

# 3D trademarks in a world of 3D- a US perspective

ABPI

David Postolski

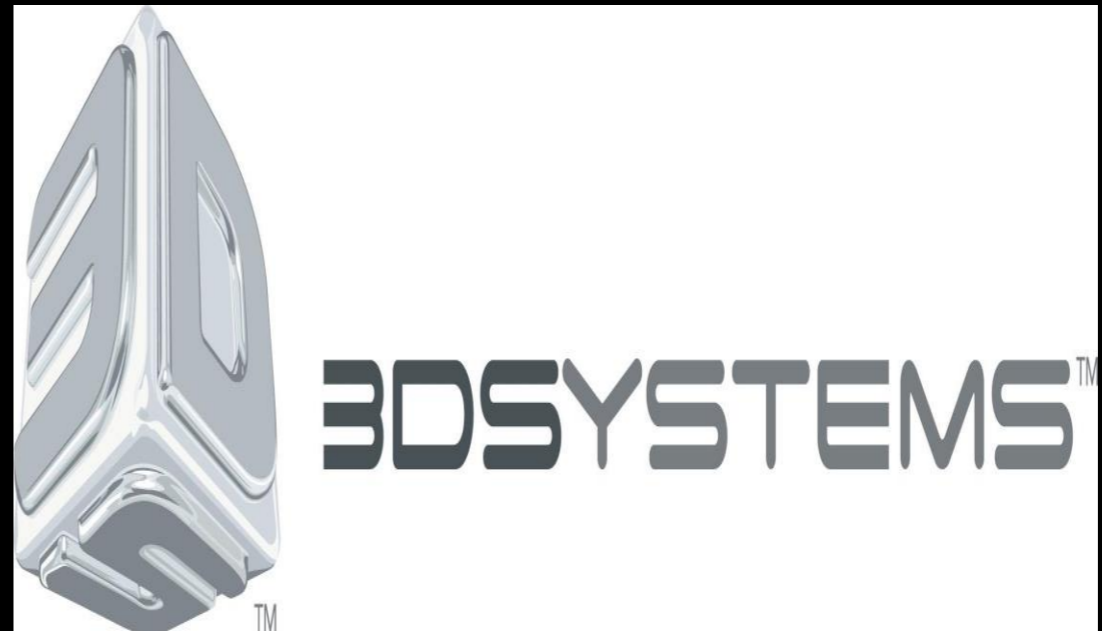
Gearhart Law

August 22, 2017

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# 3D printing history

- Emerged 1980s for industrial applicability.
- Patents expire and manufacturing supply chains jump on chance to lower costs



# 3D printing in a nutshell

- Digital file created using a 3D scanner or a 3D print software (CAD)
- Additive process- layer upon layer built
- Moving quick and fast and can IP laws keep up as they exist today





- Using a 3d printer to copy a products brand name emblem is construed as infringement
- Using your 3d printer to copy color Symbols or design elements may lead to confusion
- The intentions and knowledge of the 3d printer is irrelevant. What matters is using the 3d printer and creating objects with infringing trademarks and selling the products in the course of trade or commerce



# Nokia



- January 2013-makes Lumia 820 and Lumia 520 CAD file available for all to print on consumer 3D printers with their logo as part of the design. SMART or STUPID?
- Nokia the first to enable the production of their trademarked products that are not made by Nokia directly or a licensed manufacturer.


# US trademark law & TRIPS

- Designed to protect a product or brand from being confused with another in the eye of the consumer
- Protects names logos and emblems
- Protects consumers - so difference between using 3d printing for your own purposes or if you are engaging in interstate commerce
- TM is all about the origin or source of a product- printing at home or through a service lessens the origin or source requirement that make TMs a powerful protection.



Service Marks

- Lanham Act § 3 (15 U.S.C. § 1053)
  - Subject to the provisions relating to the registration of trademarks, so far as they are applicable, service marks shall be registrable, in the same manner and with the same effect as are trademarks, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks.



