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Intellectual Property and Tabletop Games

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ABSTRACT: There is a rich body of literature regarding intellectual property's ("IP") "negative spaces"—fields where creation and innovation thrive without significant formal protection from IP law. Scholars have written about innovation in diverse fields despite weak or nonexistent IP rights, such as fashion design, fine cuisine, stand-up comedy, magic tricks, tattoos, and sports plays. Instead, these fields rely on social norms, first-mover advantage, and other (non-IP) legal regimes to promote innovation in the absence of IP protection.

As a comparison to these studies, this Article comprehensively analyzes the role of IP law in facilitating innovation in tabletop gaming, including board games, card games, and pen-and-paper role-playing games. Over the past several decades, the tabletop gaming industry has seen a proliferation of innovation, but there is surprisingly little in the academic literature about IP and tabletop games. IP rights, including patents, copyrights, and trademarks, each protect certain aspects of games, while at the same time being constrained by doctrinal limitations that leave considerable flexibility for others to develop their own games and adapt or improve upon existing ones. There are also numerous examples of user-based innovation in tabletop gaming. This Article concludes by contending that IP rights, as well as their limitations, play a significant role in facilitating the robust innovation presently occurring in the tabletop gaming field.

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I. INTRODUCTION

Tabletop games are nearly as old as civilization itself.[1] Thousands of years before *Monopoly*, games like *Senet* and *The Royal Game of Ur* were played from Egypt to modern-day India.[2] Dice—an integral part of many modern games—have been found in archeological sites in places as far flung as Pakistan, Scotland, and Mexico.[3] Playing cards originated in ninth century AD China.[4] Even widely played games like checkers, chess, dominos, and backgammon have a lengthy lineage, with their predecessors dating back a millennia or more.[5]

Despite this rich history, innovation in the modern tabletop gaming industry is abundant. Board games are currently experiencing a "golden age," with a wide range of options, game types, and price points.[6] Over the past few decades, there has been a proliferation of new and innovative games, ranging from Euro-style board games like *Settlers of Catan*,[7] worker placement games like *Agricola*,[8] cooperative games like *Pandemic*,[9] role-

1. As used in this Article, "tabletop games" and "tabletop gaming" are defined broadly to encompass nearly all games that can be played on a tabletop or similar surface, including board games, card games, pen-and-paper role-playing games, and miniature wargames. *See Tabletop Game*, LEXICO, https://www.lexico.com/en/definition/tabletop_game [https://perma.cc/T9HT-VRB8] (defining "tabletop game" as "a game played on a flat surface, such as a board game or card game"); ERNEST ADAMS, FUNDAMENTALS OF GAME DESIGN, at xv (2d ed. 2009) (referring to "tabletop games" as "card games such as poker, board games such as *Monopoly*, and so on"). Video games and computer games are excluded from our definition of tabletop gaming, but it does include board games with electronic components.

2. *See* JACK BOTERMANS, THE BOOK OF GAMES: STRATEGY, TACTICS & HISTORY 711–14 (Edgar Loy Fankbonner trans., 2008); TRISTAN DONOVAN, IT'S ALL A GAME: THE HISTORY OF BOARD GAMES FROM MONOPOLY TO SETTLERS OF CATAN 9–18 (1st ed. 2017); Grant Piper, *The 5,000 Year Old Games We're Still Playing Today*, MEDIUM: HIST. OF YESTERDAY (Sept. 27, 2020), https://medium.com/history-of-yesterday/the-5-000-year-old-games-were-still-playing-today-b47c679f6b42 [https://perma.cc/Y8NR-JCFN]. A copy of "the game of thirty squares"—now called Senet—was found buried in Pharaoh Tutankhamun (King Tut)'s tomb. DONOVAN, *supra*, at 10–11.

3. *See generally* V. Gordon Childe & J. Wilson Paterson, *Provisional Report on the Excavations at Skara Brae, and on Finds from the 1927 and 1928 Campaigns*, 63 PROC. SOC'Y ANTIQUARIES SCOT. 225 (1929) (explaining discovery in Scotland); George F. Dales, *Of Dice and Men*, 88 J. AM. ORIENTAL SOC'Y 14 (1968) (explaining discovery in Pakistan); Barbara Voorhies, *The Deep Prehistory of Indian Gaming: Possible Late Archaic Period Game Boards at the Tlacuachero Shellmound, Chiapas, Mexico*, 24 LATIN AM. ANTIQUITY 98 (2013) (explaining discovery in Mexico).

4. *See* Andrew Lo, *The Game of Leaves: An Inquiry into the Origin of Chinese Playing Cards*, 63 BULL. SCH. ORIENTAL & AFR. STUD. 389, 401 (2000).

5. DONOVAN, *supra* note 2, at 19–50.

6. *See* Casey Phillips, *Physical Board Games Are Experiencing a 'Golden Age'*, ASSOCIATED PRESS (Sept. 3, 2016), https://apnews.com/article/75bde6bfa11a4844bad636697ce509bc; *see also* Alex Fitzpatrick, *This Board Game Designer Isn't Sorry About Taking a Big Risk*, TIME (June 30, 2016, 8:00 AM), https://time.com/4385490/board-game-design ("People have described [this] as a golden age. There's a lot of innovation happening, a lot of people stretching the space.").

7. KLAUS TEUBER, THE SETTLERS OF CATAN (Mayfair Games 1996).

8. UWE ROSENBERG, AGRICOLA (Z-Man Games 2008).

9. MATT LEACOCK, PANDEMIC (Z-Man Games 2008).

playing games ("RPGs") like *Dungeons & Dragons,*[10] and card-based games like *Magic: The Gathering.*[11] In the past several years, board game sales have soared, driven by lockdowns and school closures due to the COVID-19 pandemic.[12] The tabletop gaming market is expected to exceed $20 billion in annual sales by 2025,[13] not far behind other major entertainment industries like recorded music and the movie box office.[14]

Traditionally, intellectual property ("IP") law has been viewed as a key driver of innovation. Indeed, the Constitution itself embodies a utilitarian view of IP, expressly conditioning the grant of patent and copyright rights to a particular purpose—namely, "[t]o promote the Progress of Science and useful Arts."[15] More recently, however, some legal scholars have challenged this view by identifying numerous industries where innovation occurs "without significant . . . protection" from IP law.[16] In these so-called "negative spaces," creativity thrives despite weak or nonexistent IP rights.[17] Instead, creators in these fields rely on social norms, first-mover advantage, and other (non-IP) legal regimes to facilitate innovation.

As a comparison, this Article critically examines the role of IP law in promoting innovation in the tabletop gaming industry. Despite being a source of entertainment and distraction for millions of Americans, there is surprisingly little in the academic literature regarding IP and tabletop games.[18] This Article seeks to fill this notable gap in the literature by

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10. GARY GYGAX & DAVE ARNESON, DUNGEONS & DRAGONS (TSR, Inc. 1974). There are numerous editions of *Dungeons & Dragons*; the current 5th edition was released in 2014. *See infra* Part V.A (discussing the history of the game).

11. RICHARD GARFIELD, MAGIC: THE GATHERING (Wizards of the Coast LLC 1993).

12. *See* Erick Bauer, The NPD Group, *U.S. Toy Industry Experienced 19 Percent Growth in the First Three Quarters of 2020*, CISION PRWEB (Oct. 30, 2020), https://www.npd.com/wps/portal/npd/us/news/press-releases/2020/us-toy-industry-experienced-19-percent-growth-in-the-first-three-quarters-of-2020 [https://perma.cc/HSM6-SB5Q].

13. *See* Grand View Research, Inc., *Playing Cards & Board Games Market Size Worth $21.56 Billion by 2025: Grand View Research, Inc.*, CISION PR NEWSWIRE (Oct. 9, 2019, 6:35 AM), https://www.prnewswire.com/news-releases/playing-cards—board-games-market-size-worth-21-56-billion-by-2025-grand-view-research-inc-300934566.html [https://perma.cc/8F3R-TDXJ].

14. *See* Marie Charlotte Götting, *Global Recorded Music Revenue From 1999 to 2020*, STATISTA (July 14, 2021), https://www.statista.com/statistics/272305/global-revenue-of-the-music-industry [https://perma.cc/5SS3-2PSV] (finding total revenue of the recorded music industry in 2019 was $21.5 billion); José Gabriel Navarro, *Global Box Office Revenue from 2005 to 2020*, STATISTA (Aug. 12, 2021), https://www.statista.com/statistics/271856/global-box-office-revenue [https://perma.cc/BW9W-FCBQ] (finding total revenue of the global box office in 2019 was $42.2 billion).

