, at 366.

<sup>58</sup> Rich, *supra* n. 2, at 127.

<sup>59</sup> Arnold, *supra* n.37, at 368.

<sup>60</sup> See Appendix 1 for the complete text of 35 U.S.C. §271.

<sup>61</sup> *Id.* at 378-380.

<sup>62</sup> See *Id.* at 381; See also *Dawson Chemical Co. et al. v. Rohm & Haas Co.*, 448 U.S. 176 (1980) (the first Supreme Court case to squarely address misuse questions in the context of §271(c) and (d)).

Without going into the details of Section 271(d), in summary, it states that it is not misuse to exercise the rights granted under §271(b) and (c) by doing business, granting licenses, and bringing suits under §271(b) and (c)<sup>63</sup>. It was at this point, that induced infringement, codified in §271(b), and contributory infringement really became two separate causes of action that prior used to be known collectively as contributory infringement, and are now referred to as indirect infringement. Induced infringement is not further discussed here, as §271(b) is considered to stand by itself, independent from §271(c)<sup>64</sup>.

## **VII. The requirements of Section 271(c): Contributory infringement today**

35 U.S.C. §271(c) in its current form reads:

Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

Section 271(c) can be broken down into a number of elements that are required to state a case for contributory infringement:

An actor shall be liable for contributory infringement if the actor:

- 1) Offers to sell, sells, imports a thing into/within the United States; AND
  - this thing being either a component of a patented machine/manufacture/combination/composition; OR
  - a material/apparatus for use in practicing a patented process; AND
- 2) this thing being a material part of the invention; AND

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<sup>63</sup> Rich, *supra* n. 2, at 130.

<sup>64</sup> *Id.* at 129.

- 3) the actor knowing the thing to be especially made/adapted for use in an infringement of the patent; AND
- 4) the thing is not a staple article/commodity of commerce suitable for substantial noninfringing use.

Point 1) defines the infringement act, and a territorial restriction. Recall that direct infringement must always be proven for contributory infringement for lie<sup>65</sup>. Points 2) and 4) are related, in that a material part of the invention is unlikely to be a staple of commerce, while the converse is not necessarily true<sup>66</sup>. Point 3) is addressed in detail below.

### **THE KNOWLEDGE REQUIREMENT OF §271(C)**

Point 3), the knowledge requirement, was first addressed by the Supreme Court in *Aro II*<sup>67</sup>. In *Aro II*, Aro Manufacturing produced special cloth that it sold to consumers to repair their convertible car's patented fabric roofs<sup>68</sup>. Ford had produced and sold the patented fabric roofs on its 1952-54 range of cars, without license<sup>69</sup>. For this reason, Ford directly infringed, as did Ford's customers because they could not have obtained an implied license to use or repair the patented roof when they purchased the car from Ford, because Ford lacked authority to make and sell the roof<sup>70,71</sup>. In other words, "repair of an existing embodiment of

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<sup>65</sup> See e.g. *Aro Mfg. Co. Inc., et al. v. Convertible Top Replacement Co., Inc.*, 365 U.S. 336, 341 (1961).

<sup>66</sup> See e.g. *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325 (1909).

<sup>67</sup> *Aro Mfg. Co. Inc. et al. v. Convertible Top Replacement Co., Inc.*, 377 U.S. 476 (1964) (*Aro II*).

<sup>68</sup> *Id.* at 482.

<sup>69</sup> *Id.* at 478.

<sup>70</sup> There is no general private use exemption in the U.S. for patents.

the invention constituted a defense to a charge of contributory infringement only where use of the embodiment itself was not infringing."<sup>72</sup> Aro Manufacturing knew that the purchaser used the fabric for repairs of these Fords, as there was no known non-infringing use<sup>73</sup>.

The issue was what "knowing" in Section 271 refers to: Did Aro need to know that the replacement fabrics were especially made for use in the 1952-54 Ford convertible tops and not suitable for other non-infringing uses? Or, did Aro additionally need to know that the tops were patented, and that Ford was not licensed under the patent?<sup>74</sup> The Court held, in a split 5-4 decision, that §271(c) required proof "that the combination for which . . . [the] component was especially designed was both patented and infringing."<sup>75</sup>

Thus, a contributory infringer must know that:

- a component is especially made for use in the patented invention; AND
- the recipient does not have a license to use the patent.

On both sides of the issues, it was argued that the Court's interpretation was "consistent with the congressional intentions."<sup>76</sup> The main arguments by the minority against requiring this advanced level of knowledge were congressional intent, the legislative history that led to some change in the original wording, and the analogy to direct infringement, where it is not required that the infringer knows about the patent's existence to be liable (in

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<sup>71</sup> *Aro II* at 480.

<sup>72</sup> 5 Moy's Walker on Patents §15:24 (4th ed. 2008).

<sup>73</sup> *Aro II* at 488.

<sup>74</sup> *Id.* at 489.

<sup>75</sup> *Id.* at 488.

<sup>76</sup> *Id.* at 491 (reasons against); *Id.* at 525 (Justice Black dissenting but concurring on the knowledge issue).

effect, a strict liability provision)<sup>77</sup>. The dissenting judges were "of the view that the knowledge Congress meant to require was simply knowledge that the component was especially designed for use in a combination and was not a staple article suitable for substantial other use, and not knowledge that the combination was either patented or infringing."<sup>78</sup> Maybe the best summary of the minority position was a quote from the Congressional hearings: "You know that the component is going into that machine. You don't have to know that it is patented. You don't have to know the number of the patent, and you don't have to know that the machine it is going into constitutes an infringement."<sup>79</sup>

Justice Black, speaking for the majority, argued that the literal reading of the statute requiring "use in an infringement of such patent," was strong evidence on its face that knowledge of the patent was required<sup>80</sup>. Moreover, Justice Black argued that the legislative history makes it clear that "innocent persons, who acted without any knowledge that the goods they sold were adapted for use in the infringement of a patent which they knew about, could not be held liable as contributory infringers."<sup>81</sup>

Justice Black also made an argument that the more comprehensive knowledge requirement was necessary to prevent undue burden on the innocent buyer:

[T]hose who equally innocently do no more than repair worn-out parts can be subjected to punitive or treble damages even though they neither knew nor suspected that any patent forbade them to buy, use or repair those products. It would be one thing to require those who sell new inventions for profit to

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<sup>77</sup> *Id.* at 489 (footnote).

<sup>78</sup> *Id.* at 488 (footnote).

<sup>79</sup> *Id.* at 489.

<sup>80</sup> *Id.* at 525.

<sup>81</sup> *Id.* at 527.

check the records of the Patent Office. It is quite another to hold . . . that every housewife, plumber, and auto repairman must do so<sup>82</sup>.

