

# THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



## TRYING ON TRADE DRESS: USING TRADE DRESS TO PROTECT THE LOOK AND FEEL OF VIDEO GAMES

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### ABSTRACT

With the creation of video games for smart phones, video games are some of the most accessible forms of entertainment on the market. What was once only an attraction inside the designated location of arcade halls, is now within the grip of nearly every smart phone user. With new game apps for smart phones going viral on a regular basis, the video game industry has become one of the most profitable in the entertainment realm.

However, the industry's overall success has also led to increased competition amongst game developers. As a result, competing developers create near exact copies of highly successful video games called clones. By copying non-copyrightable elements, clone developers can create confusingly similar video games. This comment examines the creation of clone video games and how their developers avoid copyright infringement by exploiting *scènes à faire* and the merger doctrine.

The exploitation of copyright law for video game developers could be combated by trademark law. By using the Lanham Act's protection for trade dress, non-copyrightable elements that identify popular games may be protected. By seeking trade dress protection against clones, game developers can sustain the value of their investment in gaming apps, while also minimizing the issue of consumer confusion.

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*Cite as Benjamin C.R. Lockyer, Trying on Trade Dress: Using Trade Dress to Protect the Look and Feel of Video Games, 17 J. MARSHALL REV. INTELL. PROP. L. 109 (2017).*

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AND FEEL OF VIDEO GAMES

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## TRYING ON TRADE DRESS: USING TRADE DRESS TO PROTECT THE LOOK AND FEEL OF VIDEO GAMES

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### I. INTRODUCTION

Over the last thirty-five years, the video game industry has quickly moved from dark arcade halls of the 80's and 90's into warm homes and billions of consumer pockets.<sup>1</sup> With the latest evolution of video games arriving in smartphone apps or applications<sup>2</sup> for smart phones (hereinafter “game app” or “gaming app”), game apps are some of the most available and accessible forms of entertainment on the videogame market.<sup>3</sup> Today, the game app sector is one of the highest earning areas in the video game industry.<sup>4</sup>

With record sales surpassing Hollywood's own box-office sales,<sup>5</sup> the video game industry is one of the most profitable entertainment ventures in the entertainment

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\* © Benjamin C.R. Lockyer 2017. Lead Articles Editor, THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW; J.D. Candidate, 2018, The John Marshall Law School; B.A., 2014, Northern Arizona University. Growing up, I could not have imagined that my love for video games would one day be relevant in my professional career. I would like to thank ALL of my friends for the countless hours we spent discussing and playing video games together. This dedication is for you! A special thank you goes to Professor William K. Ford for his advice, expertise, and help in navigating the fascinating world of intellectual property and video games.

<sup>1</sup> See Eric Chiu, *Digital Game Sales: Gamers Favoring Online Stores Instead of Retail*, INT'L BUS. TIMES (Apr. 19, 2017), <http://www.ibtimes.com/digital-game-sales-gamers-favoring-online-stores-instead-retail-2527549>; Ingrid Lunden, *6.1B Smartphone Users Globally By 2020, Overtaking Basic Fixed Phone Subscriptions*, TECHCRUNCH (June 2, 2015), <https://techcrunch.com/2015/06/02/6-1b-smartphone-users-globally-by-2020-overtaking-basic-fixed-phone-subscriptions/> (noting that, as of June 2, 2015, there are 2.6 billion smartphone subscriptions globally, and that this number could increase to 6.1 billion subscriptions by the year 2020); see also Eli Epstein, *Tech Time Machine: The Evolution of Gaming*, MASHABLE (Jan. 8, 2015), <http://mashable.com/2015/01/08/gaming-tech-ces/#cQFQetHYPkq3> (showing how the evolution of video game consoles, video game developers, and individual genres has developed over time).

<sup>2</sup> “App” is short for application - this can be any type of computer program. Applications have been around for as long as computers, but the term ‘app’ is associated with the software that runs on a smartphone or tablet device.” BBC: Webwise, *What is an App?*, BBC, <http://www.bbc.co.uk/webwise/0/27488178> (last updated June 2, 2014).

<sup>3</sup> Chiu, *supra* note 1; Lunden, *supra* note 1.

<sup>4</sup> Andrew Meola, *Mobile Gaming is About to Become the Undisputed King of the Jungle*, BUSINESS INSIDER (Apr. 28, 2016), <http://www.businessinsider.com/mobile-gaming-will-surpass-legacy-gaming-in-2016-2016-4> (noting that mobile gaming profits is poised to surpass traditional gaming profits on console systems, such as Sony's *PlayStation*, Microsoft's *Xbox*, and Nintendo's *Wii U*).

<sup>5</sup> See Tom Chatfield, *Videogames Now Outperform Hollywood Movies*, THE GUARDIAN (Sept. 26, 2009), <https://www.theguardian.com/technology/gamesblog/2009/sep/27/videogames-hollywood.hollywood>; Industry insiders agree that the last few years have been something of a golden age for the videogame, with titles setting new records almost every other month for both sales and critical acclaim . . . . “Perhaps the biggest global headlines of all were made in 2008 by [*Grand Theft Auto IV*], which on 29 April took the title of the most successful entertainment release in history. Within 24 hours, *GTA IV* had grossed \$310m (£157m) - comfortably more than history's most

industry.<sup>6</sup> Like other markets, video game sales and distribution are moving largely onto online platforms.<sup>7</sup> Video games for smart phones are commonly sold to consumers through their smart phones and tablet devices via online market places, such as Apple's "App Store" or Google's "Android Market."<sup>8</sup> With today's rise of game apps on online marketplaces, video games can now be purchased with just a finger.<sup>9</sup> Due to their low cost and simplistic gameplay, games for smartphones are a popular medium for playing video games among consumers.<sup>10</sup>

The rise in popularity and availability of game apps has been primarily fueled by the wide-spread demand for video games<sup>11</sup> and the availability of video game creation

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successful book (*Harry Potter & The Deathly Hallows*, at \$220m in 24 hours) and its most successful film (*Spider Man 3* at \$117m)." *Id.*

<sup>6</sup> See John Gaudiosi, *New Reports Forecast Global Video Game Industry Will Reach \$82 Billion by 2017*, FORBES (July 18, 2012), <http://www.forbes.com/sites/johngaudiosi/2012/07/18/new-reports-forecasts-global-video-game-industry-will-reach-82-billion-by-2017/> (noting that many industry insiders gauge the health of the entertainment industry by examining video game sales, as opposed to the traditional method of analyzing box office sales); Jenna Pitcher, *Games Industry Revenue May Hit \$100 Billion by 2018, Says Research Firm*, POLYGON (June 25, 2014), <http://www.polygon.com/2014/6/25/5840882/games-industry-revenue-hit-100-billion-by-2018-dfc-Intelligence>; Tim Worstall, *Call of Duty: Biggest One Day Entertainment Sales Ever*, FORBES (Nov. 12, 2011), <https://www.forbes.com/sites/timworstall/2011/11/12/call-of-duty-biggest-one-day-entertainment-sales-ever/#2c3b38294e362c3b38294e36> ("Call of Duty: Modern Warfare 3 has broken all sales records in its first 24 hours of release. Sales of over \$400 million in the US and UK alone beats [sic] any entertainment product release anywhere, ever."). In November 2015, this record became broken by Bethesda Softworks LLC's *Fallout 4*, which earned \$750 million within 24 hours of its release. John Gaudiosi, *'Fallout 4' \$750 Million Game Leaves 'Call of Duty' in the Dust*, FORTUNE (Nov. 16, 2015), <http://fortune.com/2015/11/16/fallout4-is-quiet-best-seller/>.

<sup>7</sup> Chiu, *supra* note 1.

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> *E.g.*, APPLE INC., <https://itunes.apple.com/us/genre/ios-games/id6014?mt=8> (last visited Feb. 5, 2017); ANDROID MARKET, <https://play.google.com/store/apps/details?id=com.google.android.finsky&hl=en> (Feb. 5, 2017). Smart phone games are normally offered for free with others are sold for as little as \$0.99 on smartphone app marketplaces. *Id.*; See Nick Wingfield, *As Downloads Take Over, a Turning Point for the Video Game Industry*, N.Y. TIMES (Dec. 20, 2015), [http://www.nytimes.com/2015/12/21/technology/as-downloads-take-over-a-turning-point-for-the-video-game-industry.html?\\_r=0](http://www.nytimes.com/2015/12/21/technology/as-downloads-take-over-a-turning-point-for-the-video-game-industry.html?_r=0); see also Pitcher, *supra* note 6.

<sup>11</sup> From the increased popularity of game apps and the relative ease with which they are created, indie game developers and game studios have seen major success in online video game marketplaces by selling their games for low prices or profiting through advertising. Often these games can be addictive and reach viral popularity among consumers. See Caitlin Gibson, *The Next Level: Video Games are More Addictive Than Ever. This is What Happens When Kids Can't Turn Them Off.*, WASHINGTON POST (Dec. 7, 2016), [http://www.washingtonpost.com/sf/style/2016/12/07/video-games-are-more-addictive-than-ever-this-is-what-happens-when-kids-cant-turn-them-off/?utm\\_term=.0db6675b1342](http://www.washingtonpost.com/sf/style/2016/12/07/video-games-are-more-addictive-than-ever-this-is-what-happens-when-kids-cant-turn-them-off/?utm_term=.0db6675b1342).

software.<sup>12</sup> From the advancements in video game creation software, independent<sup>13</sup> and professional development companies can develop their own game apps with greater ease and at lower costs.<sup>14</sup> Particularly, developers in the submarket of video games for smart phones, have seen success with widely-popular titles like *Fruit Ninja*, *Candy Crush Saga*, *Angry Birds*, and *Flappy Bird*.<sup>15</sup>

Despite the successes of the video game industry and its developers, the game app industry has a copying problem. Within the game app industry are competing developers that copy the “look and feel”<sup>16</sup> of popular game apps to create games with highly-similar aesthetic appearances, characters, themes, and gameplay.<sup>17</sup> The level of copying by these competing developers results in a highly-similar re-creation that does not infringe on the popular game’s copyright protections. Due to the pain-staking and careful copying done to avoid copyright infringement, these games are referred to as “clones” and their creators as “clone developers.”

Clone developers are video game creators who purposefully copy the look and feel of video games to create confusion among consumers and benefit from the original

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<sup>12</sup> See Chris Morris, *Level Up! Video Game Industry Revenues Soar in 2015*, FORTUNE (Feb. 16, 2016), <http://fortune.com/2016/02/16/video-game-industry-revenues-2015/> (noting that video game industry revenues reached \$23.5 billion due to hardware and software developments changing, the way consumers interact with social media). The growth of the video game industry has also been a gravitating center for artistic talent among artists of varying mediums. Notable examples include actors and artists such as Patrick Stewart’s voice acting in Bethesda Game Studio’s *Elder Scrolls IV: Oblivion* and Japanese cartoonist Akira Toriyama’s (creator of *Dragon Ball* and *Dragon Ball Z*) character designs being used in Japanese productions, such as *Blue Dragon* and *Chrono Trigger*. See, ELDER SCROLLS IV: OBLIVION (Bethesda Game Studios 2006); BLUE DRAGON (Mistwalker & Artoon 2006); CHRONO TRIGGER (Square Enix 1995).

<sup>13</sup> See generally Independent Video Game Developer, WIKIPEDIA, [http://en.wikipedia.org/wiki/Independent\\_video\\_game\\_development](http://en.wikipedia.org/wiki/Independent_video_game_development) (last visited Feb. 8, 2017) (describing independent game developer, or indie game developer, as a developer who self-publishes his or her own product).

<sup>14</sup> See generally Zoe Quinn, *A Beginner’s Guide to Making Your First Video Game*, KOTAKU (Jan. 28, 2013), <http://kotaku.com/5979539/a-beginners-guide-to-making-your-first-video-game>; Chris Price, *How to Make Your Own Video Game*, TECHDIGEST (April 21, 2016), <http://www.techdigest.tv/2016/04/make-video-game.html>; Ryan Rigney, *How to Make a No. 1 App with \$99 and Three Hours of Work*, WIRED (Mar. 5, 2014), <https://www.wired.com/2014/03/flappy-bird-clones> (noting that source code templates of games are freely available and make video game development easier).

<sup>15</sup> See generally *id.*; FRUIT NINJA (Halfbrick Studios 2010); CANDY CRUSH SAGA (King 2014); ANGRY BIRDS (Rovio Entertainment 2009); FLAPPY BIRD (dotGEARS 2013).

<sup>16</sup> Lauren F. Kellner, *Trade Dress Protection for Computer User Interface “Look and Feel”*, 61 U. CHI. L. REV. 1011, 1011-12 (1994) (quoting Gregory J. Wrenn, *Federal Intellectual Property Protection for Computer Software Audiovisual Look and Feel: The Lanham, Copyright, and Patent Acts*, 4 HIGH TECH L.J. 279, 2833 (1989) (“The ‘look and feel’ of a user interface is ‘the sequence of the screens and the choices presented, the layout of the screens, and the method of feedback to the user . . . .”)).

<sup>17</sup> See Mark Serrels, *The Attack of the Clones*, KOTAKU (Feb. 23 2012), <http://www.kotaku.com.au/2012/02/the-attack-of-the-clones/> (discussing the rise of blatant and open copying of video games in order profit off the popularity of an original game); Tadhg Kelly, *What Games Are: Why All The Clones?*, TECHCRUNCH (Jan. 5, 2014), <https://techcrunch.com/2014/01/05/why-all-the-clones/> (discussing the rise of video games intentionally copying the appearance and look of popular video games to benefit off of the original game’s popularity).

game's popularity.<sup>18</sup> Clone developers make clones with the same look and feel of a popular game by utilizing similar concepts,<sup>19</sup> game mechanics,<sup>20</sup> and artistic styles.<sup>21</sup> In the context of websites and software, "look and feel" has been defined as "a graphical user interface that promotes the intuitive use of the web site."<sup>22</sup> These elements can include the buttons, boxes, menus, hyperlinks, and their arrangements on a screen.<sup>23</sup> Consumers rely on this experience, or interaction, when identifying the product they are observing, and deciding whether they will purchase it.<sup>24</sup> The feel of a video game can be described as the experience that players receive when playing a game.<sup>25</sup> The look and the feel of a video game—or the interaction a player has with a video game—is the very essence of a player's experience with a video game, and is the factor players arguably evaluate most, in deciding to play or purchase a video game. Thus, protecting the elements comprising a video game's look and feel are of importance to its creators.