15. U.S. CONST. art. I, § 8, cl. 8.

16. *See* Elizabeth L. Rosenblatt, *Intellectual Property's Negative Space: Beyond the Utilitarian*, 40 FLA. ST. U. L. REV. 441, 442 (2013) (defining "intellectual property's 'negative spaces'" as "areas where creation and innovation thrive without significant formal intellectual property protection").

17. *See infra* notes 36–43 and accompanying text.

18. The handful of articles that have addressed various forms of IP protection for board games include Bruce E. Boyden, *Games and Other Uncopyrightable Systems*, 18 GEO. MASON L. REV.

conducting the first comprehensive assessment of IP protection for tabletop games.

Tabletop games occupy a unique space at the intersection of patent, copyright, and trademark law.[19] Each major IP regime offers legal protection for certain aspects of games, but with significant limitations and exceptions that allow others to create their own games and improve upon existing ones. For example, copyright law can protect the illustrations and visual appearance of games, as well as expressive text describing how to play a game, but not the underlying rules or methods of play.[20] In contrast, a game's mechanics and components may be protectable under patent law, but only if it is novel and nonobvious and can satisfy current jurisprudence regarding patent eligibility, which generally precludes patenting abstract ideas like a set of game rules.[21] Trademark law precludes others from using a name, symbol, or logo that is the same or confusingly similar to an existing game to market their own games,[22] but it too is subject to numerous exceptions, such as parodies[23] and terms that have become generic.[24] In addition, there are numerous examples of user-based innovation in tabletop gaming, such as fan-created expansions and modifications of existing games.[25]

The remainder of this Article proceeds as follows. Part II summarizes IP's role in incentivizing innovation generally, starting with an overview of the theoretical justifications for IP law, followed by a more detailed discussion of existing scholarship regarding IP's negative spaces. Part III provides an overview of the tabletop gaming industry. Part IV analyzes the scope of intellectual property protection for various aspects of tabletop gaming, including copyrights, patents (both utility and design), and trademarks. Next, Part V evaluates how IP law has impacted the creation, development, and evolution of several landmark games—*Dungeons and*

439 (2011); William K. Ford & Raizel Liebler, *Games Are Not Coffee Mugs: Games and the Right of Publicity*, 29 SANTA CLARA COMPUT. & HIGH TECH. L.J. 1 (2012); Shubha Ghosh, *Patenting Games:* Baker v. Selden *Revisited*, 11 VAND. J. ENT. & TECH. L. 871 (2009); Kevin P. Hales, *A Trivial Pursuit: Scrabbling for a Board Game Copyright Rationale*, 22 SETON HALL J. SPORTS & ENT. L. 241 (2012); Daniel J. Schaeffer, *Not Playing Around: Board Games and Intellectual Property Law*, 7 LANDSLIDE 40 (2015); *see also* Pamela Samuelson, *Why Copyright Law Excludes Systems and Processes from the Scope of Its Protection*, 85 TEX. L. REV. 1921, 1942–44 (2007) (discussing copyright law's exclusions under § 102(b) and its application to games).

19. *See* Boyden, *supra* note 18, at 441 ("[G]ames exist at the boundary of intellectual property law.").

20. *See infra* Section IV.A.

21. *See infra* Section IV.B.

22. *See infra* Section IV.C.

23. *Cf.* Cards Against Human., LLC v. Vampire Squid Cards, LLC, Opposition No. 91225576, 2019 WL 1491525 (T.T.A.B. Feb. 28, 2019) (rejecting a parody claim).

24. *See, e.g.*, Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., Inc., 684 F.2d 1316, 1321 (9th Cir. 1982).

25. *See infra* notes 543–47 and accompanying text.

Dragons, *Magic: The Gathering*, and *Settlers of Catan*—in the form of case studies. Part VI discusses a number of implications regarding IP law's role in facilitating innovation in the tabletop gaming field. Part VII briefly concludes.

II. IP AND INNOVATION: THEORY AND LIMITS

This Part provides a brief overview of the theoretical justifications for IP law and its role in promoting innovation. It also discusses the growing body of scholarship about industries where innovation thrives despite the absence or inapplicability of IP protection.

In the United States, utilitarian theory has "long provided the dominant paradigm for analyzing and justifying the various forms of intellectual property protection."[26] According to this theory, "[b]y granting exclusivity to creators . . . intellectual property law enables them to profit from their work, thereby creating an incentive for them to create."[27] In short, the primary goal of IP law is the "promotion of new and improved works—whether technological or expressive."[28]

For patents and copyrights, this utilitarian principle is enshrined in the Constitution itself, which provides that "Congress shall . . . promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."[29] The Supreme Court has repeatedly reaffirmed an innovation-based rationale for patent and copyright protection.[30] Trade secrecy also is justified as incentivizing innovation by providing an alternative form of legal protection for discoveries and information,[31] particularly those that may not be patentable,[32] although this claim has been contested by some scholars.[33]

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26. PETER S. MENELL, ROBERT P. MERGES, MARK A. LEMLEY & SHYAMKRISHNA BALGANESH, 1 INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGICAL AGE: 2020, at 16 (2020). For a discussion of alternative theories regarding IP beyond utilitarianism, see generally ROBERT P. MERGES, JUSTIFYING INTELLECTUAL PROPERTY (2011)).

27. Elizabeth L. Rosenblatt, *A Theory of IP's Negative Space*, 34 COLUM. J.L. & ARTS 317, 318 (2011).

28. MENELL ET AL., *supra* note 26, at 16.

29. U.S. CONST. art. I, § 8, cl. 8.

30. *See* Diamond v. Chakrabarty, 447 U.S. 303, 307 (1980) ("The patent laws promote this progress by offering inventors exclusive rights for a limited period as an incentive for their inventiveness and research efforts. . . . in the hope that [t]he productive effort thereby fostered will have a positive effect on society through the introduction of new products and processes of manufacture into the economy . . . ." (citations omitted)); United States v. Paramount Pictures, Inc., 334 U.S. 131, 158 (1948) ("[T]he primary object in conferring the [copyright] monopoly lie in the general benefits derived by the public from the labors of authors. . . . [R]eward to the author or artist serves to induce release to the public of the products of his creative genius." (internal quotation marks omitted)).

31. *See* Mark A. Lemley, *The Surprising Virtues of Treating Trade Secrets as IP Rights*, 61 STAN. L. REV. 311, 329–32 (2008).

32. *See* Kewanee Oil Co. v. Bicron Corp., 416 U.S. 470, 485 (1974) ("Trade secret law will encourage invention in areas where patent law does not reach, and will prompt the independent innovator to proceed with the discovery and exploitation of his invention."); *see*

And although trademark law does not directly incentivize innovation, it can help promote a competitive and efficient business environment where innovation can thrive by reducing consumer confusion, encouraging investments in product quality, and preventing cheap knockoffs.[34]

More recently, however, the traditional theoretical justifications for IP have been called into question by a group of studies that have shown the existence of a high degree of innovation in certain industries despite low or nonexistent protection under IP law. Part empirical research and part ethnographic study, these articles regarding IP's so-called "negative space"[35] delve into the innovation ecosystems of fields as diverse as fashion design,[36]

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also WILLIAM M. LANDES & RICHARD A. POSNER, THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW 356–57 (2003) (arguing that trade secrets are preferable for a rational inventor when patent protection is too costly in relation to the value of his or her invention).

33. *See also* Laura G. Pedraza-Fariña, *Spill Your (Trade) Secrets: Knowledge Networks as Innovation Drivers*, 92 NOTRE DAME L. REV. 1561, 1588–96 (2017) (asserting that strong trade secret protection may adversely affect the creation of knowledge networks, which are key drivers of innovation); Michael Risch, *Why Do We Have Trade Secrets?*, 11 MARQ. INTELL. PROP. L. REV. 1, 26 (2007) ("[C]reating incentives to innovate is a very minor justification of trade secret law."). *See generally* Robert G. Bone, *A New Look at Trade Secret Law: Doctrine in Search of Justification*, 86 CAL. L. REV. 241, 270 (1998) (contending that trade secrecy "keeps information from the public with a potentially significant adverse impact on future innovation").

34. *See generally* George A. Akerlof, *The Market for "Lemons": Quality Uncertainty and the Market Mechanism*, 84 Q.J. ECON. 488, 499–500 (1970) (explaining how brand names, which are protected by trademark law, can counteract the effects of quality uncertainty); *see also* Union Nat'l Bank of Tex., Laredo, Tex. v. Union Nat'l Bank of Tex., Austin, Tex., 909 F.2d 839, 844 (5th Cir. 1990) (explaining "that trademarks are 'distinguishing' features which . . . encourage higher quality production by discouraging free-riders"); WORLD INTELL. PROP. ORG., 2013 WORLD INTELLECTUAL PROPERTY REPORT: BRANDS—REPUTATION AND IMAGE IN THE GLOBAL MARKETPLACE 3 (2013), https://www.wipo.int/edocs/pubdocs/en/intproperty/944/wipo_pub_944_2013.pdf [https://perma.cc/CQZ4-KCM7] (contending that trademarks and branding are "an important element of a vibrant innovation ecosystem"); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 270 (1987) (noting that trademarks "are valuable because they denote consistent quality, and a firm has an incentive to develop a trademark only if it is able to maintain consistent quality").