The knowledge standard introduced in *Aro II* is still valid today<sup>83</sup>.

In the *Aro II* case, the heightened knowledge was proved by the fact that the patentee sent a cease and desist letter to the alleged contributory infringer<sup>84</sup>. Because the Court in *Aro II* did not explicitly hold what might constitute knowledge about the patent, and presumably to avoid willful blindness, some courts have held that constructive knowledge of the patent and the infringement suffices<sup>85</sup>. This means that the knowledge about the patent is a typical intentional tort standard of "know, or should have known."<sup>86</sup>

It is important to notice that subjective knowledge is problematic, ultimately, because an alleged infringer cannot have knowledge of a *legal conclusion* of infringement<sup>87</sup>.

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<sup>82</sup> *Id.* at 529.

<sup>83</sup> See e.g. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F. 2d 1464, 1469 (Fed. Cir. 1990); *Trell v. Marlee Electronics Corp.*, 912 F.2d 1443, 1447-1448 (Fed. Cir. 1990); *Cybiotronics, Ltd. v. Golden Source Electronics Ltd.*, 130 F. Supp. 2d 1152, 1165-1166 (C.D. Cal. 2001).

<sup>84</sup> *Aro II* at 489.

<sup>85</sup> See e.g. *Philips Electronics North America Corp. v. Remote Solution Co., Ltd.*, 411 F. Supp. 2d 479, 482 (D. Del. 2006); *Monolithic Power Systems, Inc. v. O2 Micro Intern. Ltd.*, 476 F. Supp. 2d 1143, 1158 (N.D. Cal. 2007).

<sup>86</sup> *Philips* at 482; *Monolithic Power Systems* at 1158.

<sup>87</sup> Robert A. Matthews, Jr., 2 *Annotated Patent Digest* §10:90.

### VIII. Tort law and §271(c)

That knowledge can be inferred from circumstantial evidence, is also consistent with general tort law<sup>88</sup>. General tort law provides that the defendant's assistance or encouragement must be a substantial factor in causing the tort<sup>89</sup>. For example, in *United States v. Nichols*, Terry Nichol's conviction as a co-conspirator for the Oklahoma City Bombings by Timothy James McVeigh, which he carried out with fertilizer explosives (ammonium nitrate), was confirmed<sup>90</sup>. The issue here was whether co-conspirator Nichols could be held liable for injuries to the bombing victims because he supplied McVeigh with the fertilizer, and knew that McVeigh intended to use the fertilizer as an explosive in a weapon of mass destruction<sup>91</sup>. On the other hand, with reference to the McVeigh bombing also, a manufacturer of ammonium nitrate would not be liable for injuries to persons resulting from a fertilizer bomb, unless the manufacturer knew that the purchaser would use the fertilizer as an explosive<sup>92</sup>.

However, as discussed above, Federal Patent law for contributory infringement is based on 35 U.S.C. §271(c), and common law may serve primarily as a guideline. This is particularly true since the Supreme Court has declared that "[t]here is no federal common law."<sup>93</sup> Nevertheless, bearing in mind that Congress codified §271(c) with the intent of

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<sup>88</sup> See e.g. *Aetna Cas. & Sur. Co. v. Leahey Constr. Co.*, 219 F.3d 519, 535 (6th Cir. 2000).

<sup>89</sup> *Restatement (Second) of Torts* §876(b).

<sup>90</sup> *U.S. v. Nichols*, 169 F.3d 1255, 1260 (10th Cir. 1998).

<sup>91</sup> *Id.* at 1260.

<sup>92</sup> See *Gaines-Tabb v. ICI Explosives USA Inc.*, 160 F.3d 613, 618 (10th Cir. 1998).

<sup>93</sup> *Erie Railroad Co. v. Tompkins*, 304 U.S. 64, 78 (1938).

codifying pre-*Mercoïd* law, common law may still have a role in interpreting the statute in some cases<sup>94</sup>.

### **CONTRIBUTORY INFRINGEMENT IN GERMANY**

The German Patent Act of 1980 (incl. amendments up to September 2008) addresses contributory infringement in §10(1) PatG. This provision was copied literally from Section 30 of the Community Patent Convention (CPC) of 1975, an effort to create a European community patent that never entered into force<sup>95</sup>. As a result of pan-European negotiations, the wording of Section 30 CPC, in turn, was influenced by the U.S. contributory infringement statute, 35 U.S.C. §271(c)<sup>96</sup>. As discussed above, 35 U.S.C. §271(c) makes component suppliers jointly and severally liable with direct infringers under certain circumstances<sup>97</sup>. Similarly, the German §10(1) PatG leads to joint and several liability between the direct and indirect infringer<sup>98</sup>. However, German §10 PatG does not require an act of direct infringement, and the possibility of a direct infringement suffices<sup>99</sup>. As we have seen from

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<sup>94</sup> Charles W. Adams, *Indirect Infringement from a Tort Perspective*, 42 U.Rich. L. Rev. 635, 648 (2008).

<sup>95</sup> See e.g. Georg Rauh, *Zur Entberlichkeit der subjektiven Tatbestandsmerkmale des §10 Abs. 1 PatG (mittelbare Patentverletzung)*, GRUR Int. 2008, 293, at 296.

<sup>96</sup> *Id.*

<sup>97</sup> See *Dynacore Holding Corp. v. U.S. Philips Corp.*, 363 F.3d 1263 (Fed. Circ. 2004) (stating that direct infringement is a predicate for each act of indirect infringement); *American Telephone & Telegraph Co. v. Radio Audion Co.*, 284 F. 1020 (C.C.A. 3d Cir. 1922) (joint and several liability).

<sup>98</sup> Krasser, *Patentrecht*, 5. Aufl., 2004 at 841.

<sup>99</sup> BGH, X ZR 247/02, 07.06.2005 – *Antriebsscheibenaufzug* at 8.

the history of contributory infringement, the USA already had significant experience with indirect infringement in the mid-seventies, and had already codified contributory infringement since 1952<sup>100</sup>. In light of the U.S. influence on Section 30 CPC and the German contributory infringement statutes, this article now looks at the interpretation of the knowledge or intent requirement, the fault element, in §10(1) PatG through U.S.-torts lenses, and compares it with current U.S. law.

