To:	Stephen McArthur (stephen@smcarthurlaw.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 86928557 - VIDEO GAME LAW SCHOOL - N/A
Sent:	9/30/2016 5:11:12 PM
Sent As:	ECOM120@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5 Attachment - 6 Attachment - 7 Attachment - 8 Attachment - 9 Attachment - 10 Attachment - 11 Attachment - 12 Attachment - 13 Attachment - 14 Attachment - 15 Attachment - 16 Attachment - 17 Attachment - 18 Attachment - 19 Attachment - 20 Attachment - 21 Attachment - 22 Attachment - 23 Attachment - 24 Attachment - 25 Attachment - 26 Attachment - 27 Attachment - 28 Attachment - 29 Attachment - 30 Attachment - 31 Attachment - 32

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. APPLICATION SERIAL NO. 86928557

MARK: VIDEO GAME LAW SCHOOL

86928557

CORRESPONDENT ADDRESS:
STEPHEN MCARTHUR
The McArthur Law Firm
Suite 200
11400 W. Olympic Blvd.
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CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

VIEW YOUR APPLICATION FILE

APPLICANT: Stephen McArthur

CORRESPONDENT'S REFERENCE/DOCKET NO :
N/A
CORRESPONDENT E-MAIL ADDRESS:
stephen@smcarthurlaw.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 9/30/2016

THIS IS A FINAL ACTION.

This Office action is in response to applicant's communication filed on August 26, 2016. In its response applicant, (1) amended the identification of services, (2) submitted information about the services, and (3) argued against the Section 2(e)(1) refusal.

Number (1) is acceptable and has been entered into the record.

Number (2) is not acceptable for the reasons set forth below.

Number (3) arguments have been considered and are found to be unpersuasive.

The refusal under Trademark Act Section 2(e)(1) is now made FINAL for the reasons set forth below. *See* 15 U.S.C. §1052(e)(1); 37 C.F.R. §2.63(b). In addition, the following requirement is now made FINAL: Information About the Services Required. *See* 37 C.F.R. §2.63(b).

SUMMARY OF ISSUES:

- Section 2(e)(1) Refusal – Merely Descriptive
- Advisory: Supplemental Register Currently Unavailable
- Information about the Services Required

FINAL REFUSAL – SECTION 2(e)(1) REFUSAL – MERELY DESCRIPTIVE

Registration is refused because the applied-for mark merely describes features of applicant's services. Trademark Act Section 2(e)(1), 15 U.S.C. §1052(e)(1); *see* TMEP §§1209.01(b), 1209.03 *et seq.*

A mark is merely descriptive if it describes an ingredient, quality, characteristic, function, feature, purpose, or use of an applicant's services. TMEP §1209.01(b); *see, e.g.*, *In re TriVita, Inc.*, 783 F.3d 872, 874, 114 USPQ2d 1574, 1575 (Fed. Cir. 2015) (quoting *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 1173, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004)); *In re Steelbuilding.com*, 415 F.3d 1293, 1297, 75 USPQ2d 1420, 1421 (Fed. Cir. 2005) (citing *Estate of P.D. Beckwith, Inc. v. Comm'r of Patents* , 252 U.S. 538, 543 (1920)).

Determining the descriptiveness of a mark is done in relation to an applicant's services, the context in which the mark is being used, and the possible significance the mark would have to the average purchaser because of the manner of its use or intended use. *See In re The Chamber of Commerce of the U.S.*, 675 F.3d 1297, 1300, 102 USPQ2d 1217, 1219 (Fed. Cir. 2012) (citing *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963-64, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007)); TMEP §1209.01(b). Descriptiveness of a mark is not considered in the abstract. *In re Bayer Aktiengesellschaft*, 488 F.3d at 963-64, 82 USPQ2d at 1831.

The applied-for mark, **VIDEO GAME LAW SCHOOL**, is descriptive of applicant's services ("ducational services, namely, conducting programs in the field of intellectual property and legal services; Educational services, namely, conducting presentations in the fields of intellectual property and legal services and distribution of training materials in connection therewith; Educational services, namely, providing online instruction in the field of intellectual property and legal services; Educational and entertainment services, namely, a continuing program about legal services accessible by means of the Internet; Providing on-line videos featuring intellectual property and legal issues, not downloadable" and "Intellectual property consultancy; Legal services, namely, intellectual property consulting services in the field of identification, strategy, analytics, and invention; Legal services, namely, preparation of applications for trademark registration; Legal services, namely, trademark searching and clearance services; Providing information in the field of intellectual property; Providing information in the field

of business law, litigation and intellectual property; Providing on-line information in the field of intellectual property") because this wording describes features of applicant's services.

The previously attached evidence shows that the Merriam-Webster Dictionary defines "video game" as "an electronic game in which players control images on a television or computer screen" and it defines "law school" as "a school that trains people to become lawyers." In the context of applicant's services, this wording means educational services that train people to become lawyers in the field of law relating to electronic games in which players control images on a television or computer screen. Additionally, the attached Internet evidence shows that "video game law" is a specialized field of law that includes topics in intellectual property, such as trademarks, copyrights, and patents. Therefore, the wording **VIDEO GAME LAW SCHOOL** is descriptive of applicant's services.

Generally, if the individual components of a mark retain their descriptive meaning in relation to the services, the combination results in a composite mark that is itself descriptive and not registrable. *In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1823 (TTAB 2012); TMEP §1209.03(d); *see, e.g., In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1663 (TTAB 1988) (holding GROUP SALES BOX OFFICE merely descriptive of theater ticket sales services, because such wording "is nothing more than a combination of the two common descriptive terms most applicable to applicant's services which in combination achieve no different status but remain a common descriptive compound expression").

Only where the combination of descriptive terms creates a unitary mark with a unique, incongruous, or otherwise nondescriptive meaning in relation to the services is the combined mark registrable. *See In re Colonial Stores, Inc.*, 394 F.2d 549, 551, 157 USPQ 382, 384 (C.C.P.A. 1968); *In re Positec Grp. Ltd.*, 108 USPQ2d 1161, 1162-63 (TTAB 2013).

Applicant argues that the wording in the applied-for mark "creates a new and unique commercial impression" that competitors do not need to "describe Intellectual Property content related videos." In this case, both the individual components and the composite result are descriptive of applicant's services and do not create a unique, incongruous, or nondescriptive meaning in relation to the services. Specifically, the words "video," "game," "law," and "school" retain their descriptive meanings and do not create a non-descriptive meaning when used together. This wording merely describes features of applicant's services.

Applicant argues that the applied-for mark is not descriptive because its services pertain to intellectual property and not to video games. However, the attached Internet evidence shows that video game law is a specialized field of law that includes topics in intellectual property. The attached article from WIPO Magazine, published by the World Intellectual Property Organization, states "While questions of privacy and data security, content regulation and monetization are key considerations . . . developing a proactive IP strategy to secure appropriate IP rights is essential to the success of a developer's enterprise" and "IP is the lifeblood of the industry." This evidence shows that intellectual property is such a prominent area within video game law that, in the context of applicant's services, applicant's applied-for mark is descriptive.

