




Game Developers Conference®
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Moscone Center | San Francisco, CA

Video Game IP

What you need to know NOW!

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Banner & Witcoff, Ltd.

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Video Game IP:
What you need to know
NOW

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Disclaimer

- Discussion today is primarily with respect to U.S. law
- Each scenario is unique, and nothing in this presentation should be construed as legal advice
- This presentation is for informational purposes only
- The views presented herein are my own, and not necessarily those of my clients or my law firm


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Content Restrictions


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Content Restrictions

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- State laws restricting violent content regularly ruled unconstitutional under U.S. law
 - *VSDA v. Schwarzenegger*, 556 F.3d 950 (9th Cir. 2009)
 - *ESA v. Swanson*, 519 F.3d 768 (8th Cir. 2007)
 - *ESA v. Blagojevich*, 469 F.3d 641 (7th Cir. 2006)
- Sexual content and drug use is protected speech, too.





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Content Restrictions

- Market-based solution: video game industry adopted voluntary rating system administered by ESRB

On the front of each game package are rating symbols that provide guidance on age-appropriateness.

3+ 6+ 10+ 13+ 17+ 18+

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Copyrights

- Protects artistic expression
 - Artwork, Scenery, Characters, Sounds, Music, Text, Source Code, Animation
- Protection exists automatically; easy to obtain
 - Fixation of a work in a tangible medium of expression
 - Duration
 - Life of author + 70 years; or
 - 95 years from publication or 120 years from creation, whichever is shorter (anonymous works and works made for hire)
- Civil and Criminal penalties in the U.S. for copyright infringement

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Copyrights: What you need to know NOW

- Copyright Notice:
 - © <year of publication> <copyright owner>
 - E.g., © 2010 Banner & Witcoff, Ltd.
 - Removes defense of innocent infringement
- Scope of protection is narrow; primary use is against software pirates

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Copyrights: What you need to know NOW

- Work made for hire:
 - Made by an employee acting within the scope of employment, OR
 - A specially commissioned work:
 - For use within one of nine statutory categories of works, including audiovisual works (e.g., video games!), AND
 - The parties expressly agree in writing that the work shall be considered a work made for hire.

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Copyrights: What you need to know NOW

- Independent Contractor Agreements:
 - “To the extent allowable by law, the parties agree that all work shall be considered a work made for hire. To the extent the work is not considered a work made for hire, contractor agrees to assign and hereby assigns all copyrights in the work to Acme, Inc.”
 - BOTH parties must sign the agreement

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Copyright Registration

- How:
 - File online, and learn more, at www.copyright.gov
- Fee: US\$35.00
- When:
 - Within 3 months of first publication; or
 - ANYTIME
- Benefit:
 - Presumption of valid copyright in court
 - If registration PRIOR to infringement, then can seek:
 - attorneys fees
 - statutory damages up to US\$150,000 per infringed work

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Trademarks



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Trademarks


- Protects your BRAND
- Identifies a source of origin of goods and services
- Words, logos, colors, sounds, and more.





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Trademarks: What you need to know NOW

- Choosing a name:
 - Fanciful (easiest to protect)
 - MORROWIND for a role-playing game
 - Arbitrary
 - APPLE for hand-held units for playing electronic games
 - Suggestive
 - WORLD OF WARCRAFT for virtual world game
 - Descriptive (difficult to protect)
 - FLIGHT SIMULATOR for flight simulation game
 - Generic mark (never protectable)
 - VIDEO GAME for a video game
- Avoid generic, descriptive, geographical, and personal names
- Fanciful, Arbitrary, or Suggestive are best

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Trademarks: What you need to know NOW

- Trademark Registration
 - Obtain a trademark search (optional)
 - File an “intent-to-use” trademark application
 - Can reserve rights up to THREE YEARS until you begin actual use of the mark
 - Protection throughout the entire U.S.
- Cost
 - US\$ 1,000 – US\$2,500+, depending on search, number of channels of trade in which protection is desired
- Scope of protection/Test for infringement
 - Likelihood of confusion with another mark

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Patents



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Patents

- Protect inventions (i.e., *ideas!*)
 - Technology
 - e.g., audio/video processing techniques
 - User Interface
 - Support programs
 - e.g., matchmaking, statistics, level editors
 - Hardware
 - E.g., console, game controller, etc.
 - Game methods, goals and objectives
 - E.g., method of scoring points

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Patents

- Duration:
 - about 17 years
 - Protection begins when patent issues, and lasts until 20 years from earliest filing date
- How:
 - Patent application containing detailed description of invention enabling someone of ordinary skill in the art to make and use the best mode of the invention known to the inventors.
 - Include claims defining the scope of the invention
 - USPTO examines claims for novelty and nonobviousness (aka, inventive step)

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Patents: U.S. grace period

- 1-year grace period in U.S. triggered by:
 - Public use in the USA
 - Includes any commercial use, even if secret
 - Limited exception for experimental use
 - Offer for sale in the USA
 - Even if the offer is rejected
 - Printed publication anywhere in world
- Other countries have no grace period
 - Any public use destroys patent rights in most foreign countries

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Patent Example

- U.S. Pat. No. 6,604,008
 - A method comprising
“(b) awarding points to
the player as a function
of the player
successfully performing
a subjective style
feat...”
- *Project Gotham Racing*
by Microsoft.