The image displays four logos: FedEx (purple and grey), Jiffy Lube (red arrow pointing down with 'jiffylube' text), American Airlines (blue and red stripes with 'American Airlines' text), and the Copy GOP logo (blue and white with 'CALL THE COPY' and 'COPY GOP' text).



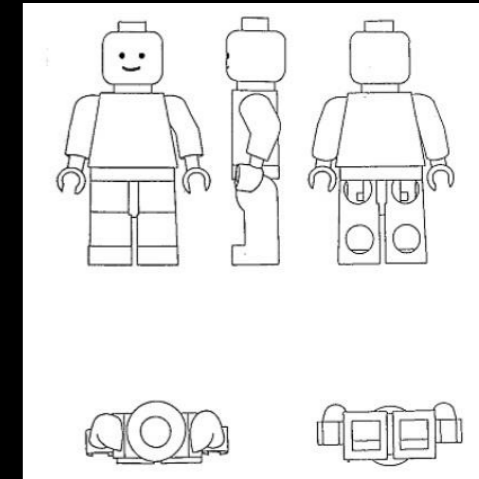


# 3D trademarks



- Often referred to as trade dress
- To register - the object cannot have a function
- Trade dress- overall commercial image (look and feel) of a product
- Trade dress- includes design, size color texture graphics or shape or configuration of a product
- Product labeling and packaging - total image and overall appearance of the product





Goods and Services

IC 028. US 022 023 038 050. G & S: toy figures; play figures; positionable toy figures; modeled plastic toy figurines; three dimensional positionable toy figures sold as a unit with other toys; construction toys; toy construction sets

Mark Drawing Code

(2) DESIGN ONLY

Design Search Code

02.01.26 - Men, mechanical men, robots; Robots (men)

Serial Number

86537461

Filing Date

February 17, 2015

Current Basis

44E

Original Filing Basis

44E

Published for Opposition

December 8, 2015

Registration Number

4903968

Registration Date

February 23, 2016

Owner

(REGISTRANT) LEGO Juris A/S CORPORATION DENMARK Koldingvej 2 Billund DK-7190 DENMARK

Attorney of Record

David Ehrlich

Prior Registrations

4520327

Description of Mark

Color is not claimed as a feature of the mark. The mark consists of the three-dimensional configuration of a toy figure featuring a cylindrical head, on top of a cylindrical neck, on top of a trapezoidal torso of uniform thickness, with flat sides and a flat back, where arms are mounted slightly below the upper surface of the torso, on top of a rectangular plate, on top of legs which bulge frontwards at the top and are otherwise rectangular with uniform thickness, on top of flat square feet.

Type of Mark

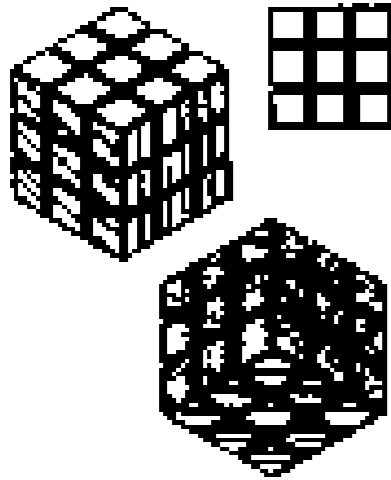
TRADEMARK

Register

PRINCIPAL-2(F)

Live/Dead Indicator

LIVE



THE MARK CONSISTS OF A BLACK CUBE HAVING NINE COLOR PATCHES ON EACH OF ITS SIX FACES WITH THE COLOR PATCHES ON EACH FACE BEING THE SAME AND CONSISTS OF THE COLORS RED, WHITE, BLUE, GREEN, YELLOW AND ORANGE. THE DRAWING IS LINED FOR THE COLORS RED, GREEN, ORANGE, BLUE AND YELLOW.