35. *See* Kal Raustiala & Christopher Jon Sprigman, *When Are IP Rights Necessary? Evidence from Innovation in IP's Negative Space*, *in* 1 RESEARCH HANDBOOK ON THE ECONOMICS OF INTELLECTUAL PROPERTY LAW 309, 311 (Ben Depoorter & Peter S. Menell eds., 2019) (defining the phrase "negative space" in the IP context as "encompass[ing] any . . . creative art, craft, or act that does not enjoy or at least does not ordinarily rely on IP rights against copyists, either because IP is formally inapplicable or because something—perhaps a social norm against IP enforcement, or a legal or economic barrier that discourages resort to formal IP—limits its salience"); Rosenblatt, *supra* note 27, at 319 ("In IP law, negative space is a series of nooks, crannies and occasionally oceans—some obscure, some vast—where creation and innovation thrive in the absence of intellectual property protection.").

36. C. Scott Hemphill & Jeannie Suk, *The Law, Culture, and Economics of Fashion*, 61 STAN. L. REV. 1147 (2009); Kal Raustiala & Christopher Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, 92 VA. L. REV. 1687 (2006); Kal Raustiala & Christopher Sprigman, Response, *The Piracy Paradox Revisited*, 61 STAN. L. REV. 1201 (2009); KAL RAUSTIALA & CHRISTOPHER JON SPRIGMAN, THE KNOCKOFF ECONOMY: HOW IMITATION SPARKS INNOVATION (2012).

fine cuisine,[37] stand-up comedy,[38] magic tricks,[39] tattoos,[40] graffiti,[41] sports plays,[42] and even roller derby names.[43] These studies find that in spaces where IP provides little protection, norms and other incentives have helped drive innovation. Several of these common non-IP incentives are described below.

First, "[m]any negative space studies have documented the powerful role social norms play in stimulating innovation and constraining appropriation."[44] In these fields, creators are members of a cohesive and relatively small community that have developed their own shared sense of norms regarding sharing, copying, and attribution of creative works. For example, in the magic community, it is common for professional magicians to share new tricks with other magicians after practicing them exclusively for a period of time.[45] However, a user or improver of another's magic trick is expected to credit the original creator, and in no event may any professional magician share information about how to perform another's trick with non-magicians (i.e., the general public).[46] If a creator violates these norms, informal sanctions are imposed by other members of the community—for example, group boycotts of joke stealers by other comedians,[47] or shunning by other magicians and producers of props for disclosing magic tricks to laypersons.[48]

Second, creators in some "negative space" industries rely on market positioning, such as first-mover advantage and market power, to help make

37. Christopher J. Buccafusco, *On the Legal Consequences of Sauces: Should Thomas Keller's Recipes be Per Se Copyrightable?*, 24 CARDOZO ARTS & ENT. L.J. 1121 (2007); *see also* Naomi Straus, Note, *Trade Dress Protection for Cuisine: Monetizing Creativity in a Low-IP Industry*, 60 UCLA L. REV. 182, 189–208 (2012).

38. Dotan Oliar & Christopher Jon Sprigman, *There's No Free Laugh (Anymore): The Emergence of Intellectual Property Norms and the Transformation of Stand-Up Comedy*, 94 VA. L. REV. 1787 (2008).

39. Jacob Loshin, *Secrets Revealed: Protecting Magicians' Intellectual Property Without Law*, *in* LAW AND MAGIC: A COLLECTION OF ESSAYS 123 (Christine A. Corcos ed., 2010).

40. Aaron Perzanowski, *Tattoos & IP Norms*, 98 MINN. L. REV. 511 (2013).

41. Cathay Y.N. Smith, *Street Art: An Analysis Under U.S. Intellectual Property Law and Intellectual Property's "Negative Space" Theory*, 24 DEPAUL J. ART, TECH. & INTELL. PROP. L. 259 (2014).

42. F. Scott Kieff, Robert G. Kramer & Robert M. Kunstadt, *It's Your Turn, But It's My Move: Intellectual Property Protection for Sports "Moves,"* 25 SANTA CLARA COMPUT. & HIGH TECH. L.J. 765, 765 (2009).

43. David Fagundes, *Talk Derby to Me: Intellectual Property Norms Governing Roller Derby Pseudonyms*, 90 TEX. L. REV. 1093, 1096–98 (2012).

44. Raustiala & Sprigman, *supra* note 35, at 314; *see also* Rosenblatt, *supra* note 27, at 339 ("If an industry is capable of internal regulation through norms, it has less need for intellectual property protection, and norms can facilitate the creation of negative space through IP forbearance.").

45. Loshin, *supra* note 39, at 126–27.

46. *Id.* at 128–30, 136–37.

47. Oliar & Sprigman, *supra* note 38, at 1818–20.

48. Loshin, *supra* note 39, at 137–39.

up for the lack of IP protection. Dan Burk and Mark Lemley have explained that "[i]n some industries, being first to market is critically important . . . because it allows the first entrant to establish strong brand recognition or because network effects reward those who are first to build a customer base."[49] In such fields, the advantages of lead time may provide sufficient incentive to innovate, even in the absence of IP law.[50] First-mover advantage and network effects also appear important to driving innovation in industries like computer software, social media, and cryptocurrencies.[51]

Third, in some fields, the exclusivity provided by IP law would ultimately harm rather than promote innovation. For instance, as Kal Raustiala and Christopher Sprigman have explained, the fashion industry depends on copying to create "induced obsolescence"—that is, once a rare, high-status item like a fashion design becomes widely available through copying by others, it loses its prestige and distinctiveness, and elite fashion designers are then motivated to create innovative new designs.[52] "Copying is thus a basic element of the [fashion] industry's trend-driven business model."[53] Likewise, in sports, "innovation thrives without patent protection because athletes know that they benefit more from being able to imitate and build upon the work of their skilled colleagues than through legal protection."[54]

In sum, scholars of IP's "negative space" contend that not only is innovation possible without IP protection, in at least some cases the existence of strong IP rights actively hinders it.[55] Indeed, Mark Lemley has referred to IP as "faith-based," contending that in the absence of evidence that IP rights stimulate innovation in many industries, proponents of stronger IP protection essentially operate from a position of belief.[56] As Lemley and others acknowledge, however, the impact of IP on innovation is industry-specific.[57]

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49. Dan L. Burk & Mark A. Lemley, *Policy Levers in Patent Law*, 89 VA. L. REV. 1575, 1585 (2003).

50. *Id.* at 1585–86.

51. *Id.* at 1588; Rosenblatt, *supra* note 27, at 348; *see also* John M. Yun, *Does Antitrust Have Digital Blind Spots?*, 72 S.C. L. REV. 305, 326–33 (2020) (discussing network effects and social media platforms); Raina S. Haque, Rodrigo Seira Silva-Herzog, Brent A. Plummer & Nelson M. Rosario, *Blockchain Development and Fiduciary Duty*, 2 STAN. J. BLOCKCHAIN L. & POL'Y 139, 158 (2019) (noting "the strong positive network effects experienced by public blockchain networks").

52. Raustiala & Sprigman, *The Piracy Paradox: Innovation and Intellectual Property in Fashion Design*, *supra* note 36, at 1718–28.

53. Raustiala & Sprigman, *supra* note 35, at 322.

54. Rosenblatt, *supra* note 27, at 349. Notably, many professional sports leagues in the United States prohibit patenting of sports moves. *See* Gerard N. Magliocca, *Patenting the Curve Ball: Business Methods and Industry Norms*, 2009 BYU L. REV. 875, 876–77.

55. *See, e.g.*, Raustiala & Sprigman, *supra* note 35, at 324 ("Taken together, the [negative space] studies we have described suggest that the incentives created by IP rights are not as central to innovation as conventional wisdom suggests.").

56. Mark A. Lemley, *Faith-Based Intellectual Property*, 62 UCLA L. REV. 1328, 1344–46 (2015).

57. *See* Burk & Lemley, *supra* note 49, at 1577 ("A wealth of empirical evidence demonstrates deep structural differences in how industries innovate."); Lemley, *supra* note 56, at 1334 ("The

In some fields, the exclusivity provided by IP law is beneficial or even necessary for innovation.[58]

Despite this wealth of industry-specific "negative space" studies, there has been no attempt in the scholarly literature to date to comprehensively analyze the impact of IP law on innovation in a multibillion-dollar entertainment industry that tens of millions of Americans at least intermittently participate in and enjoy: tabletop gaming. The remainder of this Article attempts to fill that gap.