Further, the examining attorney has attached applicant's prior registration, U.S. Registration No. 4953261 THE VIDEOGAME LAWYER for "Legal services; Legal services, namely, intellectual property consulting services in the field of identification, strategy, analytics, and invention; Legal services, namely, preparation of applications for trademark registration; Legal services, namely, trademark searching and clearance services; Licensing of intellectual property; Providing legal services in the field of intellectual property," which is registered on the Supplemental Register. Registrations featuring services the same as or similar to applicant's services are probative evidence on the issue of descriptiveness where the relevant word or term is disclaimed, registered under Trademark Act Section 2(f) based on acquired distinctiveness, or registered on the Supplemental Register. *See Inst. Nat'l des Appellations D'Origine v. Vintners Int'l Co.* , 958 F.2d 1574, 1581-82, 22 USPQ2d 1190, 1196 (Fed. Cir. 1992); *In re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006); *In re Finisar Corp.*, 78 USPQ2d 1618, 1621 (TTAB 2006).

Applicant states that it is "unaware of any other party currently using the words found in its mark to denote similar or related products." The fact that an applicant may be the first or only user of a merely descriptive designation does not necessarily render a word or term incongruous or distinctive; as in this case, the evidence shows that VIDEO GAME LAW SCHOOL is merely descriptive. *See In re Phoseon Tech., Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012); *In re Sun Microsystems, Inc.*, 59 USPQ2d 1084, 1087 (TTAB 2001); TMEP §1209.03(c).

Applicant argues that any doubt regarding the mark's descriptiveness should be resolved on applicant's behalf. *E.g., In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 1571 4 USPQ2d 1141, 1144 (Fed. Cir. 1987); *In re Grand Forest Holdings, Inc.*, 78 USPQ2d 1152, 1156 (TTAB 2006). However, in the present case, the evidence of record leaves no doubt that the mark is merely descriptive.

Based on the evidence and analysis above, applicant's applied-for mark is merely descriptive and must be refused under Section 2(e)(1).

Based on the foregoing, the refusal based on descriptiveness of applicant's applied-for mark is maintained and now made **FINAL**.

Applicant should note the following advisory regarding amendment to the Supplemental Register.

Advisory: SUPPLEMENTAL REGISTER CURRENTLY UNAVAILABLE

Although an amendment to the Supplemental Register would normally be an appropriate response to this refusal, such a response is not appropriate in the present case. The instant application was filed under Trademark Act Section 1(b) and is not eligible for registration on the Supplemental Register until an acceptable amendment to allege use meeting the requirements of 37 C.F.R. §2.76 has been timely filed. 37 C.F.R. §2.47(d); TMEP §§816.02, 1102.03.

If applicant files an acceptable allegation of use and also amends to the Supplemental Register, the effective filing date of the application will be the date on which applicant met the minimum filing requirements of 37 C.F.R. §2.76(c) for the amendment to allege use. 37 C.F.R. §2.75(b); TMEP §§816.02, 1102.03. In addition, the undersigned trademark examining attorney will conduct a new search of the USPTO records for conflicting marks based on the later application filing date. TMEP §§206.01, 1102.03.

Applicant is advised that, if the application is amended to seek registration on the Supplemental Register, applicant will be required to disclaim "LAW SCHOOL" because such wording appears to be generic in the context of applicant's goods and/or services. *See* 15 U.S.C. §1056(a); *In re Wella Corp.*, 565 F.2d 143, 144, 196 USPQ 7, 8 (C.C.P.A. 1977); *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766, 768 (TTAB 1986); TMEP §1213.03(b).

The following is the standardized format for a disclaimer:

No claim is made to the exclusive right to use "LAW SCHOOL" apart from the mark as shown.

TMEP §1213.08(a)(i).

FINAL REQUIREMENT – INFORMATION ABOUT THE SERVICES REQUIRED

In its communication filed on August 26, 2016, applicant submitted the following in response to a request for information about applicant's services: "Fields of intellectual property include copyrights, trademarks, patents, and trade secrets. "Video Games" are not a field of IP. "Video Games" are not synonymous with IP."

Applicant's response does not provide information about applicant's services, therefore, the request for information about applicant's services is now made final.

To permit proper examination of the application, applicant must submit additional information about applicant's services because t he nature of such services is not clear from the present record. *See* 37 C.F.R. §2.61(b); *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1457-58 (TTAB 2004); TMEP §§814, 1402.01(e). Applicant must submit answers to the following:

(1) Does applicant provide educational or legal services in the field of intellectual property, specifically, video games?

Conclusory statements regarding the services will not satisfy this requirement for information.

Failure to comply with a request for information is grounds for refusing registration. *In re AOP LLC*, 107 USPQ2d 1644, 1651 (TTAB 2013) (citing *In re Cheezwhse.com, Inc.*, 85 USPQ2d 1917, 1919 (TTAB 2008); *In re DTI P'ship LLP* , 67 USPQ2d 1699, 1701-02 (TTAB 2003); TMEP §814). Merely stating that information about the goods and services is available on applicant's website is an insufficient response and will not make the relevant information of record. *See In re Planalytics, Inc.*, 70 USPQ2d at 1457-58.

PROPER RESPONSE TO FINAL OFFICE ACTION

Applicant must respond within six months of the date of issuance of this final Office action or the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond by providing one or both of the following:

(1) A response that fully satisfies all outstanding requirements and/or resolves all outstanding refusals.

(2) An appeal to the Trademark Trial and Appeal Board, with the appeal fee of $100 per class.

37 C.F.R. §2.63(b)(1)-(2); TMEP §714.04; *see* 37 C.F.R. §2.6(a)(18); TBMP ch. 1200.

In certain rare circumstances, an applicant may respond by filing a petition to the Director pursuant to 37 C.F.R. §2.63(b)(2) to review procedural issues. TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is $100. 37 C.F.R. §2.6(a)(15).

TEAS PLUS OR TEAS REDUCED FEE (TEAS RF) APPLICANTS – TO MAINTAIN LOWER FEE, ADDITIONAL REQUIREMENTS MUST BE MET, INCLUDING SUBMITTING DOCUMENTS ONLINE: Applicants who filed their application online

using the lower-fee TEAS Plus or TEAS RF application form must (1) file certain documents online using TEAS, including responses to Office actions (see TMEP §§819.02(b), 820.02(b) for a complete list of these documents); (2) maintain a valid e-mail correspondence address; and (3) agree to receive correspondence from the USPTO by e-mail throughout the prosecution of the application. *See* 37 C.F.R. §§2.22(b), 2.23(b); TMEP §§819, 820. TEAS Plus or TEAS RF applicants who do not meet these requirements must submit an additional processing fee of $50 per international class of goods and/or services. 37 C.F.R. §§2.6(a)(1)(v), 2.22(c), 2.23(c); TMEP §§819.04, 820.04. However, in certain situations, TEAS Plus or TEAS RF applicants may respond to an Office action by authorizing an examiner's amendment by telephone without incurring this additional fee.

