DaVinci Editrice S.R.L. v. ZiKo Games

No. H-13-3425, 2016 WL 1718825, (S.D. Tex. 2016)

At the very outset of this case concerning copyright protection in games, the US District Court struck out DaVinci's claims against ZiKo that copying the method of play and rules of best-selling card game Bang! infringed its copyright.

DaVinci's 'Bang!' is a best-selling card game, introduced in 2002 and based upon 'Wild West' themes. The game has unique rules and the cards have creative design and distinctive artworks, the result being a distinctive game with novel appearance, game play rules and character abilities. Not surprisingly, DaVinci garnered a US copyright for a 'card game in box with instruction sheet[1].' ZiKo's 'Legend of the Three Kingdoms,' ('Legend') introduced in 2008, has virtually identical rules. In the lawsuit[2] brought by DaVinci to enforce its copyright, *DaVinci Editrice S.R.L. v. ZiKo Games*[3], the US District Court observed that the only differences between the two games were the theme of Legend and the character names and appearance. In court, ZiKo admitted this was the case. DaVinci also had uncontroverted evidence that Legend's developer had access to Bang! and was inspired by Bang!

Game rules and mechanics and copyright protection

DaVinci lost because the seemingly broad subject matter of copyright under §102(a) for 'original works of authorship fixed in a tangible medium of expression[4]' is expressly tempered by §102(b)[5]. Copyright protection does not extend to ideas, procedures, or methods of operation, regardless of the form in which it is embodied in work[6]. Indeed, as to games, the US Copyright Office website warns: 'Copyright does not protect the idea for a game, or the methods for playing it[7].' Accordingly, at the outset of the *DaVinci* case, the court struck out DaVinci's claims against ZiKo that copying the method of play and rules of Bang! infringed its copyright, stripping DaVinci's position down to a claim that the scheme of characters and roles in Bang! were substantially similar to the corresponding components of Legend.

This type of ruling dates back to the days of the Wild West. In 1879, the United States Supreme Court held that the copyright for a book about bookkeeping did not create an exclusive right to make, sell, and use account books prepared with the system the book describes[8]. In 1929, the author of a copyrighted book about the card game Bridge lost in federal court on his claim that another publication of the rules of Bridge infringed his copyright[9]. In short, once a game has been made public, nothing in copyright law prevents others from developing a game based on similar principles[10].

Game material may be subject to copyright

Accordingly, DaVinci could not assert its game rules as covered by copyright from the outset. Nor could DaVinci allege similarity between visual artwork, the text of the instructions or themes, as they were markedly different. Courts have held that mechanical and structural similarity between the plaintiff's and defendant's games will not constitute infringement absent a similarity of artwork[11]. Unfortunately for DaVinci, there was no similarity in artwork. "Copyright does not protect the ideas underlying a work or other aspects that are beyond the scope of the Copyright Act[12]." The court considered the only claim DaVinci could bring - that Legend infringed DaVinci's copyright pertaining to the characters, roles and interactions in Bang!

What elements constitute protectable content?

Distinctive characters

While game play is not protectable, the characters' appearance and names can be. For example, in court, 'Pac-Man' characters were protected, while the game play - a character chomping its way through dots in a maze while being chased - was not[13]. However, substantial appropriation of the Pac-Man characters infringed on protectable expression. Pac-Man and the ghost monsters were protected due to their unique design and fanciful nature "without reference to the real world[14]." Their distinctive character alone was held to constitute material of substantial value[15]. The defendant's infringing 'Gobbler' had only been changed superficially, and like Pac-Man, had a v-shaped mouth that rapidly opens and closes - an intentional appropriation of the expressive qualities of Pac-Man[16].

Unlike the dreamed-up ideation of Pac-Man, the characters of Bang! were viewed by the court as "stock" characters typical to the genre of "spaghetti Westerns," with "good guys" versus "bad guys[17]." The roles of such characters, indistinct and undeveloped beyond stock characters of the Wild West, are not protectable by copyright[18]. Score - another 'hit' for ZiKo.

Creative character abilities

Copyright protection may be available if characters have distinctive enough abilities, such as "fanciful special moves[19]." For example, in a Street Fighter II type of video game, kicking and punching would be "stock," while the ability to slap opponents repeatedly at a humanly impossible speed is "fanciful," and protected[20].

In Bang!, DaVinci's characters did not have imaginative moves. Standard attack-game abilities like enhanced attack range and increased strength were not protected. Moreover, in Bang!, the special character abilities were merely a subset of the rules, such as a female character being able to strike from further away[21], without literary or artistic aspects.

Plot-like event progression

Theoretically, a game could have a progression of events that make the game expressive[22]. Characters, plots and settings can be protected in video games as within the scope of copyright[23]. The named characters in Bang! lacked any specific plot or backstory, and were not copied in Legend.

