



Patent Infringement in 3D Printing Technology and Liability of the Managing Director

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1. 3D printing

3D printing is one of the most spectacular technical developments of recent years and its use is no longer reserved for companies with a high level of investment. Meanwhile, the prices for entry-level models of 3D printers are in the range of smartphones. Here, "3D printing" is a generic term for processes for the production of three-dimensional objects. Typical materials are plastics, synthetic resins, ceramics or metals. Especially when manufacturing costs play a minor role and the objective is to create an individualized product, 3D printing plays an outstanding role. Computer-aided design (CAD) files serve as printing templates which contain the relevant information for printing. CAD files can be reproduced indefinitely and distributed on the Internet. Thus, it is possible to have 3D objects produced at any location, provided that a suitable 3D printing system is available. Therefore, a product can be produced on site as required. For instance, it would be conceivable that automobile manufacturers or suppliers for automobile manufacturers place CAD files on the Internet so that workshops could print out spare parts or exchange parts with improved properties on site themselves or at locally located printing stations. Moreover, medical products which can be tailored specifically to the human individual are also conceivable, for example by using data already stored from radiological diagnostics.

This leads to new challenges for intellectual property law, especially for patent law. Since the purely private use of 3D printing is not restricted by patent law, the following article examines the patent law aspects of commercial trade in Germany.

2. Liability of the Managing Director

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Practice shows that, in particular, medium-sized companies often struggle to register industrial property rights. However, in the light of the recent case law, this aspect seems to be increasingly important. In principle, the company is liable for the damage resulting from a patent infringement and particularly if it has manufactured or distributed patent-infringing products.

However, according to a recent decision of the German Federal Supreme Court, in the case of patent infringement the managing director may also be held personally liable.¹



The subject of this decision (hereinafter referred to as BGH-Glasfaser II) were patent infringement claims. The plaintiff was the owner of a European patent with effect for Germany, which relates to the use of glass fibres which do not have a carcinogenic potential.

The defendant was a company which sells glass fibre products to the building materials trade in Germany as well as its managing director.

In the decision BGH-Glasfaser II, the X. Civil Senate of the Federal Supreme Court is of the opinion that a guarantor position of the managing director exists, for example, if the protection of rights of third parties is an organizational task to which first of all the legal representative is appointed. The liability of the managing director in these cases does not result from a position as managing director as such, but from the factual and legal possibility and reasonableness - independent of the legal form of the company - of controlling a risk situation for absolutely protected rights of third parties.²

Against this background, in the opinion of X. Senate, the legal representative of a company regularly bears a secondary burden of demonstration and proof with regard to the question of who has fulfilled his or her obligations to avoid patent infringement.³

In fact, this means a reversal of the burden of proof in patent infringement proceedings, according to which the patentee does not need to demonstrate the circumstances of personal responsibility of the legal representative for the infringement. Thus, the X. Senate states that, as a rule, it is not necessary to establish in detail that the culpable infringement of a patent by a company is based on a culpable misconduct of this legal representative.⁴

In summary, it can therefore be said that the decision BGH-Glasfasern II of the X. Senate does not require the plaintiff to make a submission on the liability of the managing director. It is therefore the task of the management body to "exculpate" itself within the scope of its secondary burden of demonstration. In contrast to this, in the competence of the I. Senate, the plaintiff must, if necessary, present in detail the personal liability of the managing director in the case of violation of competition.

Practical advice

Before starting appropriate activities, a company must therefore check whether the products or processes used fall within the scope of protection of property rights of third parties. Such an approach helps the managing director to avoid personal liability in case of patent infringement.



3. Legal framework of patent infringement in 3D printing

Since meanwhile, especially in 3D printing, the number of patent applications is increasing rapidly, this article will highlight some patent-law aspects.

In general, technical processes and products (wherein under products not only a single component but also several components are to be understood) as well as their use can be protected by patents. On the other hand, utility model protection is denied the protection of pure manufacturing processes. Therefore, a complete 3D printing technology can be optimally protected by patent law.

In order to be eligible for a patent, an invention must be novel and inventive in addition to its technical character. Thus, in principle, a product of 3D printing can be protected by a patent if it is technical and is not a purely aesthetic creation. Further, a corresponding manufacturing process for a product, although the product as such is known, can also be patented.

4. Effect of the patent

Currently, two types of patents are available in Germany for the protection of inventions. On the one hand, one can protect an invention by means of a German patent at the German Patent and Trademark Office (German patent) and on the other hand, one can obtain a patent based on the European Patent Convention at the European Patent Office (European patent). The European patent is effective for the designated states.

