

Can you see me coming?

Are lawyers and clients ready for the effects of 3D printing?

By Ava Chisling



If you believe the headlines, 3D printing can, at once, add two inches to a hunchback's height, combat climate change, and produce a bunch of organs you may one day need to survive. Although many people believe otherwise, 3D printing is not new. It is a technology that has been around for decades. It is only now, however, that the equipment needed to print 3D objects is small enough and affordable enough (roughly \$1,300), for people to use in their homes and small businesses.

3D printing first requires a virtual design of the object you want to print. It can be from scratch or use a 3D scanner to copy an existing product. 3D software then "slices" the object into many different layers, and once that process is complete,

the file is uploaded to a 3D printer, which then prints the object. You can see how the ability to print products at will could cause problems with intellectual property — a lot of problems, including copyright, trademark, and design patent infringement. And from a commercial point of view, if everyone with the right equipment can print Aspirin or Play-Doh at home, who will buy these things at the store, online or off? Are your clients ready for the possible impact of this technology? Are you?

One thing is for sure: No one wants to be the next record industry executive. Years ago, those in charge of the music industry had no idea what impact online file-sharing would have on their industry. And when they did finally figure it out,

they had no viable strategy in place to deal with it. Tracey Mosley, a longtime trademark agent and partner at Borden Ladner Gervais LLP in Ottawa, says we are not yet at that game-changing point with 3D printing, but it's coming. "We are probably five to 10 years away from the technology being small enough that you'd want it in your home, and you can afford it, and you can stock materials for it, and you have the knowledge and capacity to store files for it. . . . Right now, people have trouble keeping their home e-mail running."

The technology is definitely popular. There are headlines about 3D printing almost every day. Whether it is a 3D car or a 3D bridge, millions of people worldwide are using and investing in this technology. Here in Canada, however, what Mosley hears most about in her practice are not grandiose, news-making 3D items, but rather, small enhancements to toys or tools — people out to make a bigger handle for a product. From a legal standpoint, Mosley says, "It's not the end of the world. As long as they are not selling it or doing something that damages the reputation of the company, it's not a problem. The materials now tend to be plastic, with some of it being metal, but there is not a whole lot you can do at home just yet."

Jeremy Madl has been designing toys professionally for 18 years and agrees with Mosley. Having worked for corporations like Pepsi, Mattel, and the NFL, he says the quality of home 3D printing is not yet good enough for his standards. However, he uses it in his day-to-day business and has done so for the past six years, mostly for mock-ups. "Do I think every family needs a US\$1,200 printer in their house to pump out cellphone cases and other plastic stuff? Probably not. Right now, it's great to be able to get a nice, high-res printed prototype for client approvals. It saves an enormous amount of time and money in the

development process for mass production toys. Being able to digitally revise and print a product in a few days is extremely helpful. It used to take three to four weeks. . . .”

Sze-Mei Yeung, chairman of the IP practice group at Vancouver's Richards Buell Sutton, says she has not yet seen great interest in the technology but that is likely to change. “Our clients are still trying to understand 3D printing and how it will impact their businesses. Currently, we have not experienced any significant increase

in trademark or industrial design applications or filings from clients as a result of 3D printing. That being said, we would expect that the technology will likely result in an increase in infringement of various intellectual property rights, particularly if it is used to create commercial products.”

In May, D'Oréal USA entered into a research partnership with a bio-printing company to develop 3D printed skin. Late last year, Hasbro partnered with Wal-Mart to allow its action figures to be custom 3D

printed at select stores. Yet not everyone is as enthusiastic. When the popular online retailer of 3D goods and services, Shapeways, tried to sell a version of Katy Perry's infamous “Left Shark” dancer from her Super Bowl performance, the pop singer's lawyers fired off an angry letter. Whether or not the mascot-like shark can be copyright protected is debatable, but the speed at which the letter was sent hints that the music industry may be tired of having its property “copied” without permission. As of late June, not only is Left Shark still for sale on Shapeways, but so is Left Shark Lawyer and Come at Me Bro Shark.

Yeung says many useful and functional consumer products would not be generally protected by copyright. “There are exemptions for personal use that may limit the protection of objects from 3D printing, provided that the original work is not an infringing copy, the person obtained it legally, and the copy is not given away. With this in mind, clients need to determine whether they are able to protect their goods from the potentially infringing impact of 3D printing technology via a three-dimensional trademark and/or registration of an industrial design, which protects the aesthetic features of useful objects.”

Mosley advises her clients to be careful if they believe their IP has been infringed. These days, feedback from the public is instant and what may have started as a small problem could become a large one if the alleged infringer goes online and complains. This is the kind of publicity most companies dread. “Nowadays, this is one of the first considerations for clients,” she says. “If we are aggressive right off the top, all it takes is one person to put something on Twitter and suddenly you have a problem with the media. If you can resolve matters quietly and privately, you should. In some cases, the 3D product is so clever, the company may want to partner with these people.”

Mosley says there are many things to consider. It's one thing if the person has made a copy of your product and sent it all over the world, but if it's a community group and only four copies have been made, it's different. “You have to ask many questions,” says Mosley. “Is the problem growing? Will it be over soon? Is it a valuable market? If you have people copying your toys right before Christmas, there is no way to regain those sales.” Ultimately, the

client has to assess whether any real damage is being done to his or her company, and, says Mosley, “do you want to spend a fortune trying to stop people from copying your product or do you want to work cooperatively? There could be other forms of revenue streams. Maybe you can make the 3D files available for a subscription.”

Madd believes the technology will have a significant impact on his business. “I'm not going to be able to stop someone from scanning/building my figures and printing one out, but I do my best from keeping multiple copies being made. If 3D printing becomes more popular, I see it as a problem for my bottom line. I've worked for many years building my brand. I own all licensing rights, molds, and tooling and I do my best to stop any copies that are being made or sold.”

When it comes to the future, opinions differ as to how worried clients and lawyers should be. Yeung says 3D printing is not front of mind for lawyers right now. “Most are aware of it but have not seen it impact their clients in a significant way to date.” Mosley believes if things are going to change significantly in this area, it will be either with an expansion of materials used by the printers, including biodegradable ones, or the materials used will be cheaper. She also sees another issue: “Are we creating an environmental problem?”

Despite the possibility his business may be negatively affected, Madd is not worried about the future of 3D printing. “I'm going to keep using it, while researching and seeing what's coming next. In the future, I can see my grandkids printing out their birthday gifts on an ATM-size unit at Toys R Us. As a creative guy with way too many ideas bouncing around in my head, the technology excites me more than anything else.” ■



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