III. THE TABLETOP GAMING INDUSTRY

This Part describes the key features and aspects of the tabletop gaming industry. It first provides an overview and short history of the industry. Next, it identifies the major segments of the industry and their publishers. The following section describes the basic process of inventing a new tabletop game. Finally, it explains the various means by which game designers, publishers, and players interact to create a cohesive community, particularly in the realm of hobby games.

A. OVERVIEW AND HISTORY

Despite its long history, the world of tabletop games looks much different than it did in the 1930s, when *Monopoly* was first released.[59] Although mass-market games like *Monopoly* have never truly lost their appeal, there has been a dramatic increase in the past few decades in the quantity, quality, and types of games that are sold and played, including European-style board games ("Eurogames"), card-based games, hobby/specialty games, and pen-and-paper RPGs. This section provides a short summary of the development and evolution of tabletop games.

Historically, many tabletop games were abstract and positional in nature. Ancient games like backgammon, go, mancala, and chess involve moving physical discs or pieces within a defined playing space, where one side's move influences the choices available to his or her opponent.[60] Some of these games, like chess, were purely skill-based, while others, like backgammon, involved an element of luck.[61] Chance-driven games using

relationship between patents and innovation seems to depend greatly on industry . . . ."); *see also* Dan L. Burk, *Law and Economics of Intellectual Property: In Search of First Principles*, 8 ANN. REV. L. & SOC. SCI. 397, 411 (2012) ("[I]t seems likely that exclusive [IP] rights are performing different roles in different economic sectors.").

58. *See, e.g.*, Lemley, *supra* note 56, at 1334 (noting that "some evidence suggests that the patent system is worth the cost in the biomedical industries").

59. CHARLES DARROW, MONOPOLY (Parker Bros. 1935); *see also infra* notes 204–05 and accompanying text (describing the history of *Monopoly*).

60. *See* DAVID PARLETT, PARLETT'S HISTORY OF BOARD GAMES 83–86, 167–78, 207–12, 276–86 (2018).

61. *Id.* at 19.

objects such as twigs, shells, stones, bone fragments, and later carved objects such as cubical dice and teetotum, also were widely played.[62] Playing cards arose in China during the Tang Dynasty and were imported into Europe in the 14th century, quickly spreading to royal courts and then later to the middle and lower classes of society.[63]

During the Industrial Revolution, theme-based games like *Snakes & Ladders*, *Mansion of Happiness*, and *The Checkered Game of Life* (a predecessor to the better-known 1960s' *Game of Life*) arose, which required players to navigate pieces around a game board.[64] These games were aimed at the growing middle class, which experienced an increase in leisure time and disposable income, and often had a moral theme or message.[65] By the early twentieth century, firms such as Milton Bradley, Parker Brothers, and Waddingtons were publishing and distributing tabletop board games for the mass market.

In the decades following World War II, mass-market board games dominated the tabletop gaming market, including well-known games that are still regularly played like *Clue*, *Risk, Trouble*, *Battleship, Diplomacy*, and *Stratego*. At the same time, new types of games emerged. *Scrabble*, the first popular word game, was created in 1938 but not widely distributed until 1952, when the department store Macy's began to carry it, selling nearly four million copies in 1954 alone.[66] Wargames—board games that simulate battles and campaigns—came into their own in the 1950s, when Charles S. Roberts[67] developed the first mass-market wargame, *Tactics*, and then created the gaming company Avalon Hill to publish *Tactics II* and *Gettysburg*, the latter of which was the first wargame based upon a historical battle.[68] Eventually, hundreds of wargames were published by Avalon Hill and others, essentially forming their own subcategory of games.[69] Miniature gaming using physical models made of plastic or metal and played on a flat surface

62. *Id.* at 19–32.

63. *See generally* DAVID PARLETT, A HISTORY OF CARD GAMES (1991) (exploring the history of card games).

64. PARLETT, *supra* note 60, at 91–94, 100–01.

65. *See generally* MARGARET K. HOFER, THE GAMES WE PLAYED: THE GOLDEN AGE OF BOARD & TABLE GAMES (2003) (examining rare and popular board games in America).

66. DONOVAN, *supra* note 2, at 135–48; *see also* Bernadette Murphy, *One Tile at a Time: How Scrabble Conquered the World*, CHI. TRIB. (Aug. 7, 2001), https://www.chicagotribune.com/news/ct-xpm-2001-08-07-0108070013-story.html [https://perma.cc/T7C5-5PXM] (noting that 3.8 billion copies of *Scrabble* were sold in 1954).

67. "The Charles S. Roberts Awards are presented annually for excellence in the historical wargaming hobby." *About*, CHARLES S. ROBERTS AWARDS, https://charlieawards.wordpress.com/about [https://perma.cc/4XYQ-E8M6].

68. DONOVAN, *supra* note 2, at 89–106; Ford & Liebler, *supra* note 18, at 48–52.

69. Ford & Liebler, *supra* note 18, at 51.

at a fixed scale size became popular during the 1960s as well.[70] Although miniatures originally involved land-based battles, the genre eventually branched out to include science fiction and fantasy-type games.[71]

The 1970s saw the creation of pen-and-paper RPGs, debuting with Gary Gygax and Dave Arneson's *Dungeons & Dragons* ("*D&D*"), which itself arose from a fantasy-style miniatures game, *Chainmail*.[72] *D&D* and other RPGs allow players to create their own fictional characters with self-selected characteristics and provides an intricate set of rules and the use of multi-sided dice to resolve combat and other actions. RPGs are led by a game master (in *D&D* called a Dungeon Master), who provides a setting and story for the characters and effectively serves as a referee during the game. Unlike most tabletop games at the time, which involved competition between players that ended in a single winner, *D&D* and other RPGs are cooperative endeavors where the players jointly work on achieving a quest or pursing other goals during a campaign.[73] RPG campaigns can continue over months or years of gaming sessions.[74] By the 1980s, millions of teenagers and adults played *D&D* and its successor, *Advanced Dungeons & Dragons* ("*Advanced D&D*"), and the game became the fixture of national attention when some religious figures claimed that it contained Satanic messages and promoted witchcraft, leading to a moral panic.[75]

In the 1990s, Eurogames entered the scene, quickly becoming a major category of games. Eurogames are generally more abstract than mass-market board games (but less so than traditional games like chess), involve more strategy and skill than luck, feature a lack of player elimination, and often

70. Tony Bath of England is credited with developing the first rule-based miniatures game, called *The Hyborian Campaign* (based on *The Conan the Barbarian Stories* created by Robert E. Howard), in 1957. JOSEPH P. LAYCOCK, DANGEROUS GAMES: WHAT THE MORAL PANIC OVER ROLE-PLAYING GAMES SAYS ABOUT PLAY, RELIGION, AND IMAGINED WORLDS 39 (2015).

71. Michael Whelan & Matt Jarvis, *9 Best Miniatures Games That Aren't Warhammer*, DICEBREAKER (July 30, 2021), https://www.dicebreaker.com/categories/miniature-wargame/best-games/best-miniatures-games [https://perma.cc/FP34-4CN5].

72. DAVID M. EWALT, OF DICE AND MEN: THE STORY OF DUNGEONS & DRAGONS AND THE PEOPLE WHO PLAY IT 58–73 (2013); *see also infra* Part V.A (further explaining the origins of *D&D*). There are numerous books discussing the development of *D&D*, including JON PETERSON, PLAYING AT THE WORLD: A HISTORY OF SIMULATING WARS, PEOPLE AND FANTASTIC ADVENTURES, FROM CHESS TO ROLE-PLAYING GAMES (2012), and SHANNON APPELCLINE, DESIGNERS & DRAGONS: A HISTORY OF THE ROLEPLAYING GAME INDUSTRY: THE '70S (2014).

73. EWALT, *supra* note 72, at 7–8.

74. *See* Trisha Gopal, Michael Fequiere & Dave Yim, *This Game of Dungeons & Dragons Has Been Going on for 38 Years*, CNN (Sept. 20, 2020, 4:01 AM), https://www.cnn.com/2020/09/20/us/dungeons-and-dragons-longest-game-great-big-story-trnd/index.html [https://perma.cc/C7RZ-PD92] (recounting a *D&D* game run by Robert Wardhaugh that has been operating since 1982).

75. *See* Clyde Haberman, *When Dungeons & Dragons Set Off a 'Moral Panic'*, N.Y. TIMES (Apr. 17, 2016), https://www.nytimes.com/2016/04/18/us/when-dungeons-dragons-set-off-a-moral-panic.html [https://perma.cc/G9K8-MB6T].

have more than one way to win (victory conditions).[76] Klaus Teuber's *The Settlers of Catan*, which involves resource management and building on a fictional island, was the first popular Eurogame in the U.S. market, eventually selling over 25 million copies.[77] Today, there are hundreds of Eurogames, including widely played games like *Agricola*, *Carcassonne*, *Ticket to Ride*, and *Pandemic*.

