

Prospecting IP Issues Regarding 3D Printing - Japan View

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I. Overview

(A) Changes Expected

- Producing and selling counterfeit goods will become easier imminently
- New product development and personally tailored production will be significantly accelerated

I. Overview

(B) Prospecting Issues

(1) For products protected by current IP rights (patent / design rights),

(i) How producing/selling counterfeit should be avoided

(ii) How 3D data should be treated and protected

(iii) How 3D data should be used

I. Overview

- (2) For products not protected by current IP rights,
 - (i) How 3D data should be protected
 - (ii) How 3D data should be used

II. When Current IP protection is available

(1) For products protected by patent / design rights, does indirect infringement occur?

(Patent Law, Art. 101)

- Is 3D data "product" under Art. 2 of the Patent Law?

[Suppose (i) counterfeit goods are produced by using 3D data of the protected product, where (ii) the 3D data has been produced, uploaded and distributed without consent. Can we stop (ii)?]

II. When Current IP protection is available

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(1) For products protected by patent / design rights, if 3D data is recognized "product" under Art. 2 of the Patent Law, 3D data that can be used for producing infringing goods may constitute (indirect) infringement of the protected products.

[Art. 101 The following acts shall be deemed to constitute infringement ... of a patent right or an exclusive license: (i) where a patent has been granted for an invention of a product, acts of producing, ..., etc. any product to be used exclusively for the producing of the said product as a business; ...]

II. When Current IP protection is available

(2) For products protected by Copyrights, does copyright infringement occur?

- Is 3D data derivative work under Art. 2 of the Copyright Law?
- Is Art. 28 (Original copyright owners' right) of Copyright Law applicable?

[Suppose 3D data has been produced based on the protected work, and the work is reproduced by the 3D data with CAD software.]

II. When Current IP protection is available

(2) For products protected by Copyrights, if 3D data is produced based on the original work, copying or distributing the work may constitute infringement of copyright.

[Art. 2 § 1(xi) "derivative work" means a work created by translating, ..., or transforming, ... or otherwise adapting a pre-existing work; ...]

[Art. 28 In connection with the exploitation of a derivative work, the author of the original work shall have exclusive rights of the same types as those possessed by the author of the derivative work ...]

II. When Current IP protection is available

(3) Countermeasures against infringement

(i) Copy protection?

(ii) Liability limitation / Obligation?

(iii) Knowingly download illegal?

[Different players may play different rolls:

(i) - 3D data producers

(ii) – Platformers / 3D printer providers

(iii) - Users]

II. When Current IP protection is available

(4) Encouraging use of 3D data

(i) License notation?

(ii) Personal use?

(iii) Reproduction?

[3D data may facilitate new activities:

(i) – Sharing / processing 3D data

(ii) – Producing custom made products

(iii) – Reviving end-of-life products]

III. When No Current IP protection is available

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(1) For using 3D data,

(i) Unfair Competition Law

- Injunction / Damages available for selling form imitation goods
- Injunction not available for producing form imitation goods

[Suppose 3D data of a product with no protection has been produced, uploaded and distributed, and goods are produced by using the 3D data.]

[Art. 2 (1) The term "unfair competition" ... mean any of the following: ... (iii) assignment, lease, display for the purpose of assignment or lease, export or import of goods which imitate the form of another person's goods ...]

III. When No Current IP protection is available

(1) For using 3D data,

(ii) Contracts

- Use of 3D data can be limited by clause
- Third party use is not bound by the clause

[In the same scenario, the producer of the unprotected product and the producer of the 3D data may have a contract with a scope of the use limitation clause. This clause will not bind the producer of the goods produced by using the 3D data, however.]

III. When No Current IP protection is available

(2) For producing 3D data,

(i) Copyright Law

- Creative 3D data may be protected

[There is a court decision that confirms creative part of a CAD blueprint may have copyright protection. 3D data can then be protected by copyright, providing that the 3D is considered as a blueprint for producing a product.]

III. When No Current IP protection is available

(2) For producing 3D data,

(ii) Contracts

- Exclusive license

[In the same scenario, the producer of the unprotected product (A) and the producer of the 3D data (B) may have a contract with a clause that allows B to exclusively produce the 3D data. This clause will not bind the producer of the goods produced by using the 3D data (C), however.]

IV. Summary

- For changes introduced by 3D printing,
- traditional IP protection (patent, design, copyright) may still protect IP owner's right to some extent; but
 - other forms of non-IP protection (contracts and the like) may be needed to provide sufficient protection