### **BACKGROUND AND INTRODUCTION TO §10(1) PATG**

#### **IX. The contributory infringement statute §10(1) PatG - contains infringement act elements and fault elements**

It may be helpful to initially analyze the structure of §10(1) PatG . §10(1) PatG may be paraphrased into, for example, ten required elements<sup>101</sup>:

The patent further has the effect that:

1. any third party
2. without the patentee's authorization
3. is prohibited from offering to supply means or supplying means
5. relating to an essential element of the invention

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<sup>100</sup> *Id.*

<sup>101</sup> §10(1): Das Patent hat ferner die Wirkung, daß es jedem Dritten verboten ist, ohne Zustimmung des Patentinhabers im Geltungsbereich dieses Gesetzes anderen als zur Benutzung der patentierten Erfindung berechtigten Personen Mittel, die sich auf ein wesentliches Element der Erfindung beziehen, zur Benutzung der Erfindung im Geltungsbereich dieses Gesetzes anzubieten oder zu liefern, wenn der Dritte weiß oder es auf Grund der Umstände offensichtlich ist, daß diese Mittel dazu geeignet und bestimmt sind, für die Benutzung der Erfindung verwendet zu werden.

6. for use in the invention<sup>102</sup>
7. to persons other than those authorized to use the invention
8. if the third party knows, or reasonably should know<sup>103</sup>
9. that the means are suitable
10. and intended for use in the invention

Elements 2 and 7 are to be understood within the limits accorded by the German patent act<sup>104</sup>. Thus, this paper refers to the alleged infringer that supplies, or offers to supply, a component/means of the invention as the "third party." The person receiving the offer, or the component/means, will be referred to as the "recipient."

The requirements of §10(1) PatG must be met at the time of the offer to supply, or the supply<sup>105</sup>. Elements 1 through 7 above define the contributory infringement act, while elements 8 through 10 define the fault element. This article is looking at the interpretation of the fault element in recent cases<sup>106</sup>.

The fault elements of §10(1) PatG, that is elements 8 through 10 above, contain both subjective and objective elements.

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<sup>102</sup> Within the scope of this law ("im Geltungsbereich dieses Gesetzes"), *see e.g.* Rauh, *supra* n.2, at 294-295 for a discussion.

<sup>103</sup> where "reasonably should know" is "auf Grund der Umstände offensichtlich."

<sup>104</sup> §10(1) PatG.

<sup>105</sup> BGH, X ZR 173/02, 09.01.2007 – *Haubenstretchautomat* at 23.

<sup>106</sup> Further discussion on the contributory act elements 1 through 7 may be found in the various articles cited.

## **X. The patent's scope of protection is not enlarged by §10(1) PatG**

Despite the formulation "the patent further has the effect," the German Supreme Court (Bundesgerichtshof, BGH) has held repeatedly that §10 PatG does not extend the scope of protection afforded to a patent, and in particular does not provide a component/means supply monopoly<sup>107</sup>. This, of course, parallels the discussions about patent misuse in the U.S.

## **XI. Induced infringement**

§10 PatG also contains a provision on induced infringement. §10(2) PatG is worded as an exception to §10(1) PatG, specifying that §10(1) PatG does not apply if the means in sub-section (1) are staple articles of commerce. However, if the third party knowingly induces the recipient of the means to infringe a process patent, §10(1) PatG does apply<sup>108</sup>. The literal interpretation of this statutory provision is interesting because it suggests that induced infringement requires direct infringement with a staple article of commerce as a predicate, in contrast to §10(1) PatG. The commentary by *Schulte* agrees with this interpretation, without citing any case authority, however<sup>109</sup>. Induced infringement is not discussed any further in this paper.

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<sup>107</sup> *Antriebsscheibenaufzug* at 8 (scope of protection); BGH, X ZR 113/04, 27.02.2007 – *Rohrschweisverfahren* at 17 (stating that §10 PatG does not give the patent holder a component supply monopoly).

<sup>108</sup> §10(2) PatG. See also Appendix 2 for the complete text of §10(2) PatG.

<sup>109</sup> Schulte, *Patentgesetz*, 6. Aufl., 2001 at 269.

## **XII. Private use, *inter alia*, is not authorized with regard to indirect infringement**

§10(3) PatG invalidates a number of common patent infringement defenses<sup>110</sup>. In particular, §10(3) PatG states that the patent infringement defenses of private use, experimental use, and the preparation of single medicine portions do not count as authorized use for purposes of contributory infringement with regard to element 2 of §10(1) above<sup>111</sup>. The idea is to suppress the commercial supply of component kits, which are aimed primarily at private persons. On the face of it, this seems quite a reasonable provision, although in the context of the experimental use exemption it may be considered to afford excessive component supply control to the patent holder.

### **THE KNOWLEDGE REQUIREMENT**

Although §10(1) PatG has been in force for nearly 30 years now, it can be seen from the numerous recent publications listed in the bibliography that the subjective fault element, as well as the rest of §10(1) PatG for that matter, leave room for discussion. Because of the influence of 35 U.S.C. §271(c) on §10(1) PatG, this paper analyzes §10(1) PatG on its face<sup>112</sup> under the aspect of general U.S. tort law interpretations of its subjective elements, and with regard to current U.S. law. Because contributory infringement amounts to a tort under U.S. law, an attempt is made at interpreting the fault level of §10(1) PatG from first principles, and comparing that outcome with recent holdings by the German Supreme Court (BGH), and scholarly articles written on the subject. It is hoped that this analysis might shed some light on §10(1) PatG from a new, and different angle.

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<sup>110</sup> See Appendix 2 for the complete text of §10(3).

<sup>111</sup> *Id.*

<sup>112</sup> Here, this means without recourse to U.S. case law, except for the tort definitions of the fault levels.

### **XIII. Systemic Differences: Why a Fault element is unusual in §10(1) PatG**

As mentioned above, the wording of §10(1) PatG was influenced by 35 U.S.C. §271(c), the U.S. contributory infringement provision, via §30 CPC 1975. Subjective elements like those found in elements 8 through 10 of §10(1) PatG above, are rare in German civil law as definitional element of an unlawful act, and essentially foreign to its civil law<sup>113</sup>. But they are, of course, also mostly required to determine a fault. However, German civil law separates the unlawful act and the fault element in a different manner from U.S. law: Under German law, the unlawful act is normally formulated purely in objective terms, whereas the remedy codifications for e.g. damages under §139 PatG contain the required fault element. In contrast, the U.S. contributory infringement provision 35 U.S.C. §271(c), similar to §10 PatG, contains a fault element, while the codification for damages in 35 U.S.C. §284 does not contain a fault element. This systemic difference is of interest because §10 PatG thus manages to import a subjective element into an otherwise purely objective remedy provision. Injunction as defined in §139(1) PatG, for example, does not require a fault element. In the case of an injunction due to direct infringement, based on §9 PatG and §139 PatG, a fault element is inexistent. Arguably, §10(1) PatG thus imports a fault element into the injunction requirements in the case of contributory infringement<sup>114</sup>. For this reason, *Rauh* argues that the subjective element should be moved to §139 PatG<sup>115</sup>.

