





Table for Reference - Joint Patent Infringement

Japan 	Germany 	The U.S. 	The U.K. 
Principle			
An infringer must be engaged in the acts satisfying all the elements of a patented invention.	Direct infringement of a patent is established only when the accused product realizes all elements of the product patent, or the accused person performs all steps of the method patent.	Single Entity Rule: Direct infringement requires a party to perform or use each and every step or element of a claimed method or product. (<i>Warner-Jenkinson Co., Inc. v. Hilton Davis Corp.</i> , 520 U.S. 17, 117 S.Ct. 1040, 137 L.Ed.2d 146 (1997), etc.)	To find direct patent infringement, the infringer must perform each and every element or step of the patent claim.
Cases where liability for infringement shall be established even though the alleged infringer is partly engaged in the acts working the invention			
<p>No Supreme Court precedent which ruled clearly on what circumstances would be sufficient.</p> <p>Approaches such as the followings are discussed in judgements of inferior courts and in academic society as to establishment of patent infringement even when all of the elements cannot be satisfied without combining acts of multi entities.</p> <p>Tool theory When an entity uses an act of a third party as a pawn or tool, the act of the third party shall be evaluated as having been performed by the entity, and the entity can be regarded as implementing acts satisfying all the elements. * <i>Electrodeposition image forming method case</i> (Judgement of the Tokyo District Court dated on September 20th, 2001; Case No.2000wa20503)</p> <p>Control & direction theory Even when an act of a third party cannot be regarded as a pawn or tool, as far as an entity controls and directs the act of the third party, the act of the entity shall be evaluated prescriptively to affirm its liability for infringement. * <i>Spectacle lens supply system case</i> (Judgement of the Tokyo District Court dated on December 14th, 2007; Case No. 2004wa25576)</p>	<p>The following liabilities based mainly on the German Civil Code can apply in patent infringement cases.</p> <p>1. Joint Tortfeasance (“Mittäterschaft”) Multi parties who consciously and deliberately cooperate in committing the act of infringement are jointly liable as infringers according to Section 830 of the German Civil Code.</p> <p>2. Secondary Liability (“Nebentäterschaft”) Negligent actions of multi parties, who do not cooperate consciously and deliberately, can establish liability when their actions cause infringement by combination according to Section 840 of the German Civil Code.</p> <p>3. Interference Liability (“Störerhaftung”) An interferer is a person who willfully contributes to an infringement in a sufficiently causal manner. The interferer must have actual or constructive knowledge of the infringement, i.e. the interferer either knows about the infringement, or at least should have known about it, such that he/she had the possibility to stop further infringement. See Section 1004 of the German Civil Code.</p>	<p>Joint/divided infringement as to method claims - standards for vicarious liability An entity responsible for others' performance of method steps in two sets of circumstances: (1) where that entity directs or controls others' performance, and (2) where the actors form a joint enterprise. (<i>Akamai Techs., Inc. v. Limelight Networks, Inc.</i>, 797 F.3d 1020, 1022 (Fed. Cir. 2015); generally referred to as "Akamai V")</p> <p>1. Direction or control Two prong test: 1) an alleged infringer conditions participation in an activity or receipt of a benefit upon performance of a step or steps of a patented method, and 2) an alleged infringer establishes the manner or timing of that performance In those instances, the third party's actions are attributed to the alleged infringer such that the alleged infringer becomes the single actor chargeable with direct infringement. (<i>Akamai V</i>; see also <i>Eli Lilly and Co. v. Teva Parenteral Medicines, Inc.</i>, 845 F.3d 1357 (Fed. Cir. 2017))</p> <p>2. Joint Enterprise Where two or more actors form a joint enterprise, all can be charged with the acts of the other, rendering each liable for the steps performed by the other as if each is a single actor. A joint enterprise requires proof of four elements: (1) an agreement, express or implied, among the members of the group; (2) a common purpose to be carried out by the group; (3) a community of pecuniary interest in that purpose, among the members; and (4) an equal right to a voice in the direction of the enterprise, which gives an equal right of control. (<i>Akamai V</i>)</p>	<p>Joint/Divided Patent Infringement Rules that apply to Joint/divided patent infringement are those relating to tortious act ("joint tortfeasance"). When two or more persons jointly perform an act of infringement, they are liable for patent infringement as joint tortfeasors. Joint/divided infringement contains at least: 1) vicarious joint liability, like in master-servant / principal-agent relationships, 2) joint liability through “procurement” by inducement, incitement, or persuasion, and 3) joint liability through “common design.”</p> <p>1. Vicarious joint liability Vicarious joint liability may arise in the context of specific relationships between A and B: i.e., an employer and an employee, and a principal and an agent. (<i>Koursk</i> [1924], <i>Sea Shepherd UK v Fish & Fish Ltd</i> [2015] UKSC 10, etc.)