



LEGAL IMPLICATIONS OF 3D PRINTING ON TRADE MARKS & DESIGNS

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ECTA

Agenda

1 Introduction

2 Designs

3 Trade marks

4 Conclusion

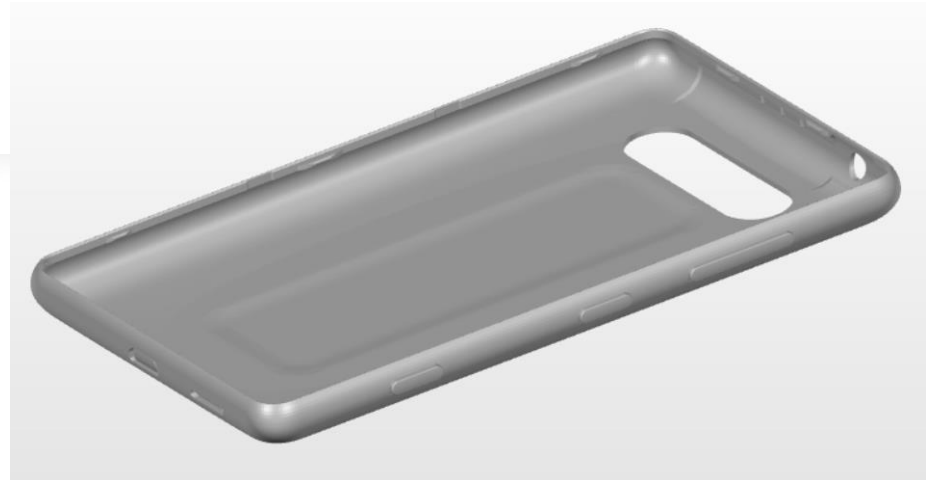


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INTRODUCTION - SHIFTING LANDSCAPE

2013: Nokia released design files enabling 3D printing of Nokia Lumia 820 and 520 cases – creative commons licence (only private purposes)

- Mechanical drawings
- Measurements
- Recommended materials



Embrace the opportunities!