/Anna H. Rosenblatt/
Examining Attorney
Law Office 120
(571) 272-4599
anna.rosenblatt@uspto.gov

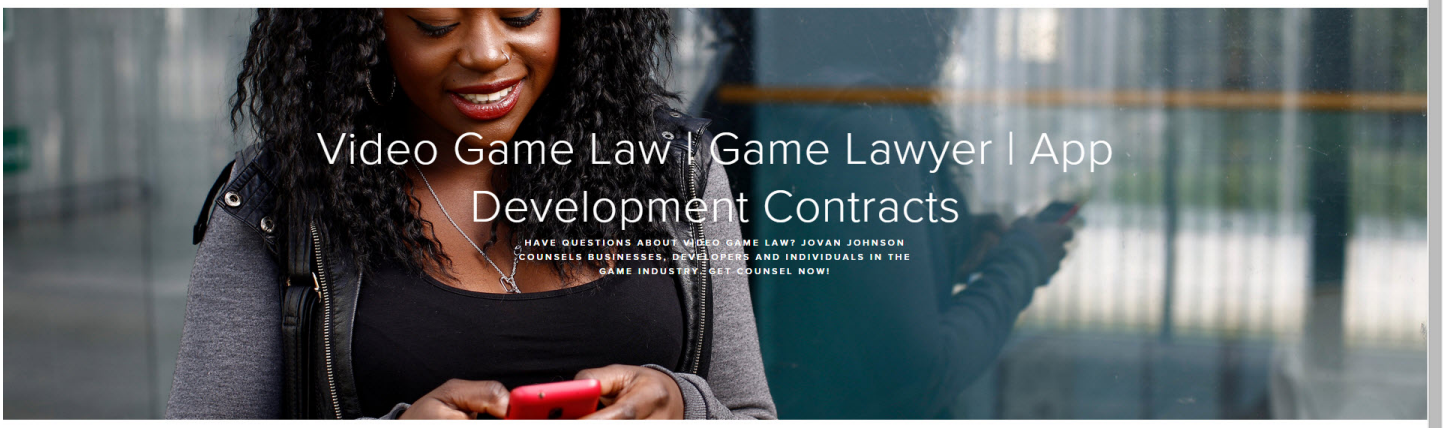
TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using the Trademark Electronic Application System (TEAS), to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using the Trademark Status and Document Retrieval (TSDR) system at http://tsdr.uspto.gov/. Please keep a copy of the TSDR status screen. If the status shows no change for more than six months, contact the Trademark Assistance Center by e-mail at TrademarkAssistanceCenter@uspto.gov or call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/trademarks/teas/correspondence.jsp.



Apps & Games

- App Consultant
- App Law
- FTC Civil Investigative Demands
- App Development
- App Expert Witness
- App Privacy
- Protect Your App
- Video Game Law
- Game Publishing Contracts

Video Game Law

Similar to other areas of multimedia, video game law has a significant focus on copyright and licensing. It's essential that developers understand the importance of having clear and complete paperwork in an effort to prevent legal issues in the future. Consider the following questions:

- Where did the concept for a game originate? If you took the idea from your favorite comic book or film, you should seek permission before moving forward.
- Did the person who did voice over work sign a contract making clear that he or she has no ownership interest in the final product? You could get a slew of calls from individuals looking for additional money based on the success of a game or app to which they contributed.
- Does the person or company providing start-up money to develop your game own a stake in your development company, or are they simply giving you a loan that must be repaid when your profits start rolling in? If you incorrectly assume that you received a loan, you could end up with some unwanted business partners who will not go away easily.
- Imagine you are at E3, GDC, PAX, or Inidecade, and are presented with a publishing deal. Do you have someone who can help you understand what's in the deal, what revisions you should request, or whether you should sign it?

Don't get stopped in your tracks. Jovan Johnson provides common sense counsel so that you can get it right from the beginning.

Also of interest:

- Publishing Contracts
- App Development Contracts
- App Law
- App Privacy
- Copyright Registration

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There are occasions when we ask for help responding to client queries due to our busy schedules. We do not sell or rent your personal information, nor do we spam.

I understand that, depending on the nature of my request, I may be contacted by a principal of either Johnson-Moo.com, Wolk & Levine, Third Harbor, or Novy Unlimited.

SUBMIT

Video Game Law

This seminar will examine the varied legal issues that have spawned (and continue to spawn) in the video game space. Still a relatively new industry that continues to evolve at a breakneck pace, video games require lawyers to address substantive areas of law in new ways, particularly copyright and trademark law. The course follows a civilian approach to study persons in games, things in games, and how persons acquire things in games. Specific topics include: (a) special copyright considerations in video games, including fair use and DMCA protections; (b) games as entertainment products, and concerns of violent and mature content versus the value and protection of video games as speech under the First Amendment; (c) policing of video game content under self-regulation systems in the U.S. and Europe; (d) conflicts and compromises within the contractual relationships of game developers and game publishers; (e) the expanding role of gamers and their contributions to video games, such as through user-generated content, player communities, fan fiction, etc.; and (f) special legal challenges and controversies arising from online gaming and massively-multiplayer-online games (MMOs). Students will benefit from prior course work in intellectual property and other related topics, *e.g.*, Copyright Law; Entertainment Law; Internet Law; or Trademarks and Unfair Competition, but these are not prerequisites. Students will be expected to write and present to the class a paper on a topic of their own choosing. Grading will be determined from the paper, presentation and class participation.
(added 11/08)

COURSE INFORMATION

Course #:	LAW 638
Degree:	JD Program
Area of Study:	Intellectual Property Law
Course Type:	Seminar

Credit Hours

Two credit hours.

WIPO | MAGAZINE

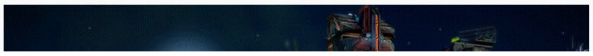
Video Games and IP: A Global Perspective

April 2014

*By **David Greenspan**, Senior Director of Legal and Business Affairs, Namco Bandai Games America (USA), **S. Gregory Boyd**, Partner and Chairman of Interactive Entertainment Group, Frankfurt Kurnit Klein & Selz PC (USA), **Jas Purewal**, Senior Associate, Osborne Clarke (USA)*

Since the launch of the first mainstream game console by Nintendo in 1985, video games have become a global industry worth an estimated US$65 billion. It is the fastest growing sector of the entertainment industry and an important driver of economic growth, creating millions of jobs, generating much-needed tax revenues and offering exciting opportunities for talented creators and engineers from all corners of the globe.

Unlike other creative industries, video games draw on the worlds of both technology and creativity. They fuse cutting-edge technology and imaginative artistic expression. The computer code underlying a game transforms ideas into rich expressions of visual art which come alive on a range of devices – consoles, computers, tablets and smartphones.



The global video games industry is worth an estimated US$65 billion and its cultural impact is being felt across the world. (Photo: © Electronic Arts Inc.)

A global phenomenon

The cultural impact of the industry is being felt across the world. It has become a global phenomenon with recent major successes from studios in countries as diverse as Belarus (Wargaming.net), China (with Tencent and Perfect World) and Finland (with Supercell and Rovio).

Over the last 20 years, the demographics of players have changed dramatically. Gone are the days when the average video game player was a teenage boy playing alone and firing away at bad guys in front of a television screen at home. Today, the average video game player will be thirty something, as likely to be female as male, will play on multiple devices and can come from anywhere in the world.

Dramatic changes, exciting opportunities

Advances in technology have also dramatically changed the games themselves, spawning a wide range of new formats, stories, and genres. Games are in fact as varied as the imagination of the developers, featuring realistic graphics, voice-overs, use of motion capture technology giving characters fluid movements, music equal to film scores and original story lines. The development and marketing budgets for major game titles often rival those of the movie industry.

While still dominated by multi-billion dollar hardware companies such as Sony, Nintendo, Microsoft, Apple, and Samsung and publishers such as Activision, Electronic Arts (EA) and King (mobile), new technologies have opened up the gaming industry to many new independent developers. WIPO's recent publication, *Mastering the Game: Business and Legal Issues for Video Game Developers* provides established developers as well as new market entrants with information about how to develop a proactive strategy to secure the IP rights in their work for its distribution and use. The guide explores, in very practical terms, the range of legal and business issues facing developers at various stages of the process of developing a game and transforming it from a concept into a marketable product. It further underlines the importance of negotiating contracts to define who owns the IP rights in a work.