#### **SUBJECTIVE AND OBJECTIVE INTENT IN §10(1) PATG**

Elements 8 through 10 of contributory infringement define a fault "if the third party knows, or reasonably should know that the means are suitable and intended for use in the

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<sup>113</sup> Rauh, *supra* n. 93, at 293.

<sup>114</sup> *Id.* at 299.

<sup>115</sup> *Id.* at 300.

invention." With regard to the third party (the alleged contributory infringer), these elements allow a subjective knowledge inquiry, and an objective should-know inquiry. Additionally, there is the recipient's intent. The latter is discussed together with the third party subjective knowledge inquiry in the next section, followed by the third party objective should-know inquiry.

#### **XIV. The third party subjective intent inquiry and the double subjective element.**

The third party subjective intent inquiry can be split into two parts: A) The third party knows that the means are intended for use in the invention, and B) the third party knows that the means are suitable for use in the invention. Both prongs need to be met. This is an interpretation that is similar to the holding in *Aro II*, where A) corresponds to the test that the contributory infringer must know that the recipient does not have a license to use the patent, and B) is similar to the test that the contributory infringer must know that a component is especially made for use in the patented invention. The German provisions appear to be worded a bit broader though.

##### ***A. The third party knows that the means are intended for use in the invention***

This prong reads on the subjective intent of the third party to know what the means are intended for, and because the recipient of the means is the one that determines how the means are (going to be) used, some term this the "double subjective element"<sup>116</sup>. One issue here is whether knowledge by the third party of a subjective intent on the part of the recipient is necessary and intended in provision A). In the opinion of this author, it is not necessary or

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<sup>116</sup> Uwe Scharen, *Die Behandlung der (so genannten) mittelbaren Patentverletzung in der Rechtsprechung des Bundesgerichtshofs*, GRUR 2008, 944, 947; *Antriebscheibenaufzug* at 17.

intended that the provision A) is read with a double subjective intent. The below discussion using general U.S. tort law principles shows, in the authors opinion, why this discussion has not even taken place in the U.S., to the best of the author's knowledge.

The provision A) requires knowledge on behalf of the alleged tortfeasor, the third party. Such a provision would be considered at the fault level of intent under U.S. tort law. Intent in torts is commonly defined as "voluntarily acting with *knowledge* to a *substantial certainty* that X will result."<sup>117</sup> Applying this definition to A), we obtain "the third party voluntarily acts with knowledge to a substantial certainty that use of the means in the invention is intended." Thus, under this definition, the subjective knowledge is clearly limited to the third party. The third party does not need to know the true intent of the recipient, but needs to be substantially certain that the means will be used in the invention. Thus, given that the provision A) of §10(1) PatG is worded after a 35 U.S.C. 271(c), it is possible that this meaning was intended by the drafters.

Such an interpretation is supported for two reasons. Firstly, only the third party offers to supply, or supplies the means. Hence, only the third party can commit the contributory infringement act under §10(1) PatG. Because contributory infringement is not a strict liability tort, whether a wrong is committed is determined by the intentions, the *mens rea*, of the third party when offering to supply, or supplying the means. Specifically, if the third party is substantially certain that the recipient will use the means in the invention but goes ahead and supplies the means anyway, the third party commits a wrong against the patent owner. It is hereby entirely irrelevant whether or not the recipient actually intends to commit

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<sup>117</sup> *Vogel v. Grant-Lafayette Elec. Co-op.*, 548 N.W.2d 829, 836-37 (Wis. 1996); *Garratt v. Dailey*, 279 P.2d 1091 (Wash. 1955).

the infringement or not, because the wrongness of the act by the third party is wholly determined by his own state of mind.

Secondly, it is only possible for the third party to establish knowledge to a substantial certainty about the intentions of the recipient based on objective facts (e.g. the recipient tells him, the recipient runs a factory that produces infringing products, the recipient is active in the same sector of commerce as the patent owner etc.) Again, the subjective intent of the recipient is effectively irrelevant. For example, consider the third party has the intention to make an offer for means to the recipient, who works in the same sector of commerce as the patent owner. To avoid contributory infringement, the third party asks the recipient about his intentions. Despite intentions to the contrary, the recipient informs the third party that he has no intentions of using the means in the invention. Again, the true intentions of the recipient are not relevant, because it is based on objective fact that the third party determined his actions. Moreover, this objectified view may allow the third party the indirect possibility to rebut a finding that he knew, or should reasonably have known about a planned infringing use, by showing due diligence. Moreover, if the objective circumstances indicate that a patent infringement is substantially certain, the third party can explicitly warn the recipient that his supplies are not to be used in a possible infringement, and thus preempt<sup>118</sup>.

Hence, only the subjective intent of the third party should matter, because the third party is the acting party, and the only one in a position to act wrongly. The subjective intent of the recipient is entirely irrelevant in determining whether a wrong was committed or not. For this reason, this author believes that it is incorrect to talk of a double subjective intent, and advocates that the subjective interpretation of A) is limited to the mindset of the third party. It is doubtful that the drafters of the provisions intended the double subjective intent.

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<sup>118</sup> BGH, X ZR 153/03, 13.06.2006 – *Deckenheizung* at 15.

Based on the fact that this double-subjective intent has never been discussed in U.S. cases to the best of the author's knowledge, it is almost certain that a double subjective intent was not considered or intended to be read into §271(c), and thus §10(1) PatG. A similar conclusion is reached by *Rauh* along a different line of argument, who states that it should be recognized that the unlawful act is committed solely by the third party, and thus the subjective intent of the recipient should be irrelevant, as long as his intentions are shown objectively<sup>119</sup>.

***B. The third party knows that the means are suitable***

This second prong B) of the third party subjective intent inquiry is similarly structured to the first prong A) above. Yet this author is not aware of any case or commentary that has discussed the subjective suitability of the means to the recipient, although the final suitability of the means can only be determined by the recipient, based on his true intentions. It is arguable, based on the wording of §10(1) PatG, that the suitability referred to may be objective (regardless of how the intention is considered). This view would more closely follow §271(c), which speaks of “especially made for use in the invention,” although it is clear that “especially made” is more narrow than “suitable.”<sup>120</sup> Following a similar line of argument as given for A) above, this author would argue for an objective approach, but also remarks that the objective suitability of the means, for use in the invention, is already (clearly objectively) addressed in elements 5 and 6 of the definition of the contributory infringement act, similar to the “material part of the invention” requirement in §271(c). Because this appears to be a non-issue, the point is not further elaborated on.

