

# Leveling Up IP Protections For Video Game Icons' Film Debuts

By **Joshua Weigensberg and Parmida Enkeshafi** (July 16, 2024)

Video games are increasingly transforming the entertainment landscape through commercially and critically successful television and film adaptations, such as "The Super Mario Bros. Movie," HBO's "The Last of Us," and Amazon's "Fallout." These adaptations have brought beloved video game characters into new media and broadened their popularity.

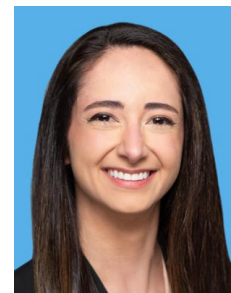
The success of many of these adaptations can be rightfully attributed in part to the strength of preexisting intellectual property assets, which often include iconic characters from the video games being adapted. Understanding the legal protections for these characters is therefore crucial to fight against unauthorized use and ensure proper licensing.

In this article, we explore IP protections available for video game characters and discuss the steps that creators can take to safeguard their rights in those characters. By understanding these protections, video game developers can ensure their characters are properly protected as they venture into new realms of entertainment.

For international developers and publishers looking to protect their IP in the U.S. and ensure that their creative assets are adequately safeguarded in this key market, it is crucial to understand and navigate the specific legal frameworks that apply to video game characters.



Joshua Weigensberg



Parmida Enkeshafi

## Copyright Protections

One way to protect characters, including those born out of video games, is through copyright law.

Copyright law will not protect the name, standing alone, or the general idea of a character.[1] Moreover, the U.S. Copyright Office will not register a copyright in a character separate and apart from the work in which the character appears.[2] Rather, copyright protection extends to the detailed expression of the character in a tangible, fixed form.[3]

For works of the performing arts, a character can be protected by copyright if it contains sufficient original authorship in its depiction or description. This protection covers the unique expression in, for instance, visual or written form.[4]

For visual works of art, the visual aspects of a character, such as facial features and clothing, can be protected by copyright if they are sufficiently developed. The Copyright Office may register works containing such visual aspects of a character, but the registration will not extend to aspects of the character that are not depicted in the material submitted to the Copyright Office.[5]

A key question in assessing whether a character is protected by copyright often is the degree of delineation and distinctiveness of the expression of the character within a work.

In one 1940 case, *Detective Comics Inc. v. Bruns Publications Inc.*, the U.S. Court of Appeals for the Second Circuit held that the defendant's "Wonderman" character impermissibly copied "the pictorial and literary details" embodied in the Superman comic books.

These details included Superman's characteristics of possessing extraordinary strength and speed, maintaining a secret identity, wearing tight acrobatic costumes, leaping between tall buildings, stopping bullets and crushing guns with his bare hands.[6]

It is worth noting that in the 84 years since that case was decided, many of those attributes arguably have become commonplace genre elements, and so it is possible that the case would come out differently if tried today.

More recently, in its 2015 decision in *DC Comics v. Towle*, the U.S. Court of Appeals for the Ninth Circuit determined that the Batmobile, owned by DC Comics, was eligible for copyright protection as a character.[7] In reaching this conclusion, the court found that the Batmobile possessed distinct physical and conceptual qualities through its depictions in comic books, movies and TV shows; that it was "sufficiently delineated," based on consistently appearing characteristics such as its bat-themed design, high-tech gadgets and crime-fighting capabilities; and that those characteristics, plus its unique name and other attributes, made it "especially distinctive."

In so holding, the court also provided a counterexample of a character that may not merit protection, writing that a "masked magician dressed in standard magician garb whose role is limited to performing and revealing the magic tricks ... is not an especially distinct character differing from an ordinary magician in a manner that warrants copyright protection." [8]

Although these cases provide illustrations of how the courts have resolved the question of protections over certain characters in the past, the inquiry is a fact-intensive one and IP owners are best served by assessing the strength of their own, or of others', rights in characters.