While many have cashed in on the public's seemingly insatiable appetite for video games, and there is still huge potential for growth, there are also significant risks and uncertainties. These are related, in particular, to the rising costs facing the industry – a major flop can severely impact a publisher's or developer's business - and the need to keep pace with constantly evolving tastes in terms of the games consumers want to play, how they want to play them and how they want to purchase them.

The Lord of the Rings and derivative works

Acquiring the right to make a derivative work – a new work derived from an existing copyright work can be a complex process.

To make *The Lord of the Rings* trilogy, Peter Jackson had to obtain a license from the Saul Zaentz Company which holds movie rights to Tolkien's work. As a derivative work the trilogy was copyrightable as a new work and licensable in its own right.

In 2001, Electronic Arts (EA) developed the first *Battle for Middle Earth* game on the basis of a license from Peter Jackson films. Under this license EA could only produce game content, or a derivative work that came from the Jackson films. However, in 2005 while creating the sequel to *Battle for Middle Earth* and other *Rings* games, EA acquired a license to produce a game based on Tolkien's published works. This opened up a great deal of new territory for creativity.

Just a few years ago, games (played on consoles) were sold mainly through retail outlets, and while physical console and computer sales still generate a substantial proportion of industry revenue, mobile gaming (games played using mobile devices) has become the fastest growing sector of the industry. Digital distribution is expanding as a result of lower entry barriers and costs. At the same time, the marketplace is becoming ever more crowded, making it difficult to distinguish one game

from another.

The video game industry is constantly evolving creatively (how a game looks), technologically (the hardware and software that bring the games to life) and commercially (the business models used distribute games to consumers). With such innovations, come new challenges.

Defining the rules of the game

The core legal issues facing all entities involved in the video game ecosystem - developers, financiers, publishers and distributors - focus on ensuring that appropriate legal arrangements are in place to enable the development, financing and distribution of games. While questions of privacy and data security, content regulation and monetization are key considerations (and are covered in the publication), developing a proactive IP strategy to secure appropriate IP rights is essential to the success of a developer's enterprise.

Game Project and IP Law

Copyright	Trade Secret	Trademark	Patent
Music	Customer mailing lists	Company name	Hardware technical solutions
Code	Pricing information	Company logo	Inventive game play or game design elements
Story	Publisher contacts	Game title	Technical innovations such as software, networking or database design
Characters	Middleware contacts	Game subtitle	
Art	Developer contacts		
Box design	In-house development tools		
Website design	Deal terms		

IP is the lifeblood of the industry. IP rights are associated both with the tools used to develop games and the content included in a game. For example, copyright safeguards the creative and artistic expression that goes into the software (the code), the artwork and the sound (and music) of a game. If developers want to create a new work on the basis of an existing copyrighted work, a so-called derivative, then they must first secure the appropriate licenses from the copyright holders. An

example of a derivative work is *Shrek* the game which was based on *Shrek* the film. The process can also work the other way. When filmmakers want to develop a film on the basis of the story line of a successful game they too must secure rights from the right holders of the original work, for example, *Doom* the movie was based on *Doom* the game.

Trademarks protect the names and logos associated with a game and its characters and can be used to set a company and its games apart from others in the minds of consumers; patents protect the next generation hardware (and are particularly important for hardware manufacturers) or technical solutions as well as the inventive game play or design elements; and trade secrets can be used to safeguard a company's competitive advantage by protecting confidential business information, such as contacts or subscriber mailing list data, or an in-house development tool. Without the appropriate rights and licensing agreements in place, developers may find their game cannot be distributed; they may be unable to fully leverage the value of their work. What developers own is IP; what they sell (through licensing deals) is IP. In fact, all they have is IP, so they need to protect it.

The pace of change within the gaming industry itself can be a challenge insofar as the laws that are currently in place to safeguard and encourage innovation and creativity may lag behind and may not always provide an adequate solution to an emerging or unforeseen situation. These challenges are further compounded by the lack of harmonization of the laws applicable to the video game industry around the world.

Intellectual property is the lifeblood of the video games industry and a proactive IP strategy to secure appropriate IP rights is essential to the success of a developer's enterprise. (Photo: Electronic Arts)

Changing patterns of ownership

Costs of development can vary considerably depending on the platform, artwork, game play complexity and whether any underlying IP is licensed in, but commonly run into the millions of dollars for console and online games, and the hundreds of millions of dollars for blockbuster games. Traditionally, it was the role of publishers to secure financing for game development, but with the emergence of new forms of distribution and alternate funding mechanisms, such as crowd-funding, the roles of publishers and developers are evolving. As a consequence, the IP rights that typically vested with publishers may now be shared with a publisher or owned by a developer or an investment vehicle. These changing patterns of ownership further highlight how important it is for developers to become IP aware.

From the very beginning of the industry, developers have incorporated licensed material into their games in an endeavor, not only to stand out in the crowd, but also to attract a wider audience through the use of recognizable brands and technologies to create more realistic game play.

A basic understanding of IP allows developers to more effectively tackle the range of licensing issues arising across the value chain with licensors whether in relation to securing middleware (software that is integrated into the game engine to handle specialized elements, such as graphics or networking), talent, or external IP licenses relating to, for example, music, sports or film licensing which have become important areas of interest.

A familiarity with the range of legal and business issues explored in Mastering the Game will help developers pre-empt problems, avoid costly mistakes and provide a better understanding of the major terms of various industry agreements.

Eye-catching facts about the growth of video games

Industry statistics reflect the industry's staggering growth and growing popularity.

- Within 24 hours of its release in September 2013, *Grand Theft Auto* 5 earned more than US$800 million dollars and sold more than 11 million copies worldwide. Within a record-breaking three days, sales hit US$1 billion dollars. In comparison, the biggest movie hit of the summer of 2013, *Iron Man* 3 brought in worldwide sales of US$372 million in its first weekend.
- Within 24 hours of the release of Microsoft's Xbox One and Sony's PlayStation 4 consoles in

November 2013, over 1 million units of each were sold. Within 18 days, sales for each console hit the two million mark.

- Online revenue for video games including digital delivery and subscriptions increased to US$24 billion in 2012. Similarly, mobile gaming generated between US$8 to 12 billion in revenue in 2012 with game apps, dominating the iOS and Google Play app stores.

Categories of Video Games

Console	Personal computer (PC)	Mobile/Casual
Run on dedicated hardware	Run on Windows, Mac or Linux	Run on tablets and phones
Expensive to develop	Wide variety in terms of cost and genre	Less expensive to develop
Wide variety of genre	No single gatekeeper for platform	Social and casual games
System controlled by IP owners	Majority of sales through digital	Largest number of potential players
Box product and digital but dominated by box sales		

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GAMASUTRA
The Art & Business of Making Games

PRINT

Hey, That's MY Game! Intellectual Property Protection for Video Games

By Steve Chang,Ross Dannenberg

So you've created a video game. Naturally, you're proud of the result after months of all-nighters spent programming and debugging the source code. Your game includes ideas, puzzles, game concepts, and user interfaces that no game has ever had. You've created artwork and graphics that are sure to enthrall even the most skeptical of gamers. Your game is most assuredly destined to be Game of the Year!

Too bad someone stole it and published it before you did. All your "guaranteed" profits gone in a flash. But that's ok, because software is or at least should be free to copy, right? By becoming a software developer you have automatically bought into the notion that software should be open source, right? Who needs to be fairly compensated for their efforts when ramen noodles are 3 for $0.99?

You disagree? Ok, if you are actually upset that someone would copy your work, and want to know how to stop them from such illicit behavior in the future, read on. This article discusses the basic types of intellectual property – patents, copyrights, trademarks and trade secrets – and how to use them effectively to protect your video game. With a little advanced planning and basic knowledge of intellectual property, your video game will be protected ... at least from a legal perspective.

