



WITTEWELLER NEWS II/2020

## Client Information and News



### Federal Supreme Court ruled: Ritter Sport remains the only square chocolate

The square-shaped packaging has been the distinguishing feature of Ritter Sport chocolate bars for decades. This will continue to be the case in the future. The German Federal Supreme Court (Bundesgerichtshof, BGH) has rejected an appeal filed by competitor Milka.

Trademark owner Alfred Ritter GmbH & Co. KG, based in Waldenbuch near Stuttgart had its characteristic packaging protected in the 1990s as three-dimensional trademarks, neutralized packaging of chocolate in two sizes with the typical side flaps, and the long snap-open seam on the back. For ten years, Milka-manufacturer Mondelez unsuccessfully tried to have the 3D marks deleted.

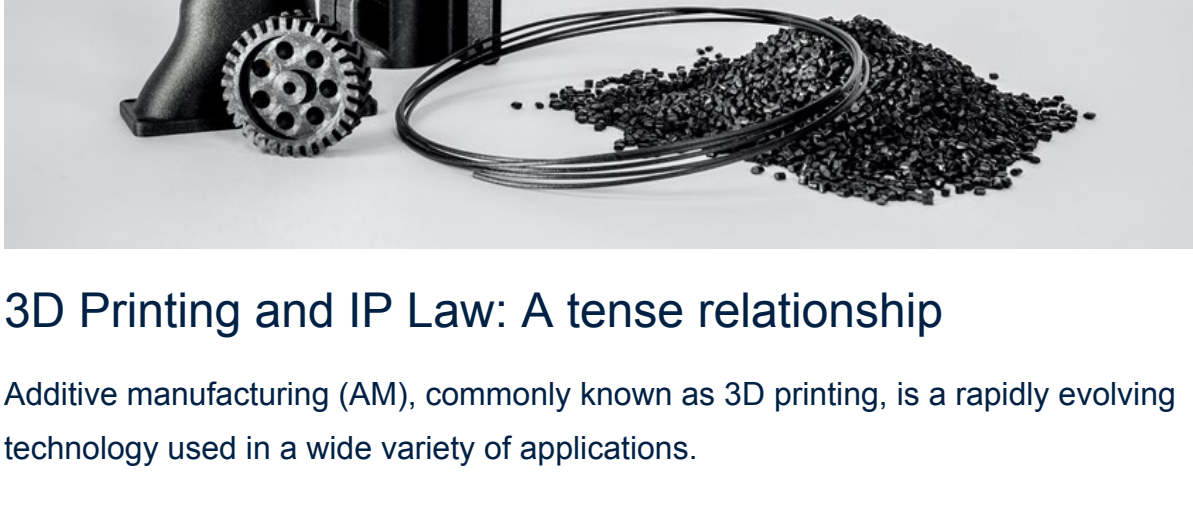
The BGH had to decide on the question whether the registered signs consist exclusively of a shape which gives substantial value to the product, and whether there would be a ground for refusal to register the trademark.

In its decision, the BGH argues as follows: The basic square shape of the packaging does indeed provide the consumer with the indication of origin of the chocolate, and certain quality expectations are associated with it. However, the shape in itself has no artistic value and does not lead to significant price differences compared to other chocolate bars. In that regard, there is no obstacle to trademark protection in the present case.

Furthermore, the BGH confirmed the findings of the Federal Patent Court which had previously been involved in the chocolate dispute. The Federal Patent Court had decided in 2018 that Ritter Sport may retain the 3D trademark rights. Mondelez has contested this decision at the BGH in Karlsruhe in the meantime.

#### Related link:

- [BBC NEWS](#)



### 3D Printing and IP Law: A tense relationship

Additive manufacturing (AM), commonly known as 3D printing, is a rapidly evolving technology used in a wide variety of applications.

Nowadays affordable, 3D printers are increasingly used by start-up companies, part-time professionals, and consumers. Everyday items can easily be reprinted at home.

Compared to traditional manufacturing methods such as drilling, milling and casting, 3D printing has some significant advantages like saving resources as well as manufacturing complex shapes and individual designs easier, faster and less expensive.

3D printing in the field of manufacturing products ready for installation or intended for the consumer ("rapid manufacturing") is becoming an increasingly important part of this process and could eventually lead to a complete transformation of the industry value chain.

As much as 3D printing technology in rapid manufacturing offers new business opportunities, the challenge of defining an appropriate regulatory framework is also present. Reprinted products may infringe patent, design, utility model or trademark rights.

The potential conflict between 3D printing and IP law particularly becomes apparent in the following questions:

#### Boundary between patent-law allowed imitation of spare parts and unauthorized new creation

In patent law, it has not yet been finally determined in which cases the imitation of spare parts is permitted and in which cases the reprint has to be assessed as an unauthorized new creation.

The imitation and distribution of a regularly required, as such unprotected wearing part for a product protected by a patent, which from an economic point of view has not yet reached its life span, is generally permitted.

In contrast, the use of a non-OEM 3D printed replica spare part may be illegal if it is used to repair a patented product that has already reached its life span from an economic point of view. From a legal point of view, this would constitute a new production of the protected product.

Possible solution: Prohibition of reprinting spare parts whose replacement would significantly prolong the product's life cycle. The reprinting of wearing parts would thus still be permitted.

#### The potential conflict between permitted product imitation and the growing number of 3D printers in private households

With the expected increase in the use of 3D printers in private households, the number of reprints of products or product parts is expected to grow rapidly. The problem here is that the manufacturer has no legal means of opposing reprints for exclusively private purposes according to the current status.