## **Trademark Protections**

Video game characters can also be protected under trademark law, which the Ninth Circuit's 2005 opinion in *Bosley Medical Institute Inc. v. Kremer* said is designed "to prevent the use of identical or similar marks in a way that confuses the public about the actual source of goods and services." [9]

Video game characters can function as trademarks when they are source-identifying, and the companies that own such trademarks may enforce them against infringers. Many courts have recognized trademark protection for graphic characters.

However, just because a character appears in a video game, that does not mean the character functions as a trademark. The U.S. Patent and Trademark Office's "Manual of Examining Procedure" provides that "[m]arks that merely identify a character in a creative work, whether used in a series or in a single work, are not registrable." [10]

In 2023, in *In re: Joseph A. Stallard*, the USPTO refused to register an image of a video game character as a trademark on the grounds that the image was not source-identifying where, for instance, there was no evidence that the character's image appeared on the sites where the game was sold or on the game's launch screen. [11]

The USPTO manual advises that, in examining whether a character is being used in a trademark function, it may look to whether the character appears on the packaging or physical media on which a creative work is sold and whether the character appears on displays associated with the creative work.[12]

One note of caution to video game developers is that video game companies may find themselves accused of trademark infringement based on the characters they include in their games. In *Universal City Studios Inc. v. Nintendo Co.*, Universal sued Nintendo, claiming that the video game "Donkey Kong" infringed its trademark for "King Kong." [13]

Nintendo was able to avoid liability, however, based in part on the differences between the two characters' names — "Donkey" versus "King" — and the many differences between the entertainment properties in which the characters appeared. The U.S. Court of Appeals for the Second Circuit's 1984 opinion said: "The two properties have nothing in common but a gorilla, a captive woman, a male rescuer and a building scenario." [14]

## **Efforts to Protect Video Game Characters**

### ***Princess Peach***

The character of Princess Peach, also originally known as Princess Toadstool in earlier Western releases, has become one of the most iconic figures in video game history. First appearing in the groundbreaking game "Super Mario Bros." for the Nintendo Entertainment System in 1985, Princess Peach has played a pivotal role in the franchise's enduring popularity.

The Super Mario Bros. Movie, released on April 5, 2023, capitalized on the strong brand recognition of the Mario franchise, and benefited significantly from its established fan base, and the broad appeal of its animation and humor. The movie's success at the box office can also be attributed to the familiarity and affection that fans have for the franchise's characters.

In terms of intellectual property protection, Princess Peach is the subject of several trademark and copyright registrations. These registrations include at least one trademark registered by Nintendo. For copyright, Princess Peach appears in the titles of many different registrations.

### ***Jinx***

"League of Legends," developed and published by Riot Games Inc., launched on Oct. 27, 2009, and has become a staple in the gaming and e-sports communities due to its dynamic gameplay and rich lore. Riot Games enhances player engagement by using trailers and animated videos to introduce new champions. Jinx, a playable champion, was introduced in October 2013 with the animated trailer, "Get Jinxed."

Riot Games obtained a registration for that trailer. That registration may function as one way to protect Jinx as a character prior to her in-game debut. Riot Games has also obtained trademark registrations for Jinx. Jinx is now also one of the central figures in "Arcane," an animated series that has received critical acclaim, appeared consistently in Netflix's Top 10, and won multiple Annie Awards and a Primetime Emmy for Outstanding Animated Program.

## **Steps to Protect IP Rights in Characters**

For those who create or own rights in video games, whether based in the U.S. or abroad, there are several steps that can be taken, consistent with the above considerations, to help maximize legal protections over the characters that appear in those games and reduce legal exposure as well, which include:

- Create unique and original characters: Develop characters with distinctive features, storylines and traits, to strengthen your rights in the characters, avoid similarities with existing popular characters and reduce the risk of infringement claims.
- Protect characters as elements of a broader copyrighted work: Ensure that your copyrights in the visual and written expressions of your characters are registered. When completing an application to register such works, refer to the Copyright Office guidance including its compendium and the guidelines therein.
- Register your trademarks in character names and designs: Protect character names, distinctive visual elements and logos that you have used in a source-identifying manner by registering them as trademarks to prevent others from using similar marks that could cause consumer confusion.
- Monitor and enforce character IP: Actively monitor the use of your characters and take legal action against unauthorized use or infringement, to maintain the integrity and value of your IP assets.
- Draft clear licensing agreements for character use: When licensing characters, create detailed agreements specifying the scope, duration, and financial terms to ensure proper use and compensation.
- Document your creation process: Keep detailed records of the development process, including sketches, drafts and iterations, to demonstrate the originality and evolution of your characters.
- Conduct thorough IP searches: Utilize public databases to check for existing trademarks and copyrights, ensuring your characters and their names are unique and original.
- Conduct proper due diligence: For parties that are licensing intellectual property assets for in-game use, or acquiring rights via mergers and acquisitions, conduct proper due diligence, including a comprehensive chain-of-title review.
- Be cautious around artificial intelligence: Use of AI technologies may accelerate development — but it can also jeopardize your ability to protect, and therefore enforce and exploit, your copyrights, including in characters.

Companies that are considering adapting video games, including the characters from those games, for films or television series may also consider the following:[15]

- Clearly delineate rights: Provisions governing which rights are granted should be carefully and specifically crafted so that it is clear which rights are granted to the studio and which are reserved to the rightsholder.

- Collaborate with rightsholders: Engage game creators in the adaptation process to leverage their insights, maintain character authenticity in the adaptation format, and preserve the integrity and good will in those characters.
- Consider who owns new elements: New creative elements added in the adaptation that do not exist in the underlying property may become the property of the studio that is creating the adaptation.
- Plan for character-centric marketing: Marketing strategies that highlight the connection between the game characters and their adapted versions may help to leverage the existing fanbase as part of promoting the film or series and to strengthen trademark rights in the characters.
- Discuss enforcement: Make sure it is clear which party is responsible for enforcing the intellectual property rights in the characters.

---

*Joshua Weigensberg is a partner and Parmida Enkeshafi is an associate at Pryor Cashman LLP.*

*The opinions expressed are those of the author(s) and do not necessarily reflect the views of their employer, its clients, or Portfolio Media Inc., or any of its or their respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.*

[1] U.S. Copyright Office, Compendium of U.S. Copyright Office Practices § 313.4(H) Characters, Copyrightable Authorship: What Can Be Registered (3d ed. 2021); Compendium (Third) § 804.3(B) Characters, Works of the Performing Arts; Compendium (Third) § 911 Characters, Visual Art Works.

[2] Compendium (Third) § 313.4(H) ("A registration for a visual art work, a literary work, or a work of the performing arts that depicts or describes a character covers the expression set forth in the deposit copy(ies), but it does not cover the character per se."); Compendium (Third) § 911 ("Applicants should not refer to or assert claims in 'character,' 'character concept, idea, or style,' or a character's generalized personality, conduct, temperament, or costume.").

[3] Compendium (Third) §§ 313.4(H), 804.3(B), 911.

[4] Compendium (Third) § 804.3(B).

[5] Compendium (Third) § 911.

[6] *Detective Comics, Inc. v. Bruns Publ'ns Inc.*, 111 F.2d 432 (2d Cir. 1940).

[7] 802 F.3d 1012 (9th Cir. 2015).

[8] *Id.* at 1019 (cleaned up).

[9] *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005) (citing *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942)).

[10] Trademark Manual of Examining Procedure (TMEP) § 1202.10, Names and Designs of Characters in Creative Works, Use of Subject Matter as Trademark.

[11] In re Joseph A. Stallard, 2023 USPQ2d 1009 (TTAB 2023).

[12] TMEP § 1202.10.

[13] 746 F.2d 112 (2d Cir. 1984).

[14] Id. at 117.

[15] See generally Simon Pulman & Briana Hill, Four Entertainment Deal Considerations for IP Rightsholders (and One for Entertainment Studios), PryorCashman.com, <https://www.pryorcashman.com/simon-pulman/publications/four-entertainment-deal-considerations-for-ip-rightsholders-and-one-for-entertainment-studios> (Apr. 17, 2023).