A proprietor of a German patent or a European patent with effect for Germany may prohibit the commercial use of the patented product or process. A corresponding infringement leads to the fact that the proprietor of a patent (or the exclusive licensee) can in principle have the following claims against the infringer:

- Cessation and desistance of the use of the protected patent subject-matter,
- Compensation for all damages incurred and still to be incurred as a result of the use of the protected patent subject-matter (compensation for damages),
- Provision of information regarding, inter alia, the origin and the channel of commerce of protected products, as well as the names and addresses of the manufacturers, suppliers or other previous holders, as well as the wholesalers and the quantity of the products manufactured or delivered,
- Accounts of income and expenditure relating to the infringing acts, including a detailed profit and loss account



- Destruction of products held or owned by the infringer which are the subject-matter of the patent,
- Recall of the products which are the subject-matter of the patent or for definitive removal of the products from the channels of commerce, and
- Making the judgment public.

In principle, German patent law distinguishes between direct and indirect patent infringement.

i) Direct patent infringement

According to § 9, sentence 1 PatG, the proprietor of the patent alone is entitled to use the patented invention. According to § 9 PatG, in the absence of the consent of the proprietor of the patent, any third party is prohibited from

1. Producing, offering, putting on the market or using a product which is the subject-matter of the patent, or from either importing or possessing such a product for the purposes referred to;
2. Using a process which is the subject-matter of the patent or, if the third party knows or if it is obvious from the circumstances that use of the process is prohibited in the absence of the consent of the proprietor of the patent, from offering the process for use within the territorial scope of this Act;
3. Offering, placing on the market or using a product which is produced directly by a process which is the subject-matter of the patent, or from either importing or possessing such a product for the purposes referred to.

On the basis of paragraph 1, the patent proprietor has a positive right of use of a product, so that only the patent proprietor (or also the licensee) is entitled to use the product accordingly in the domestic market.

Paragraph 2, on the other hand, imposes a restriction to the effect that only the patent proprietor may assert rights based on his manufacturing process. If, for example, there is another manufacturing process for this product, the patent proprietor will not derive any rights to prohibit these alternative processes.

Paragraph 3 opens up the possibility of an import ban on products manufactured by the process of the invention.



ii) Indirect patent infringement

If, on the other hand, an essential element is "used" by a third party in an unauthorized manner, a so-called indirect patent infringement may be considered. By means of the indirect patent infringement the patent proprietor should be able to assert to his or her rights in advance to an imminent direct patent infringement. Thus, the patent proprietor can, for example, act against a supplier and does not have to approach the downstream recipients.

Classical examples are:

- Offer and supply of a device capable of carrying out a patent-protected process;⁵
- Offer and supply of a device part which can be combined with other device parts to form the patent-protected combination;⁵
- Offer and supply of a machine capable of manufacturing a patent-protected object.⁵

The first two variants may even lead to a direct patent infringement in individual cases.⁵

Here, especially for the required CAD file, indirect patent infringement can lead to different case constellations. In the case of an indirect patent infringement, the manufacture and possession of the essential means is permitted.⁶

Any third party is prohibited from offering and supplying certain means. Thus, for example, uploading a CAD file (offering) or forwarding it to individuals (supplying) may constitute an indirect patent infringement if the file is regarded as an essential means.⁷

Until now, the question of whether electronic data can be regarded as an "essential" means has been controversial. However, there is a certain tendency in the case law that software as such is seen as means. For example, the Higher Regional Court of Munich has assumed the characteristics of a means of controlling a milling process for a CAD file.⁸

It remains to be seen whether a CAD software also relates to an essential element of the invention if only a product is protected and it thus cannot necessarily be included in the patent claim. Already now the opinion is expressed in the literature that such a view is justifiable.⁹



Practical advice

In this case, it would be advisable to design a patent in such a way that the claims refer to a CAD file or include corresponding procedural steps. This would make it easier to secure potential infringers. A company should also pay attention to how it handles CAD files. The establishment of Digital Rights Management (DRM) systems could be a possibility.

References

¹ BGH X ZR 30/14 – Glasfasern II

² BGH X ZR 30/14 (items 112 and 113) – Glasfasern II

³ BGH X ZR 30/14 (items 119 and 120) – Glasfasern II

⁴ BGH X ZR 30/14 (item 118) – Glasfasern II

⁵ Kühnen, Handbuch der Patentverletzung, 8th edition, Chapter A, marginal 302-306

⁶ BGH, GRUR 2006, 570 [BGH 22.11.2005 - X ZR 79/04] - Extracoronales Geschiebe

⁷ see also: Blanke-Roeser, GRUR 2017, 467 (470)

⁸ see also: Graf Ballestrem, Mitt. 2016/358 with reference to the decision of the Higher Regional Court of Munich from 19.05.2011, 6 U 2347/05

⁹ Graf Ballestrem, Mitt. 2016/358

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