Registration Number

1265094

Registration Date

January 24, 1984

Owner

(REGISTRANT) CBS Inc. CORPORATION NEW YORK 51 W. 52nd St. New York NEW YORK 10019(LAST LISTED OWNER) RUBIK'S BRAND LTD. CORPORATION UNITED KINGDOM 7 LAMBTON PLACE LONDON UNITED KINGDOM

# 3D trademarks



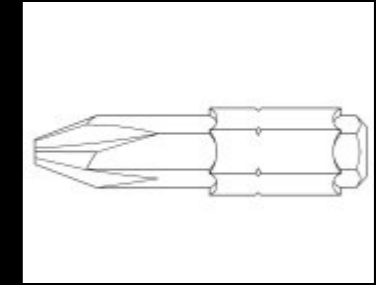
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- Abercrombie Test-Product configuration must be inherently distinctive (capable of identifying source and the overall image falls under suggestive arbitrary or fanciful test)) or have acquired secondary meaning AND shape must be nonfunctional Generic fail for distinctiveness and descriptive must acquire secondary meaning.

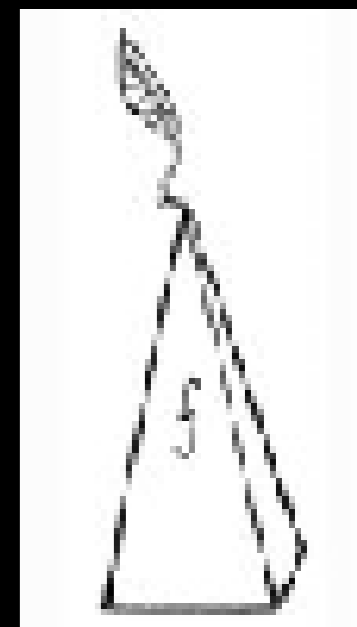


- Seabrook test- Is the design shape or combination of elements so unique unusual and unexpected in the particular market that one can assume without proof that it will automatically be perceived by customers as an indicator of origin - a trademark”

# Functional

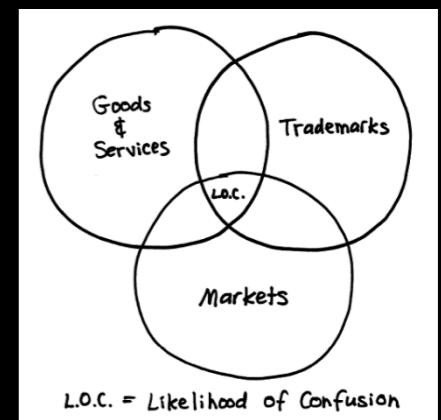


- Product designs held to be functional and thus no trade dress protection: baby bottle. Tractor tread design. Shape of Etch a sketch drawing toy, clamshell shape of a cell phone. Product feature is functional if it's an important ingredient in the commercial success of the product
- Non Functional- round wall thermostats. Shape and appearance of the head of a golf club. Hand held kitchen blender and shape of Ferrari classic auto. Design feature not functional if the design is a mere arbitrary embellishment



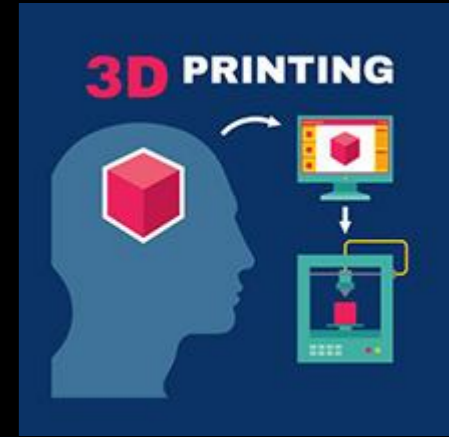
# Likelihood of Confusion

- Polaroid factors
- 1955 -Post sale confusion doctrine-even though the actual consumer may not be deceived about a products origin at the time of purchase, other members of the public might be misled when they subsequently encounter the consumer in possession of the product. ROLEX
- Lois Software- TM holders can bring claims against both legitimate competitors using Similar TM and counterfeiters selling knockoff products