Although clone game apps do not technically infringe any copyrights, clone game apps create confusion among consumers through the use of similar characters, themes, and gameplay. Clone developers carefully exploit copyright loopholes to benefit from the original game's popularity by creating confusion among consumers.<sup>26</sup> This issue of cloning arises because video game developers and their games receive little or limited protection under the Copyright Act.<sup>27</sup>

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<sup>18</sup> *Id.*

<sup>19</sup> 17 U.S.C. § 102(b); see generally Thomas M. S. Hemnes, *The Adaptation of Copyright Law to Video Games*, 131 U. PA. L. REV. 171, 188-96 (1982).

<sup>20</sup> See generally *id.*; Bruce E. Boyden, *Games and Other Uncopyrightable Systems*, 18 GEO. MASON L. REV. 439 (2011).

<sup>21</sup> *Id.* Clone games recreate the look and feel of popular games by copying the non-copyrightable elements in order to create confusion among consumers. *Id.* The simplicity of game apps allows clone developers to quickly recreate a similar version of the game and get their cloned versions to market quickly.

<sup>22</sup> Gregory Melus, *Trade Dress 2.0: Trademark Protects in Web Design What Copyright Does Not*, 42 AIPLA Q.J. 351, 379-80 (2014).

<sup>23</sup> *Id.*

<sup>24</sup> *Id.* (noting "look and feel" has been defined as a "graphical user interface that promotes the intuitive use of the web site.").

<sup>25</sup> Boyden, *supra* note 20, at 472-76 (describing the look and feel of a video game as the game play a user experiences while interacting with the video game's code).

<sup>26</sup> Tetris Holding, LLC v. Xio Interactive, Inc., 863 F. Supp. 2d 394 (D.N.J. 2012) (noting that the defendant had fully copied the original elements and trade dress of the plaintiff's widely popular and cult classic game, *Tetris*, to a high degree); see also Alyson Shontell, *THE NEW FLAPPY BIRD: Top App 'Splashy Fish' Is Played 250 Million Times Per Day*, BUSINESS INSIDER (Feb. 19, 2014), <http://www.businessinsider.com/splashy-fish-creator-says-how-big-his-flappy-bird-clone-is-2014-2> (citing Ellis Hamburger, *Indie smash hit 'Flappy Bird' racks up \$50K per day in ad revenue*, THE VERGE (Feb. 5, 2014), <http://www.theverge.com/2014/2/5/5383708/flappy-bird-revenue-50-k-per-day-dong-Halfbrick-Studios-interview> (noting the rise of *Flappy Bird* clones appearing in the wake of the game's rise in popularity)).

<sup>27</sup> Atari, Inc. v. Amusement World, Inc., 547 F. Supp. 222, 230 (D. Md. 1981)

It seems clear that defendants based their game on plaintiff's copyrighted game; to put it bluntly, defendants took plaintiff's idea . . . Copyright Protection is available only for expression of ideas, not for ideas themselves. Defendants used plaintiff's idea and those portions of plaintiff's expression that were inextricably linked to that idea;

Capcom U.S.A., Inc., v. Data E. Corp., 1994 WL 1751482, at \*15 (N.D. Cal. Mar. 16, 1994).

Due to limiting doctrines, copyright law does not protect the elements comprising the look and feel of a video game—a video game’s source-identifying “visual appearance” or “graphic user interface.”<sup>28</sup> These doctrines are designed to prevent monopolies on ideas or concepts within the public domain. Often, the elements comprising a game’s look and feel are not protected because they are necessary for depicting a certain theme, feel, or look to a video game’s player. By just entering the name of a popular game app, such as *Fruit Ninja*, hundreds of clone games with confusingly similar titles and themes can come up in search results.<sup>29</sup> As evidenced by the abundance of clone versions of popular video games, clone developers have been successful in exploiting copyright limitations to copy and recreate the look and feel of video games.<sup>30</sup>

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Street Fighter II and Fighter’s History bear more similarities than Street Fighter II and Mortal Kombat because they contain a greater percentage of reality based moves that are faithful to one or more of the martial arts disciplines and characters drawn largely from a pool of stereotyped human fighters. As a result, Capcom has left room for its competitors to emulate large portions of its game because many of its elements are not protectable. Capcom cannot now withdraw from the public domain ideas and standardized expression. It also cannot be heard to argue that two projectiles are similar even though they differ in size, shape, and color. To do so would be commensurate to awarding Capcom a monopoly over a range of characters and moves that it did not create. It would also allow Capcom to lay proprietary claim to all reality based fight games featuring human characters. Copyright law affords no such protection;

Incredible Techs. Inc., v. Virtual Techs, Inc., 400 F.3d 1007, 1015 (7th Cir. 2005)

In contrast, we see no error of law in Judge Kennelly’s finding that the Global VR video display is subject to the scènes à faire doctrine . . . [G]olf is not a game subject to totally ‘fanciful presentation.’ In presenting a realistic video golf game, one would, by definition, need golf courses, clubs, a selection menu, a golfer, a wind meter . . . . As such, the video display is afforded protection only from virtually identical copying.

<sup>28</sup> Boyden, *supra* note 20, at 472 (2011) (“[T]he transmission of information from creator to audience is importantly different in a game as compared to music and plays. The copyrightable expression of a game does not extend to the gaming experience in the same way expression reaches the core of the musical or play-watching experience.”); Kellner, *supra* note 16; *see also* Stephen C. McArthur, *Clone Wars: The Five Most Important Cases Every Game Developer Should Know*, GAMASUTRA (Feb. 27, 2013), [http://www.gamasutra.com/view/feature/187385/clone\\_wars\\_the\\_five\\_most\\_.php](http://www.gamasutra.com/view/feature/187385/clone_wars_the_five_most_.php) (noting that historically, the courts have been unavailing to video game developers bringing copyright infringement lawsuits against cloners); *discussing* Tetris Holding, LLC, 863 F. Supp. 2d 394; Spry Fox LLC v. LOLApps, Inc., 2012 WL 5290158 (W.D. Wash. Sep. 18, 2012); Amusement World, 547 F. Supp. 222; Data East USA Inc. v. Epyx, Inc., 862 F.2d 204 (9th Cir. 1988); Capcom U.S.A. Inc., 1994 WL 1751482; Melus, *supra* note 22, at 379-80 (citing Conference Archives, Inc. v. Sound Images, Inc., 2010 WL 1626072, at \*3-15 (W.D. Pa. Mar. 31, 2010)).

<sup>29</sup> A search of *Fruit Ninja* on Google Play’s App Page reveals other titles like *Food Ninja*, *Fruit Slice*, and *Veggie Samurai*. GOOGLE PLAY, [https://play.google.com/store/apps/collection/search\\_results\\_cluster\\_apps?clp=ggENCgtmcnVpdCBuaW5qYQ%3D%3D%3AS%3AANO1ljKC8gA&hl=en](https://play.google.com/store/apps/collection/search_results_cluster_apps?clp=ggENCgtmcnVpdCBuaW5qYQ%3D%3D%3AS%3AANO1ljKC8gA&hl=en) (last visited June 24, 2017).

<sup>30</sup> Hemnes, *supra* note 19; *e.g.*, McArthur, *supra* note 28; Serrels, *supra* note 17.

In addressing this issue, fairly recent cases involving video games have discussed using trade dress as a potential alternative to combat the copying of clone developers.<sup>31</sup> In some cases, courts have held that elements used in a video game's graphic user interface may be protected as trade dress under the Lanham Act.<sup>32</sup> Despite these findings, these limited decisions at the district level do not provide a clear standard for determining how these elements may be infringed—they only find that graphic elements comprising a game's look and feel may be protected as trade dress.<sup>33</sup> However, this gap may have been filled with approaches to analyzing trade dress elements in websites, in cases like *Conference Archives, Inc. v. Sound Images, Inc.*<sup>34</sup>

Using the standard for evaluating trade dress infringement in cases involving website interfaces, this comment seeks to see whether elements unprotected by the Copyright Act may be protected under the Lanham Act. Part II of this Comment examines copyright protection for video games made for smartphones and discusses whether trade dress protection—as seen in the context of graphic user interfaces for websites—can bridge these gaps. Part II also discusses the relevant authorities and limitations regarding the scope of copyright and trade dress protection for websites, software, and video games. Part III then examines the scope of copyright protection for the game *Fruit Ninja* and then identifies which elements comprising the game's look and feel are either protected, not protected, or receive limited protection under the Copyright Act. After identifying which elements are not protected or receive limited protection, Part III examines whether these elements may be protected as trade dress under the standard set forth in *Conference Archives Inc. v. Sound Images, Inc.* Finally, Part IV concludes what benefits trade dress protection provides against clone video games and whether it is a viable alternative for protecting video games.

## II. BACKGROUND

### A. Copyright Protection for Video Games

As original works of authorship fixated in a reproducible medium, video games are copyrightable works under the Copyright Act.<sup>35</sup> Video games are copyrightable as literary and audio-visual works.<sup>36</sup> In order for a work to be copyrightable it must be:

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<sup>31</sup> Hemnes, *supra* note 19, at 220-22; *see also* Tetris Holding, LLC, 863 F. Supp. 2d at 415-16; Spry Fox LLC, 2012 WL 5290158 at \*8-9; *see also* Rodesh v. Discronics, Inc., 1993 WL 385481 at \*4 (9th Cir. Sep. 30, 1993); 15 U.S.C. § 1125(a)(3).

<sup>32</sup> *E.g.*, Tetris Holding, LLC, 863 F. Supp. 2d 394.

<sup>33</sup> *Id.* (noting the court was not required to make a finding of whether Tetris' block pieces qualified as trade dress because the issue was conceded).

<sup>34</sup> *Conference Archives, Inc. v. Sound Images, Inc.*, NO. 3:2006-76 2010 WL 1626072 (W.D.Pa. Mar. 31, 2010).

<sup>35</sup> U.S. Copyright Office, *Other Digital Content* (last visited Sep. 25, 2017), <https://www.copyright.gov/registration/other-digital-content/index.html> (noting that video games are registerable and protected under the Copyright Act).

<sup>36</sup> *See* 17 U.S.C. § 102(a)(1), 17 U.S.C. § 102(a)(6); 1-2A MELVILLE B. NIMMER & DAVID NIMMER, 4 NIMMER ON COPYRIGHT § 2A.10(B); Atari Games Corp. v. Oman, 888 F.2d 878, 882 (D.C. 1989); *but*



(1) an original work of authorship; (2) fixated in a tangible medium; and (3) an expression of an idea and not merely an idea.<sup>37</sup> Video games are copyrightable works because they are complex final expressions involving various art forms, such as computer programming, graphic and visual design, voice acting, screen writing, and directing. Often video games are created in a collaborative process with teams of developers working on graphics, game mechanics, storyline, and voice acting.<sup>38</sup>

Despite being copyrightable works, limiting doctrines like *scènes à faire* and the merger doctrines, prevent video games from being copyrighted as a whole.<sup>39</sup> These limits prevent individuals from owning all aspects of an idea.<sup>40</sup> If video game copyrights extended over abstract story plots or game mechanics, there would be outright monopolies over entire game genres.<sup>41</sup> These doctrines limit copyright protection for video games to a thin layer that protects only the game's individual elements and immediate expression.<sup>42</sup>

### 1. *The Limitations of Copyright Protection*

The merger doctrine limits copyright ownership where the idea and expression of an idea, or thing, are inextricably intertwined.<sup>43</sup> Specifically, the merger doctrine limits the scope of copyright protection when there are a limited number of ways to express an idea or thing.<sup>44</sup> Where ideas and expressions are deeply merged, copyright law will only protect the immediate expression of the author.<sup>45</sup> For example, in *Herbert Rosenthal Jewelry*, the Ninth Circuit held that the plaintiff could not exert its copyright over a “bee shaped” pin.<sup>46</sup> In making its decision, the court noted that

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*see* Hemnes, *supra* note 19, at 174-79 (noting that black letter copyright law does not protect video games as a whole).

<sup>37</sup> *Id.*

<sup>38</sup> 17 U.S.C. §§ 102(a)(1)-(8) (2012).

<sup>39</sup> 17 U.S.C. § 102(b); Boyden, *supra* note 20, at 466; *see generally* Hemnes, *supra* note 19, at 206-220.

<sup>40</sup> *See* *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971) (“When the ‘idea’ and its ‘expression’ are . . . inseparable, copying the “expression” will not be barred, since protecting the ‘expression’ in such circumstances would confer a monopoly of the ‘idea’ upon the copyright owner free of the conditions and limitations imposed by the patent law.”) (citation omitted); *see generally* Boyden, *supra* note 20 (discussing limitations on copyright protection for games as systems, processes, and methods).

<sup>41</sup> *See* Hemnes, *supra* note 19, at 184-85; McArthur, *supra* note 28 (noting that the game *Wolfenstein* would have a monopoly over first person shooter games if given copyright protection over its game mechanics; a monopoly that would have prevented popular first person shooters like *Call of Duty* and *Halo*).

<sup>42</sup> *See* Oman, 888 F.2d at 884-86; Hemnes, *supra* note 19, at 174-79; *see also* McArthur, *supra* note 28 (noting that without these limitations there would be complete monopolies over entire genres of video games that stymie innovation).

<sup>43</sup> MELVILLE B. NIMMER & DAVID NIMMER, 4 NIMMER ON COPYRIGHT § 13.03(B)(3); *BUC Int'l Corp. v. Int'l Yacht Council Ltd.*, 489 F.3d 1129, 1142-43 (11th Cir. 2007).

<sup>44</sup> *Id.*

<sup>45</sup> *See* Capcom U.S.A., Inc., 1994 WL 1751482 at \*9 discussing how the merger doctrine renders video games “largely unprotectable”).