In conclusion to the third party subjective intent inquiry, it should further be noted that the subjective intent element represents a formidable hurdle because of the required

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<sup>119</sup> *Rauh*, *supra* n. 93, at 298; *Id.* at 301.

<sup>120</sup> Bearing in mind that §10(2) PatG excludes staple articles.

proof. The objectified alternative discussed below is thus a more practical alternative in all but the most exceptional cases.

## **XV. The third party objective intent inquiry**

The third party objective intent inquiry can be split into two parts, similar to the subjective intent inquiry: C) The third party *reasonably should know* that the means are intended for use in the invention, and D) the third party *reasonably should know* that the means are suitable for use in the invention. Both prongs need to be met.

It is interesting to point out that rarely the objectified inquiry has been read as "the circumstances are such that the means are substantially certain to be suitable, and substantially certain to be intended for use in the invention"<sup>121</sup>.” *Scharen* uses this reading to argue that the reasonably-should-know objective inquiry may be used to avoid the subjective intent of the recipient, rather than the subjective intent by the third party<sup>122</sup>. In view of the literal reading of §10(1) PatG, and the discussion above for the third party subjective intent inquiry, it is questionable that the recipient’s intent (rather than the third party) is meant. Firstly, the phrasing in §10 PatG is not amenable to be interpreted to read both on the knowledge of the third party, *and* the intentions of the recipient. Even if it might be argued that the provision reads on either one of the third party or the recipient, it is unlikely to be applicable to both. Moreover, as argued before, there is at least an argument to be made that the suitability and the intention of the recipient should be considered objectively (that is, no double-subjective intent), thus these elements do not need to be objectified. Even the court in *Deckenheizung* interpreted this subjective intent provision in two different ways in one and

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<sup>121</sup> Scharen, *supra* n. 101, at 947.

<sup>122</sup> *Id.*

the same paragraph<sup>123</sup>. The court's holding, however, follows the interpretation that objectification reads on the third party intent, and not on the suitability of the means and/or the intent of the recipient<sup>124</sup>. For this reason, the below discussion is limited to that same reading.

***C. The third party should reasonably know that the means are suitable***

The wording that the third party "reasonably should know," is an objective inquiry. Instead of asking what the third party actually knows, it is sufficient to show what a reasonable person should have known from the same circumstances. Based on what this hypothetical reasonable person should have inferred, the same knowledge is attributed to the third party. One possible candidate for the reasonable person in patent infringement cases may be the person holding ordinary skill in the art.

This objectified inquiry is clearly less onerous to prove than the subjective intent inquiry of Section XIV, and may be more similar to a reckless or even negligence fault level. In addition to easing the burden of proof, it may be noted that this objectified element also avoids the problem of willful blindness on the part of the third party. Note that such an objectified approach would correspond to a showing of constructive knowledge, discussed in Section VII for U.S. cases. Thus, the objective inquiry is more attractive to the party bringing suit in practice.

The question of whether the third party should reasonably know that the means are suitable for the intended use by the recipient has not been treated much in the context of the mental element, similarly to the case of the subjective element. Instead, the suitability is evaluated under the objective inquiry in elements 5 and 6 of §10(1) PatG, as remarked by

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<sup>123</sup> *Deckenheizung* at 11.

<sup>124</sup> *Id.* at 1, *Id.* at 12.

*Rauh*, referring to *Krasser*<sup>125</sup>. *Rauh* accurately points out that most commentators have either left the question open, or did not consider it at all<sup>126</sup>.

If the offered or supplied means are useable only in the invention, the suitability is trivial<sup>127</sup>. If the means can be used in a non-infringing manner, however, the technical features may not be used to infer that the third party can reasonably know the intended use of the component<sup>128</sup>. Of course, these are the same discussions and arguments about staple versus non-staple articles (“especially made for use in the invention”) in the USA.

***D. The third party should reasonably know that the means are intended for use in the invention***

This prong of the fault element is most relevant in practice, and offers some insights based on court decisions.

***i. The third party suggests or teaches an infringing use***

If the third party suggests, or even recommends, an infringing use of the supplied means e.g. in an instruction manual, or other documentation including advertisements, it is reasonable for the third party to know that the recipient will likely use the means according to the suggestions, and thus infringe<sup>129</sup>. Conversely, if the documentation does not suggest an infringing use, it is not reasonable to assume infringing use unless there are concrete

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<sup>125</sup> *Rauh*, *supra* n. 93, at 294.

<sup>126</sup> *Id.*

<sup>127</sup> *Antriebsscheibenaufzug* at 21.

<sup>128</sup> *Id.*

<sup>129</sup> *Haubenstretchautomat* at 23 (stating that suggestion or recommendation in an instruction manual suffices); *Deckenheizung* at 13 (stating in more general terms that a suggestion by the third party suffices); *Rohrschweisverfahren* at 15 (advertisements).

indications that suggest with a high likelihood that the user will not follow the instruction manual<sup>130</sup>. Note, however, that an unsolicited offer by the third party to the recipient does not allow to draw any conclusions about how the recipient intends to use a component<sup>131</sup>. Thus, the third party cannot be inferred to possess any such knowledge based on the unsolicited offer<sup>132</sup>.

In *Deckenheizung*, the third party suggested an infringing use in documentation supplied to installation professionals, as well as by illustrating an infringing use in their advertisements<sup>133</sup>. Additionally, the corporation's own documentation describes that the means are used according to the patented invention in 20% of the supplied projects<sup>134</sup>.

The court in *Deckenheizung* further held that it is not sufficient to advise clients to continue to use the product only in a specific, non-infringing manner<sup>135</sup>. This is a more stringent position than taken two years earlier by the same court in *Antriebsscheibenaufzug*, where the court held that if the means can be used in a non-infringing manner, the technical features may not be used to infer that the third party can reasonably know the intended use of the component<sup>136</sup>.

Although element 5) of §10(1) PatG asks for an “essential element of the invention,” §10(1) PatG does not explicitly distinguish between staple and non-staple articles of

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<sup>130</sup> *Haubenstretchautomat* at 24.

<sup>131</sup> *Deckenheizung* at 12.

<sup>132</sup> *Id.*

<sup>133</sup> *Deckenheizung* at 13.

<sup>134</sup> *Id.*

<sup>135</sup> *Deckenheizung* at 13-14.

