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Trade Marks – Overview

- Purpose
 - give an indication of origin
 - give an indication of quality – for example Tesco Value, Rolls-Royce
 - advertising function
 - investment – it can be sold, assigned, licensed, and be subject to security
- Justification
 - the basic function is to denote the origin and quality and to reward the manufacturer who consistently produces goods of a particular quality
 - the monopoly granted can be unlimited, Bass plc registered a mark in 1876, the first mark to be registered in the UK and it is still valid today
 - personal property right

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Trade Marks – Subject matter

A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

- a) distinguishing the goods or services of one undertaking from those of other undertakings; and
- b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.

(Directive 2015/2436 (Trade Mark Directive), Article 3)

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Trade Marks and Video Games

- TMs include names, logos, colours, sounds, shapes, slogans, symbols or non-traditional signs
- TM considerations are relevant regarding:
 - Protection of assets connected with both physical and digital products and services
 - Trade mark infringement claims to pursue creators and distributors of emulators and ROMs, cheat software, or video game clones
 - The use of third-party TMs within video games, with or without authorisation (under the doctrine of the First Amendment, US, whereby video games have the same free speech protections as other “expressive works” such as films, books and music)

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EUTM Application Number 017282203



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J.W. Spear v Zynga (UK)
(Scrabble v Scramble with Friends)



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Trade Marks and Free Speech (US)

Brown v. Entertainment Merchants Ass'n, 131 S.Ct. 2729 (2011) – the Supreme Court held that video games have the same free speech protections as other “expressive works” such as films, books and music and thus invalidating a California statute that prohibited the sale of violent video games to minors

- *Rogers test (Rogers v. Grimaldi)*, determines if an artistic work is protected under free speech by looking at whether:
 1. the use of another's trademark in an expressive work has some “artistic relevance” to the underlying work; and
 2. the use “explicitly misleads as to the source or the content of the work.”

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The Use of Third-party TMs (US)

E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.

- Trade mark protection is limited to confusion regarding the *origin* of a product, the use of a trade mark within a video game does not amount to consumer confusion



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Design Law – Overview

- Registered and unregistered designs (UK / EU), trade dress and design patents (US)
- Protects the appearance of a product (both physical and digital), from static icons to dynamic animated characters, interfaces, virtual spaces, etc. such as :
 - Box design
 - 3D models and environments
 - GUIs and icons

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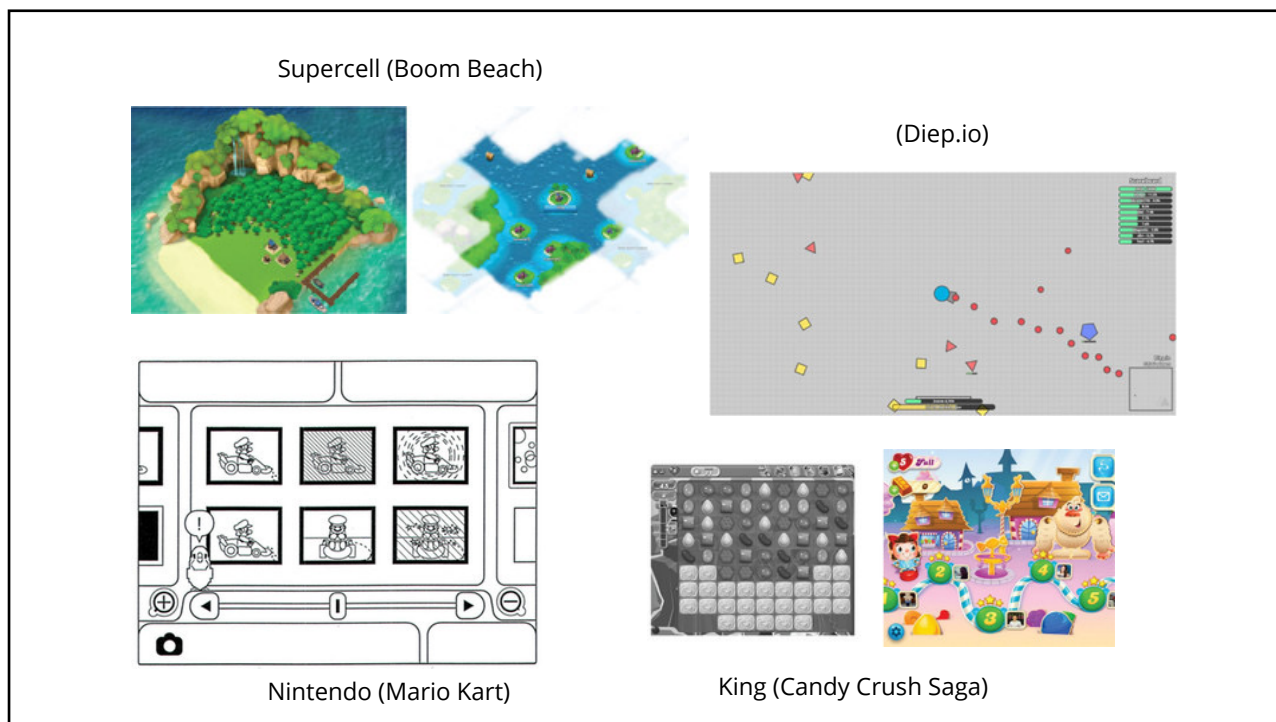
Registered Designs