<sup>46</sup> *Herbert Rosenthal Jewelry Corp.*, 446 F.2d at 742.

granting copyright protection over the plaintiff's pin would grant a monopoly over an entire idea, a power unintended by Congress.<sup>47</sup>

Scènes à faire denies copyright protection over the use of plot elements, foils, or settings necessary to depict something.<sup>48</sup> French for “scenes that must be done,”<sup>49</sup> scènes à faire limits copyright protection over “incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.”<sup>50</sup> Scènes à faire in video games prevent developers from protecting common or classic elements in games, such as the protagonist being a “chosen one” or a “bar tending” character being used for information in role-playing games.<sup>51</sup> One of the main points of analysis in a copyright infringement claim is the scope of the protected subject matter within a work.<sup>52</sup> To determine whether a video game's protected elements have been infringed, copyright law filters out protected elements of a work from the unprotected elements by using these doctrines.<sup>53</sup>

Most of the elements comprising a game's look and feel are subject to the merger doctrine and scènes à faire.<sup>54</sup> Video games are comprised of a variety of individual elements.<sup>55</sup> Generally, most elements used in video games are non-copyrightable subject matter due to these limiting doctrines.<sup>56</sup> As a result, even though a video game's elements may be copyrightable, its scope of protection would be limited to the game's exact expression.<sup>57</sup>

Although Plaintiff game developers are likely to establish most of the elements necessary in a copyright infringement claim, they are unlikely to establish the element of substantial similarity. To show copyright infringement, game developers generally must show: (1) ownership of a valid copyright; and (2) that the infringing work uses

<sup>47</sup> *Id.*

<sup>48</sup> NIMMER, *supra* note 43.

<sup>49</sup> McArthur, *supra* note 28.

<sup>50</sup> Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 616 (7th Cir. 1982) (citing Alexander v. Haley, 460 F. Supp. 40, 45 (S.D.N.Y. 1978)).

<sup>51</sup> See generally McArthur, *supra* note 28; Hemnes, *supra* note 19, at 212-18.

<sup>52</sup> Amusement World, Inc., 547 F. Supp. at 228 (noting that an axiom of copyright law is that “while one's expression of an idea is copyrightable, the basis for the underlying idea one uses is not.”).

<sup>53</sup> Computer Associates Int'l, Inc. v. Altai, Inc., 982 F.2d 693, 706 (2d Cir. 1992) (using an “abstraction, filtration, comparison” analysis to separate idea from expression in computer programs); see also, Spry Fox LLC, 2012 WL 5290158 at \*4 (citing Apple Computer, Inc. v. Microsoft Corp., 35 F.3d 1435, 1443 (9th Cir. 1994); Cavalier v. Random House, Inc., 297 F.3d 815, 822 (9th Cir. 2002) (directing court to “filter out and disregard the non-protectable elements” when conducting the extrinsic test).

<sup>54</sup> Data East USA, Inc., v. Epyx, Inc., 862 F.2d 204, 208-10 (9th Cir. 1988) (finding no copyright infringement where the similar features in two video games were the result of “constraints inherent in the sport of karate”). As *Spry Fox* shows, copyrights over a video game cannot prevent other developers from developing a game with similar concepts, but a different expression from the plaintiffs. Spry Fox LLC, 2012 WL 5290158 at \*4.

<sup>55</sup> See generally Hemnes, *supra* note 19.

<sup>56</sup> *Id.* at 196-204 (discussing the copyrightable aspects of the games *Pac-Man* and *K.C. Munchkin* in *N. Am. Philips*, 672 F.2d 607). Courts have also found protection for some of the simplest game elements in addition to protectable elements like music and game characters. *E.g.*, Tetris Holding, LLC, 863 F. Supp. 2d at 412-14 (discussing the basic elements of *Tetris* that are subject to copyright protection).

<sup>57</sup> *Id.*; Tetris Holding, LLC, 863 F. Supp. 2d at 403.

elements that are substantially similar to the original game's elements.<sup>58</sup> In determining whether the defendant's game is substantially similar to the plaintiff's, courts examine evidence of access<sup>59</sup> and substantial similarity<sup>60</sup> between the two works. Evidence of access can be established by a showing of direct or circumstantial evidence that the defendant had access to the plaintiff's work.<sup>61</sup> However, developers will likely have difficulty providing evidence to get past both steps of proving copying in-fact, and unlawful appropriation, in establishing substantial similarity.<sup>62</sup> Although evidence of access can be easily established where popular video games have been widely disseminated,<sup>63</sup> evidence of substantial similarity to protected elements is difficult to establish.<sup>64</sup>

To make matters worse, the courts vary in how they analyze substantial similarity. The majority approach is defined by the Second Circuit in *Arnstein v. Porter*.<sup>65</sup> The Ninth Circuit uses the same two-step approach and uses an 'extrinsic'<sup>66</sup> and 'intrinsic'<sup>67</sup> analysis to determine whether there is probative similarity and

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<sup>58</sup> NIMMER, *supra* note 43, § 13.01; Mark A. Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. COPYRIGHT SOC'Y U.S.A. 719 (2010) (noting that although there is a general consensus in analyzing access, there is not a uniform method of analyzing substantial similarity among district courts). The majority approaches in analyzing substantial similarity break down the analysis between expert and layperson observations in deciding the question of copying. *Id.* (discussing the majority approach embodied in *Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) and the Ninth Circuit's approach embodied in *Sid & Marty Krofft Television Prod.*, 562 F.2d 1157, 1164 (9th Cir. 1977)).

<sup>59</sup> NIMMER, *supra* note 43, at § 13.02.

<sup>60</sup> NIMMER, *supra* note 43, at §§ 13.01, 13.03; Lemley, *supra* note 58, at 719-20 (noting that evidence of access may be established through direct or circumstantial evidence); *see also*, *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 482 (9th Cir. 2000) (noting that evidence of indirect access may be established where the plaintiff's work was widely disseminated); *Funky Films, Inc. v. Time Warner Entm't Co.*, 462 F.3d 1072, 1080-8181 (9th Cir. 2006) (finding indirect access of evidence after plaintiff established chain of events showing the defendant had access to the work). Plaintiff game developers with widely successful games are more likely to establish the defendant's had notice of the plaintiff's game, due to widespread popularity of the game. *Id.* Thus, video game developers with very popular games are likely to establish indirect evidence of access.

<sup>61</sup> *See Id.*

<sup>62</sup> *See generally* Lemley, *supra* note 58.

<sup>63</sup> Hemnes, *supra* note 19, at 182-86; *e.g.*, *Three Boys Music Corp.*, 212 F.3d at 482.

<sup>64</sup> Lemley, *supra* note 58, at 736-40.

<sup>65</sup> *Id.* at 722 ("The Second Circuit speaks of a two-part inquiry, one involving analysis and dissection and the second involving an 'ordinary observer' test."). "If there is evidence of access and similarities exist, then the trier of fact must determine whether the similarities are sufficient to prove copying. On this [second] issue, analysis ('dissection') [of the work's copyrightable and non-copyrightable elements] is relevant, and the testimony of experts may be received to aid the trier of fact." *Arnstein*, 154 F.2d at 468.

<sup>66</sup> Lemley, *supra* note 58, at 723.

"[The extrinsic test does not depend] on the responses of the trier of fact, but on specific criteria which can be listed and analyzed. Such criteria included the type of artwork involved, the materials used, the subject matter, and the setting for the subject. Since it is an extrinsic test, analytic dissection and expert testimony are appropriate. Moreover, this question may often be decided as a matter of law." (quoting *Sid & Marty Krofft Television Prods., Inc.*, 562 F.2d at 1164).

<sup>67</sup> *Id.* The intrinsic test examines whether there is substantial similarity in the expressions of the two works from the perspective of an ordinary reasonable person. *Id.* "It is intrinsic because it does

unlawful appropriation.<sup>68</sup> The general method adopted by jurisdictions is an approach “that permits expert testimony in the first step—inferring copying—but excludes it when it comes to the second step of determining whether that copying is unlawful.”<sup>69</sup> Other than this, there are only a few differences in how courts conduct a substantial similarity analysis.<sup>70</sup>

Although analyses of substantial similarity vary among districts, the “ordinary observer” standard for analyzing evidence of infringement varies only slightly.<sup>71</sup> Unlike the traditional “ordinary person” standard used, the “ordinary observer” standard is viewed from the perspective of the work’s intended audience.<sup>72</sup> As the Sixth Circuit has noted, the intended audience’s “perception of similarity may be much different from the lay observer’s, and it is appropriate in such cases to consider similarity from the specialist’s perspective.”<sup>73</sup> There is not a clear standard for when works must be analyzed from an intended audience or “extraordinary observer standard.”<sup>74</sup> However, it should be noted that the Ninth Circuit applied this higher “extraordinary observer standard” to a case involving video games.<sup>75</sup> In its analysis, the Ninth Circuit applied the “extraordinary observer standard” by analyzing whether a martial arts video game constituted unlawful copying from the perspective of a seventeen and a half year-old boy.<sup>76</sup> As a result, evidence of copying in video games is to be viewed from an ordinary observer stand point, or a higher standard, if following the stance of the Ninth Circuit.

By imitating the look and feel of successful games, clone developers are able to quickly create and market their clone version in a short amount of time.<sup>77</sup> Clone games avoid infringing on copyrights by carefully copying elements that are either not protected, or receive limited protection under the Copyright Act.<sup>78</sup> In establishing evidence of copyright infringement against clone developers, game developers are limited to claiming infringement over only their work’s original elements.<sup>79</sup> Often, plaintiff game developers are only able to exert their copyright over a few elements of their game, such as music or a character’s design.<sup>80</sup> By changing the protected elements of a video game’s appearance, character elements, or text, clone developers

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not depend on the type of external criteria and analysis which marks the extrinsic test.” *Id.* (quoting *Sid & Marty Krofft Television Prods., Inc.*, 562 F.2d at 1164).

<sup>68</sup> *Id.* at 723.

<sup>69</sup> *Id.* at 726 (noting the method of using use expert testimony in the First, Sixth, and Seventh Circuits).

<sup>70</sup> *Id.* at 729 (noting that courts also differ in defining the reasonable ordinary observer).

<sup>71</sup> *Id.* at 729-30.

<sup>72</sup> *Id.*

<sup>73</sup> *Id.* at 730 (citing *Kohus v. Mariol*, 328 F.3d 848, 857 (6th Cir. 2003)).

<sup>74</sup> *Id.*

<sup>75</sup> *Data East USA, Inc.*, 862 F.2d at 209.

<sup>76</sup> *Id.* at 209-10.

<sup>77</sup> *E.g.*, *Serreles*, *supra* note 17.

<sup>78</sup> 17 U.S.C. § 102(b); *e.g.*, *Tetris Holding*, 863 F. Supp. 2d. at 397; *see also* 888 F.2d at 885-86 (“A knock-off manufacturer could . . . write a computer program which would exactly replicate the audiovisual display but which would not predicate the underlying program.”) (quoting William Patry, *Electronic Audiovisual Games: Navigating the Maze of Copyright*, 31 J. COPYRIGHT SOC’Y USA 1, 5 (1983)).

<sup>79</sup> *Id.*

<sup>80</sup> *See generally* *Hemnes*, *supra* note 19; *e.g.*, *Spry Fox LLC*, 2012 WL 5290158.

can avoid infringing on the original elements of a video game and create the game's same look and feel.<sup>81</sup>

### *B. Video Games and the Scope of Protection Under Trademark Law*

Trade dress protection over video game and graphic elements in digital interfaces is a relatively new area of law.<sup>82</sup> The purpose of trademark law is to prevent consumer confusion about the source of a product or service.<sup>83</sup> As such, trademark infringement suits seek to enjoin companies from using similar logos and brand names that create confusion among consumers.<sup>84</sup> Traditionally, trade dress protection in the video game context has been limited to product packaging.<sup>85</sup> Although theoretically possible, courts have been traditionally skeptical about finding that a website's graphic elements can constitute protectable trade dress.<sup>86</sup> However, decisions over the last decade have explored this issue and found that elements in a graphic user interface

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<sup>81</sup> *E.g.*, *DaVinci Editrice S.R.L. v. ZiKo Games, L.L.C.*, 2014 WL 3900139 at \*4. Often, plaintiff video game developers are unable to get past the expert analysis phase of copyright infringement where they must show unlawful copying. Lemley, *supra* note 58, at 733.

<sup>82</sup> *See generally* Hemnes, *supra* note 19, at 220 (noting that the ghost and gobbler character elements used in *Pac-Man* may be better protected under trademark law); Melus, *supra* note 22, at 357-72 (citing Lisa M. Byerly, *Look and Feel of Web Site User Interfaces: Copyright or Trade Dress?*, 14 SANTA CLARA COMPUT. & HIGH TECH. L.J. 221, 247-66 (1998) (“arguing that the ‘look and feel’ of website[s] should be protected under trade dress instead of copyright”).

<sup>83</sup> 15 U.S.C. § 1125(a) (2006) (prohibiting the use of marks on goods or services in commerce that are likely to cause confusion as to the source of the goods or services among consumers); Hemnes, *supra* note 19, at 221 (“[T]rademark law recognizes a right in the first user of a mark to make all of the profit derived from the goodwill associated with a mark and to prevent unfair or deceptive use of the same or confusingly similar marks by other persons.”). Trademark laws “primarily serve to prevent the use of identical or similar marks in a way that confuses the public about the actual source of goods and services.” Deborah Buckman, *Initial Interest Confusion Doctrine Under Lanham Trademark Act*, 183 A.L.R. Fed. 553 (2003).

<sup>84</sup> *Id.*

<sup>85</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8:4 (4th ed. 2017) (“[T]rade dress includes the total look of a product and its packaging and even includes the design and shape of the product itself.”); *e.g.*, *Nintendo of Am., Inc. v. Brown*, 94 F.3d 652 (9th Cir. 1996) (granting summary judgment against sellers of video game cartridges that were identical to the plaintiff's video games); *Nintendo of Am., Inc. v. NTDEC*, 822 F. Supp. 1462 (D. Ariz. 1993) (holding that seller of counterfeit Nintendo video game cartridges was liable for trademark infringement); *Sony Computer Entm't Am., Inc. v. Gamemasters*, 87 F. Supp. 2d 976 (D. Cal. 1999) (holding that allegedly counterfeit video game hardware were likely to cause consumer confusion as to original source and therefore violated the manufacturer's trademarks); *Midway Mfg. Co. v. Bandai-Am., Inc.*, 546 F. Supp. 125 (D.N.J. 1982) (finding trademark infringement because there was a likelihood of confusion between the video game mark ‘Galaxian’ and an identical mark used by defendant on a very similar game); *Midway Mfg. Co. v. Dirkschneider*, 571 F. Supp. 282 (D. Neb. 1983) (finding defendants liable for trademark infringement because they had substantially copied a manufacturer's video games and used the same or similar names for their copies).

