Kluwer Patent Blog

Will Father Christmas bring a definition of “staple product” for the purpose of contributory infringement?

Miquel Montañá (Clifford Chance) · Monday, December 21st, 2020

A recent judgment of 13 November 2020 from the Barcelona Court of Appeal (Section 15) has brought to the fore again the thorny topic of “indirect” or “contributory” infringement. The difficulty of the topic is illustrated, for example, by the fact that two very learned Judges (Judge Arnold, then in the first instance and Judge Floyd, in the Court of Appeal), reached opposite decisions on contributory infringement in the pregabalin (Lyrica®) case. Readers will remember that the Court of Appeal of England & Wales reversed Judge Arnold’s decision denying contributory infringement. In the Spanish case discussed in this blog, the Barcelona Court of Appeal (Section 15), although expressing doubts of fact and doubts of law, has reversed the first instance decision, which had found contributory infringement.

The facts of the case can be summarized as follows. Claim 1 of the patent asserted reads as follows:

> “*A method for the preparation of a gel of plasma rich in growth factors (P.R.G.F.) from the blood of a patient, said blood having been extracted from the patient moments before the start of surgery and prior to the administration of anaesthesia, into tubes citrated to 10% with trisodium citrate, said method comprising:*
>
> *(a) centrifuging the tubes between 160-800 G for 6-8 minutes at room temperature to separate the blood into the following fractions: a fraction of red blood cells in the bottom part of the tube, a fraction of plasma rich in growth factors (P.R.G.F.) in the middle part of the tube, and a fraction of plasma poor in growth factors (P.P.G.F.) in the upper part of the tube;*
>
> *(b) extracting the plasma rich in growth factors (P.R.G.F.) fraction of the centrifuged product and transferring it to Eppendorf tubes or glass test tubes, adding 10% calcium chloride and waiting a period of time for the gel to form, where*
>
> *(c) the blood of the patient is not mixed with any other component of animal or human origin.”*

The patentee filed a patent infringement action based on “indirect” infringement against a company that was selling three kits and a centrifuge that, according to the Court of First Instance, could be used for the purpose of putting the invention into practice. The judgment was based on Article 51

of the Spanish Patent Act of 1986, which read as follows:

> *"1. The patent also confers on its owner the right to prevent any third party from delivering or offering to deliver means for the implementation of the patented invention relating to an essential element thereof to persons not authorized to exploit it, without the patent owner's consent, when the third party knows or the circumstances make it evident that such means are suitable to put the invention into practice and are intended for it.*
>
> 2. *The provisions of the previous section are not applicable when the means to which it refers are products that are found habitually in trade, unless the third party incites the person to whom the delivery is made to commit acts prohibited in the previous article. […]*"

In the first instance, the Court considered that all the requirements of this provision were fulfilled. Although the defendant had argued that when using its kits and its centrifuge a liquid, instead of a gel, was formed, the evidence considered showed that, after some time, a gel was actually formed. In fact, this was mentioned in the instruction sheet of the products marketed by the defendant.

In the second instance, the Court of Appeal agreed with the first instance decision, except on one crucial point. The Court of Appeal considered that since, in its opinion, the kits and centrifuge marketed by the defendant were "staple products", there could only be contributory infringement if the defendant had "induced" third parties to directly infringe the patent. According to the Court, marketing a product with a sheet of instructions that shows that it can be used to put an invention into practice does not amount to inducing someone to put the invention into practice.

For the purpose of this blog, it is worth pausing to consider the test used by the Court to determine whether a product is a "staple product" or not. According to the Court, products which "at least have a normal non-infringing use" would be staple products. Like the Court of Appeal, this author has doubts as to whether this is the right test. For example, the fact that active ingredient X may be used to treat a non-patented indication does not necessarily mean that active ingredient X is a product found habitually in trade. The law does not say that the patent owner must prove "inducement" when the product may be used for non-patented purposes. Rather, it says that inducement must be proved when it is a product found habitually in trade, which does not appear to be exactly the same thing. In this regard, Terrell has written that "*The use of the word "staple" is presumably a reference to raw materials or other basic products commonly available and with a multitude of possible applications, and the purpose of the subsection is to protect the supplier of such products even if they have knowledge that they are to be put to an infringing purpose. The scope of the words is far from clear and the dividing line between protecting the supplier of raw materials on the one hand and giving a fair monopoly to the patentee must be a question of fact in each case.*"

Hopefully, Father Christmas, or perhaps the Supreme Court, will bring some guidance on where the fine line must be drawn or on whether or not there is a line to be drawn in the first place.

---

subscribe here.

Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

This entry was posted on Monday, December 21st, 2020 at 7:52 pm and is filed under (Indirect) infringement, Patents, Spain
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.