</p> <p>2. Procurement A will be jointly liable for patent infringements committed by B in a situation where A procures B to commit the infringing act by inducement, incitement or persuasion. (<i>Resolution Chemicals v H. Lundbeck A/S</i> [2013] EWHC 739 (Pat), <i>Sea Shepherd UK</i>)</p> <p>3. Common design A will be jointly liable for patent infringement where A and B act in concert with one another pursuant to a common design. (<i>Koursk</i>, <i>Resolution Chemicals</i>, <i>Sabaf Spa v MFI Furniture Centres Ltd and Managhetti Spa</i> [2003] RPC 264, <i>Sea Shepherd UK</i>) To establish accessory liability in tort it is not enough to show that A did acts which facilitated B's commission of the tort. A will be jointly liable with B if they combined to do or secure the doing of acts which constituted a tort. This requires proof of two elements. A must have acted in a way which furthered the commission of the tort by B; and A must have done so in pursuance of a common design to do or secure the doing of the acts which constituted the tort. (<i>Sea Shepherd UK</i>) A common design does not call for any finding that A has explicitly mapped out a plan with B. Their tacit agreement will be sufficient. Nor, is there any need for a common design to infringe. It is enough if A and B combine to secure the doing of acts which in the event prove to be infringements. (<i>Unilever Plc v Gillette (UK) Limited</i> [1989] RPC 583)</p>
<p>Joint direct infringement theory As far as there are objective relevance between acts of multiple persons and subjective relevance, they shall be evaluated as having performed jointly acts of direct infringement and each actor shall be liable not only for the acts performed of his/her own but for the infringement as a whole. (Views are different on whether joint intention to commit infringing act jointly is essential and the extent of mutual understanding which shall be sufficient.) * <i>Porous molded body case</i> (Judgement of the Osaka District Court dated on May 4th, 1961; Case No.1960yo493)</p>	<p>Referential Cases of the Federal Court of Justice</p> <p>MP3 player import case [2009] (BGH, GRUR 2009, 1142 - Xa ZR 2/08) Direct infringer is also who enables or facilitates the implementation of the infringing act by a third party, although he could obtain with reasonable effort knowledge that the act supported by him infringes the absolute right of the patentee.</p> <p>Audio signal encoding case [2015] (BGH, X ZR 69/13) Infringer of a negligent patent infringement must also be the person who caused the infringement through his own reproachable behavior. Reproachable conduct in this sense may lie, for example, in the fact that acts of a third party aimed at the use of the patent are not prevented in breach of duty. (<i>MP3 player import</i>, etc.) Reproachable conduct in this sense may also exist if a person, in the application of a process, takes advantage of the fact that certain steps of the protected process are carried out by a third party and can be included in his own action.</p>	<p>System claims</p> <p>1. To "use" a system To “use” a system for purposes of infringement, a party must put the invention into service, i.e., control the system as a whole and obtain benefit from it. (<i>NTP, Inc. v. Research in Motion, Ltd.</i>, 418 F.3d 1282 (Fed. Cir. 2005), <i>Centillion Data Sys., LLC v. Qwest Commc'ns Int'l, Inc.</i>, 631 F.3d 1279 (Fed. Cir. 2011); see also <i>Synchronoss Tech., Inc. v. Dropbox, Inc.</i>, 987 F.3d 1358 (Fed. Cir. 2021)) Proof of an infringing “use” of the claimed system under § 271(a) requires the patentee to demonstrate that the direct infringer obtained benefit from each and every element of the claimed system. In addition, the direct or indirect control required is the ability to place the system as a whole into service. (<i>Intell. Ventures I LLC v. Motorola Mobility LLC</i>, 870 F.3d 1320)</p> <p>2. Vicarious liability The Akamai V standard for vicarious liability applies for method claims, but the Centillion court discussed the principles of vicarious liability from method claims in the context of system claims. (<i>Centillion</i>)</p>	<p>To "use" as to System Claims</p> <p>“The claimed invention requires there to be a host computer. In the age that we live in, it does not matter where the host computer is situated. [...] Its location is not important to the user of the invention nor to the claimed gaming system. In that respect, there is a real difference between the claimed gaming system and an ordinary machine.” “[I]t is pertinent to ask who uses the claimed gaming system. The answer must be the punter. Where does he use it? [...] [I]t is not straining the word “use” to conclude that the United Kingdom punter will use the claimed gaming system in the United Kingdom, even if the host computer is situated in, say, Antigua. Thus the supply of the CD in the United Kingdom to the United Kingdom punter will be intended to put the invention into effect in the United Kingdom.” "A punter who uses the [...] system will be using the whole system as if it was in the United Kingdom. He will in substance use the host computer in the United Kingdom, it being irrelevant to the punter where it is situated." (<i>Menashe v. William Hill</i> [2002] EWHC 397 (Pat), [2002] EWCA Civ 1702)</p>