<sup>86</sup> MCCARTHY, *supra* note 85, at § 8:7.25 (collecting cases) (“[I]t is probable that few Web sites have an appearance that is so unusual or distinctive that it can constitute what might be called protectable ‘web dress’ or ‘site dress.’”).

may qualify as protectable trade dress.<sup>87</sup> In examining the issue of trade dress in graphic user interfaces, these courts have held that alleged trade dress elements must be plead with great specificity.<sup>88</sup> As such, cases like *Tetris Holding* and *Conference Archives* show that video game elements may be protected under the Lanham Act as trade dress.<sup>89</sup>

Although cases like *Tetris Holding* and *Spry Fox* show that trade dress protection can be afforded to video game elements, there is not a clear standard as to what aspects of video games may constitute protectable trade dress.<sup>90</sup> Despite this, case law regarding trade dress elements in software and websites, such as *Conference Archives*, provides some guidance for applying a trade dress analysis to elements of digital interfaces.<sup>91</sup> Although *Conference Archives* is not the first case to find that elements of digital user interfaces may be protected as trade dress, it became the first case to create a standard for objectively analyzing the similarities of websites, and potentially, other types of digital user interfaces.<sup>92</sup> Using the method for analyzing trade dress laid out in *Conference Archives*, video game developers may have more success in pleading trade dress infringement over the use of their video game characters.<sup>93</sup>

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<sup>87</sup> *Blue Nile, Inc. v. Ice.com*, 478 F. Supp. 2d 1240, 1242 (W.D. Wash. 2007) (arguing that trade dress should be expanded to websites); *Conference Archives, Inc.*, 2010 WL 1626072 at \*21 (finding that the plaintiff plead sufficient facts to constitute a trade dress infringement action); *Tetris Holding, LLC*, 862 F. Supp. 2d 394, 416 (finding that the defendant infringed on the plaintiff's protectable trade dress).

<sup>88</sup> *Conference Archives, Inc.*, 2010 WL 1626072 at \*4-5; *see also* MCCARTHY, *supra* note 85, at 83 § 8:7.25 (noting that complaints merely alleging infringement of a website's "look and feel" does not pass muster under the rule that trade dress must be defined with considerable particularity. Hazy and indefinite references to the protectable and allegedly infringed aspect of trade dress in a Website as its 'look and feel' fall far short of the exactitude that is required.").

<sup>89</sup> *See* Mark S. Lee, *Trade dress and video games*, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW § 16:28 (2016)

Videogame owners sometimes argue that another who takes elements of the game not only infringes the copyright in it, but also infringes trade dress rights in the 'look and feel' of the game . . . . [C]laims of trade dress in videogames are permitted only where plaintiff[s] can specifically articulate a synthesis of nonfunctional elements that combine to create source identifying trade dress.

*see also* Hemnes, *supra* note 19, at 204 (noting that a confusing similarity between competing video game characters in could be actionable under section 43(a) of the Lanham Act.); *Tetris Holding, LLC*, 863 F. Supp. 2d. at 415-16 (holding that plaintiff's stated a claim for trade dress infringement of its video game's block elements); *Spry Fox LLC*, 2012 WL 5290158 at \*9 (finding that plaintiff did not state a sufficient claim for trade dress infringement over its video game's character elements).

<sup>90</sup> *Tetris Holding LLC*, 863 F. Supp. 2d. at 415-16 (noting that the court did not have the opportunity to analyze the presence of secondary meaning in video games because the defendant conceded the issue); *Spry Fox LLC*, 2012 WL 5290158 at \*9 (deciding not to decide on the issue of trade dress infringement, due to plaintiff's failure to properly articulate the claim); *see also* Hemnes, *supra* note 19, at 204 (noting that *Pac-Man*'s central "gobbler" character is a recognized mark of great value that could be protectable under section 43 of the Lanham Act, but was not an issue in the case).

<sup>91</sup> *Conference Archives, Inc.*, 2010 WL 1626072 at \*3-15 (describing a method of analyzing similarities between websites to determine whether trade dress infringement has occurred).

<sup>92</sup> *Id.*

<sup>93</sup> *Id.*

### 1. Overcoming Copyright Preemption

Section 301(a) of the Copyright Act preempts state law claims where the Copyright Act provides an adequate remedy.<sup>94</sup> Different aspects of a product may be protected through multiple forms of intellectual property protections.<sup>95</sup> Although the language of section 301(a) does not expressly indicate that the Lanham Act is preempted, courts following the holding of *Dastar Corp.*,<sup>96</sup> limit the application of the Lanham Act where the Copyright Act provides an adequate remedy.<sup>97</sup> Section 301 preempts trademark actions—on the basis of there being an adequate remedy—when a work is copyrightable subject matter and the rights asserted in the trademark action are equivalent to rights under § 106 of the Copyright Act.<sup>98</sup> “The preemption analysis therefore includes two requirements: a subject matter requirement, and an equivalency requirement.”<sup>99</sup> As a result, when the Copyright Act does not provide an equivalent relief—or adequate remedy—for a right being sought under trademark law, the action is not preempted.<sup>100</sup> Courts refuse to extend copyright protection to protect a video game’s look and feel.<sup>101</sup> As such, the elements that copyright does not adequately protect, may be protected under the Lanham Act.<sup>102</sup>

Under trademark law, the Copyright Act’s thin level of protection over aesthetic elements in video games may be remedied. The Lanham Act provides protection over non-functional elements that identify a products source by the way it looks and feels.<sup>103</sup> Section 1125(a) of the Lanham Act prohibits any person from using protected trade dress in commerce, or in connection with any goods or services, if it will create a

<sup>94</sup> 17 U.S.C. § 301(a).

<sup>95</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 6:5 n.7 (4th ed. 2016) (quoting *Kohler Co. v. Moen Inc.*, 12 F.3d 362 (7th Cir. 1993) (“[C]ourts have consistently held that a product’s different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property.”)).

<sup>96</sup> *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003).

<sup>97</sup> J. Scott Anderson, *Painstaking Semantics: Selecting Website Trade Dress Elements to Survive a Copyright Preemption Challenge*, 7 J. MARSHALL REV. INTELL. PROP. L. 97, 100 (2007); *Dastar Corp.*, 539 U.S. 23, 34 (2003) (“Thus, in construing the Lanham Act, we have been careful to caution against misuse or over-extension of trademark and related protections into areas traditionally occupied by patent or copyright.”) (internal quotation omitted); MCCARTHY, *supra* note 95, at § 6:14; *but see* MCCARTHY, *supra* note 95, at § 6:5 n.7 (arguing that the court’s analysis in *Conference Archives Inc.*, 2010 WL 1626072 at \*12 is a misstatement and application of the law). \*\*Author’s Note\*\* Although Professor McCarthy’s argument regarding *Conference Archives*’s preemption analysis is taken into account, this comment’s use of *Conference Archives* is primarily focused on the court’s novel analyzing approach to analyzing trade dress infringement.

<sup>98</sup> Anderson, *supra* note 97, at 100 (*Harper & Row Publishers v. Nation Enter.*, 723 F.2d 195, 199-200 (2d Cir. 1983), *rev’d on other grounds*, 471 U.S. 539 (1985); *Wrench LLC v. Taco Bell Corp.*, 256 F.3d 446, 453 (6th Cir. 2001) (analyzing state law contract rights)).

<sup>99</sup> *Id.*

<sup>100</sup> *Id.* at 100-101.

<sup>101</sup> Boyden, *supra* note 20, at 472.

<sup>102</sup> *Id.*

<sup>103</sup> 155 U.S.C § 1125; *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992) (holding that non-functional trade dress can be protected under the Lanham Act); *see also* *Qualitex Co. v. Jacobsen Prod. Co.*, 514 U.S. 159 (1995) (noting that only non-functional aspects of a product can qualify for trade dress).

likelihood of consumer confusion.<sup>104</sup> Unlike the Copyright Act, the Lanham Act is designed to prevent source confusion when products placed in commerce have the same look and feel. As a result, a trade dress infringement action over uncopyrightable elements should not be preempted.

## 2. Establishing Secondary Meaning and Non-Functionality

To be registered as trade dress with the United States Patent and Trademark Office (“USPTO”), applicants must show that the symbols, color scheme, or design they are submitting is distinctive because it has acquired secondary meaning.<sup>105</sup> A symbol, color scheme, or design has acquired secondary meaning when the symbol or color scheme identifies the specific or unique source of a good or service in the consumer’s mind.<sup>106</sup> In determining the presence of secondary meaning over trade dress elements, courts inquire into the mental association by a substantial segment of consumers, and potential consumers, between the trade dress in question and the source of that trade dress.<sup>107</sup>

In examining whether non-word marks can qualify as trade dress, the focus is on whether the non-word mark has achieved a “new meaning.”<sup>108</sup> Courts examine the following factors to determine whether trade dress has secondary meaning: (1) the length and manner of the trade dress use; (2) the volume of sales using the trade dress; (3) the amount and manner of advertising of the product using the trade dress; (4) the nature of use of the trade dress in newspapers and magazines; (5) consumer-survey evidence regarding source identification of products using the trade dress elements; (6) direct consumer testimony; and (7) the defendant’s intent in copying the trade dress.<sup>109</sup> “In considering this evidence, the focus is on how it demonstrates that the meaning of the mark or trade dress has been altered in the minds of consumers.”<sup>110</sup> Thus, if a

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<sup>104</sup> See 155 U.S.C. § 1125(a); courts have defined trade dress as “the design and appearance of a product together with the elements making up the overall image that serves to identify the product presented to the consumer.” *Yankee Candle Co., Inc. v. Bridgewater Candle Co., LLC*, 259 F.3d 25, 38 (1st Cir. 2001) (citing *Chrysler Corp. v. Silva*, 118 F.3d 56, 58 (1st Cir.1997) (quoting *Fun-Damental Too, Ltd. v. Gemmy Indus. Corp.*, 111 F.3d 993, 999 (2d Cir. 1997)).

<sup>105</sup> 8-1200 UNITED STATES PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) 1202.02 (2017).

<sup>106</sup> Melus, *supra* note 22, at 368 (citing *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (“defining distinctiveness according to four categories in order of uniqueness as fanciful or arbitrary, suggestive, descriptive, or generic”).

<sup>107</sup> *Id.* (citing *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1354 (9th Cir. 1985)). To establish secondary meaning in trade dress, the trade dress of a product must indicate the source of the product to consumers. *Id.*

<sup>108</sup> 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §15:9 (4th ed. 2017).

<sup>109</sup> *Bd. of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel*, 550 F.3d 465, 476 (5th Cir. 2006) (citing *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526 (5th Cir. 1998)).

<sup>110</sup> *Pebble Beach Co.*, 155 F.3d at 541 (citing *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 795 (5th Cir. 1983) (noting the question is not the extent of marketing and promotional efforts, but the effectiveness of the of these efforts in altering the meaning of the mark in the consuming public’s eye).



color scheme, layout or design is capable of identifying a source or game developer to a consumer, the proposed elements are protectable as trade dress.

Another hurdle in establishing trade dress protection for video game elements is the Lanham Act's bar against registering functional elements as trade dress.<sup>111</sup> To qualify as protectable, trade dress elements cannot serve any functional purpose.<sup>112</sup> A feature of a product is functional "if it is essential to the use or purpose of the article or if it affects the cost or quality of the article, that is, if exclusive use of the feature would put competitors at a significant non-reputational disadvantage."<sup>113</sup> The functionality analysis of trade dress focuses on the item as a whole; not the individual trade dress element.<sup>114</sup>

### 3. *The Likelihood of Confusion Factors*

After establishing their game is worthy of trade dress protection, game developers have the burden of establishing that the defendant's game creates a likelihood of confusion between the two parties' games.<sup>115</sup> Case law inquiring into whether a likelihood of confusion occurs from the use of similar trade dress elements in video games and websites, is a novel issue that has not been fully examined.<sup>116</sup> Under a trademark infringement analysis, there is a likelihood of confusion when consumers believe two competing products come from the same source.<sup>117</sup>

Each circuit's likelihood of confusion test examines roughly the same set of non-exclusive factors.<sup>118</sup> In analyzing whether there is a likelihood of confusion, the factors

<sup>111</sup> *Qualitex*, 514 U.S. at 165.

<sup>112</sup> Xuan-Thao N. Nguyen, *Should It Be A Free for All? The Challenge of Extending Trade Dress Protection to the Look and Feel of Web Sites in the Evolving Internet*, 49 AM. U.L. REV. 1233, 1246 (2000); *Christian Louboutin S.A. v. Yves Saint Laurent America Holding, Inc.*, 696 F.3d 206, 212 (2d Cir. 2012).

<sup>113</sup> *Inwood Lab. Inc. v. Ives Lab. Inc.*, 456 U.S. 844, 850 n.10 (1982); *see also* *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 33 (2001).

<sup>114</sup> *Traffix Devices, Inc.*, 532 U.S. at 27 (citing *Qualitex*, 514 U.S. at 165); *See also*, *Valu Engineering, Inc. v. Rexnord Corp.*, 278 F.3d 1268 (Fed. Cir. 2002); *Au-Tomotive Gold, Inc. v. Volkswagen of America, Inc.*, 457 F.3d 1062 (9th Cir. 2006).

<sup>115</sup> 44 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 23:11 (4th ed. 2016) (citing *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111, 117 (2004) ("Section 1115(b) [Lanham Act § 33(b)] places a burden of proving likelihood of confusion (that is, infringement) on the party charging infringement even when relying on an incontestable registration.")).