Practical considerations for enhancing game IP protection

Creating a 'family' of related game products may support a fruitful claim for trade dress protection under the Lanham Act, without the necessity of registration[24]. Section 43(a) of the Lanham Act gives a cause of action for 'false designation of [the] origin' of goods or 'false or misleading representation[s] of fact[25].' Were DaVinci to expand across the field of role-playing games with similarly named products, it is more likely that a competitor could have been seen as misrepresenting their product as DaVinci's, or trading off of DaVinci's good will. The standard under the Lanham Act is the likelihood of confusion in the marketplace, typically demonstrated in court by consumer surveys.

Developing a family of products may also strengthen the copyright 'substantial similarity' claim. In *Spry Fox*[26], a court held while the title 'Triple Town' is not itself copyrightable, the fact that another company chose the title 'Yeti Town' was potentially relevant to the substantial similarity inquiry. It was "at least plausible" to infer that the title was chosen because the creator was copying 'Triple Town,' which meant that the case could at least get to a jury[27].

Unfortunately, protecting rules and methods for board, table and card games by patent in the wake of *Bilski*[28] and *Alice*[29] is also highly challenged. Implementing the game of bingo on a computer to allow users on a computer network to play each other remotely was found to present "abstract" ideas not subject to patent[30] under Section 101 of the America Invents Act[31]. Similarly, applying the rules and game play of wagering games may be viewed, under current law, simply as a "method of exchanging and resolving financial obligations based upon probabilities," or an "abstract idea" akin to a "fundamental economic practice," unworthy of patent protection[32].

To the extent the game to be protected has a novel layout or format for its appearance, some incremental protection less dependent upon artwork or gross appearance may come in the form of a design patent[33]. Shape, configuration and surface ornamentation may be protected by design patent. They are relatively inexpensive to obtain, and allow the owner to use the terms 'patent pending' or 'patented' on the product. Copyright and design patent protection are not mutually exclusive, and may be obtained simultaneously.

Other methods of protection, including design patent and creation of distinctive trade dress, should be considered as part of the strategy to protect a new game. While these protections may be limited, copyright alone does not cover everything in the box. And the best protection of a good game is most likely timely replication across different themes.

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1. Bang! Dodge City 1st ed., Registration No.VA0001952097, 2015-01-28, http://cocatalog.loc.gov
2. DaVinci Editrice S.R.L. v. ZiKo Games, LLC, No. H-13-3425, 2016 WL 1718825, at *1 (S.D. Tex. 2016).
3. Yoka Games is based in the People's Republic of China; its US distributor, ZiKo, is based in Texas. DaVinci sued both defendants under the Copyright Act of 1976. This article will refer to the defendants collectively as 'Yoka.'
4. 17 U.S.C. § 102(a).
5. 17 U.S.C. § 102(b).
6. Ibid.
7. Copyright Registration of Games, US Copyright Office, FL-108 (2011), www.copyright.gov/fls/fl108.pdf
8. Baker v. Selden, 101 U.S. 99 (1879).
9. Whist Club v. Foster, 42 F.2d 782 (S.D.N.Y. 1929).
10. Copyright Registration of Games, U.S. Copyright Office, FL-108 (2011), www.copyright.gov/fls/fl108.pdf
11. Melville B. Nimmer & David Nimmer, Nimmer on Copyright. Sec. 2:18[J][3](a) (2010).
12. Spry Fox 2012 WL 5290158 at 4.
13. Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 618 (7th Cir. 1982).
14. Ibid.
15. Ibid. at 619.
16. Ibid.
17. DaVinci Editrice S.R.L. v. ZiKo Games, LLC, No. H-13-3425, 2016 WL 1718825, at *20 (S.D. Tex. 2016).
18. Nichols v. Universal Pictures Corp., 45 F.2d 119, 121 (2d Cir. 1930).
19. Capcom U.S.A., Inc. v. Data E. Corp., No. C 93-3259 WHO, 1994 WL 1751482, at *9 (N.D. Cal. Mar. 16, 1994).
20. Ibid. at *20.
21. Motion for Summary Judgment, ZiKo Games, LLC, Ex. 6 at 110:6-10, DaVinci Editrice S.R.L. v. ZiKo Games, LLC, No. H-13-3425, 2016 WL 1718825, at *9 (S.D. Tex. 2016).
22. Spry Fox LLC v. LOLApps Inc., 2012 WL 5290158 (W.D. Wash. Sept. 18, 2012).
23. Ibid. at 5.
24. 15 U.S.C. § 1051, et seq.
25. 15 U.S.C. § 1125(a).
26. Spry Fox LLC v. LOLApps Inc., 2012 WL 5290158 at *6 (W.D. Wash. Sept. 18, 2012).
27. Ibid.
28. Bilski v. Kappos, 561 U.S. 593 (2010).
29. Alice Corp. v. CLS Bank International, 573 U.S., 134 S. Ct. 2347 (2014).
30. Planet Bingo, LLC v. VKGS LLC, 576 F. App'x 1005, 1007-8 (Fed. Cir. 2014).
31. Pub. L. No. 112-29, 125 Stat. 284.
32. In re Smith, 815 F.3d 816, 818, 819 (Fed. Cir. 2016). See also Race Tech, LLC. V. Kentucky Downs, LLC, 2016 WL 843382, at *4-9 (W.D. KY, March 1, 2016).
33. 35 U.S.C. § 171.