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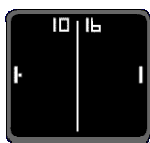


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Utility Patent Examples

- RE 28,507 – PONG!
- U.S. 7,077,749 – Weather simulation in MS Flight Simulator
- 6,641,481 – MS quitters play together patent
- 6,132,314 – Namco's rowing arcade game
- 6,261,179 – StarFox allows user to select level
- 6,733,383 – EA caution periods in auto-race simulations
- 6,695,694 – Konami Dance Dance Revolution arcade game
- 6,764,402 – Pokemon
- 6,935,954 – Sanity level in a video game
- 6,729,954 – Dynasty Warriors
- 6,923,717 – Adrenaline rush in sports games



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Design Patents

- Design Patents
 - Hardware Designs
 - Software Designs:
 - Any image displayed on a display screen
 - Icons
 - Fonts
 - Graphical User Interfaces
 - Characters



FIG. 2



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Patents: What you need to know NOW

- Time limitations for applying for patents
 - 1-year grace period in U.S.
 - No grace period in most other countries
- Cost (most expensive form of IP)
 - Filing: US\$10,000 – US\$15,000 immediately
 - Prosecution: US\$5,000 – US\$15,000 w/in 2-4 years
 - Maintenance: US\$3,750 - \$7,600 in 6 – 14 years.
- Self help?
 - Not recommended
- Enforcement
 - Patent litigation is expensive, but can be very lucrative... some companies even bet the company on a single case.

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Content Licensing



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Content Licensing

- Avoid infringing works you reasonably should know are protected by intellectual property
 - Copyrights
 - Music
 - Characters/Artwork
 - Plot/Script
 - Game engine
 - Trademarks
 - Logos/Product Placement
 - In-game advertising
 - Patents
 - Methods of game play
 - Special hardware or user interface

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Case Study: *Rockin' Bowl-O-Rama*



- Bowling game
- Developer:
 - Cosmodog, Ltd.
- IP Protection:
 - Patents
 - Copyrights
 - Trademarks
 - Licensing

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Case Study: *Rockin' Bowl-O-Rama*

- Copyright Protection
 - Copyright Registration TX 6-381-477



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Case Study: *Rockin' Bowl-O-Rama*

- Design Patents:
 - D587,272
 - D577,727
 - D564,598
 - D566,196
 - D564,034

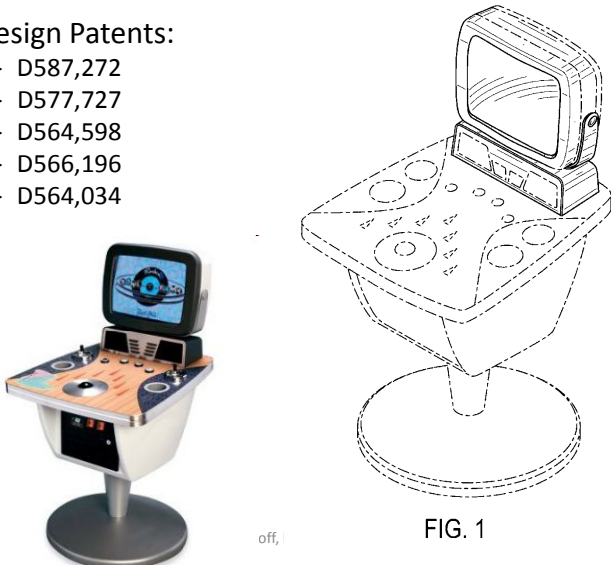


FIG. 1



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Case Study: *Rockin' Bowl-O-Rama*

- U.S. Patent 7,549,929 (23-Jun-2009)
 - “Determining a bowling game score”
 - Claim 1: A method for scoring a bowling game, the method comprising:
 - determining a first time at which a first bowling ball reaches a predefined location in a bowling lane;
 - determining a second time at which one or more pins knocked down by the first bowling ball have fallen; and
 - determining a first bonus score based on a difference between the first time and the second time.

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Case Study: *Rockin' Bowl-O-Rama*

- Trademarks
 - TRICK SHOT
 - Reg. No. 3,290,084
 - Arcade-type electronic video games
 - TEN PIN POKER
 - Reg. No. 3,478,703
 - Non-wagering arcade-type electronic video games (based on agreement with third party)

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Case Study: *Rockin' Bowl-O-Rama*

- Trademark License
 - ROCK 'N' BOWL, Reg. No. 1,850,925
- Music Licenses
 - In-game jukebox with “shuffle” feature
 - Thirty (30) tracks from EMI, Sony/ATV, and others
 - Songs from artists including Fats Domino, Little Richard, Dee Clark, Bobby Lewis, Wanda Jackson, and more.

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Average (mean) Costs of Enforcement

Through end of Discovery:

	<\$1M	\$1M-\$25M	>\$25M
Trademark	\$214K	\$503K	\$1.008M
Copyright	\$195K	\$479K	\$951K
Patent	\$498K	\$1.794M	\$3.731M


Inclusive, all costs:

	<\$1M	\$1M-\$25M	>\$25M
Trademark	\$384K	\$857K	\$1.746M
Copyright	\$366K	\$826K	\$1.696M
Patent	\$967K	\$3.109M	\$6.250M

Source: AIPLA Report of the Economic Survey 2009

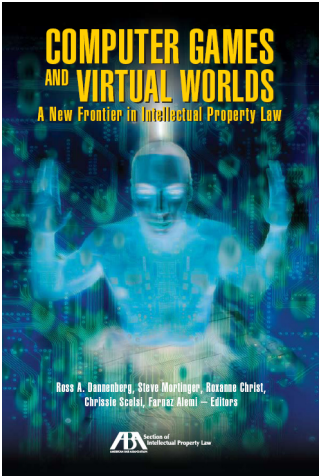
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Resources

1. New book available for purchase at www.abanet.org.
2. www.PatentArcade.com:
At the crossroads of video games, virtual worlds, and intellectual property law.





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Questions?

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