<sup>116</sup> *See* *Blue Nile, Inc.*, 478 F. Supp. 2d at 1243 (W.D. Wash. 2007) (holding that plaintiff stated a valid claim for trade dress protection over the "look and feel" of its website); *Conference Archives, Inc.*, 2010 WL 1626072 at \*4 (discussing standard for trade dress protection over website trade dress); *Tetris Holding, LLC*, 863 F. Supp. 2d at 415-16 (granting summary judgment in favor of Plaintiff's trade dress infringement claim). The leading cases discussing trade dress protection over websites and have merely discussed and recognized that graphic elements may constitute protectable trade dress at the pleading stage. Despite these developments, the issue of whether the use of similar trade dress constituting a video game or website can create a likelihood of confusion has not been heard yet. *E.g.*, *Tetris Holding LLC*, 863 F. Supp. 2d 394; *Conference Archives, Inc.*, 2010 WL 1626072; *Spry Fox LLC*, 2012 WL 5290158.

<sup>117</sup> *Id.*

<sup>118</sup> MCCARTHY, *supra* note 115.

relevant and commonly used by all circuits are: (1) strength of the mark; (2) similarity of the marks; (3) channels of trade; (4) sophistication of the consumers; (5) evidence of actual confusion; and (6) sophistication of the consumer.<sup>119</sup> The strength of the mark and the degree of similarity of the products factors are the only two factors that examine individual portions of trade dress elements—as opposed to the look and feel of the graphic user interface overall.<sup>120</sup> The channels of trade, “bridging the gap,” quality of the defendant’s product, and the sophistication of the buyers factors all examine the consumer’s interaction with the product or concept in the marketplace.<sup>121</sup>

The first factor examines the strength of the plaintiff’s mark or trade dress. In analyzing the strength of a plaintiff’s trade dress, trade dress is divided into four categories of protection.<sup>122</sup> In order of descending strength of protection, marks and trade dress can either be fanciful/arbitrary,<sup>123</sup> suggestive,<sup>124</sup> descriptive,<sup>125</sup> or generic.<sup>126</sup> The stronger the mark or trade dress of the video game is, the stronger the likelihood of confusion regarding infringement.

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<sup>119</sup> MCCARTHY, *supra* note 115.

[T]he federal courts have developed a multi-factor test to assist in the difficult determination of whether there is or is not a likelihood (probability) of confusion.

The test used is not identical throughout the various federal circuits. Most such tests have about eight factors to consider and the number of factors varies slightly among the 13 federal circuits;

*e.g.*, Polaroid Corp. v. Polarad Elec., 287 F.2d 492, 495 (2d Cir. 1961); Amazing Spaces, Inc. v. Metro Mini Storage, 608 F.3d 225, 248 (5th Cir. 2010) (*citing* Smack Apparel, 550 F.3d at 476); *see also* First Brands Corp. v. Fred Meyer, Inc., 809 F.2d 1378, 1384, n. 6 (9th Cir. 1987).

<sup>120</sup> Melus, *supra* note 22, at 386 (*citing* Polaroid Corp., 287 F.2d at 495).

<sup>121</sup> *Id.*

<sup>122</sup> Abercrombie & Fitch Co., 537 F.2d at 9.

<sup>123</sup> *Id.* at 11. Fanciful/arbitrary marks and trade dress receive the most amount of protection and do not require proof of a secondary meaning. A mark is fanciful when it is made up; meaning there is no definition for the word, such as the mark Kodak for cameras. Marks and trade dress are arbitrary when the name has nothing to do with the product or service connected with the good. Arbitrary marks receive protection only in the market where its use is arbitrary. An example of an arbitrary mark is the mark “Apple” for computers.

<sup>124</sup> *Id.* at 10. A suggestive mark receives slightly less protection than fanciful/arbitrary marks but more than descriptive marks with secondary meaning. A mark is suggestive when consumers are required to use a “leap of imagination” in determining the meaning of the mark. If an image is instantly conjured upon hearing the mark, it is likely not suggestive. An example of a suggestive mark would be the mark “Big Apple Deli” for a New York style sandwich shop.

<sup>125</sup> *Id.* Descriptive marks with acquired secondary meaning receive the lowest amount of protection available under the Lanham Act. With a showing of secondary meaning, a descriptive mark can be registered if consumers identify a manufacturer from it. An example of a descriptive mark with acquired secondary meaning is the mark “Kentucky Fried Chicken.” Although the mark describes the product as a Kentucky style fried chicken, the mark has meaning among consumers that identify the name with the manufacturer. Aside from the exception of descriptive marks that acquire secondary meaning, descriptive marks do not receive protection under the Lanham Act. Merely descriptive marks describe the product sold and instantly conjure an image of the product in the consumer’s mind, unlike suggestive marks, which require some thought. An example of a merely descriptive mark would be either “hot coffee” for a coffee shop or “turkey sandwiches” for a sandwich shop.

<sup>126</sup> *Id.* at 9. Like merely descriptive marks, generic marks do not receive protection under the Lanham Act in order to prevent granting a monopoly over a commonly used word. A mark is generic when it is commonly used to describe a genus or class of a product, such as a farmer using the word “apples” to sell apples.

The second factor examines the similarity of the marks. The similarity of the defendant's mark to the plaintiff's mark examines the overall look and feel of the mark, or in the case of trade dress, the product.<sup>127</sup> In analyzing whether the defendant's trade dress is similar to the plaintiff's trade dress, courts examine the appearance, sound, and meaning of a mark or trade dress.<sup>128</sup> There is a strong likelihood of confusion when there is a high degree of similarity between two marks.<sup>129</sup> Therefore, a higher degree of similarity between two graphic interfaces weighs in favor of there being a likelihood of confusion among consumers.<sup>130</sup>

The third factor analyzes the channels of trade, or the proximity of the products in commerce and the marketplace. The proximity of the goods is analyzed by examining the channels of trade the products in question are sold in, and the likelihood consumers would see both products alongside each other.<sup>131</sup> If both products are in direct competition with each other, there is a stronger likelihood of confusion.<sup>132</sup> In determining whether products are in direct competition with each other, courts examine whether the products are complementary goods<sup>133</sup> or substitute goods,<sup>134</sup> and whether the products appear in the same stores alongside each other.<sup>135</sup> When it is likely the defendant's product will appear alongside the plaintiff's product in a store, the "channels of trade factor" weighs in favor of a likelihood of confusion.<sup>136</sup>

The fourth factor examines the sophistication of consumers in purchasing a particular product.<sup>137</sup> In analyzing the fourth factor, courts examine the amount of care consumers take in purchasing a particular product.<sup>138</sup> When a consumer exercises more caution and care in purchasing a product, it is less likely there is a likelihood of confusion.<sup>139</sup>

The fifth factor analyzing actual consumer confusion examines whether consumers are actually confused by the use of similar trade dress.<sup>140</sup> Although this

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<sup>127</sup> *Virgin Enter. Ltd. v. Nawab*, 335 F.3d 141, 149 (2d Cir. 2003).

<sup>128</sup> *Id.*

<sup>129</sup> *Id.*; *McNeal Nutritionals, LLC v. Heartland Sweeteners, LLC*, 511 F.3d 350, 367 (3d Cir. 2007); *A&H Sportswear, Inc. v. Victoria's Secret Stores, Inc.*, 237 F.3d 198, 214 (3d Cir. 2000).

<sup>130</sup> *Conference Archives Inc.*, 2010 WL 1626072 at \*18.

<sup>131</sup> *Virgin Enter. Ltd.*, 335 F.3d at 149-150.

<sup>132</sup> *Id.*

<sup>133</sup> *Id.* Complementary goods are goods that go with another and are not in direct competition, such as a hammer and nails or a hotdog and buns.

<sup>134</sup> *Id.* Substitute goods act as cheaper alternatives to luxury items that are purchased when consumers are less cost conscious. An example of substitute goods in the marketplace would be consumers purchasing brand-name toilet paper when their finances are good and generic toilet paper when they are more cost conscious.

<sup>135</sup> *See Gen. Motors Corp. v. Keystone Auto. Indus.*, 453 F.3d 351, 357-358 (6th Cir. 2006). Courts examine the geographic territory where the products are sold to determine if they would be sold in the same stores. Further, courts may also inquire into where the products are sold in the store as well. If the goods are complementary or substitutes, there is a stronger likelihood the products will be displayed alongside each other. *Id.* Close proximity of the goods increases the likelihood of confusion because consumers may believe the products are different variations sold by the same manufacturer.

<sup>136</sup> *Id.*

<sup>137</sup> *Polaroid Corp.*, 287, F.2d 492, 495 (2d Cir. 1961).

<sup>138</sup> *Gen. Motors Corp.*, 453 F.3d at 357; *Virgin Enter. Ltd.*, 335 F.3d at 151.

<sup>139</sup> *Id.*

<sup>140</sup> *Gen. Motors Corp.*, 453 F.3d at 356-67; *Virgin Enter. Ltd.*, 335 F.3d at 151.

information is often unavailable, courts will consider this to be the most persuasive factor, when evidence of actual consumer confusion is available.<sup>141</sup> Naturally, the presence of evidence showing actual confusion weighs in favor of there being a likelihood of confusion because it is likely that consumers will continue to be confused.<sup>142</sup> However, the absence of evidence showing actual confusion does not weigh against a likelihood of confusion.

### III. ANALYSIS

#### A. *Building on Tetris*

In *Tetris Holding*, the plaintiff video game developer, Tetris Holding LLC, made a successful showing of trade dress infringement.<sup>143</sup> Tetris Holding LLC brought an action alleging copyright and trademark infringement against the defendant, Xio Interactive, Inc. (“Xio”).<sup>144</sup> Tetris Holding LLC is the owner of the game *Tetris*, which gained popularity in the United States during the late 1980s and early 1990s.<sup>145</sup> *Tetris* is a puzzle game where players organize bright colored blocks in various geometric shapes to form unbroken horizontal rows, which subsequently disappear.<sup>146</sup> The blocks used in *Tetris*, although simple in design, have a distinct look that employs bright colors and simple lines to create a three-dimensional appearance.<sup>147</sup> Xio’s cloned version of *Tetris*, called *Mino*, was designed to replicate the look and feel of *Tetris* by copying *Tetris*’ distinctive block elements.<sup>148</sup>

The court granted summary judgment in favor of Tetris Holding on both its copyright infringement claim and its trade dress infringement claim.<sup>149</sup> In establishing its claim, Tetris Holding needed to prove: (1) that its “trade dress is distinctive through acquired secondary meaning;” (2) that its trade dress is not functional; and (3) that the similarity of the defendant’s game created a likelihood of confusion among consumers about the source of the defendant’s product.<sup>150</sup> Despite this, Tetris Holding only had to establish that its blocks were not functional because Xio conceded the other elements.<sup>151</sup> Tetris Holding claimed its trade dress elements

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<sup>141</sup> *Virgin Enter. Ltd.*, 335 F.3d at 148.

<sup>142</sup> *Id.*

<sup>143</sup> *Tetris Holding LLC*, 863 F. Supp. 2d at 415-16.

<sup>144</sup> *Id.* at 396.

<sup>145</sup> *Id.* Although initially released for Nintendo’s portable *Game Boy* console, *Tetris*’ cult-classic popularity has led to modern versions of the game being released for smartphones and other consoles.

<sup>146</sup> *Id.*

<sup>147</sup> *See Id.* at 397-98; Tetris, WIKIPEDIA, <https://en.wikipedia.org/wiki/Tetris> (last visited Mar. 26, 2017).

<sup>148</sup> *Tetris Holding, LLC*, 863 F. Supp. 2d at 397.

<sup>149</sup> *Id.* at 416.

<sup>150</sup> *Tetris Holding, LLC*, 863 F. Supp. 2d at 415; *see generally* *Abercrombie & Fitch Co.*, 537 F.2d at 9-11; *Traffix Devices, Inc.*, 532 U.S. at 29; *Wal-mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000); *Blue Nile, Inc.*, 478 F. Supp. 2d at 1243; Liz Brown, *Bridging the Gap: Improving Intellectual Property Protection for the Look and Feel of Websites*, 3 NYU J. INTELL. PROP. & ENT. L. 310 (2014).

<sup>151</sup> *Tetris Holding LLC*, 863 F. Supp. 2d at 415.

were “the brightly-colored *Teriminos*, which are formed by four equally-sized, delineated blocks, and the long vertical rectangle playfield, which is higher than wide.”<sup>152</sup> The court found that the blocks in *Tetris* were not functional due to a variety of other ways for the game and its blocks to be designed.<sup>153</sup> Further, the court also found that the defendant’s game contained intentions to be a near-identical clone of *Tetris*.<sup>154</sup> As a result, the court held that Tetris Holding showed no genuine issue as to a material fact that the Xio’s game created a likelihood of confusion.<sup>155</sup>

Although the court found trade dress infringement over video game elements, *Tetris Holding* provides more questions than answers. Due to Xio conceding the first and third elements of the trade dress claim, the court did not analyze how Tetris’ blocks had acquired secondary meaning nor whether an actual likelihood of consumer confusion existed.<sup>156</sup> The only issue decided by the court surrounded whether the shape, color, or appearance of Tetris’ “Tetrimino” blocks were functional.<sup>157</sup> Due to the court not reaching this issue, there is not any case law analyzing whether video game elements may have acquired distinctiveness.<sup>158</sup> However, some of these questions may be answered by considering how courts treat trade dress protection for digital elements websites.<sup>159</sup>

### *B. Conference Archives: A Method for Establishing Trade Dress in Video Games?*

There is not a clear standard for which elements in video games will be registered and protected by the USPTO.<sup>160</sup> Generally, to register trade dress with the USPTO,

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<sup>152</sup> *Id.* at 415.

<sup>153</sup> *Id.*

<sup>154</sup> *See Id.*

<sup>155</sup> Tetris Holding LLC, 863 F. Supp. 2d at 416.

<sup>156</sup> *Id.* at 415.