<sup>136</sup> *Antriebsscheibenaufzug* at 21.

commerce. In the author's opinion, by more explicitly distinguishing between staple and non-staple articles that are suitable means for use in the invention, the more difficult intent question could have been avoided<sup>137</sup>. If only 20% of the means are used according to the invention (see above), then a good argument for the means being a staple article could be made.

ii. Dominant use of the means is infringing

In *Rohrschweisverfahren*, a component was used by 85-90% of cases for use in the invention by licensees<sup>138</sup>. The lower court found that if the predominant use of means is for use in the invention by licensees, and the third party's advertisement material promotes this use, the third party can reasonably be expected to assume that the components will be used in the invention by supplied parties<sup>139</sup>. Although the court explicitly did not object to this reasoning, the court found that there was no evidence as to the real intended use by the remaining 10-15% of recipients, and left it open whether such a scenario amounts to "reasonable knowledge" and remanded to the court below<sup>140</sup>. Again, this court did rely on the recipient's mens rea.

This case is a bit more complicated than *Deckenheizung* because the issue is whether there is "substantial non-infringing use." In the author's opinion, if the percentages are stacked such that 90% of the supplied means are known to be used in accordance with a patent, the supplier can be held to a high level of scrutiny with respect to whom he supplies.

iii. An explicit warning of an infringing use may protect the third party

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<sup>137</sup> Using §10(2) PatG.

<sup>138</sup> *Rohrschweisverfahren* at 15.

<sup>139</sup> *Id.*

<sup>140</sup> *Id.* at 20.

In *Deckenheizung*, the court stated that an explicit warning about patent infringing use would suffice as a precaution by the third party<sup>141</sup>. *Fitzner* also suggests that a third party may probably protect itself by contractually obliging the other party not to commit an infringement<sup>142</sup>. The problem with such an approach is that it requires rather intrusive contract provisions, and care must be taken not to infringe the recipient's rights. On the other hand, there may not be much else that the third party can do because *Fabry and Trimborn* suggest that it is not possible to disclaim liability for contributory infringement in the general contract terms<sup>143</sup>. Unfortunately, *Fabry and Trimborn* fail to cite a relevant case authority.

iv. A high level of diligence is imposed on the third party

The possible need to foresee any reasonably possible infringing uses of a component, imposes a significant burden on the third party supplier. The third party is effectively required to investigate the recipient to a considerable level of detail to find out what exactly the recipient is likely to do. Nonetheless, particularly for complex products, it may be near impossible to be diligent with reasonable effort because many patented components may be involved. Moreover, it is unsatisfactory that the third party does not have the possibility to directly rebut a finding that he should reasonably have known about a planned infringing use, by showing due diligence, at the very least if no direct infringement has occurred. The above suggested reading of §10(1) PatG would at least provide some relief.

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<sup>141</sup> *Deckenheizung* at 15.

<sup>142</sup> Uwe Fitzner, *Die mittelbare Patentverletzung – quo vadis?*, Mitt. 2008, 243, 249.

<sup>143</sup> Bernd Fabry and Michael Trimborn, *Die mittelbare Patentverletzung – Das unterschätzte Geschäftsrisiko*, GRUR 2008, 861, 863 (Allgemeine Geschäftsbedingungen).

## **THE KNOWLEDGE REQUIREMENT IN SWITZERLAND**

In Switzerland, the right to exclude conferred by a patent is defined in Art. 8 of the Swiss Patent Act (PatG CH), subject to certain exemptions. Art. 66 PatG CH provides for the right to bring civil and criminal suits, and subsection Art. 66(d) defines indirect infringement, including contributory infringement. The article is broad because it states that liability attaches for inducement of patent infringement, contribution to patent infringement, and aiding and abetting in patent infringement<sup>144</sup>. Literal reading of Art. 66(d), which depends on one of Art. 66(a)-(c), clearly requires direct infringement<sup>145</sup>. The direct infringement must occur within Switzerland, for Art. 66(d) to apply<sup>146</sup>. Art. 66(d) does not expressly contain a knowledge or intent element, however, in order for a claimant to recover damages in a civil suit, a contributory infringer must have acted intentionally, or negligently according to Art. 73 PatG CH. An injunction, on the other hand, does not require a mental element<sup>147</sup>.

In Swiss Supreme Court case BGE 129 III 588, the plaintiff owned a patent on an embroidery method<sup>148</sup>. The plaintiff sued a competitor that manufactured machines, which allegedly infringed the patent when operated<sup>149</sup>.

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<sup>144</sup> Art. 66(d) PatG CH. *See also* Appendix 3 for the complete text of Art. 66 PatG CH.

<sup>145</sup> Although indirect infringement according to Art. 66(c) and (d) is also possible for the removal of a patent mark, which is not defined in Art. 8 PatG CH, but Art. 11 PatG CH. *See also* Appendix 3 for the complete text of Art. 66 PatG CH.

<sup>146</sup> *See e.g.* BGE 122 III 81 at 87.

<sup>147</sup> Art. 72 PatG CH. *See also* Appendix 3 for the complete text of Art. 72 PatG CH.

<sup>148</sup> BGE 129 III 588 at 589.

<sup>149</sup> *Id.* at 590

The court stated that Art. 66(d) PatG CH is equivalent in meaning to general Swiss tort provisions, in particular Art. 41 OR that requires a fault element, and Art. 50, a joint tortfeasor provision<sup>150</sup>. With reference to BGE 34 II 334, the court stated that for means that are especially made for use in the invention, that is, non-staple goods, liability attaches only if the alleged contributory infringer *knows or should know* that the means are suitable for use in an invention, and are intended for use in the invention by the recipient<sup>151</sup>.

In the embroidery machine case BGE 129 III 588, the court found that the embroidery machines could be used in an infringing manner by making certain modifications and settings, and thus the issue was whether there was any reason that the alleged contributory infringer knew or should have known that his clients were intending to use the machine in an infringing manner<sup>152</sup>. Based on the fact finding of the lower court, induced infringement was not found, as the instruction manuals supplied by the alleged contributory infringer did not disclose how to operate the machine so that the patent would be infringed<sup>153</sup>. Furthermore, the lower court found no evidence of infringing use of the machines (direct infringement), or that the alleged contributory infringer had any knowledge that its customers intended to infringe, and thus contributory infringement was denied by the Swiss Supreme Court<sup>154</sup>.

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<sup>150</sup> *Id.*; See also Thierry Calame, *Schweizerisches Immaterialgueter- und Wettbewerbsrecht*, Vol. IV, 455, (R.Von Bueren and L. David eds., Helbing & Lichtenhahn Verlag 2006).

<sup>151</sup> BGE 129 III 588 at 592.

<sup>152</sup> *Id.* at 593-594.

<sup>153</sup> *Id.* at 594.