Collectible card games also rose to prominence in the 1990s with *Magic: The Gathering*, a fantasy-themed card game created by Richard Garfield where players assume the role of dueling wizards, playing cards to cast spells, use artifacts, and summon creatures to battle.[78] Each *Magic: The Gathering* card contains custom artwork and are sold in 15-card packs that can be collected by players; thousands of distinct cards have been issued by the game's publisher, Wizards of the Coast (now part of Hasbro) since 1993, with over a billion dollars in sales.[79] Other prominent collective card games include the *Pokémon Trading Card Game*, *Yu-Gi-Oh*, and *Star Wars: Customizable Card Game*.

A recent innovation is the creation of so-called legacy board games, where the components and/or rules of a game change permanently over the course of multiple play sessions "based on the outcome of each game played and the [various] choices made by the player(s)."[80] For instance, the board game may be physically changed by placing stickers on the playing surface, marking the board or cards, and adding or removing components.[81] In this respect, a legacy game is like an RPG, where the results of previous gaming sessions continue to affect the participants.[82] Game designer Rob Daviau is credited with developing the first legacy-style board games, based on his observation that the murderous characters in *Clue* are inexplicably repeatedly

76. STEWART WOODS, EUROGAMES: THE DESIGN, CULTURE AND PLAY OF MODERN EUROPEAN BOARD GAMES 35, 71–73 (2012).

77. Richard Dansky, *The Settlers of Catan*, *in* HOBBY GAMES: THE 100 BEST 265, 265 (James Lowder ed., 2007); Scott Keyes, *Settlers of Catan: How a German Board Game Went Mainstream*, ATL. (June 7, 2011), https://www.theatlantic.com/entertainment/archive/2011/06/settlers-of-catan-how-a-german-board-game-went-mainstream/239919 [https://perma.cc/5WM9-7SNH]; *see also infra* Part V.C (describing the history, development, and IP rights in *The Settlers of Catan*).

78. Richard Garfield, *Magic: The Gathering*, *in* BRIAN TINSMAN, THE GAME INVENTOR'S GUIDEBOOK 5, 7 (2008) (ebook); Jordan Weisman, *Magic: The Gathering*, *in* HOBBY GAMES: THE 100 BEST 192, 192 (James Lowder ed., 2007); *see also infra* Part V.B (describing the history, development, and IP rights in *Magic: The Gathering*).

79. Garfield, *supra* note 78, at 7–8.

80. *Mechanism: Legacy*, BOARDGAMEGEEK, https://boardgamegeek.com/boardgamefamily/25404/mechanism-legacy [https://perma.cc/EBQ6-T79D]; *see also* Paul Booth, *Playing for Time*, *in* REROLLING BOARDGAMES: ESSAYS ON THEMES, SYSTEMS, EXPERIENCES AND IDEOLOGIES 15, 24, 35 (Douglas Brown & Esther MacCallum-Stewart eds., 2020).

81. Booth, *supra* note 80, at 35.

82. For instance, an RPG character can gain new skills, attributes, and items; develop relationships or conflicts with non-player characters ("NPCs"); or be injured or even killed, and the impact of these events continue in future gaming sessions.

back to dinner in future games.[83] In 2011, Daviau created *Risk: Legacy*, where events in one play session—for instance, a nuclear attack on a country—continue to impact the next game.[84] Since then, dozens of legacy-style tabletop games have been published,[85] including Daviau's critically-acclaimed *Pandemic Legacy: Season One*.[86]

Another notable development is the rise of high-quality tabletop games suitable for children and families. While children have always been a primary audience for tabletop games, today there are an abundance of games aimed at elementary school-age children and younger.[87] These include simplified versions of prominent mass-market games and Eurogames like *Monopoly Junior*, *Clue Junior*, *Catan Junior*, and *Ticket to Ride: My First Journey*, as well as new games like *Qwirkle*, *The Magic Labyrinth*, *Forbidden Island*, and *Sushi Go* that are suitable for children and adults alike. Indeed, some parents use board games and RPGs to help educate their kids in a phenomenon known as "gameschooling."[88] Aside from being a classic staple of family nights, researchers also have found many benefits to tabletop gaming, including development of memory formation, cognitive skills, effective communication, gross and fine motor skills, and teamwork.[89]

B. MARKET SEGMENTS AND GAME PUBLISHERS

The tabletop gaming market can be classified into three main (albeit overlapping) segments. First, mass-market games like *Monopoly*, *Life*, *Clue*,

83. Rick Lane, *The Legacy of Rob Daviau, The Man Who Helped Flip Boardgames on Their Head*, EUROGAMER (Apr. 10, 2016), https://www.eurogamer.net/articles/2016-04-03-the-legacy-of-rob-daviau-the-man-who-helped-flip-boardgames-on-their-head [https://perma.cc/42UC-TRV5].

84. Booth, *supra* note 80, at 35.

85. *See Legacy Game*, BOARDGAMEGEEK, https://boardgamegeek.com/boardgamemechanic/2824/legacy-game/linkeditems/boardgamemechanic [https://perma.cc/246Y-77HL] (listing 91 legacy-style board games).

86. *See* Nate Anderson, Pandemic Legacy *is the Best Board Game Ever—But is it "Fun?,"* ARS TECHNICA (Mar. 12, 2016, 9:00 AM), https://arstechnica.com/gaming/2016/03/pandemic-legacy-is-the-best-board-game-ever-but-is-it-fun [https://perma.cc/M4ZB-F2KA] ("*Pandemic Legacy* is, at this writing, the best board game ever made. That's not my judgment—it represents the collective wisdom of Board Game Geek users, who have catalogued more than 82,000 games and have rated *Pandemic Legacy* the best of the lot.").

87. *See* Courtney Schley, *Board Games We Love for Kids and Families*, WIRECUTTER (Dec. 20, 2021), https://www.nytimes.com/wirecutter/reviews/board-games-for-kids [https://perma.cc/P52Y-G2BX] (listing recommended tabletop games for various ages of children).

88. Cat Timms, *The Ultimate Guide to Gameschooling*, MULBERRY J., https://themulberryjournal.com/writing-collective/family-life/ultimate-guide-gameschooling [https://perma.cc/DY4C-2DVS].

89. Schley, *supra* note 87 ("[A] great board game for kids can do so much more: It can help teach teamwork, decision-making, logic, creativity, communication, gross and fine motor skills, and many other areas central to learning and development."). *See generally* BRIAN MAYER & CHRISTOPHER HARRIS, LIBRARIES GOT GAME: ALIGNED LEARNING THROUGH MODERN BOARD GAMES (2010) (explaining how educators can utilize board games in school curricula for students of all ages).

Uno, *Scrabble*, and *Trivial Pursuit* are generally manufactured and sold by a handful of large (multibillion-dollar market cap), publicly traded firms such as Hasbro and Mattel.[90] As the name suggests, these classic games are aimed at the mass market of Americans who occasionally play with friends and family, but are not regular "gamers."[91] Most mass-market games have relatively simple rules, are at least a couple of decades old and thus widely known, and are sold in large chain stores like Walmart, Target, and Kohl's, as well as online.[92] In addition to the basic games themselves, publishers of mass-market games have released or licensed numerous variations, expansions, and geographically- or community-branded versions to help increase sales.[93]

Second, Eurogames like *Agricola*, *Dominion*, *Puerto Rico*, *Terra Mystica*, and *7 Wonders* are designed to be accessible to casual players but also of interest to more serious gamers due to their emphasis on skill rather than luck.[94] These games are published by a variety of companies both here and abroad, from medium-size firms like Ravensberger (Germany) and Asmodee (France) to smaller companies like Rio Grande Games (United States), and are sold in both hobby and toy stores and larger chains like Target and Barnes and Noble; many are also available on Amazon.com.[95] The *Spiel de Jahres* award is given annually to the top Eurogame.[96] This prestigious prize often results in hundreds of thousands of additional sales for the winning game, plus widespread recognition and acclaim for its designer.[97]

Third, hobby games (also called specialty games) are targeted at persons for whom gaming is a significant part of their social lives.[98] Hobby games are usually more complex and more time consuming than both mass-market games and Eurogames.[99] They are typically more expensive as well ($50 and up) due to more expensive components and/or lower print runs.[100] RPGs,

90. TINSMAN, *supra* note 78, at 68–82.

91. *Id.* at 67–68.