<sup>157</sup> *Id.*

<sup>158</sup> *Id.* at 415; *see also* Spry Fox LLC, 2012 WL 5290158 (not hearing the issue of whether the plaintiff’s alleged elements constituted protected trade dress). The lack of case law on these matters may also be due to the fact that cases involving clone games settle and therefore do not get litigated fully. *E.g.*, Leena Rao, *Zynga, Vostu Settle Copyright Lawsuit; Brazilian Gaming Co. to Pay Up*, TECHCRUNCH (Dec. 6, 2011), <https://techcrunch.com/2011/12/06/zynga-vostu-settle-copyright-lawsuit-brazilian-gaming-company-to-pay-up/>; Owen Thomas, *EA and Zynga Have Given Up On a Pointless Lawsuit Over an All-but-Dead Game*, BUS. INSIDER (Feb. 16, 2013), <https://www.businessinsider.com/ea-zynga-the-ville-lawsuit-2013-22>.

<sup>159</sup> MCCARTHY, *supra* note 85 (citing Conference Archives, Inc., 2010 WL 1626072; Blue Nile, Inc, 478 F. Supp. 2d at 1240 (not dismissing allegation of the “novel legal theory” of infringement of trade dress in the “look and feel” of the appearance of a Web site) (quotation omitted); Lepton Labs, LLC v. Walker, 55 F. Supp. 3d 1230, 1239 (C.D. Cal. 2014) (Web dress allegation was sufficiently defined to survive a Rule 12(b)(6) motion); *see also* Kellner, *supra* note 16; Anderson, *supra* note 97; Gary Franklin & Kevin Henry, *Protecting Your Company’s Website: The Application of Intellectual Property to the Digital Marketplace*, 37-WTR Vt. B.J. 26, 29-33 (2012).

<sup>160</sup> Traditionally, trade dress protection in the video game industry applies to the physical packaging of video games. *See e.g.*, Nintendo of Am., Inc., 94 F.3d 652 (granting summary judgment against sellers of video game cartridges that were identical to the plaintiff’s video games). However, with the rise of purchases through websites and online marketplaces, the issue shifts to whether digital graphics used in an online marketplace or video game can be protected as trade dress. *See*

developers must show that the product design elements they are registering are inherently distinctive or have acquired secondary meaning.<sup>161</sup>

Although this issue of secondary meaning was not examined in *Tetris Holding*,<sup>162</sup> cases examining secondary meaning within the digital elements of software and website design elements provide some possible applications for trade dress protection in the video game industry.<sup>163</sup> The design of a website, or the appearance of a video game, invites users in with a familiar interface and recognizable elements.<sup>164</sup> Although the focus in a trade dress claim is on the graphic user interface as a whole, this does not remove the need to articulate what specific elements are being claimed as trade dress to avoid dismissal of a claim.<sup>165</sup> As a result, trade dress elements must be plead with specificity and not in general terms.<sup>166</sup> Despite this hurdle, these website and software trade dress infringement cases show that the overall feel of a website's non-copyrightable aspects can acquire distinctiveness through secondary meaning.<sup>167</sup> The aesthetic appearance of a website arguably has the same display or characteristics as a video game. Both video games and websites present the user with a digitally created interface. These displays employ color schemes, specific arrangements, and other graphic and technical elements that influence the way the user interacts with the interface.<sup>168</sup> As such, the method of determining trade dress elements for websites should be analogous to analyzing potential trade dress elements in video games.

In *Conference Archives*, the court examined "three technical elements" to determine the appearance of a website: colors, orientation, and code elements.<sup>169</sup> On computers, colors are commonly created using a hexadecimal color system that creates and assigns specific numbers to specific color shades.<sup>170</sup> Under the color element, computers recreate specific shades and hues through the hexadecimal number-color

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Anderson, *supra* note 97 (noting the difficulties of selecting website elements that qualify for trade dress protection).

<sup>161</sup> 15 U.S.C. § 1052 (2006) (setting forth the grounds on which the Trademark Office may refuse registration on the principal register); *Blue Nile, Inc.*, 478 F. Supp. 2d at 1246.

<sup>162</sup> *Tetris Holding, LLC*, 863 F. Supp. 2d at 415 (noting that the defendant's did not dispute whether the blocks used in the game *Tetris* had acquired distinctiveness through secondary meaning).

<sup>163</sup> *Conference Archives, Inc.*, 2010 WL 162607, at \*16 (creating a technical standard for evaluating the presence of trade dress in software claims).

<sup>164</sup> *Id.* ("Like the packaging of a product, the look and feel of a web site invites the user in. It offers a familiar interface, with recognizable elements. Similar colors, sizes, and layouts make navigation and interaction facile."); *MCCARTHY, supra* note 85.

<sup>165</sup> *Sleep Science Partners v. Lierberman and Sleeping Well, LLC* 2010 WL 1881770 at \*3 (May 10, 2010) (quoting *Clicks Billiards, Inc. v. Sixshooters, Inc.*, 251 F.3d 1252, 1259 (9th Cir.2001) ("In evaluating a trade dress claim, a court must not focus on individual elements, 'but rather on the overall visual impression that the combination and arrangement of those elements create."); *MCCARTHY, supra* note 85; *e.g.*, *Blue Nile, Inc.*, 478 F. Supp. 2d at 1244; *Lepton Labs, LLC*, 55 F. Supp. 3d at 1239; *Conference Archives, Inc.*, 2010 WL 1626072; *Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 381 (2d Cir. 1997).

<sup>166</sup> *See Id.*

<sup>167</sup> *Id.*

<sup>168</sup> *Melus, supra* note 22 at 379-80; *Boyden, supra* note 20, at 476.

<sup>169</sup> *Conference Archives, Inc.*, 2010 WL 1626072 at \*4.

<sup>170</sup> *Id.* (noting that the hexadecimal system assigns numbers to specific colors and has exactly 16,777,216 unique color options that can be reproduced); *see also* Carl Miller, *List of Different Color Shades*, EHOW, [http://www.ehow.com/about\\_5452316\\_hexadecimal-color-theory.html](http://www.ehow.com/about_5452316_hexadecimal-color-theory.html) (last visited Aug. 12, 2017) (explaining the mechanics of the hexadecimal system).

system.<sup>171</sup> From this system, each color is assigned a specific hex triplet number that can be used to recreate specific colors and hues.<sup>172</sup> By using the hexadecimal system, courts may avoid a reasonable person standard and can determine whether the same exact color has been used to a technical certainty.<sup>173</sup> As a result, “if two products utilize the same exact hex triplet, there is a likelihood that the color was copied.”<sup>174</sup>

In a similar manner, *Conference Archives* noted that the orientation or layout of a website interface can be measured through the use of pixels.<sup>175</sup> Thus, the similarity of a game’s layout and design may be denoted with accuracy, such as an image being “10 pixels down from the top of the page, and 50 pixels over from the left side of the page.”<sup>176</sup> Naturally, the more similarity there is in pixel placement between the two graphic designs, the stronger the likelihood of confusion.

Lastly, the code elements of a website are utilized by programmers to determine the colors, layouts, and text comprising the actual appearance of the website.<sup>177</sup> Comparing the code of graphic user interfaces provides an objective standard for analyzing the degree of similarity and presence of infringement.<sup>178</sup> Similarities within the codes indicate that the code has been copied to replicate the look and feel of the original interface’s design.<sup>179</sup> A high degree of similarity between two graphic interfaces indicates a stronger claim for trade dress infringement.

*Conference Archives’* proposed analysis of what elements can constitute trade dress in an infringement action, is analogous and applicable to trade dress in video games. By breaking down the elements comprising the graphic user interface on a screen, the court created a method of objectively comparing the similarities of digital elements, such as layouts, color hues, and basic source code. This method is analogous to that of video games due to a player’s interaction with elements on a screen. As a result, the court’s analysis in *Conference Archives* fills in some of the blanks left by *Tetris Holding*, in determining what digital elements may be protected as trade dress.

### *C. Fruit Ninjas and Veggie Samurai: A Case Study About Cloning*

A notable example of a successful game app that has been successfully cloned is Halfbrick Studios’ world-famous fruit slicing game, *Fruit Ninja*.<sup>180</sup> *Fruit Ninja*,

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<sup>171</sup> *Id.*

<sup>172</sup> *Id.*

<sup>173</sup> *Conference Archives, Inc.*, 2010 WL 1626072 at \*4-5.

<sup>174</sup> *Id.*

<sup>175</sup> *Id.* A pixel is a unit of measurement for graphic interfaces that denotes a single point on the screen. A common size or resolution of computer monitors is 1,280 pixels in width and 1,024 in height.

<sup>176</sup> *Id.*

<sup>177</sup> *Id.*

<sup>178</sup> *Id.*

<sup>179</sup> *Id.*

<sup>180</sup> See Amanda Lovelock, *Halfbrick and Google Play Join Forces to Celebrate 1 Billion Fruit Ninja Downloads*, BUSINESS WIRE (Aug. 6, 2015), <http://www.businesswire.com/news/home/20150806005489/en/Halfbrick-Google-Play-Join-Forces-Celebrate-1>; See also Gael Fashingbaeur Cooper, *Confirmed: Fruit Ninja Game Will Be Blended Into a Big-Screen Film*, CNET (Sept. 23, 2016), <https://www.cnet.com/news/fruit-ninja-game-movie-new-line-cinema/> (noting that *Fruit Ninja* is second only to the popular mobile game, *Candy Crush Saga*,

involves an Asian-warrior motif and fruit.<sup>181</sup> *Fruit Ninja* challenges its players to swipe pieces of colorful fruit by moving their fingers across the screen while avoiding bombs.<sup>182</sup> The game's mechanics are simple, and rewards players for slicing multiple fruits in combinations to unlock new blades and backgrounds.<sup>183</sup>

*Fruit Ninja*'s look and feel can be divided into distinguishable elements on a user's screen. The look of *Fruit Ninja* can be summed up as an Asian style game involving fruit with a sensei character, Japanese swords, and bombs (a stereotypical ninja plot trope).<sup>184</sup> The feel of the game can be summed up as the elements comprising its user interface. *Fruit Ninja*'s look element is its graphic user interface ("GUI") logo of a watermelon being sliced in half from the lower-left to the upper-right by a blade with a red splatter.<sup>185</sup> Other elements comprising its "look" would be its gameplay menus and buttons, such as the three lives that are displayed in the upper-right hand corner of the screen, the pause button in the lower left-hand corner, and the player's current score and previous high-score in the upper left hand corner.<sup>186</sup>

Despite the widespread success of Half Brick Studios and its game, *Fruit Ninja* is still subject to slavish copying by clone developers.<sup>187</sup> For example, *Fruit Ninja* had 408 clones on app stores only a few years after its release.<sup>188</sup> The most prominent *Fruit*

with one billion downloads. Released onto the Apple App Store in 2010, *Fruit Ninja* is the second most downloaded mobile game in the world and has been the subject of worldwide acclaim and recognition);

FRUIT NINJA, *supra* note 15. With its widespread popularity, *Fruit Ninja*'s developer Halfbrick Studios has also released various updates and spinoffs to their mobile game. See Justin Davis, *Fruit Ninja: Puss in Boots Review*, IGN (Oct. 25, 2011), <http://www.ign.com/articles/2011/10/25/fruit-ninja-puss-in-boots-review> (reviewing Halfbrick Studios' themed version of *Fruit Ninja* based on the Dreamworks Studios movie *Puss in Boots* as "breathing new life" into the original game); David Hinkle, *Fruit Ninja Frenzy to Plant Seeds on Facebook*, ENGADGET (Mar. 3, 2011), <https://www.engadget.com/2011/03/03/fruit-ninja-frenzy-to-plant-seeds-on-facebook/> (discussing Halfbrick Studios release of a new version of *Fruit Ninja* for the social media site Facebook); FRUIT NINJA FX, HALFBRICK STUDIOS, <http://fruitninja.com/fruit-ninja-fx/> (last visited Nov. 17, 2016) (showing Halfbrick Studios' arcade version of *Fruit Ninja*, *Fruit Ninja FX*); FRUIT NINJA KINECT, HALFBRICK STUDIOS, <http://halfbrick.com/our-games/fruit-ninja-kinect/> (last visited Nov. 17, 2016) (showcasing the arcade version of *Fruit Ninja*, *Fruit Ninja FX*); FRUIT NINJA VR, HALFBRICK STUDIOS, <http://fruitninja.com/vr/> (last visited Nov. 17, 2016) (displaying the virtual reality version of *Fruit Ninja*). In addition, Halfbrick Studios recently sold *Fruit Ninja*'s movie rights to New Line Cinema. Tatiana Siegel, *New Line Lands 'Fruit Ninja' Film Based on Game*, HOLLYWOOD REPORTER (Sept. 23, 2016), <http://www.hollywoodreporter.com/heat-vision/new-line-lands-fruit-ninja-914606>.

<sup>181</sup> FRUIT NINJA, *supra* note 15.

<sup>182</sup> *Id.*

<sup>183</sup> *Id.*

<sup>184</sup> *Id.*

<sup>185</sup> *Id.*; COMPACT AMERICAN DICTIONARY OF COMPUTER WORDS: AN A TO Z GUIDE TO HARDWARE, SOFTWARE, AND CYBERSPACE (ed. By American Heritage Dictionaries, 1998); see also *Graphical User Interface (GUI)*, Webster's New World Computer Dictionary (10th ed. 2003), available at <http://nucats.library.northwestern.edu/cgi-bin/Pwebrecon.cgi?BBID=5661532>.

<sup>186</sup> *Id.*

<sup>187</sup> See e.g., Serrels, *supra* note 17; Matt Martin, *408 Fruit Ninja clones: How does China deal with its mobile problems?*, GAMESINDUSTRY.BIZ (July 24, 2013), <http://www.gamesindustry.biz/articles/2013-07-24-408-fruit-ninja-clones-how-does-china-deal-with-its-mobile-problems> (noting that the popular game *Fruit Ninja* has 408 clones in competition with the game at the time the article was published).