<sup>154</sup> *Id.*

Interesting is that the threat of a direct infringement also suffices to sue for an injunction<sup>155</sup>. Literal reading of Art. 72 with Art. 66 would suggest that a request to stop a contributory infringement is possible when it is threatened, while still requiring that a direct infringement has taken place. This is, however, apparently not the case, and it appears that the threat of a direct infringement suffices to obtain an injunction on a potential contributory infringer<sup>156</sup>. The author thinks that this is going a little too far, and causality is stretched. If the patent owner perceives a threat of a direct infringement, should he not rather try to stop the direct infringement from occurring? If this cannot be done, for example because the patented goods are consumer products, should the patentee not rather send a note to the contributory infringer, and only take action once a first shipment goes out to consumers? Such a note might even allow to get damages, because the alleged contributory infringer was put on notice, and a knowledge requirement can be proved more easily. Philosophically, it appears questionable whether a party should be stopped from doing something because there is a threat that this action might aid and abet another threat of a wrongdoing.

Because there are not many Swiss cases on the knowledge requirements for contributory infringement, it would be prudent to maybe call this a somewhat unsettled area of the law. The issue of whether there is a double-subjective intent, as discussed in Germany, apparently has not come up.

## **CONCLUSIONS**

This article traced the historic roots of contributory infringement in the U.S., providing insight into the structure of the contributory infringement statute, 35 U.S.C. §271(c) as it was codified in 1952, and today. Because 35 U.S.C. §271(c) influenced the

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<sup>155</sup> Art. 72 PatG CH. *See also* Appendix 3 for the complete text of Art. 72 PatG CH.

<sup>156</sup> BGE 129 III 588 at 591.

contributory infringement provisions in §10(1) PatG of the German Patent Act, the U.S. background material was used to analyze the knowledge requirements of §10(1) PatG, in the hope that it might show a different angle to the issue of the double subjective element, in particular. The author believes that the double subjective intent is not required. Both the USA and Switzerland do not seem to apply a double subjective intent either.

### **ACKNOWLEDGMENT**

The Author would like to thank Dr. T. Calame and Dr. T. Breimi for their careful reading and helpful comments in preparation of this article.

## **APPENDIX 1: 35 U.S.C. §271**

**Comment** on the structure of 35 U.S.C. §271: Paragraph (a) defines direct infringement. Paragraphs (b) and (c) define indirect infringement. Paragraph (b) defines induced infringement, and paragraph (c) defines contributory infringement. Paragraph (d) is ancillary to paragraphs (b) and (c), and defines exceptions to patent misuse, allowing (b) and (c) to be used. Paragraph (e) is a *Bolar*-exemption type provision. Paragraph (f) defines certain export restrictions. Paragraph (g) refers to the import of products-by-process. Paragraph (h) is a government-liability provision, and paragraph (i) states that an offer to sell must take place during the life-time of the patent.

### **35 United States Code §271**

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented invention during the term of the patent therefore, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed without his consent would constitute contributory infringement of the patent; (3) sought to enforce his patent rights against infringement or contributory infringement; (4) refused to license or use any rights to the patent; or (5) conditioned the license of any rights to the patent or the sale of the patented product on the acquisition of a license to rights in another patent or purchase of a separate product, unless, in view of the circumstances, the patent owner has market power in the relevant market for the patent or patented product on which the license or sale is conditioned.

(e)(1) It shall not be an act of infringement to make, use, offer to sell, or sell within the United States or import into the United States a patented invention (other than a new animal drug or veterinary biological product (as those terms are used in the Federal Food, Drug, and Cosmetic Act and the Act of March 4, 1913) which is primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques) solely for uses reasonably related to

the development and submission of information under a Federal law which regulates the manufacture, use, or sale of drugs or veterinary biological products.

**(2)** It shall be an act of infringement to submit--

**(A)** an application under section 505(j) of the Federal Food, Drug, and Cosmetic Act or described in section 505(b)(2) of such Act for a drug claimed in a patent or the use of which is claimed in a patent, or

**(B)** an application under section 512 of such Act or under the Act of March 4, 1913 ([21 U.S.C. 151-158](#)) for a drug or veterinary biological product which is not primarily manufactured using recombinant DNA, recombinant RNA, hybridoma technology, or other processes involving site specific genetic manipulation techniques and which is claimed in a patent or the use of which is claimed in a patent,

if the purpose of such submission is to obtain approval under such Act to engage in the commercial manufacture, use, or sale of a drug or veterinary biological product claimed in a patent or the use of which is claimed in a patent before the expiration of such patent.

**(3)** In any action for patent infringement brought under this section, no injunctive or other relief may be granted which would prohibit the making, using, offering to sell, or selling within the United States or importing into the United States of a patented invention under paragraph (1).

**(4)** For an act of infringement described in paragraph (2)--

**(A)** the court shall order the effective date of any approval of the drug or veterinary biological product involved in the infringement to be a date which is not earlier than the date of the expiration of the patent which has been infringed,

**(B)** injunctive relief may be granted against an infringer to prevent the commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product, and

**(C)** damages or other monetary relief may be awarded against an infringer only if there has been commercial manufacture, use, offer to sell, or sale within the United States or importation into the United States of an approved drug or veterinary biological product.

The remedies prescribed by subparagraphs (A), (B), and (C) are the only remedies which may be granted by a court for an act of infringement described in paragraph (2), except that a court may award attorney fees under [section 285](#).

**(5)** Where a person has filed an application described in paragraph (2) that includes a certification under subsection (b)(2)(A)(iv) or (j)(2)(A)(vii)(IV) of section 505 of the Federal Food, Drug, and Cosmetic Act ([21 U.S.C. 355](#)), and neither the owner of the patent that is the subject of the certification nor the holder of the approved application under subsection (b) of such section for the drug that is claimed by the patent or a use of which is claimed by the patent brought an action for infringement of such patent before the expiration of 45 days after the date on which the notice given under subsection (b)(3) or (j)(2)(B) of such section was

received, the courts of the United States shall, to the extent consistent with the Constitution, have subject matter jurisdiction in any action brought by such person under [section 2201 of title 28](#) for a declaratory judgment that such patent is invalid or not infringed.

**(f)(1)** Whoever without authority supplies or causes to be supplied in or from the United States all or a substantial portion of the components of a patented invention, where such components are uncombined in whole or in part, in such manner as to actively induce the combination of such components outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

**(2)** Whoever without authority supplies or causes to be supplied in or from the United States any component of a patented invention that is especially made or especially adapted for use in the invention and not a staple article or commodity of commerce suitable for substantial noninfringing use, where such component is uncombined in whole or in part, knowing that such component is so made or adapted and intending that such component will be combined outside of the United States in a manner that would infringe the patent if such combination occurred within the United States, shall be liable as an infringer.