- Legal requirements:
 - It must be novel
 - It must have an individual character
 - Designs do not protect features of appearance of a product which are solely dictated by its technical function
- Significance – potential protection against cloning

IELR 3.1: Rosie Burbidge, 'A lost destiny or world of warcraft? Unlocking the hidden power of designs'

IELR 4.2: Emmanuelle Sarlangue, 'Registered Community designs in the video game industry: a neglected yet potent tool'

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Confidential Information / Trade Secrets

- Most legal systems do not recognise trade secret as exclusive rights as such, but rather a specific legal remedy designed to protect the secrecy put up by the rightsholder, which is based on different legal principles, such as unfair competition, general principles of tort law, contract law or breach of confidence in common law jurisdictions
 - The Trade Secret Directive establishes a minimum standard of protection
 - It specifically states that trade secrets are not considered intellectual property rights, which also precludes the application of the Enforcement Directive

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Trade Secrets

- Defend Trade Secrets Act (DTSA) 2016 **US**
- Directive 2016/943 (Trade Secrets Directive) **EU**
- Objective is to harmonise the legal framework in order to boost innovation and competitiveness, minimum standard
- Article 2(1) defines trade secret through the following requirements:
 - is secret – in the sense that it is not (as a body or in the precise configuration and assembly of its components) generally known among or readily accessible to persons within the circles that normally deal with this kind of information
 - has commercial value because it is secret
 - has been subject to reasonable steps (under the circumstances) to keep it secret by the person lawfully in control of the information.
- *Oculus v. ZeniMax*

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Rights of Publicity

- A property right that protects against the misappropriation of a person's name, likeness, or other indicia of personal identity – such as nickname, pseudonym, voice, signature, likeness, or photograph – for commercial benefit
 - US
 - State law level, statute or case law
 - *Rogers* test, transformative use analysis
 - Outside US
 - Personality and image rights, different legal regimes
 - Related protection: trade marks
 - Related claims: copyright claims, privacy and defamation claims

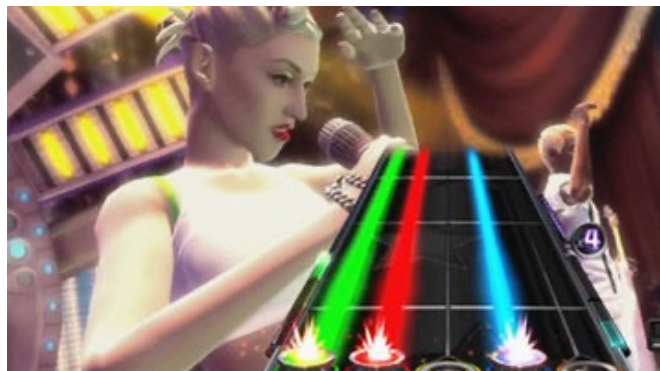
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Kirby v. Sega of America [Court of Appeals, Second District, 2006]



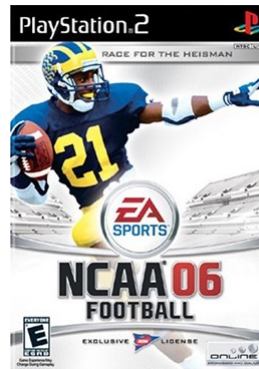
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No Doubt v. Activision [Court of Appeal, Second District, 2011] [settled in 2012]



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Ryan Hart v. Electronic Arts [3rd Circ, 2013]



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Lindsay Lohan v. Grand Theft Auto V



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Key Points

- Managing the specifics of video games presents a real challenge when it comes to IP protection
- From an IP law perspective, numerous aspects of video games remain unclear, which can cause problems for video game developers, publishers, and even players
- Each type of IPR plays a specific role in the overall business and IP strategy and it is important that stakeholders carefully consider all aspects of protection, management and enforcement
- Commercialisation = ownership of your assets + access to third-party assets + IPRs + licensing

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In-class Exercise

- Work together in small groups of 3-4 students.
- Your company wants to include purchasable NFTs representing well-known brands, products, and celebrities. Examples include:
 1. Nike Air trainers
 2. Lamborghini Aventador
 3. Marta Viera da Silva (Brazilian footballer)
 4. Kim Kardashian's clothing line SKIMS
 5. The Apple logo
- Draft a memo outlining the potential legal issues and recommending a course of action, considering IPRs and other related rights, and any jurisdictional differences.

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Thank you!