<sup>188</sup> *Id.*



*Ninja* clone available for download is Quantum Squid's *Veggie Samurai*.<sup>189</sup> *Veggie Samurai* painstakingly copies the mechanics of *Fruit Ninja*'s slicing concept and Asian-warrior motif.<sup>190</sup> Further, *Veggie Samurai* uses a very similar GUI logo to *Fruit Ninja*'s GUI logo.<sup>191</sup> The only difference between the two games is that *Veggie Samurai* employs a samurai theme with slightly different game modes and slicing graphics.<sup>192</sup>

As one of the most popular video games available, *Fruit Ninja* has been unable to prevent the willful and intentional copying of its uncopyrightable elements.<sup>193</sup> The only copyright protection afforded to the game is specific protection against the creation of a slicing game involving fruits and ninjas.<sup>194</sup> Even with this protection, *Fruit Ninja* is not able to exert protection over the slicing function of its game mechanics.<sup>195</sup> As current case law regarding video game copyrights show, the protection for each of these elements is limited.<sup>196</sup> So, with all of this said, if Half Brick Studios ever sought to sue Quantum Squid for cloning *Fruit Ninja*, would they win?

### 1. Copyright and Trade Dress Protection for *Fruit Ninja*

As a video game, *Fruit Ninja* qualifies as a copyrightable work. However, *Fruit Ninja*'s copyrightable elements are limited to the specific expressions of its Asian motif, fruits, sensei character, backgrounds, bombs and blades used. The Copyright Act's limiting doctrines prevent *Fruit Ninja* from being able to exert protection over the graphic elements comprising its look and feel. The doctrine of scènes à faire prevents *Fruit Ninja* from exerting protection over the elements comprising its look and feel because the use of a ninja, a ninja sword, bombs, and a sensei<sup>197</sup> character are necessary to depict ninjas slicing fruit.<sup>198</sup> Under the merger doctrine, most of *Fruit*

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<sup>189</sup> VEGGIE SAMURAI (Quantum Squid 2010); *see also* Serrels, *supra* note 17.

<sup>190</sup> *Id.* The layout of the interface design, mechanics, and theme are identical to *Fruit Ninja*. VEGGIE SAMURAI, *supra* note 189. *Veggie Samurai*'s graphic interface design is the exact same as *Fruit Ninja*'s in that both games have the high scores and score counters in the upper left hand corner, a pause button in the lower left, and a marker indicating three lives in the upper right hand corner. *Id.* Further, *Veggie Samurai* uses an Asian and food motif as well by choosing another Japanese Warrior, the samurai, and vegetables. In addition, the game's mechanics are the same as *Fruit Ninja*'s in that the game lobs vegetables in the same motion on the screen while requiring players to achieve combinations and avoid poison bottles that penalize players for hitting them. *Id.*

<sup>191</sup> *Id.* *Veggie Samurai*'s app icon shows a picture of a yellow bell pepper being sliced by a blade (from the upper right hand corner towards the lower left hand corner) with a yellow splatter.

<sup>192</sup> *Id.*

<sup>193</sup> Serrels, *supra* note 17.

<sup>194</sup> Spry Fox, LLC, 2012 WL 5290158 at \*8-9. *Fruit Ninja*'s copyright protection would provide limited protection against the copying of its premise, mechanics, obstacles, background, font, music, and sound effects due to the limiting doctrines of scènes à faire and the merger doctrine.

<sup>195</sup> Boyden, *supra* note 20, at 479 ("Even video games, despite being comprised of software, audio visual elements, plots, graphics, and characters, nevertheless have an uncopyrightable core: the actual play of the game.").

<sup>196</sup> Spry Fox, LLC, 2012 WL 5290158 at \*8-9; Tetris Holding, LLC, 863 F. Supp. 2d at 398.

<sup>197</sup> "Sensei" is Japanese for teacher. In most Asian themed games and movies, there is usually a bald and elderly character representing the protagonist's master/teacher.

<sup>198</sup> *See* Capcom U.S.A., Inc., 1994 WL 1751482 at \*15; Incredible Techs. Inc., 400 F.3d at 1015. In depicting a story or scene involving ninjas, elements such as a ninja sword, ninja master or teacher (sensei), black clothing, bombs, and ninja stars are inherent in describing ninjas and ninja culture.

*Ninja's* graphic user elements comprising its look and feel would also be limited in protection due to the limited amount of expressions available.<sup>199</sup>

The exploitation of these limitations are seen in the *Fruit Ninja* clone *Veggie Samurai*.<sup>200</sup> In *Veggie Samurai*, the elements of *Fruit Ninja's* bombs, slicing objects, sound effects, and an Asian warrior motif are closely copied to recreate the same feel and appearance only with a samurai theme and vegetables.<sup>201</sup> Thus, so long as clone developers do not copy the exact combination of elements used in *Fruit Ninja*, *Fruit Ninja* clones will likely survive copyright infringement claims.<sup>202</sup>

As a result of the elements constituting *Fruit Ninja's* look and feel not qualifying for copyright protection, *Fruit Ninja's* trade dress elements are not likely to be preempted by the Copyright Act.<sup>203</sup> As previously noted, the elements likely to be chosen as trade dress are unlikely to be protected under the Copyright Act.<sup>204</sup> Although each of these elements are copied by clone video games, original videogame developers cannot establish infringement. It is likely that the *Copyright Act* does not preempt *Fruit Ninja's* trade dress claims because there is not an adequate remedy to protect them under copyright law.

## 2. Acquired Distinctiveness Through Secondary Meaning

An examination of the length and manner of *Fruit Ninja's* proposed trade dress is likely to weigh in favor of secondary meaning. Over the past six years, *Fruit Ninja* has attained widespread popularity as the second most downloaded mobile video game ever, and will be the subject of a Hollywood motion picture.<sup>205</sup> Further, the total number of downloads for *Fruit Ninja* weigh in favor of a finding of secondary meaning.<sup>206</sup> As a result, it is likely that *Fruit Ninja's* use of their mark weighs in favor of acquired distinctiveness through secondary meaning.

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<sup>199</sup> *Id.* Under the merger doctrine, these elements receive a limited scope of protection because there are a limited number ways available to depict ninjas, fruits, sword-fighting sound effects, bombs, fruit, and elderly Asian men.

<sup>200</sup> VEGGIE SAMURAI, *supra* note 189.

<sup>201</sup> *Id.*

<sup>202</sup> In *Tetris Holding*, the Court noted that the defendant's copying of the original game created a near-exact replica of the original game. *Tetris Holding, LLC*, 863 F. Supp. 2d at 395-97. Further, the Court noted that had the defendant used any different combination of elements to recreate the same exact game, they could have avoided infringement. *Id.* at 416.

<sup>203</sup> 17 U.S.C. § 301(a). In establishing trade dress protection over the elements constituting *Fruit Ninja's* look and feel, *Fruit Ninja* must establish that there is not an adequate remedy under the Copyright Act that preempts a claim under the Lanham Act.

<sup>204</sup> FRUIT NINJA, *supra* note 15. *Fruit Ninja's* graphic user interface icon (GUI) features a white sword slash through a watermelon on a brown background with watermelon juice in appearing like a blood splatter. Other elements likely include the Asian motif of the game, slice and dice feel of the game, and the design layout of the game.

<sup>205</sup> *Fruit Ninja* has been sold and adapted for a variety of gaming consoles such as the iPhone, Android, Xbox 360, Playstation VR, and even its own arcade game over the course of six years. Further, New Line Cinema is producing a *Fruit Ninja* movie.

<sup>206</sup> Lovelock, *supra* note 180 (noting how after only five years on the market, *Fruit Ninja* had been downloaded on online marketplaces over one billion times).

*Fruit Ninja's* use of advertising using its GUI likely weighs in favor of secondary meaning. Since *Fruit Ninja's* initial release, Halfbrick Studios has made efforts to market their app using their trade dress in conjunction with other major manufacturers.<sup>207</sup> By joining with major brand partners, and its viral popularity, *Fruit Ninja* has made significant efforts to develop its registered trademark and trade dress, and thus weighs in favor of secondary meaning.

The use of *Fruit Ninja's* watermelon GUI and trade dress in newspapers and magazines weighs in favor of secondary meaning. As one of the most popular game apps in history,<sup>208</sup> *Fruit Ninja* has been the subject of much discussion; from its appearance on multiple gaming platforms, and onto the silver screen.<sup>209</sup> As a result, the widespread use of *Fruit Ninja's* trade dress will likely weigh in favor of possessing secondary meaning.

The defendant's intent in copying *Fruit Ninja's* trade dress weighs in favor of secondary meaning. Ownership of a registered mark and trade dress weighs in favor of the mark possessing secondary meaning.<sup>210</sup> Due to Halfbrick Studios possessing federal registrations over the mark and logo for *Fruit Ninja*,<sup>211</sup> this factor is likely to weigh in favor of *Veggie Samurai* acting in bad faith.<sup>212</sup>

### 3. Functionality

It is unlikely that the elements comprising *Fruit Ninja's* graphic user interface will uniformly be found non-functional. Most of the elements comprising *Fruit Ninja's* look, such as its Asian motif, are unlikely to be found as non-functional elements. Similar to the blocks used in *Tetris Holding, LLC*, *Fruit Ninja's* fruits, Asian motif, and ninja swords are not essential to creating the game, nor do they make the game materially more, or less, desirable.<sup>213</sup> Like *Tetris Holding*, the amount of options for a potential theme that a game developer has, makes any choice arbitrary, and therefore not functional. As a result, it is likely a court will find that *Fruit Ninja's* ninja and Asian theme, ninja sword, and fruit elements are not functional.

However, the elements comprising *Fruit Ninja's* feel would likely be ineligible as trade dress. With the exception of virtual reality games, most games are displayed on two-dimensional rectangular frames; a smartphone, TV, or computer screen. Most

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<sup>207</sup> Michael Barris, *Pillsbury Toaster Strudel taps Fruit Ninja app in More Fruit campaign*, MOBILE MARKETER (Aug. 11, 2014), <http://www.mobilemarketer.com/cms/news/advertising/18441.html>.

<sup>208</sup> Fashingbaeur Cooper, *supra* note 180; Lovelock, *supra* note 180.

<sup>209</sup> Davis, *supra* note 180; Hinkle, *supra* note 180.

<sup>210</sup> United States Patent & Trademark Office, *supra* note 105.

<sup>211</sup> FRUIT NINJA, Registration No. 3960787; FRUIT NINJA, Registration No. 4169727; FRUIT NINJA, Registration No. 4460863; FRUIT NINJA CHAMPION, Registration No. 4928001.

<sup>212</sup> Fashingbaeur Cooper, *supra* note 180; Lovelock, *supra* note 180. Due to a lack of direct evidence, the final two factors regarding consumer testimony and survey-evidence in the analysis is currently unclear. However, due to *Fruit Ninja's* widespread popularity, it is likely consumers identify the fruit and Asian warrior motif with *Fruit Ninja*. However, without direct evidence, these factors are currently undecided as to whether they indicate a secondary meaning.

<sup>213</sup> Inwood lab. Inc., 456 U.S. at 850 (noting that a product feature is functional if the feature is essential to the purpose of the product or affects the cost or quality of the product).

arcade style games employ some form of a health gauge, point counter, or a pause button. These elements are almost a necessary component in creating the user interface for a video game. In addition, due to the real-world limitations of screens having four corners, there are a limited amount of ways to place these elements on a screen. From this, it is unlikely that *Fruit Ninja* would be able to enjoin Quantum Squid or other developers from using a pause button or a point counter for a game.

#### D. Trade Dress Infringement

Because of *Fruit Ninja*'s trade dress having acquired secondary meaning, the strength of the plaintiff's mark indicates that there is a likelihood of confusion from *Veggie Samurai*'s use of similar trade dress.<sup>214</sup> Under the *Abercrombie* spectrum, *Fruit Ninja*'s trade dress receives protection as trade dress with acquired secondary meaning.<sup>215</sup> As a result, the strength of *Fruit Ninja*'s trade dress weighs in favor of there being a likelihood of confusion.

The similarity of the marks factor weighs in favor of there being a likelihood of confusion between *Fruit Ninja* and *Veggie Samurai* because of the amount of slavish copying done by clone developers like Quantum Squid. A side-by-side comparison of *Fruit Ninja* and *Veggie Samurai* yields little difference in the appearance of both games. Both games involve similar rules and gameplay with players slicing flying objects to score points while avoiding objects that subtract points.<sup>216</sup> The graphic layout used in both games during gameplay is nearly identical in placement.

Under the pixel analysis in *Conference Archives, Inc.*, both games are likely to have almost identical pixel placements, due to their location on the screen. Both games have a total of three lives displayed in the upper right hand corner of the screen, the high score and current player score in the upper left hand corner, and the pause button in the lower left hand corner.<sup>217</sup> However, due to the limited amount of ways in displaying this information, and the commonality of score counters and life counters, it is unlikely *Fruit Ninja* can claim protection over its counters beyond its immediate appearance, assuming it has secondary meaning. Thus, the similarity of *Veggie Samurai*'s pixel placement to *Fruit Ninja*'s trade dress is not likely to cause a likelihood of confusion.

The channels of trade or proximity of the goods factor weighs in favor of a likelihood of confusion due to both *Fruit Ninja* and *Veggie Samurai* being offered in Apple's App Store and Google's Android Market. Consumers seeking to find the game *Fruit Ninja* may have trouble finding Halfbrick Studio's popular game if they are uncertain about the exact spelling or name of the game.<sup>218</sup> When using a slightly

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<sup>214</sup> VEGGIE SAMURAI, *supra* note 189. Instead of ninjas and fruit, *Veggie Samurai* employs another type of Japanese Warrior and food item by using a samurai theme and vegetables.

<sup>215</sup> *Abercrombie & Fitch Co.*, 537 F.2d at 11-12.

<sup>216</sup> FRUIT NINJA, *supra* note 15; VEGGIE SAMURAI, *supra* note 189.

<sup>217</sup> *Id.*

<sup>218</sup> Search terms such as "Fruit Samurai," "Fruit Warrior," "Veggie Ninja," and "Ninja Slice" yield results of various clone games with similar trade dress and marks. In some instances, *Fruit Ninja* will appear as the top result when terms like "Fruit Samurai" and "Ninja Slice" are entered on the Apple App Store. However, right behind *Fruit Ninja* are clones with similar looking GUIs and names being

inaccurate spelling or variation of the word mark “*Fruit Ninja*,” the title is not one of the first titles to appear. A consumer who is unfamiliar with the exact title of the game could easily be tricked into downloading a clone version of *Fruit Ninja*. Thus, the proximity of the goods factor weighs in favor of a likelihood of confusion.