92. *See id.*

93. *See, e.g.*, Lacey Womack, *Ranked: 20 Best Trivial Pursuit Editions*, GAMER (Nov. 24, 2021), https://www.thegamer.com/trivial-pursuit-editions-ranked [https://perma.cc/5772-97P8]; *The Best Editions of Clue*, RANKER (Nov. 5, 2019), https://www.ranker.com/list/best-clue-editions/ranker-games [https://perma.cc/KGE7-9VDW]; *The Definitive Ranking of Monopoly Special Editions*, BUZZFEED (Nov. 27, 2013), https://www.buzzfeed.com/monopoly/the-definitive-ranking-of-monopoly-special-editions [https://perma.cc/TWA9-MZVX].

94. TINSMAN, *supra* note 78, at 118–19.

95. *Id.* at 119–22. A notable exception is Hasbro's Avalon Hill division, which publishes a variety of both mass-market games and Eurogames.

96. *Spiel des Jahres 2021*, SPIEL DES JAHRES, https://www.spiel-des-jahres.de/en/best-of-2021 [https://perma.cc/R2BQ-LMP7].

97. TINSMAN, *supra* note 78, at 122–23.

98. *Id.* at 95–96.

99. *Id.*

100. For instance, *Gloomhaven*, a widely acclaimed specialty game, has a retail price of $140. *See Board Games*, CEPHALOFAIR, https://cephalofair.com/collections/board-games [https://perma.cc/EA42-TYWY].

card-collecting games, and miniatures games are often considered specialty games as well.[101] There are numerous hobby game publishers, most of which are significantly smaller than the mass-market publishers,[102] although Wizards of the Coast—which publishes both *D&D* and *Magic: The Gathering* ("*Magic*")—is part of Hasbro.[103] Some hobby publishers focus on a single type of game, such as Games Workshop (miniatures)[104] and GMT Games (wargames),[105] or a particular theme, such as Restoration Games, which remakes old board games that have been out of print for at least ten years.[106] Specialty games are usually available in locally owned gaming stores, as well as online from the publisher's website and sometimes on Amazon.com.

Finally, the recent rise of crowdfunding has significantly altered the tabletop gaming industry.[107] Kickstarter, a crowdfunding site launched in 2009, allows players to invest in a proposed game by making a financial contribution toward its development, often in exchange for some promised tangible item in the future, such as a collector's edition of the game.[108] Kickstarter and similar crowdfunding sites, such as Indiegogo, have fundamentally challenged the existing model of tabletop game publishing by democratizing the financing and development of new games, thus allowing designers to self-publish games with less financial risk.[109] Indeed, some of the most popular recent games, such as *Cards Against Humanity* and *Exploding Kittens*, have been crowdfunded projects, with the latter raising nearly $9 million through Kickstarter.[110] By one estimate, nearly a third of tabletop games published in 2015–2017 were crowdfunded.[111]

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101. TINSMAN, *supra* note 78, at 60, 95–96.

102. *See id.* at 59–60, 95–96.

103. Hasbro, Inc., Annual Report (Form 10-K) 8 (Feb. 24, 2021).

104. *See Our History*, GAMES WORKSHOP GROUP PLC: INVESTOR RELATIONS, https://investor.games-workshop.com/our-history [https://perma.cc/US5M-N356] ("Games Workshop is the largest and the most successful hobby miniatures company in the world.").

105. *See About Us*, GMT GAMES, https://www.gmtgames.com/t-about.aspx [https://perma.cc/49A3-C453] ("GMT Games is now in its 31st year of creating and publishing a broad line of Wargames . . . .").

106. *About*, RESTORATION GAMES, https://restorationgames.com/about [https://perma.cc/SD5K-ARLE].

107. "Crowdfunding is defined as the process of asking a large number of separate third parties for relatively small amounts of money to fund an endeavor." Paul Battista, *The Taxation of Crowdfunding: Income Tax Uncertainties and a Safe Harbor Test to Claim Gift Tax Exclusion*, 64 U. KAN. L. REV. 143, 143 (2015).

108. Oliver Roeder, *Crowdfunding Is Driving a $196 Million Board Game Renaissance*, FIVETHIRTYEIGHT (Aug. 18, 2015, 6:15 AM), https://fivethirtyeight.com/features/crowdfunding-is-driving-a-196-million-board-game-renaissance.

109. *Id.*

110. *See Exploding Kittens*, KICKSTARTER (Feb. 17, 2021), https://www.kickstarter.com/projects/elanlee/exploding-kittens [https://perma.cc/TC9B-7WM6]. At the time, this was a record for a crowdfunded tabletop game; it was recently broken by *Frosthaven*, a sequel to *Gloomhaven*, which raised over $12.9 million through Kickstarter. *Frosthaven,* KICKSTARTER (Mar. 11, 2022), https://www.kickstarter.com/projects/frosthaven/frosthaven; *see also* Charlie Hall, *Games Broke*

C. THE PROCESS OF INVENTING A NEW GAME

Tabletop game designers have a variety of motivations for inventing new games. Some are motivated by the possibility of earning a profit, but many others are interested in the creativity associated with developing a new game, sharing an enjoyable experience with others, or seeing their name in print.[112] Most designers invent new games on a part-time, freelance basis; only a small number work in the industry full-time.[113] Generally, tabletop game publishers opt to buy or license new games from independent creators, rather than developing them in-house, commonly paying a royalty of three to six percent of the game's retail sales price.[114]

The process of inventing a new tabletop game involves a number of steps. First, the designer picks a theme for the game—its overall topic or subject matter. The designer then develops the game's mechanics—its basic structure, method of play, and victory conditions.[115] There are literally dozens of categories of game mechanics, from traditional roll the dice and move around a board, to worker placement, deck construction, card playing and taking, negotiating, auction, multiplayer combat, resource gathering, tile placement, and cooperative.[116] Many new games borrow, adapt, or combine mechanics from older games. For instance, Richard Garfield, best known as creator of *Magic*, used the dice-rolling mechanics of *Yahtzee* for his new, award-winning, monster-battling game, *King of Tokyo*.[117]

Once the game's mechanics are developed, a game designer then compiles them in the form of written instructions.[118] After that, the designer

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Funding Records on Kickstarter in 2020, Despite the Pandemic, POLYGON (Dec. 22, 2020, 5:06 PM), https://www.polygon.com/2020/12/22/22195749/kickstarter-top-10-highest-fundedcampaigns-2020-video-games-board-games [https://perma.cc/EAR7-RSEC] (describing the Kickstarter funding records broken in 2020).

111. Johannes Wachs & Balázs Vedres, *Does Crowdfunding Really Foster Innovation? Evidence from the Board Game Industry*, 168 TECH. FORECASTING & SOC. CHANGE 1, 1, 3 fig.1 (2021).

112. TINSMAN, *supra* note 78, at 46–48.

113. *Id.*; *see also* annodomini, Comment to *How Does One Get Into the 'Board Game Industry?'*, REDDIT (Jan. 26, 2013, 11:23 PM), https://www.reddit.com/r/boardgames/comments/17bzdj/how_does_one_get_into_the_board_game_industry [https://perma.cc/BWZ7-RVUT] ("One thing to be aware of is that very few people actually make a living in the board game industry . . . . Many people in the industry do it as a [sic] essentially a paid hobby: as an occasional source of freelance income, or a second job, or as something to do when you retire early from a more lucrative career and want to do something fun that might make a little money.").

114. TINSMAN, *supra* note 78, at 53; *Board Game Licensing Contract Terms*, CARDBOARD EDISON (2015), https://cardboardedison.com/reports [https://perma.cc/8UUZ-TJ52].

115. TINSMAN, *supra* note 78, at 53–54.

116. *See generally* GEOFFREY ENGELSTEIN & ISAAC SHALEV, BUILDING BLOCKS OF TABLETOP GAME DESIGN: AN ENCYCLOPEDIA OF MECHANISMS (2020) (providing an overview of the structures, rules, and spirit of tabletop games).

117. Richard Garfield, *Play More Games*, *in* THE KOBOLD GUIDE TO BOARD GAME DESIGN 7, 9–10 (Mike Selinker ed., 2011).

118. TINSMAN, *supra* note 78, at 156.

creates a prototype of the game, either in physical form or using a computer-based simulator like *Tabletopia*, *Vassal*, or *Tabletop Simulator*.[119] Next, designers recruit family, friends, and even strangers to playtest the prototype, which can help identify weaknesses or flaws in the game, such as unclear instructions, confusing mechanics, balancing issues, and whether the overall experience is enjoyable.[120] Some designers will conduct multiple rounds of playtesting over a year or more to refine their game prior to submission to potential publishers or self-publishing.[121]

D. THE TABLETOP GAMING COMMUNITY

Like some "negative space" fields, there is a well-developed community of creators, publishers, and players in the tabletop gaming industry, particularly in the field of hobby (specialty) games. There are numerous ways that participants in the gaming field interact, both in person and online. One of these is through programs and game nights organized by local game stores.[122] In these events, RPG and collectible card game players engage in organized play and search for new members through these programs. More recently, board game cafés have served as a meeting and play space for hobby game players, particularly in larger cities.[123] With the onset of the COVID-19 pandemic, many of these in-person events have migrated online to Discord servers and websites hosted by game publishers.[124]

Somewhat paradoxically, social media also has made it easier to become connected in tabletop gaming. There are a myriad of podcasts,[125] Facebook

119. Charlie Hall, *Tabletopia is Slick as Hell, and It's Free on Steam*, POLYGON (Dec. 1, 2016, 12:30 PM), https://www.polygon.com/2016/12/1/13806190/tabletopia-steam-board-games-free-to-play [https://perma.cc/E7Y3-XKNJ].