Patents, copyrights, trademarks and trade secrets each serve to motivate innovators to create new and exciting games by providing various protections for their efforts. For example, the patent system encourages innovation by promising inventors a short period of exclusivity if they come forward with their inventions.

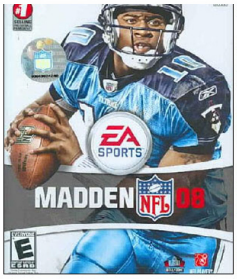
Without copyright protection, there is little incentive for authors and artists to create new creative works, because they naturally would be hesitant to create works that others could copy willy nilly without compensation to the artist (those ramen noodles sure are tasty, huh?).

Trademarks help ensure that the name you've made for yourself stays yours. And finally, trade secret law helps those who decide to keep their technology secret, like the famously secret formula for Coca-Cola®. The discussion below is a short walk through these forms of intellectual property.

Trademarks

Trademarks protect the goodwill and reputation associated with your company or video game as a brand. A trademark – any name or symbol indicative of a source of origin of a product or service – is arguably your most valuable business asset, and is perhaps also the most recognizable form of intellectual property. You can hardly drive down a major road without encountering a sign for a McDonalds® restaurant, a Coca-Cola® soda, or Nike® shoes. Many consumers purchase goods and services based on name recognition alone, e.g., EA or MADDEN.

There are two ways to protect your trademark from being copied. The first is through state trademark laws. Each state offers trademark protection based on the use of the trademark in that state. The second more common (and more effective) way is to register the trademark with the U.S. Patent and Trademark Office



(USPTO), which provides protection throughout the United States.

Registered trademarks offer advantages over non-registered trademarks, and allow you to use the ® symbol. Once a trademark is registered, no other entity can use any name or mark that is identical to or is likely to cause confusion with your registered trademark anywhere in the U.S.

An exception arises where the other entity proves that it was using its trade name or mark prior to your trademark registration, in which case the other entity might have limited rights to use their name or mark in their geographic location.

How does this affect your video game? Your trademark serves as a source of origin for your game. It is your reputation, your lifeblood. You want gamers to hear your name and know that the game is going to be phenomenal. Without trademark protection, someone else can adopt the same name as you to produce games.

However, you have no quality control over their games, and they could ruin your public reputation and the goodwill you have worked so hard to create. Trademark registration is relatively inexpensive (current registration fee is no more than $375 per class of goods and services), and is typically the first form of intellectual property protection any venture formally secures.

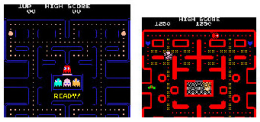
Copyrights

Copyrights are the second form of intellectual property, and protect the *expression* of an idea (but not the idea itself). Take *Pac-Man*, for example. Copyright protection protects the actual artwork and sounds in the game as an audiovisual work, and the underlying source code as a literary work. No one can copy the actual images and sounds used during the game, illustrated in Fig. 1, or the underlying program.

However, copyright does not protect the *idea* of a player controlled character eating dots in a maze-like game board while being chased by differently colored evil characters such as the caterpillar game shown in Fig. 2.

Copyright protection exists the moment an author fixes an expression in a tangible medium. This means the moment you save your source code to disk, or you sketch out the artwork for your game character or level art, you automatically have copyright protection without doing anything further.

An author can also choose to register the copyright with the U.S. Copyright Office (current registration fee is $45), which provides certain additional benefits, such as the right to statutory damages for copyright infringement. Copyrights were historically regarded of as the only form of "substantive" intellectual property protection for computer software, but that couldn't be farther from the truth.



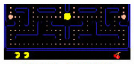


Figure 1 - PACMAN


Figure 2 – Caterpillar Man

Patents

Patents – the third and most diverse form of intellectual property – protect *inventions* from being copied. An invention is any new and useful process (e.g., game play methods, graphics techniques, user interface communications), machine (e.g., a computer programmed with computer software), article of manufacture (e.g., a disk or storage media on which software is distributed), or composition of matter, and also includes new ornamental designs (e.g., icons, user interface artwork, characters, etc.).[1] Patents can be thought of as protecting *ideas*, whereas a copyright only protects a particular *expression* of an idea.

All patents include a description of the invention as well as one or more "claims" that define the legal metes and bounds of your invention (similar to physical boundaries of real estate that a trespasser must stay out of).

Determining these bounds accurately is important, because a patent provides a limited but powerful monopoly on what is claimed, and prevents for a limited time anyone other than the patent owner from making, using, selling, or importing an item, or performing a process, that is encompassed by the claims of the patent (such an act would be considered patent infringement).

A claim drafted too broadly may be invalid for attempting to encompass what is old or obvious, while a claim that is too narrow may be ineffective against competitors making minor modifications to your invention.

Once a patent issues, the patent owner may negotiate a license with competitors who are practicing the invention, or sue for an injunction and/or monetary damages. Because claims are generally drafted to encompass something broader than a specific commercial product, patents can provide broad protection against competitors who copy your idea but make minor changes in an effort to avoid the patent.

[1] A third type of patents, which protect asexually reproducing man-made plants, are not discussed in this article.

As an illustration of the scope of patent protection versus copyright protection, Incredible Technologies, Inc., the developer of *Golden Tee Golf*, sued Virtual Technologies, Inc., for copyright infringement based on Virtual's game *PGA Tour Golf*, which was specifically created so that players of *Golden Tee* could switch to *PGA Tour Golf* with little difficulty.[2]

PGA Tour Golf essentially copied, with some stylistic changes, the layout of buttons and instructions found on the *Golden Tee* control panel. However, Virtual had been careful not to copy the artwork, image, or sounds from *Golden Tee*. In finding no copyright infringement, the court stated:

> an item may be entirely original, but if the novel elements are functional, the item cannot be copyrighted: although it might be eligible for patent protection.
>
> * * *
>
> The trackball system of operating the game is not subject to copyright protection. Functional features, such as the trackball system, might, at least potentially might, be eligible for patent protection.

Had Incredible Technologies sought patent protection for the method by which a player uses a trackball to swing a golf club in *Golden Tee*, or for a machine programmed to provide *Golden Tee's* specific interactive style, the outcome might have been different. However, patents can be expensive to obtain, often costing tens of thousands of dollars by the time the patent gets issued.

the time the patent gets issued.

Figure 3 - Golden Tee Golf

Figure 4 - PGA Tour Golf

Trade Secrets

The fourth form of intellectual property is perhaps the easiest to protect. A trade secret is basically all its name suggests – a piece of information that you keep secret. Each state has its own trade secret law, usually as part of its laws against unfair competition, but the requirements are generally the same: a trade secret is information that has business value, that is kept secret, and which was taken without permission.

The most common form of trade secret misappropriation occurs when former employees of one company go to work for a different company, and take with them information (e.g., customer lists of registered game players in a virtual world, manufacturing techniques or tools such as unreleased in-house software used to create game levels, etc.) that the first company tried to keep secret.

For your part, if you have developed in-house information that is of value to you, and you want to protect it as a trade secret, all you have to do is take reasonable precautions to keep it a secret (e.g., controlling access to the information, having employees agree to keep secrets, well, secret).

Conclusion

Each form of intellectual property has its advantages and disadvantages. Patents provide the strongest protection, but are the hardest to get (and most expensive), and remain in force the shortest amount of time (usually about 16-18 years). Copyrights are easier to obtain (and less expensive), and last a long time (at least 70 years), but have the narrowest scope of protection (only your specific expression is covered).