INTRODUCTION – Legal challenges



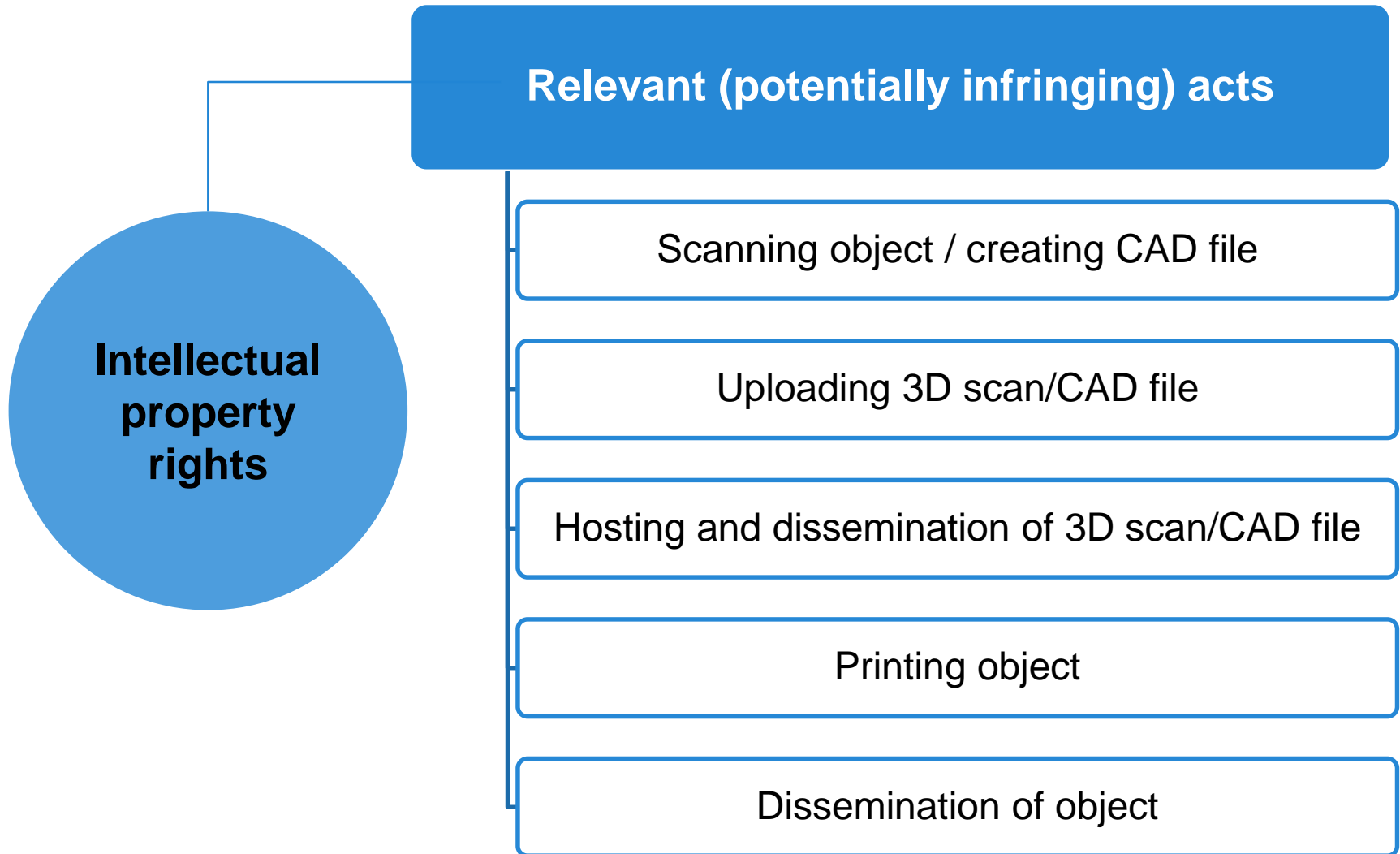
**Intellectual
property
rights**

**Unfair
commercial
practices**

**Liability
issues**

**Product
liability**

INTRODUCTION – Legal challenges



1

DESIGNS

DESIGNS - Overview

- “the **appearance** of the whole or a part of a **product** resulting from the **features** of, in particular, the lines, contours, colours, shape, texture and/or materials of the product itself and/or its ornamentation” (Article 3(a) CDR)
- **Registered** and **unregistered** Community designs
- Criteria: **novelty** and **individual character**
- Excluded from protection:
 - Invisible components
 - Designs solely dictated by technical function
 - Must fit vs. must match
 - Repair parts



DESIGNS – Points of attention

■ Design infringement?

- **Registered design** grants an exclusive right to **use** the design
= including the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes
- **Unregistered design**: same protection provided that design was intentionally copied (= bad faith)

■ Infringing acts:

- 3D printing a product in which the design is incorporated = likely “making”
- Offering or putting on the market of a 3D printed product incorporating a design



■ However: important exception!

No exercise of rights against acts done

- **privately and (!)**
- **for non-commercial purposes** (Article 20 (1) (a) CDR)

- May become **main challenge/issue** for design holders
 - **Before:** main challenge was old-fashioned factory counterfeiting with considerable investments in materials, intermediaries, skill, knowhow → legislation drafted in this sense
 - **Now:** 3D printing makes reproduction possible without such investments → much more reproduction may occur under private use exception
- Current legal framework **outrun** by technological developments → design holders deprived from a considerable part of their design protection
- No **indirect infringement** (cf. patent law)
- **Solution?** 3steps test TRIPs? reprography remunerationadapt legislation? feasible in reality?
 - No conflict with normal exploitation of protected design
 - No unreasonable prejudice to legitimate interests design holder

2

TRADE MARKS

TRADE MARKS - Overview

- “any signs, in particular **words**, including personal names, or **designs**, letters, numerals, colours, the **shape of goods** or of the packaging of goods, or sounds, provided that such signs are capable of:
 - **distinguishing** the goods or services of one undertaking from those of other undertakings; and
 - **being represented** on the Register” (Article 4 EUTMR)
- Obtained through registration
- Excluded from protection: cf. infra



TRADE MARKS – Points of attention

- 3D printing appears to create **less legal issues** in regard of TMs (to the detriment of the IP holder)
- Reasons:

1. Excluded shapes (article 7 (1) (e) EUTMR)

- Shape results from **nature of the goods**
- Shape is **necessary to obtain a technical result**
- Shape gives **substantial value** to the goods

→ **No TM protection for shape of 3D printed goods such as**

- Jewellery
- Design objects (furniture, decoration, lamps)
- Spare parts (popular application of 3D printing)
- Utility objects (screws and bolts)
- Artificial body parts for medical purposes



2. **TM's scope of protection:** infringement requires

- **Use in the course of trade**

- relates to use in the context of **commercial activity** with a view to **economic advantage** and not as a **private matter** (cf. CJEU Arsenal 12/11/2012)
- cf. **private use exception** under design law

- Article 9 (2) (a) and (b): **use as a TM - "in relation with goods or services"**

- Article 9 (2) (c): **use without due cause** (cf. CJEU Bulldog 06/02/2016)

- EUTM with a reputation in the Union
- use that takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark

- **Adverse effect on the TM function**

- TM function: indication of origin of goods, investment function, advertisement function
→ very important for luxury brands
- Luxury brands: price + scarcity → social status → luxury character
- 3D printing: lower price/quality, more ubiquitous → diminishes luxury character
- Cf. US: "post sale confusion" doctrine – "bystander confusion" or "status confusion"

→ **Difficult for the TM owner to act against non-commercial 3D printing of/with his TM - issue similar to design law**

CONCLUSION

- Emergence of 3D printing has **considerable impact** on holders of trade mark rights and design rights
- Greatest challenge: **consumers creating/manufacturing their own products**
- Future shift in **counterfeit market?**
 - Traditional counterfeiting required mass production in order to achieve economies of scale ↔ 3D printing allows one-off production of counterfeit goods
 - May disturb the market for certain luxury, rare, or out-of-production spare parts → 3D printing expands scope of products susceptible to counterfeiting
 - Less attractive for consumers to buy counterfeit goods at a lower price than the original product if they can also 3D print it at the same cost
- **Solution?** Updating legal framework required? Or let the market adapt to new technologies?

Questions?