120. TINSMAN, *supra* note 78, at 163–65; Angela M. Webber, *How to Make a Game: Playtesting Advice from Game Designers*, GEEK & SUNDRY: NERDIST (Apr. 11, 2018, 12:00 PM), https://geekandsundry.com/how-to-make-a-game-playtesting-advice-from-game-designers [https://perma.cc/F3BR-WE73].

121. For instance, Richard Garfield conducted "Alpha," "Beta," and "Gamma" rounds of testing of prototypes of *Magic: The Gathering* while he was a Ph.D. student at the University of Pennsylvania. Richard Garfield, *The Creation of Magic: The Gathering*, MAGIC: THE GATHERING (Mar. 12, 2013), https://magic.wizards.com/en/articles/archive/making-magic/creation-magic-gathering-2013-03-12 [https://perma.cc/TA8Q-Z2SS].

122. *See* Charlie Hall, *The Board Game Industry Is Coming Together to Help Indie Stores During the Pandemic*, POLYGON (Mar. 26, 2020, 5:57 PM), https://www.polygon.com/2020/3/26/21195817/independent-board-game-stores-how-to-help-covid-19-coronavirus [https://perma.cc/J2EB-6YFC] ("The lifeblood of the modern tabletop industry is a vast network of local game stores and the communities they help to bring together.").

123. Hana Schank, *How Board Games Conquered Cafes*, ATL. (Nov. 23, 2014), https://www.theatlantic.com/entertainment/archive/2014/11/board-game-bars/382828 [https://perma.cc/2C2F-W7B5].

124. Hall, *supra* note 122.

125. *See Best 50 Tabletop Gaming Podcasts*, FEEDSPOT (Feb. 7, 2022), https://blog.feedspot.com/tabletop_gaming_podcasts [https://perma.cc/SVS5-GA3R].

groups, YouTube channels,[126] and blogs[127] devoted to tabletop gaming. These platforms serve as conduits of information and networking, not only for like-minded gamers to connect with each other, but also for newer fans to discover games that appeal to their tastes. Likewise, social media has aided in the increasing acceptance of "geek" and gaming culture.[128]

BoardGameGeek ("BGG") is an online forum for game hobbyists, as well as a database that hosts reviews, images, and videos for thousands of tabletop games.[129] Founded in 2000, it is "the hub of board gaming on the internet."[130] BBG's forums cover topics and subjects as varied as board game design, trading and selling games and game parts, regional and international game groups, and employment opportunities in the gaming industry.[131] In addition, BGG holds an annual board game convention, BGG.CON,[132] where winners of the annual Golden Geek Awards are announced.[133]

Tabletop game conventions are another space where designers, publishers, and players interact. National conventions like GenCon,[134] PAX Unplugged,[135] and Origins,[136] as well as smaller regional and local conventions,[137] allow board game designers to showcase their creations for playtesting and for board game enthusiasts to get a sneak peek at new games. The largest board game convention in the world, Essen Spiel, is a four-day convention that takes place in Essen, Germany, where winners of the prestigious *Spiel de Jahres* prize are announced.[138]

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126. *See 80 Board Games Youtube Channels*, FEEDSPOT (Mar. 17, 2022), https://blog.feedspot.com/board_games_youtube_channels [https://perma.cc/6JFZ-GFTJ].

127. *Tabletop Games: r/tabletop*, REDDIT, https://www.reddit.com/r/tabletop [https://perma.cc/F6W2-BYG7].

128. *See generally* JASON TOCCI, GEEK CULTURES: MEDIA AND IDENTITY IN THE DIGITAL AGE (2009) (Ph.D. dissertation, University of Pennsylvania), http://repository.upenn.edu/edissertations/953 [https://perma.cc/9J5X-6SUN].

129. *Welcome to BoardGameGeek*, BOARDGAMEGEEK, https://boardgamegeek.com/wiki/page/Welcome_to_BoardGameGeek [https://perma.cc/XG3A-X3TH].

130. Kevin Draper, *Should Board Gamers Play the Roles of Racists, Slavers and Nazis?*, N.Y. TIMES (Aug. 1, 2019), https://www.nytimes.com/2019/08/01/style/board-games-cancel-culture.html [https://perma.cc/VZH9-Z37P].

131. *Forums*, BOARDGAMEGEEK, https://boardgamegeek.com/forums/region/1/bgg [https://perma.cc/Y93H-F29W].

132. *BGG.CON*, BOARDGAMEGEEK, https://boardgamegeek.com/forum/52/bgg/bggcon [https://perma.cc/DF3H-LUV9].

133. *Golden Geek Awards*, BOARDGAMEGEEK, https://boardgamegeek.com/award/8314/golden-geek-awards [https://perma.cc/APJ3-QJVS].

134. GENCON, https://www.gencon.com [https://perma.cc/LAH3-GJ7E].

135. *So What Can I Do at PAX?*, PAX UNPLUGGED, https://unplugged.paxsite.com [https://perma.cc/B9GX-D36X].

136. *Origins Game Fair 2022*, ORIGINS GAME FAIR, https://www.originsgamefair.com [https://perma.cc/94EH-DSAZ].

137. *See, e.g.*, PREZCON, https://www.prezcon.com [https://perma.cc/V4PD-HALS].

138. WOODS, *supra* note 76, at 55.

In sum, tabletop gaming has come a long way since rolling a six-sided die and moving brightly colored pieces along a board. Far from being a niche hobby, it has now reinserted itself as a favorite activity of many adults and families. With the industry churning out hundreds of complex and novel games with high-quality components, the current "golden age" of tabletop gaming is rife with innovation.[139] As a result, it is timely to analyze the scope of IP protection for tabletop games and its limits.

IV. IP PROTECTION AND LIMITS FOR TABLETOP GAMES

Tabletop games hold a unique position at the intersection of IP law, with numerous aspects of games being partially covered by various doctrines but not fully protected by any of them.[140] This Article represents the first attempt in the law review literature to systematically and comprehensively assess the scope and limits of legal protection for tabletop games under IP law, with examples and illustrations drawn from case law and the U.S. Patent and Trademark Office ("USPTO"). It first analyzes protection for tabletop games under copyright law, followed by patent law, and then trademark law. It concludes by addressing other types of legal protection for games that fall within the general ambit of IP law, such as design patents, rights of publicity, and trade secrecy.

A. COPYRIGHT

As a general matter, copyright law protects "original works of authorship [that are] fixed in a[] tangible medium of expression."[141] The originality standard for copyright is quite low, especially compared to patent law—it only requires "independent creation plus a modicum of creativity."[142]

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139. Owen Duffy, *Board Games' Golden Age: Sociable, Brilliant and Driven by the Internet*, THE GUARDIAN (Nov. 25, 2014, 5:00 AM), https://www.theguardian.com/technology/2014/nov/25/board-games-internet-playstation-xbox [https://perma.cc/9K94-YJ9B].

140. *See* Boyden, *supra* note 18, at 439 ("[T]he elusiveness of games poses problems for intellectual property law . . . . Games seem to straddle the boundaries between copyright and patent, between author, performer, and reader, and between protected and unprotected material."); Schaeffer, *supra* note 18, at 41 ("Board games occupy a nexus of the three primary forms of intellectual property protection—copyright, trademark, and patent . . . ."); Benjamin J. Siders & Kirk A. Damman, *Emerging Challenges in Tabletop Gaming: Player Modifications, Third-Party Parts, and Disruptive Technology*, 7 LANDSLIDE 52, 52 (2015) ("Games are a unique hybrid of intellectual property, and may incorporate almost every major category thereof.").

141. 17 U.S.C. § 102(a) (2018).