# 3d printing - where are we today



- Consumer grade 3d printing is tedious and overburdensome. The cool factor is worn off
- 3d systems- exited the consumer market
- Stratasys- Makerbot- focuses more on educators and professionals. \$1375-7000 for six models. Formlabs \$400
- Solidoodle- closed shop
- Shapeways (paid site) Sculpteo, Meltwerk, iimatetialise, Thingiverse (open source and free) business is connecting CAD files created by ANYONE to professional printers
- These companies and the CAD designers don't even know about IP or think their design is not infringing anyone's IP

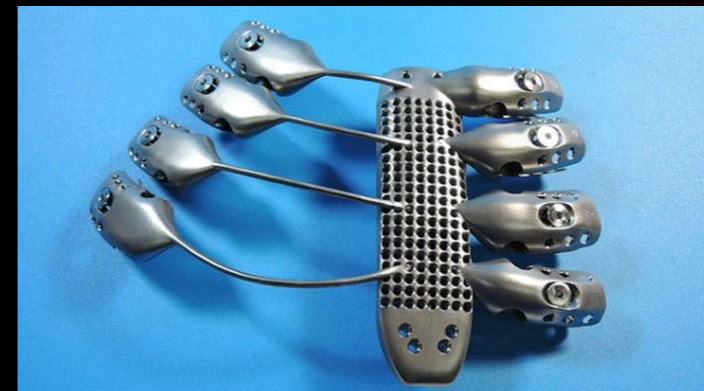




# 3d printing today



- Self policing. Be a responsible innovator
- Educating the 3d printing community. Terms of Service state that CADs available may be subject to IP protection but the site doesn't do any due diligence
- Creating a regulatory scheme that goes after patent infringers for design, copyright infringers for creating source code of infringing CADs and going after trademark infringers whether it's the designer or then professional printing service who is printing infringing products and brands
- Brand owners must educate the public on the merits of buying genuine products through traditional manufacturing methods. Inferior materials and manufacturing methods make for inferior products which only erode TM owners brand strength
- Does the millennial care about inferior products made of inferior materials or do they want the brand name?
- Personal experience MIX LAB and IP Workshop



# Current CAD search

- Downloading cad is for a single non commercial use but there is no mechanism in place to enforce this provision
- Like Keurig coffee machines 3d printers need digital rights management (DRM) software to prohibit the printing of copyrighted Trademarked and patented material



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# Creating protectable 3D TMs is the 1st step in going after a 3D printed Version

- Inherently distinctive and non functional- public must recognize the products shape as an indication of source. Is the shape unique? The more unusual the better
- Secondary meaning and non functional
- Non functional - advertising should refer to the shape but don't list functional advantages



# Practical Tips- Acquired Distinctiveness

- engage in extensive advertising;
- create advertising that causes consumers to equate the mark with the source of goods or services;
- advertise in a manner that makes clear that the mark is not simply ornamental, decorative or a feature; and
- be careful not to advertise functional or utilitarian aspects of a mark.



# How to solve?



- Amend the Lanham Act to prohibit the unauthorized private non commercial use of TMs
- Private counterfeiting was not an issue when act was created
- Authorized/authentic and unauthorized/unauthentic version of a TM product - each seemingly identical in appearance -may be a distinction without difference thereby causing consumers to NOT rely on TMs as indicators or origin





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**David Postolski, a partner at Gearhart Law, is a registered patent attorney and Intellectual Property attorney. With over 15 years' experience, David specializes in assisting inventors, creators, artists, start-ups, entrepreneurs, early stage companies and emerging companies with their U.S and International intellectual property strategy, protection, enforcement and monetization. David remains very involved in the creation of New York State's first federally approved patent pro bono program in conjunction with Volunteer Lawyers for the Arts. David is a frequent speaker and author on intellectual property issues surrounding raising capital, business formation, licensing, and reward and equity based crowd funding. David is also a Professor at Parsons School of Design where he teaches master level students about IP, ethics and other regulatory considerations in starting business ventures and products around design. David is the current chair of the Professional Issues Division of the ABA Section of Intellectual Property law as well as a member of the CLE Board, Sponsorship Board, and founder of the International Action Group.**