Trademarks last as long as you keep using the mark, but do not prevent anyone from copying your games, and trade secrets last as long as you can keep a secret. The strongest approach is certainly to pursue all four as appropriate, but don't overlook the benefits of even one or two forms of intellectual property protection when budgets are tight, because intellectual property is often the lynchpin of a company's success.

[2] *Techs., Inc. v. Virtual Techs., Inc.*, 400 F.3d 1007 (7th Cir. 2005). That will be the only case cite in this article, we promise.

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Video Games and the law: Copyright, Trademark and Intellectual Property

By New Media Rights on Wed, 02/23/2011 - 11:27

Planning on creating a video game, or created one already? This guide will help you understand some the frequent questions about copyright, trademark and intellectual property when it comes to video games.

Learn how video games are protected under copyright and trademark law, how to respond when your game is removed from the web or a mobile app store by a DMCA takedown notice, and the many ways the law affects the creative process of making a video game. Find a question you're interested in below and click it to get some answers.

Frequently asked questions about video games and the law:

What is copyright?

What parts of the video game are copyrightable?

Is my artwork copyrightable?

How will a court determine if a video game infringes another video game?

Speaking of sports video games, does this mean I can include real life athletes and sports statistics in my game?

Can I create a game with a similar concept to another video game?

Are video game titles copyrightable?

How do I make money? And how does this affect me legally?

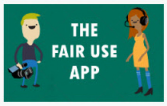
What are possible issues with advertising?

What do I do if I receive a notice that I am in violation of the Digital Millenium Copyright Act (DMCA) 17 U.S.C. §512?

What is copyright?

Copyright protects artistic and literary expression. While this meant just books, maps and charts at the beginning of the United States, today it covers a broad variety of creative expression from email

interactive Fair Use App.



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Frequently Asked Questions about Copyright Law

a broad variety of creative expression from email, to websites, to video games. Please see our Citizen's Legal Guide to American Copyright Law for copyright law basics.

What parts of the video game are copyrightable?

Generally speaking, the underlying code is protected as a literary work, and the artwork and sound are protected as an audiovisual work. While you don't need to have the work (ie your video game) registered to covered by copyright law, there are advantages to registration (see our guide to copyright law), and you can seek registration at http://www.copyright.gov/.

Is my artwork copyrightable?

Yes. However, your artwork only has copyright protection insofar as no one can just closely duplicate it. For example, if a video game has a princess and she looks like Princess Toadstool, that could be in violation of Nintendo's copyright (unless the game obtained a license or had a good fair use reason to use the character). If your princess was of your own creation, then you should be fine.

Similarly, certain artwork in video games falls under the doctrine of *scenes a faire*. This references particular artwork and elements of a video game that are necessary to execute a particular idea and are NOT copyrightable. That includes things like the scoring system, the lives, the coins, and the sky/ground. *Scenes a faire* also applies to certain genres of games. For example, if you have a golfing game, you would include certain design elements like holes, golf balls, golf clubs, golfers, grass, trees, and water. While you can't copy these elements verbatim from another golfing game, you have the right to include such elements in your game because otherwise no one else could create a golfing game..

Copyright Law

Video Games and the law guide: Copyright, Trademark and Intellectual Property

How to find free music, images, and video you can use or remix in your own creative works

Guide to Secret Audio & Video Recordings

Events & Competitions

Recently added

- Event: Law 101 - The basics of Intellectual Property for Makers @ Fablab San Diego
- Event: Law 101 Workshop for Filmmakers and Video Editors at UCSD Extension
- Event: Copyright for Media Makers

PGA Tour Online and Golden Tee Golf: *Scenes a faire*

How will a court determine if a video game infringes another video game?

Here a very brief discussion of how the courts look at video games in determining whether two works are subtantially similar enough to warrant infringement.

The first approach is from the 2nd circuit "The

Subtractive Approach" (*Altai, Nichols*) and the other approach is "The Concept and Feel Approach" (*Ruth Greeting Cards, Krofft*)

Subtractive Approach

It begins looking at the whole work then takes it apart element by element. After separating out the protectable elements from the unprotected, then it looks to see whether the protectable parts are substantially similar. This naturally favors accused infringers.

For a developer who creates a Pacman clone game for example, they would have a reasonable shot of success where courts use this approach because if level designs and sprite designs themselves weren't copied, then all of the organization and arrangement that make up Pacman's gameplay has become scene-a-faire in the 2-D video game development world.

Total Concept and Feel Approach

The court doesn't dissect a work into "protected" and "unprotected." Instead, the court reasons that a work should be looked at as a combination of its parts. This naturally favors plantiffs because they can essentially argue that all sorts of "facts," "phrases," "stock characters," and especially "ideas" that aren't normally protectable can be protected.

Under this analysis, a Pacman clone may face more of a challenge.

Even though a game's concept/gameplay isn't protected by the letter of copyright law, in practice because of these differing approaches, and the difficulty in identifying exactly what in a video game is an “idea” or “expression” for purposes of copyright law, you copy a game's concept and overall feel at your own risk.

Speaking of sports video games, does this mean I can include real life athletes and sports statistics in my game?

It's advisable not to use any real life persons in games unless they consent to it. They could potentially bring a variety of claims against you, specifically right of publicity, which protects

potentially bring a variety of claims against you, specifically right of publicity, which protects an individuals right to have their name or likeness (voice, image, etc) exploited commercially. While using statistics is not a violation of the right of publicity *per se*, be careful how they are presented. A critical issue is whether it looks like the athlete or celebrity is endorsing your game. Here is a good guide from the Citizen Media Law Project on using the name or likeness of another.

Can I create a game with a similar concept to another video game?

Yes, but be careful. This is another complicated area. If you wanted to make a game about ghost hunting, then that is fine. It is much more treacherous territory if you just recreate Pac-Man. Copyright protects the *expression* of an idea, but not the idea itself. This is not so easily parsed out with video games, so if you are worried that you may be replicating someone's expression, its a good idea to seek the advice of an experienced attorney. New Media Rights offers assistance here.

Are video game titles copyrightable?

No. But they are protected by trademark. Trademark law concerns itself more with marketing, branding, and business practices, and is concerned with avoiding confusing consumers as to the source of a product or service. Even if you do not call your game the exact same thing as another video game, you can still be found in violation if your game has a confusingly similar title. So if you are creating a competing game that shares some similarities with another game, you will often want to avoid using a confusingly similar name for your game to avoid a trademark violation.

A similar issue arises out of meta-tagging. Embedding another product's name into your website in order to garner more search engine traffic could possibly lead to trademark violation issues.

Are game controllers and consoles copyrightable?

These are considered functional elements of a game, so they are generally not copyrightable. Copyright does not protect useful products. If you come up with a unique

system or device, it is possible seek patent protection. Patents protect inventions and processes that are nonobvious, useful and new. Patents must be registered at the United States Patent and Trademark Office (http://www.uspto.gov). It is strongly recommended that you get a patent attorney to file this for you: it is a very complicated area of the law and a mistake could cost you the protection. You should seek assistance ASAP !

How do I make money? And how does this affect me legally?

You can make money by either charging people directly or using advertisements. Be aware that monetizing your product may have a negative effect on any fair use claim you believe you have. Read more on fair use here: http://www.newmediarights.org/guide/legal/copyright/fair_use/citizens_legal_guide_fair_use_copyright_law.

What are possible issues with advertising?

What are possible issues with advertising?