**(g)** Whoever without authority imports into the United States or offers to sell, sells, or uses within the United States a product which is made by a process patented in the United States shall be liable as an infringer, if the importation, offer to sell, sale, or use of the product occurs during the term of such process patent. In an action for infringement of a process patent, no remedy may be granted for infringement on account of the noncommercial use or retail sale of a product unless there is no adequate remedy under this title for infringement on account of the importation or other use, offer to sell, or sale of that product. A product which is made by a patented process will, for purposes of this title, not be considered to be so made after--

**(1)** it is materially changed by subsequent processes; or

**(2)** it becomes a trivial and nonessential component of another product.

**(h)** As used in this section, the term “whoever” includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this title in the same manner and to the same extent as any nongovernmental entity.

**(i)** As used in this section, an “offer for sale” or an “offer to sell” by a person other than the patentee, or any designee of the patentee, is that in which the sale will occur before the expiration of the term of the patent.

## **APPENDIX 2: §§9, 10, 11 PATG GERMANY**

### **§9**

Das Patent hat die Wirkung, dass allein der Patentinhaber befugt ist, die patentierte Erfindung im Rahmen des geltenden Rechts zu benutzen. Jedem Dritten ist es verboten, ohne seine Zustimmung

1. ein Erzeugnis, das Gegenstand des Patents ist, herzustellen, anzubieten, in Verkehr zu bringen oder zu gebrauchen oder zu den genannten Zwecken entweder einzuführen oder zu besitzen;

2. ein Verfahren, das Gegenstand des Patents ist, anzuwenden oder, wenn der Dritte weiß oder es auf Grund der Umstände offensichtlich ist, daß die Anwendung des Verfahrens ohne Zustimmung des Patentinhabers verboten ist, zur Anwendung im Geltungsbereich dieses Gesetzes anzubieten;

3. das durch ein Verfahren, das Gegenstand des Patents ist, unmittelbar hergestellte Erzeugnis anzubieten, in Verkehr zu bringen oder zu gebrauchen oder zu den genannten Zwecken entweder einzuführen oder zu besitzen.

### **§ 10**

(1) Das Patent hat ferner die Wirkung, daß es jedem Dritten verboten ist, ohne Zustimmung des Patentinhabers im Geltungsbereich dieses Gesetzes anderen als zur Benutzung der patentierten Erfindung berechtigten Personen Mittel, die sich auf ein wesentliches Element der Erfindung beziehen, zur Benutzung der Erfindung im Geltungsbereich dieses Gesetzes anzubieten oder zu liefern, wenn der Dritte weiß oder es auf Grund der Umstände offensichtlich ist, daß diese Mittel dazu geeignet und bestimmt sind, für die Benutzung der Erfindung verwendet zu werden.

(2) Absatz 1 ist nicht anzuwenden, wenn es sich bei den Mitteln um allgemein im Handel erhältliche Erzeugnisse handelt, es sei denn, daß der Dritte den Belieferten bewußt veranlaßt, in einer nach § 9 Satz 2 verbotenen Weise zu handeln.

(3) Personen, die die in § 11 Nr. 1 bis 3 genannten Handlungen vornehmen, gelten im Sinne des Absatzes 1 nicht als Personen, die zur Benutzung der Erfindung berechtigt sind.

### **§11**

Die Wirkung des Patents erstreckt sich nicht auf

1. Handlungen, die im privaten Bereich zu nichtgewerblichen Zwecken vorgenommen werden;

2. Handlungen zu Versuchszwecken, die sich auf den Gegenstand der patentierten Erfindung beziehen;

2a. die Nutzung biologischen Materials zum Zweck der Züchtung, Entdeckung und Entwicklung einer neuen Pflanzensorte;

2b. Studien und Versuche und die sich daraus ergebenden praktischen Anforderungen, die für die Erlangung einer arzneimittelrechtlichen Genehmigung für das

Inverkehrbringen in der Europäischen Union oder einer arzneimittelrechtlichen Zulassung in den Mitgliedstaaten der Europäischen Union oder in Drittstaaten erforderlich sind;

3. die unmittelbare Einzelzubereitung von Arzneimitteln in Apotheken auf Grund ärztlicher Verordnung sowie auf Handlungen, welche die auf diese Weise zubereiteten Arzneimittel betreffen;

4. den an Bord von Schiffen eines anderen Mitgliedstaates der Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums stattfindenden Gebrauch des Gegenstands der patentierten Erfindung im Schiffskörper, in den Maschinen, im Takelwerk, an den Geräten und sonstigem Zubehör, wenn die Schiffe vorübergehend oder zufällig in die Gewässer gelangen, auf die sich der Geltungsbereich dieses Gesetzes erstreckt, vorausgesetzt, daß dieser Gegenstand dort ausschließlich für die Bedürfnisse des Schiffes verwendet wird;

5. den Gebrauch des Gegenstands der patentierten Erfindung in der Bauausführung oder für den Betrieb der Luft- oder Landfahrzeuge eines anderen Mitgliedstaates der Pariser Verbandsübereinkunft zum Schutz des gewerblichen Eigentums oder des Zubehörs solcher Fahrzeuge, wenn diese vorübergehend oder zufällig in den Geltungsbereich dieses Gesetzes gelangen;

6. die in Artikel 27 des Abkommens vom 7. Dezember 1944 über die Internationale Zivilluftfahrt (BGBl. 1956 II S. 411) vorgesehenen Handlungen, wenn diese Handlungen ein Luftfahrzeug eines anderen Staates betreffen, auf den dieser Artikel anzuwenden ist.

### **APPENDIX 3: ART. 66, ART. 72 PATG CH**

#### **Art. 66 PatG CH - Haftungstatbestände**

Gemäss den nachfolgenden Bestimmungen kann zivil- und strafrechtlich zur Verantwortung gezogen werden:

- a. wer die patentierte Erfindung widerrechtlich benützt; als Benützung gilt auch die Nachahmung;
- b. wer sich weigert, der zuständigen Behörde Herkunft und Menge der in seinem Besitz befindlichen Erzeugnisse, die widerrechtlich hergestellt oder in Verkehr gebracht worden sind, anzugeben und Adressaten sowie Ausmass einer Weitergabe an gewerbliche Abnehmer zu nennen;
- c. wer an Erzeugnissen oder ihrer Verpackung das Patentzeichen ohne Ermächtigung des Patentinhabers oder des Lizenznehmers entfernt;
- d. wer zu diesen Handlungen anstiftet, bei ihnen mitwirkt, ihre Begehung begünstigt oder erleichtert.

#### **Art. 72 PatG CH - Klage auf Unterlassung oder Beseitigung**

Wer durch eine der in Artikel 66 genannten Handlungen bedroht oder in seinen Rechten verletzt ist, kann auf Unterlassung oder auf Beseitigung des rechtswidrigen Zustandes klagen.

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