Further, the proximity of goods factor also weighs in favor of a likelihood of confusion due to most clone video games acting as substitutes to the original game. As a direct substitute or competitor, *Veggie Samurai* directly interferes with *Fruit Ninja*’s market share.<sup>219</sup> As a result, the proximity of goods factor weighs in favor of a likelihood of confusion among consumers.

The sophistication of consumer factor indicates a likelihood of confusion because low cost of game apps weighs in favor of a likelihood of confusion among consumers due to the low amount of care consumers exercise in purchasing smartphone apps.<sup>220</sup> Priced at \$0.99 USD on average, or offered for free, smartphone apps are commonly downloaded without much thought.<sup>221</sup> As a result, the sophistication of consumers factor weighs in favor of there being a likelihood of confusion among consumers.

#### IV. CONCLUSION

Through the use of trademark law, developers can successfully enjoin clone developers from exploiting the popularity of their games. Unlike the Copyright Act, the Lanham Act provides protection over trade dress elements on a case-by-case basis.<sup>222</sup> The Lanham Act can be used to bring a claim regarding non-protected aspects of the Copyright Act.<sup>223</sup> This allows game developers to overcome the hurdles of showing a substantial similarity before the trial stage in copyright claims.<sup>224</sup> Thus, under the Lanham Act, video game trade dress infringement claims are more likely to be adjudicated in front of a trier of fact.

The actions and intentions of clone developers are closer to trademark law in that they create a likelihood of confusion among consumers, as opposed to misappropriating an original expression from a copyrightable work and claiming ownership.<sup>225</sup> The main

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offered for free. For example, the search term “Fruit Samurai” has various clones immediately following it. In some cases, terms like “Fruit Warrior” will only show clone games of *Fruit Ninja* in the results.

<sup>219</sup> VEGGIE SAMURAI, *supra* note 189. Initially *Veggie Samurai* was available for free before it gained enough notoriety to charge consumers for downloads.

<sup>220</sup> Virgin Enter. Ltd., 335 F.3d at 151.

<sup>221</sup> See generally Nathan Olivarez-Giles, *Instagram Adds ‘Shop Now’ Button for In-App Impulse Buying*, WALL STREET JOURNAL (Nov. 1, 2016, 7:12 pm ET), <https://www.wsj.com/articles/instagram-adds-shop-now-button-for-in-app-impulse-buying-1478041969> (recognizing \$0.99 online purchases as “impulse” purchases); Thorin Klosowski, *How to Avoid Impulse Purchases in the Internet Shopping Age*, LIFE HACKER (June 20, 2012), <https://lifehacker.com/5919833/how-to-avoid-impulse-purchases-in-the-internet-shopping-age>.

<sup>222</sup> Buckman, *supra* note 83, at 558 (discussing how the Lanham Act examines cases on a cases-by-case basis, and allows most claims to make it in front of a trier of fact).

<sup>223</sup> Tetris Holding, LLC, 863 F. Supp. 2d at 416; Conference Archives, Inc., 2010 WL 1626072 at \*12.

<sup>224</sup> *Id.*

<sup>225</sup> *Id.*

purpose of trademark law, as codified in the Lanham Act, is meant to “prevent the use of identical or similar marks in a way that confuses the public about the actual source of goods and services.”<sup>226</sup> The actions of clone developers are exactly what the Lanham Act seeks to prevent.<sup>227</sup> The purpose of these actions by clone developers does not conform with the policy of the Copyright Act in that they do not seek to create a better version of a popular game like *Fruit Ninja*, but to rather merely benefit from the viral popularity of quality video games.<sup>228</sup> Moreover, trademark laws “primarily serve to prevent the use of identical or similar marks in a way that confuses the public about the actual source of goods and services.”<sup>229</sup>

The issue of cloning in video games harms both developers and consumers alike.<sup>230</sup> Due to a lack of resources and protection, small and famous developers have little power in enjoining the sale of clone video games.<sup>231</sup> From this, clone developers and their games are able to take advantage of a game’s popularity by using confusingly similar trademarks and trade dress without recourse.<sup>232</sup>

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<sup>226</sup> *Id.*; 15 U.S.C. § 1051 *et seq.*, Virgin Enter. Ltd., 335 F.3d at 149-150; Buckman, *supra* note 83, at 553-558.

<sup>227</sup> *Id.* at 558.

<sup>228</sup> Serrels, *supra* note 17; Justin Meyers, *Angry Clones are Taking Over the App World*, BUSINESS INSIDER (May 3, 2011), <http://www.businessinsider.com/angry-clones-are-taking-over-the-app-world-2011-5>.

<sup>229</sup> *Id.*

<sup>230</sup> See Don Reisinger, *Fake “Flappy Bird” Apps Spreading Malware, Experts Say*, CBS NEWS (Feb. 12, 2014), <http://www.cbsnews.com/news/fake-flappy-bird-apps-spreading-malware-experts-say/>; Jason Evangelho, *If You Download ‘Flappy Bird’ Now, Your Only High Score Will Be Your Phone Bill*, FORBES (Feb. 11, 2014), <http://www.forbes.com/sites/jasonevangelho/2014/02/11/if-you-download-flappy-bird-now-your-only-high-score-will-be-your-phone-bill/#538b9a8b4b24>; see also 15 U.S.C. § 1125(a); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23.1 (2016) (“[T]he test of likelihood of confusion is the touchstone of trademark infringement as well as unfair competition.”).

<sup>231</sup> See generally 15 U.S.C. § 1125(a); MCCARTHY, *supra* note 230 (“[T]he test of likelihood of confusion is the touchstone of trademark infringement as well as unfair competition.”) The problem of cloning is further exacerbated by the fact that most clone video games utilize similar word marks and trade dress to undercut the total number of downloads and sales of the original game. See Meyers, *supra* note 228 (noting that even highly successful game developers like Rovio, the creators of *Angry Birds*, are unable to prevent cloning);

15 U.S.C. § 1125(c) (noting owners of famous marks have federal dilution claims when there is either: 1) dilution by “blurring” or 2) dilution by “tarnishment.”); see also *Starbucks Corp. v. Wolfe’s Borough Coffee, Inc.*, 588 F.3d 97 (2d Cir. 2009) (explaining the requirements for dilution by blurring); *Victoria’s Secret Catalogue, Inc. v. Moseley*, 605 F.3d 382 (6th Cir. 2010) (explaining the requirements for dilution by tarnishment). Trademark dilution claims are designed to protect the goodwill, or the marketing value or selling power, of a famous mark regardless of whether consumers are confused. *Id.* For well-funded developers with famous marks, such as Nintendo and its world-famous *Pokemon* franchise, the use of confusingly similar marks and trade dress dilutes the strength of their famous marks by blurring and tarnishing their name. *Id.* Despite the value of a trade dress dilution claim to plaintiffs, the high hurdle of establishing their mark as famous limits the pool of video game developers who may claim ownership of a famous mark, let alone famous trade dress. 15 U.S.C. § 1125(c)(2)(a) (2012). As a result, most indie video game developers who suffer from consumer confusion arising from the creation a clone video are unable to qualify their marks as famous, and thus will not be discussed in this comment. *Id.*

<sup>232</sup> *Id.*

This lack of protection for video games is further exacerbated by the fact that most video game developers do not possess the necessary resources and capital to enjoin and seek damages against clone developers.<sup>233</sup> Unlike large developers, small and independent game developers do not possess legal departments or law firms on retainer.<sup>234</sup> Due to cost concerns, most small and indie game developers choose not to sue clone developers thus allowing most clone developers to operate with little consequence.<sup>235</sup> As a result, even when presented with a potential claim for copyright infringement, small and indie developers are unlikely to file a lawsuit.

In addition to video game developers, consumers are harmed by clone games due to the presence of malware and other fraud mechanisms hidden within some clone games.<sup>236</sup> Due to the use of similar marks and trade dress, some clone developers have utilized the popularity of a video game to not only profit off the original, but to exploit consumers through malware.<sup>237</sup> As a result, the confusion caused by cloned game apps harm both consumers and developers.

Although developers like Halfbrick Studios cannot bring a successful copyright infringement claim against clones,<sup>238</sup> they are more likely to succeed under the Lanham Act. In the case of games like *Fruit Ninja*, where most of the elements comprising the game's look and feel are uncopyrightable, game app developers can exert protection over their elements by acquiring secondary meaning as trade dress.<sup>239</sup> By establishing aspects that are uncopyrightable but are eligible for trade dress protection, game app developers can bring successful actions to show that slavish copies create a likelihood of confusion among consumers.<sup>240</sup>

Opponents to the use of trademark law for game apps, will likely argue that this method stunts the innovation and promotion of useful arts or curtails fair market competition. Contrary to this fear, court holdings, such as *Tetris Holding*, show that the use of trademark law is likely inapplicable in attempting to enjoin any game app that holds a requisite amount of originality and creativity.<sup>241</sup> In bringing a claim for trade dress infringement, developers must take care to articulate what

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<sup>233</sup> See Simon Parkin, *Clone Wars: Is Plagiarism Killing Creativity in the Games Industry?*, THE GUARDIAN (Dec. 23, 2011) <https://www.theguardian.com/technology/gamesblog/2011/dec/21/clone-wars-games-industry-plagiarism> (“[F]ollowing the rise of the App Store where, thanks to low costs and shorter development periods, studios can be far more responsive to popular trends, claims of game plagiarism are becoming more commonplace . . .”). Often small and independent video game studios lack the resources to afford legal help in preventing clone developers from confusing the public and selling their copied games. See also Serrels, *supra* note 17.

<sup>234</sup> *Id.*

<sup>235</sup> Serrels, *supra* note 17 (noting that video game developers are often aware that their video games are being blatantly copied but are forced to pick and choose their disputes due to a lack of resources and poor case precedent).

<sup>236</sup> See *supra* note 230.

<sup>237</sup> *Id.*

<sup>238</sup> Meyers, *supra* note 228; Serrels, *supra* note 17 (noting the limitations and challenges developers face in developing protecting their own games).

<sup>239</sup> *Id.*

<sup>240</sup> Conference Archives, Inc., 2010 WL 1626072 at \*21; Spry Fox, LLC, 2012 WL 5290158 at \*8-9; Tetris Holding, LLC, 863 F. Supp. 2d at 415-416.

<sup>241</sup> Tetris Holding, LLC, 863 F. Supp. 2d at 415-16 (noting that the infringement analysis may have been different if the defendant had not painstakingly copied the plaintiff's block design).

uncopyrightable elements in their game constitutes trade dress.<sup>242</sup> Thus far, instances where a clone game appears to be a cloned copy of the original's look and feel indicates a likelihood of success in exerting trade dress protection.<sup>243</sup>

Although comprised almost entirely of unoriginal elements, game apps like *Fruit Ninja* will be able to stop shameless copies of their games that are merely exploiting their popularity. In the instance of *Fruit Ninja*, a variety of elements comprising the game's look and feel that were not subject to copyright protection, are eligible for trade dress protection, and would be successful in enjoining clones like *Veggie Samurai*. By utilizing trade dress protection over non-copyrightable elements, the game app industry can effectively protect its innovations without hindering market competition or altering the idea-expression dichotomy.

Game apps have become a mainstay in the United States and in cultures across the world.<sup>244</sup> As technology continues to develop and newer forms of gaming become available, the role of game apps in modern culture will only continue to grow in salience and complexity as the medium develops.<sup>245</sup> Video games for smartphones represent an immensely innovative and vibrant sector of the video game industry.<sup>246</sup>

However, the increased ease of development has allowed for the direct and open exploitation of game apps by competitors, not seeking to innovate or create a better game, but to merely profit off of consumer confusion. This gap in protection goes directly against the Copyright Act's intention to incentivize the creation of useful arts and threatens to deter new developers from developing game apps out of fear that their hard work will be stolen and dangled in front of their faces.

Although game developers have long accepted that copyright law would play a negligible role in protecting their original creations,<sup>247</sup> the decisions from *Tetris Holding, LLC, Conference Archives, Inc.*, and other cases, demonstrate a judicial awareness that clone game app developers carefully appropriate uncopyrightable elements to exploit consumer confusion. The utilization of trade dress protection over uncopyrightable elements in digital-graphic designs and interfaces creates the opportunity to end the rampant cloning of popular video games.

In doing so, video game developers may seek to protect their works under current laws in place, as opposed to lobbying for a shift in copyright law that diminishes the distinction between ideas and expressions in order to preserve the artistic integrity of the game app industry. While the reinterpretation of trade dress protection for digital display and designs has yet to receive the approval of appellate courts, there is hope that lower courts will continue to develop this distinctive body of case law. In doing

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<sup>242</sup> *Spry Fox, LLC*, 2012 WL 5290158 at \*8-9 (holding that plaintiff failed to establish a claim of trade dress infringement due to a lack of specificity as to what elements constituted trade dress). Using the break down of elements constituting a digital work's look and feel, developers can increase the likelihood of their claims succeeding past the pleading stages in court. *Conference Archives, Inc.*, 2010 WL 1626072 at \*10-12.

<sup>243</sup> *Tetris Holding, LLC*, 863 F. Supp. 2d at 415-416. *Tetris Holding, LLC* has been the only successful case to exert trade dress protection against a slavish copy. Despite the games in *Tetris Holding, LLC* being near-identical copies of each other, the court in *Spry Fox, LLC* appeared to hint that trade dress could still be exerted in instances where the look and feel of the game was recreated without the appropriation of protected elements. *Spry Fox, LLC*, 2012 WL 5290158 at \*77.

<sup>244</sup> Epstein, *supra* note 1; Lunden, *supra* note 1.

<sup>245</sup> *Id.*; Morris, *supra* note 12.

<sup>246</sup> Epstein, *supra* note, 1; Lunden, *supra* note 1; Morris, *supra* note 12.

<sup>247</sup> Serrels, *supra* note 17.



so, courts and plaintiff video game developers can stand up to the onslaught of clone video games intentionally copying popular games, to only create and benefit from consumer confusion.