This does not only increase the risk of illegal Internet downloads of 3D artwork (CAD files) for 3D printing of original products, e.g. via file-sharing networks. It is also possible to create the template by simply scanning the original product. No expensive devices are required, only a smartphone with a 3D scanning application.

Last but not least, there is a risk for companies that print templates are passed on to competitors by dissatisfied employees. This could result in significant financial losses for original manufacturers.

Possible solutions: Restriction of the existing privileges for individuals in connection with 3D printing and creation of a new legal requirement that even the download of a CAD data set for an original product must be considered a patent infringement.

#### Related link:

- [RE-EVALUATING INTELLECTUAL PROPERTY LAW IN A 3D PRINTING ERA](#) (Campbell University School of Law)

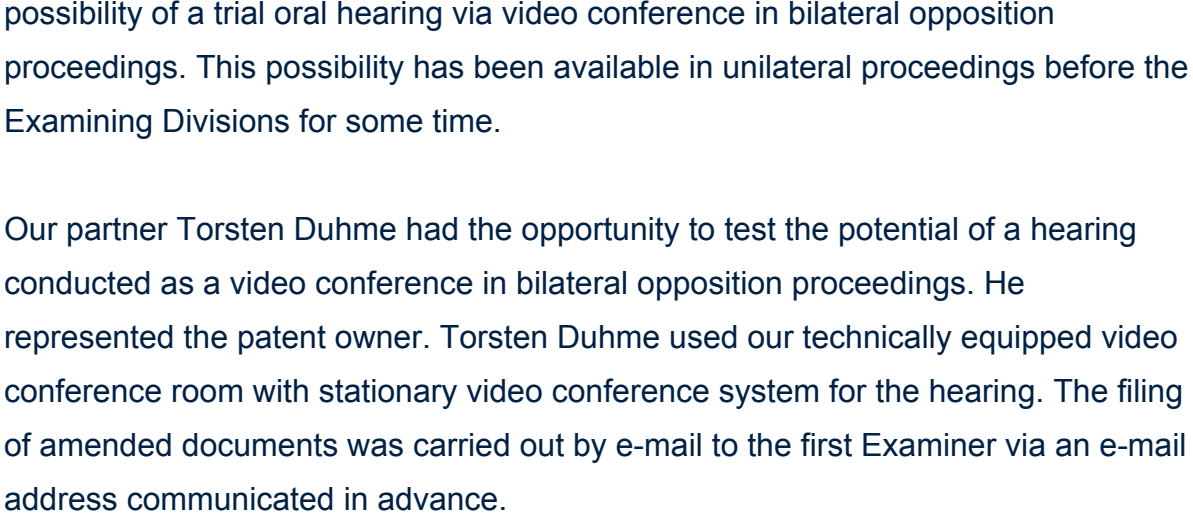
The growing importance of technology in the AM sector is reflected in the significant increase in patent applications in this area. This can also be derived from the fact that the European Patent Office (EPO) and United States Patent and Trademark Office (USPTO) have introduced new classification symbols for the innovative AM technologies.

According to a [recent study](#) conducted by the EPO and the European Union Intellectual Property Office (EUIPO), most patents filed with the EPO in the field of 3D printing are generated by applicants from the European Union (47%), followed by the United States (35%). 19% of all AM applications filed with the EPO are from Germany. A summary of the study is available [here](#).

Due to the rapid development of 3D printing technology manufacturers are faced with several challenges:

- Better protection of original products from 3D reprints. Manufacturers should check whether their patents sufficiently cover 3D reprints.
- If necessary, additional application of 3D trademarks or designs should be filed to protect the three-dimensional shape of a product.
- Risk of illegal publication of CAD files of the original product can be reduced by increased technical and organizational measures to protect the CAD files.
- Manufacturers could also consider making CAD files for their products or spare parts available as (paid) downloads at an early stage, if necessary proactively, in order to keep consumers away from illegal downloads at an early stage and thus ultimately improve customer loyalty.

WITTEWELLER represents one of the TOP-10 patent applicants indicated in the above-mentioned study in the field of additive manufacturing which provides us with extensive experience in patent prosecution in the field of 3D printing technologies.



### Pilot project for conducting oral proceedings before opposition divisions of the EPO by video conference: First experiences at WITTEWELLER

The European Patent Office (EPO) is conducting a pilot project for oral proceedings before the opposition divisions from 4 May, 2020 to 30 April, 2021 and offers the possibility of a trial oral hearing via video conference in bilateral opposition proceedings. This possibility has been available in unilateral proceedings before the Examining Divisions for some time.

Our partner Torsten Duhme had the opportunity to test the potential of a hearing conducted as a video conference in bilateral opposition proceedings. He represented the patent owner. Torsten Duhme used our technically equipped video conference room with stationary video conference system for the hearing. The filing of amended documents was carried out by e-mail to the first Examiner via an e-mail address communicated in advance.

Torsten Duhme appreciated the progress of the pilot project so far: *"The test has been pleasingly uncomplicated and successful. The fact that the members of the Opposition Division were sitting together in one room and were always visible to the other parties during the hearing was positive for the successful process. Although it was not always possible to see the facial expressions and reactions of all parties in the "big" picture, however, according to our initial assessment, this is an important aspect in order to come as close as possible to a real hearing situation on site."*

To summarize, we can state that conducting hearings by video conference opens up an efficient possibility to avoid travelling expenses, especially with regard to the restrictions and risks of COVID-19. This project will likely stand the test in the longer term. It is, however, currently not provided for hearings with more than two parties, hearings where taking evidence by means of hearing of witnesses is required, or where simultaneous interpreters take part.

See EPO Decision and Notice in the Official Journal EPO 2020, [A41](#) and [A42](#).



Responsible according to German press law: Mark Wegener, Patentanwalt

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