There are two ways in which you can advertise online: one is to place advertisements for your own game; the other way is to host others' advertisements on your site to produce revenue. There is a potential trademark complication with advertisements; make sure you are not using another's brand name (ie. the name of the video game) in order to free ride on their success. Remember to carefully read the Terms of Service of the ad service you choose to go with.

What do I do if I receive a notice that I am in violation of the Digital Millenium Copyright Act (DMCA) 17 U.S.C. §512?

The DMCA provides a shield from liability to online service providers (OSPs), which covers a broad variety of services from your internet access provider to app stores like the Android Market and Iphone app store that host video games. If you are suspected of copyright infringement, you may receive a take-down notice via the DMCA. You can respond with a counter-notification to have your content restored; however, while that will restore the content, you agree that the copyright owner can bring you to court. So while a counternotice can be a good tool to restore your content, you want to make sure you you are careful in considering whether and how to respond to a DMCA takedown notice, and it would be wise to seek legal counsel. You can read more on the DMCA here: (http://www.newmediarights.org/guide/legal/copyright/citizens_legal_guide_digital_millenium_copyright_act_dmca).

If you have any other questions regarding video games and copyright please don't hesitate to contact New Media Rights.

Images:

"676 - Burning Pac-Man -- Seamless Texture" by Flickr user Patrick Hoesly used under Attribution 2.0 Generic (CC BY 2.0) Creative Commons License

"Video game consoles: Atari 2600, SNES, NES, PS2 Slim, Wii, Game Cube" by Flickr user

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What's a Video Game Lawyer? (And How Can I Become One?)

Ryan Morrison July 25, 2014 In The Know 5 Comments

Why hello there, Internet. I am Ryan Morrison, and I am a video game lawyer. (I'll wait for you to stop laughing.) Okay, now that you have composed yourself, let me assure you that video game law is, in fact, a thing. When people hear I do video game law, they usually are left looking confused, or quickly ask if they can join me, so I thought this article would be a good way of explaining my basic day-to-day, and what the mysterious video game lawyer title really entails.

How Did I Get Here?

I've been a gamer since I can remember, and I jumped at the chance to become part of the industry when I could. I worked at Large Animal Games in New York City, and really learned a lot under the excellent game designers who worked and ran that company. I decided to switch from an ultimate goal of litigating

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company. I decided to switch from an ultimate goal of litigating criminal law (I honestly can't remember why I wanted to do that) to working in the game industry from the legal side. I saw firsthand the atrocities being committed by larger companies, and I knew I could make a living *and* make a difference by pursuing video game law.

What the Heck is Video Game Law?

It's the age old saying, "you wouldn't go to a foot doctor for heart surgery," that rings true here: "You shouldn't go to a movie attorney for video games." To the uninitiated, games are games. However, to the creators and players, there are a near limitless array of genres, distribution platforms, and audiences. The trick, as an attorney, is using the archaic laws that surround the industry to protect the new and innovative ideas coming out each and every day from exciting startups.

Now, of course, video game law is really a lot of different areas of law, all within the *context* of video games. Still, that context is very important and can be crucial when choosing contract language or arguing an office action from the United States Patent and Trademark Office.

Who Are Your Clients?

Each year it becomes cheaper and easier to create a game or an app, and each year more and more companies are popping up all over the country. Because of that, there is a growing client base that has been for the most part unrepresented. Larger firms charge rates that are not attainable to these smaller studios, and attorneys who started the niche area of game law, like Tom Buscaglia, can't do *everything* themselves.

The biggest hurdle as an attorney focused in the tech and game field is that most startups don't even consider needing a lawyer. It's not that they are against the idea, it's that the thought has literally never crossed their mind. It unfortunately leads to a lot of investors taking advantage of the "little guys" with good ideas, or it leads to the end of friendships and the start of long and expensive legal battles down the road.

I've spent near countless hours over at Reddit.com trying to educate the community on their legal rights and what they should be doing to operate their businesses confidently and legally. I have been astounded at just how loud and clear that message has been heard. I would have been happy for them to just know the difference between a trademark and a copyright, but now half of the reader base is asking complex questions most lawyers would have to spend a few hours researching. It's beautiful!

Now, of course, the difference between these companies knowing the law and being able to *utilize* the law are very different things. The fear of legal fees is just too much for those tech startups with a few thousand dollars and a dream. To combat that, we are starting to see a lot of flat fee rates being offered, as well as severely reduced (or free) rates for communication. As the tech field grows, the legal field is starting to become more approachable. Lawyers are notoriously against change, but we can't sit with our arms crossed as the rest of the world flies by. (I mean, come on, are you still having clients use a pen to sign a retainer?)

What Are the Main Legal Concerns For Game Companies?

My usual list for most companies is to:

Ticket in Court?
September 21, 2016

eDiscovery Boot Camp Review
September 15, 2016

1. Incorporate;
2. Form independent contractor agreements (as most startups hire a lot of freelancers);
3. Trademark your game/app and company name;
4. Have a terms of service and privacy policy drafted.

The last one, a privacy policy, is beyond important when tracking user data, and is a major reason why I would never recommend going to a generic entertainment lawyer if you are making an online game or application. The law is too dangerous to play fast and loose when it comes to user data.

The age of patent trolls is still here, however trademark trolls are starting to become much more of an issue for startups. My favorite example to use is the fiasco surrounding King, makers of Candy Crush Saga, and their overreaching trademarks that border on the ridiculous. The term "saga" has existed in nerd culture as long as the term trekkies, and it encompasses a feeling of an epic or long story where a small band of heroes struggles against an impossible foe. Or, according to the USPTO and King, "saga" means a simple mobile phone game that is just a re-skinned clone of every "match 3" game before it. Exciting...

Regardless, the issue here was that, to a trademark examiner (and our law), there is no difference between a huge story-driven game that is playable only on your computer, and a beyond simple phone app. It would be like comparing the Titanic movie to a home movie of your toddler splashing in a pool. To prevent these problems, it's important to not only trademark your own titles, but to stand up to these million dollar companies when they start waving their bank account around to knock you out of the marketplace.

Another issue facing the game world is the fact that freelancers retain ownership of all intellectual property they create, absent an agreement. Since formal contracts and legal advice have been so long removed from the game world, it has led to a lot of big problems about who exactly owns what. That's why one of the first things these companies need is a proper IC Agreement. I've been very happy to see it start to become the "norm."

How Can I Join the Video Game Law World?

I get asked this a lot, and I don't really have a good answer for it. I don't have any secrets to break into the industry because I just opened my own firm, branded myself a video game lawyer, and went to battle for some bullied startups that couldn't afford legal help. It wasn't a marketing strategy, but it turned into the best advertising I could have ever done. I now have clients writing me theme songs and drawing pictures of me as a super hero, and I wouldn't trade careers with anyone in the world. If you are a gamer and you are passionate about helping the industry, come on board and let's fix what's been done wrong. If you are looking to make a quick buck off a few startups, pick another field. You aren't welcome here.

Featured image: "Silver Game Controller Isolated on White Background" from Shutterstock.

Tags FEATURE LAW PRACTICE

About Ryan Morrison

Ryan P. Morrison, Esq. (@MrRyanMorrison) is founder of The Law Offices of Ryan P. Morrison, P.C., a law firm focused on helping the video game community stand up to the bullies that

P.C., a law firm focused on helping the video game community stand up to the bullies that have taken over the industry. He has spoken on panels with industry experts and worked on deals involving triple A game studios all the way down to a few friends in their dorm room.

