Clone Wars: When Does Imitation Become Infringement?

by Sean F. Kane

Since the inception of the video game age, game developers have looked to successful games for inspiration. In some cases this has resulted in the creation of sub-genres of games serving the same niche markets while in other cases it has led to nearly identical games being made available by different entities. The latter situation is what led the owner of the renowned game Tetris to file suit against Xio Interactive Inc. over its game Mino. Mino is a falling block game which incorporates gameplay rules similar to Tetris, as well as utilizing a similar playing area and geometric block combinations.

Following Mino's appearance in Apple's iTunes store, Tetris Holding, LLC sent Apple a takedown notice under the Digital Millennium Copyright Act and then initiated an action against Xio under theories of copyright and trade dress infringement in a suit entitled *Tetris Holding, LLC v. Xio Interactive, Inc.,* Civil Action No. 09-6115 (D. N.J.).

Xio admitted to downloading a copy of Tetris and creating what amounted to a "clone" of the game, but claimed that it had taken steps to only copy the non-protectable elements of Tetris. These steps even included obtaining an opinion from legal counsel. Xio alleged it was safe from Tetris Holding's reprisal since Mino only copied "rules, function and expression" which were "essential to the gameplay" but which did not constitute original protectable expression.

In granting summary judgment to Tetris Holdings on both counts, the court found that the look and feel of Tetris is copyrightable as the expression of the idea distinguishable from the ideas of the game. In its opinion the court reiterated the well-known refrain that game developers are free to use others' ideas, but not the **expression** of those ideas. The court noted that the idea-expression dichotomy in the video game world is "simple to state—copyright will not protect an idea, only its expression—but difficult to apply, especially in the context of computer programs." In discussing the different tests set forth in other opinions, the court attempted to put them in the video game context by stating generally that "game mechanics and rules are not entitled to protection, but courts have found expressive elements copyrightable, including game labels, design of game boards, playing cards and graphical works." However, the court stated that

Xio was mistaken in thinking that this notion meant that "*any and all expression* related to a game rule or game function is unprotectible."

The court went on to describe the functional game-mechanics of Tetris in summary form and clarified that these rules are "the general, abstract ideas underlying Tetris and cannot be protected by copyright." However, the court determined that Xio did more than just incorporate Tetris' underlying rules in Mino. In looking at the similarity of the look and feel of the two games, the court stated that "[t]here is such similarity between the visual expression of Tetris and Mino that it is akin to literal copying" regardless of the fact that Xio did not actually copy the underlying Tetris code. The court noted that "the style of the pieces is nearly indistinguishable, both in their look and in the manner they move, rotate, fall, and behave. Similar bright colors are used in each program, the pieces are composed of individually delineated bricks, each brick is given an interior border to suggest texture, and shading and gradation of color are used in substantially similar ways to suggest light is being cast onto the pieces." The court then explained that the look and shape of the pieces were not necessarily functional, as similar playing games could be designed using dissimilar pieces. The court described other problematic similarities between *Tetris* and *Mino* such as the game board dimensions, the manner in pieces are displayed, and the appearance of the completed game board. The Court found that the movements of the blocks in Tetris were not merely functional, but expressions associated with those elements.

Developers should not take away from this case the message that similar games will always infringe. The court took steps to note that its decision was not intended to limit the applicability of the doctrines of "scènes à faire" or "merger." The doctrine of scènes à faire means that certain expressions are so associated with a particular genre, motif or idea that one is compelled to use the expression. Additionally, the defense under the doctrine of merger arises when an idea and expression have become so synonymous that they are virtually inseparable. Protection does not exist in ether of these circumstances, as to do so would be tantamount to giving a monopoly over the idea. Following its descriptions of the both doctrines the court merely found them to be inapplicable to the current case. As Tetris is a wholly fanciful creation and unique puzzle game the court found that it does not have any stock or common elements that must be included. Moreover, the doctrine of merger was found inapplicable by the court because even Xio's own expert admitted that many ways could have been chosen to express the novel *Tetris* elements.

The take-away from this case should be that developers must be thoughtful in the ways they pay homage to other games. Refraining from literal copying of the underlying code of a game is a good practice but is not necessarily sufficient to protect what is otherwise a "clone" game. Introducing novel elements in a game along with only using what are clearly unprotectible ideas from another game should be the guiding factors for any developer. Moreover, it is important to work with learned counsel experienced in how the idea-expression dichotomy may play out in the video game space in order to identify what are usable ideas versus protected expression. Finally, developers should take note that Xio's admissions of its actions and the level of thought that went into its copying of Tetris really proved Tetris Holding's case for them. Had Xio not been so forthcoming it is unlikely this case would have been decided at the summary judgment stage.

If you have questions, please contact the Pillsbury attorney with whom you regularly work or the attorneys below:

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