@MrRyanMorrison

Previous
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Next
Design Thinking in a Future Legal Practice

Kezhaya Law PLLC
Great article. I'm a huge fan of eSports (StarCraft 2 more than dota2) and I've heard a lot of the players have sometimes had issues with getting visas to play tournaments. A major news network, I think it was CNN, recently aired a story about Polt getting the visa for professional athletes to study at UT Austin.
Have you considered teaming up with an industry giant to do their immigration work?
Keep fighting the good fight.

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I want to sue a chinesse game company because theysteal my coints and steal my chips for money rewards want can i do ?? The company is topgame plase email me juniorcastellanosr@hotmail.com this could be a presedent in the game industrie

Foody
I am an attorney in Texas and this is precisely the kind of article I want to see. The corporate world, in general, is highly carnivorous. The constantly growing and rapidly evolving tech world is nigh cannibalistic. I have been trying to figure out a way to get into this area, but I have NO IDEA where to even begin, since pretty much all small developers always cite lack of money and shy away (at least the ones in Dallas that I know have). I have no idea if you will read this comment, since it has been a year or so since you posted, but if there is any way I can help protect video game developers, as well as consumers, please let me know. It is a serious passion of mine and I would like to see it continue to be an environment that everyone enjoys.

hudson1019
There is a game- Csgo that allows 13 year old kids to gamble real money with the hopes of getting a knife or gun. This is a form of gambling. And with minors. Can you direct me to someone who can help me take them to court.

Abraham Downen
I was wondering if i can file a suit against a app that had some kind of malfunction or somone hacked into there servers or hacked into my account and screwed me. I had made a club in the game and people joined my club I was estabishing a very good club and reputation on the game. I won over $1780000000 chip and had them before app malfunction. It took me over $300 in USD yes real money and a lot of time on the app I mean alot I spent almost 24 hours one time playing this app its addictive. Yes i could be doing better things with my time but I like chatting and gambling with people on the app. But what im asking if they dont remburse me for my chips or my actuall money and give me my club back can I file a suit against them??

Shawn Brannon
Ive had money stolen and refused a re fund from "gree games".

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Game On: Protecting the Intellectual Property of Video Games and Apps

The cornerstone of the video game industry is intellectual property in the form of the code and technology that produces unique gaming products and apps. Today more and more video games and apps are being produced and marketed by individuals hoping to hit it big with traditional or online gamers or iPhone and Android users. This scenario has created challenges for developers and distributors of video games and apps with enforcing intellectual property rights under legal protections like copyrights, trademarks and patents.

PRACTICE AREAS
BUSINESS LAW
COMMERCIAL LITIGATION, ARBITRATION AND MEDIATION
INTELLECTUAL PROPERTY
EMPLOYMENT LAW
DIVORCE
ESTATE PLANNING & ADMINISTRATION
REAL ESTATE
INSURANCE COVERAGE
CRIMINAL LAW
EDUCATIONAL RIGHTS

Gaming Industry Appeal

The video game industry produces, on average, $47 billion in gross revenue each year from its vast gaming products that appeal to users of all ages and demographics. What makes the products that video game companies sell unique is the intellectual property behind them, such as the code, artwork and sound of games or apps. The challenges that many companies and developers face today, however, is the volume of games and apps being produced, which makes investigating and enforcing intellectual property violations difficult.

Copyrights are the most common types of legal protections that guard the artistic and creative expression that goes into video game code, artwork and sound. Copyrights help prevent the duplication of things like game characters, but general elements needed to show a particular activity, like golfing, are not copyrightable under the *scenes a faire* doctrine. Trademarks protect the names and logos of gaming companies and products, while patents defend against the design or utility of gaming-related technology.

Recent Gaming Case

When a video game developer recently decided to remake the famous *Tetris* video game into an app, they assumed the rules of the game and its functionality were not protected under copyright law. The developer relied on the *scenes a faire* doctrine to defend their game. The federal court judge disagreed, however, and reasoned that *Tetris* is protected because of the many ways it could be recreated and expressed differently. It would not be protected, though, if its functionality "is so inseparable from the underlying idea that there are no or very few other ways of expressing it," which is the case with many sports video games.

Game On

The video game industry moves quickly, sometimes faster than the laws that protect gaming products, which makes keeping up with intellectual property enforcement difficult. In addition, developers tend to move around to different gaming companies, so it is common to share ideas or code, and they do not pursue claims themselves because they typically give up their intellectual property rights to the distributing companies. If both gaming companies and developers want to continue to game on, they need to work together to legally protect their unique gaming intellectual property.

EDUCATIONAL RIGHTS
APPELLATE LAW
CONSTRUCTION

It is important to register video games, apps and other creative gaming endeavors under copyright, trademark and patent protections, or a combination of the three. Contact a local intellectual property attorney for advice before developing or distributing any new games.

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DESIGN MARK

Serial Number
86670719

Status
REGISTERED

Word Mark
THE VIDEOGAME LAWYER

Standard Character Mark
Yes

Registration Number
4953261

Date Registered
2016/05/03

Type of Mark
SERVICE MARK

Register
SUPPLEMENTAL

Mark Drawing Code
(4) STANDARD CHARACTER MARK

Owner
Stephen McArthur INDIVIDUAL UNITED STATES 11400 W. Olympic Blvd., Suite 200 Los Angeles CALIFORNIA 90065

Goods/Services
Class Status -- ACTIVE. IC 045. US 100 101. G & S: Legal services; Legal services, namely, intellectual property consulting services in the field of identification, strategy, analytics, and invention; Legal services, namely, preparation of applications for trademark registration; Legal services, namely, trademark searching and clearance services; Licensing of intellectual property; Providing legal services in the field of intellectual property. First Use: 2014/06/19. First Use In Commerce: 2014/06/19.

Disclaimer Statement
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Filing Date
2015/06/23

Amended Register Date

2016/02/26

Examining Attorney
HETZEL, DANNEAN

Attorney of Record
Stephen McArthur

THE VIDEOGAME LAWYER

To:	Stephen McArthur (stephen@smcarthurlaw.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 86928557 - VIDEO GAME LAW SCHOOL - N/A
Sent:	9/30/2016 5:11:14 PM
Sent As:	ECOM120@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

IMPORTANT NOTICE REGARDING YOUR U.S. TRADEMARK APPLICATION

USPTO OFFICE ACTION (OFFICIAL LETTER) HAS ISSUED
ON **9/30/2016** FOR U.S. APPLICATION SERIAL NO. 86928557

Please follow the instructions below:

(1) TO READ THE LETTER: Click on this link or go to http://tsdr.uspto.gov, enter the U.S. application serial number, and click on "Documents."

The Office action may not be immediately viewable, to allow for necessary system updates of the application, but will be available within 24 hours of this e-mail notification.

(2) TIMELY RESPONSE IS REQUIRED: Please carefully review the Office action to determine (1) how to respond, and (2) the applicable response time period. Your response deadline will be calculated from **9/30/2016** (*or sooner if specified in the Office action*). For information regarding response time periods, see http://www.uspto.gov/trademarks/process/status/responsetime.jsp.

Do NOT hit "Reply" to this e-mail notification, or otherwise e-mail your response because the USPTO does NOT accept e-mails as responses to Office actions. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System (TEAS) response form located at http://www.uspto.gov/trademarks/teas/response_forms.jsp.

(3) QUESTIONS: For questions about the contents of the Office action itself, please contact the assigned trademark examining attorney. For *technical* assistance in accessing or viewing the Office action in the Trademark Status and Document Retrieval (TSDR) system, please e-mail TSDR@uspto.gov.

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