142. *See* Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 346 (1991); *see also* Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n, 805 F.2d 663, 668 n.6 (7th Cir. 1986) (distinguishing the concepts "originality," "creativity," and "novelty," and observing that "for a work to be copyrightable, it must be original and creative, but need not be novel"); MELVILLE B. NIMMER & DAVID NIMMER, 1 NIMMER ON COPYRIGHT § 2.01 (2021) ("[E]ven [the] most commonplace and banal results of independent effort may command copyright protection, provided that the independent effort in question is quantitatively more than minimal . . . ." (footnotes omitted)); Dennis S. Karjala, *Distinguishing Patent and Copyright Subject Matter*, 35

Copyrightable subject matter includes, but is not limited to: literary and musical works; dramatic and choreographic works; pictorial, graphic, and sculptural works; sound recordings; and architectural works.[143] However, copyright protection is expressly excluded for "idea[s], procedure[s], process[es], system[s], method[s] of operation, concept[s], principle[s, and] discover[ies]," even if included or embodied in an otherwise copyrightable work.[144]

Historically, games were viewed as falling outside the scope of copyright protection.[145] The rationale for this exclusion, however, is less than clear.[146] Some cases consider games to be merely a set of rules that amount to an unprotectable idea.[147] Others conclude that games are a system or process,[148] a long-held exclusion from copyright protection dating back to the Supreme Court's landmark decision in *Baker v. Selden*[149] that is now codified in section

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CONN. L. REV. 439, 471 (2003) ("Copyright's standard of originality is much lower, at least in principle, than patent's requirement of nonobviousness.").

143. 17 U.S.C. §§ 102(a)(1)–(8); *see also* Nat'l Basketball Ass'n v. Motorola, Inc., 105 F.3d 841, 846 (2d Cir. 1997) (noting that the categories of copyrightable works listed in section 102(a) "is concededly non-exclusive").

144. 17 U.S.C. § 102(b).

145. *See* Boyden, *supra* note 18, at 442 ("For nearly a century, courts have uniformly held that games are not copyrightable." (footnote omitted)); *see also* Hoopla Sports & Ent., Inc. v. Nike, Inc., 947 F. Supp. 347, 354 (N.D. Ill. 1996) ("Courts have also held that 'games' themselves . . . are not copyrightable.").

146. *See* Boyden, *supra* note 18, at 442 ("Courts have been considerably less forthcoming, however, with reasons for [excluding games from copyright protection]."); Samuelson, *supra* note 18, at 1943 ("The cases on games and rules are quite spare in their analysis.").

147. *See, e.g.*, Allen v. Acad. Games League of Am., Inc., 89 F.3d 614, 617 (9th Cir. 1996) (reasoning that games "consist of abstract rules and play ideas" that likely merge with the underlying expression of those rules (quoting Midway Mfg. Co. v. Bandai-Am., Inc., 546 F. Supp. 125, 148 (D.N.J. 1982))); Landsberg v. Scrabble Crossword Game Players, Inc., 736 F.2d 485, 489 (9th Cir. 1984) (holding that strategies for playing *Scrabble* were unprotectable ideas); Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., 611 F.2d 296, 300 n.1 (9th Cir. 1979) ("[B]usiness ideas, such as a game concept, cannot be copyrighted."); Whist Club v. Foster, 42 F.2d 782, 782 (S.D.N.Y. 1929) ("In the conventional laws or rules of a game, as distinguished from the forms or modes of expression in which they may be state[d], there can be no literary property susceptible of copyright."); *see also* Boyden, *supra* note 18, at 445–46 ("[S]everal cases describe games, and game rules, as unprotectable ideas. Copyright, as is well known, protects only the expression of an idea, not the idea itself." (footnotes omitted)).

148. *See, e.g.*, Seltzer v. Corem, 107 F.2d 75, 76–77 (7th Cir. 1939) (holding that the rules for roller derby were an uncopyrightable system); DaVinci Editrice S.R.L. v. ZiKo Games, LLC, 183 F. Supp. 3d 820, 830 (S.D. Tex. 2016) (concluding that "[c]opyright does not protect game rules because they fall within the section 102(b) exceptions," and explaining that "[t]his general rule is consistent with . . . *Baker v. Selden* . . . ."); Boyden, *supra* note 18, at 448 ("The idea that games are systems is a promising theory for explaining why games are excluded from copyrightability."). Some definitions of games expressly refer to games as a system. *See, e.g.*, KATIE SALEN & ERIC ZIMMERMAN, RULES OF PLAY: GAME DESIGN FUNDAMENTALS 80 (2004) ("A game is a system in which players engage in an artificial conflict, defined by rules, that results in a quantifiable outcome.").

149. *See generally* Baker v. Selden, 101 U.S. 99 (1879) (holding that a system for improved bookkeeping is not copyrightable).

102(b) of the Copyright Act.[150] Whatever the precise rationale, there is a widespread agreement that "game mechanics and . . . rules are not entitled to [copyright] protection."[151]

Even though a game's mechanics and rules—"the 'heart' of [a] game"[152]—are uncopyrightable, numerous other aspects of it may qualify for copyright protection.[153] For instance, artwork that appears on the box, cards, miniatures, or other components of a game may be protectable as pictorial, graphic, or sculptural works.[154] Similarly, some board game surfaces that depict real or fictional locations and terrain "may . . . be copyrightable as 'maps.'"[155] The text of a game's instructions may also be protectable if it is sufficiently expressive to be distinguishable from the underlying rules of the game.[156]

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150. *See* 17 U.S.C. § 102(b) (2018) ("In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery . . . .").

151. Tetris Holding, LLC v. Xio Interactive, Inc., 863 F. Supp. 2d 394, 404 (D.N.J. 2012); *see also* Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co., 513 F.2d 1183, 1188–89 (2d Cir. 1975) (concluding that "[t]he rules of the game are perforce in the public domain" due to lack of copyright protection); Chamberlin v. Uris Sales Corp., 56 F. Supp. 987, 988 (S.D.N.Y. 1944) ("[I]t is very doubtful if rules of a game can, in any event, be copyrightable subject matter."), *aff'd*, Chamberlin v. Uris Sales Corp., 150 F.2d 512 (2d Cir. 1945); NIMMER & NIMMER, *supra* note 142, § 2A.14 ("[N]o copyright may be obtained in the system or manner of playing a game." (footnotes omitted)); U.S. COPYRIGHT OFFICE, COMPENDIUM OF COPYRIGHT OFFICE PRACTICES § 714 (3d ed. 2021) ("[C]opyright does not protect the idea for a game . . . or the procedure, process, or method of operation for playing a game."); *id.* § 910 ("Uncopyrightable elements include the underlying ideas for a game and the methods for playing and scoring a game. These elements cannot be registered, regardless of how unique, clever, or fun they may be.").

152. *See* Hales, *supra* note 18, at 242.

153. *See* COMPENDIUM (THIRD), *supra* note 151, § 910 ("Games often include both copyrightable and uncopyrightable elements.").

154. *See Tetris Holdings*, 863 F. Supp. 2d at 404 ("[C]ourts have found expressive elements copyrightable, including game labels, design of game boards, [and] playing cards . . . ."); NIMMER & NIMMER, *supra* note 114242, § 2A.14 ("[A] minimal artistic expression, if original, renders copyrightable labels for games, as well as the pattern or design of game boards and playing cards as pictorial or graphic works." (footnotes omitted)). Miniatures, which are used in miniatures games to stage the game scenes, may consist of a mix of protectable sculptural works and unprotectable functional elements. *Cf.* Lego A/S v. Best-Lock Constr. Toys, Inc., 874 F. Supp. 2d 75, 100–01, 105 (D. Conn. 2012) (holding that plaintiff's Lego minifigures included unprotectable functional components, such as straight legs and square feet, as well as copyrightable sculptural aspects, including "cylindrical shape of the head[;] the trapezoidal shape of the torso;" the extended arms; and the bent elbow); *see also* Lego A/S v. Best-Lock Constr. Toys, 404 F. Supp. 3d 583, 603 (D. Conn. 2019) (reaffirming "that certain elements of the Lego minifigures are, indeed, functional" while other elements "are purely sculptural").

155. NIMMER & NIMMER, *supra* note 142, § 2A.14[C][1]; *see also, e.g.*, TICKET TO RIDE, U.S. Copyright Office Registration No. VA0002095583 (Apr. 26, 2012); TICKET TO RIDE: EUROPE, U.S. Copyright Office Registration No. VA0002095585 (Aug. 1, 2012); SMALL WORLD, U.S. Copyright Office Registration No. VA0002095778 (Aug. 1, 2012).

156. *See* NIMMER & NIMMER, *supra* note 142, § 2A.14[C][1] ("[T]he wording of instructions for playing the game is itself copyrightable . . . . That copyright would not, however, permit a monopoly in the method of play itself, as distinguished from the form of instructions for

Tabletop games with extensive text, such as word-based games and RPGs, may also be protectable as literary works under the Copyright Act.[157] For instance, Hasbro, which currently owns the *D&D* franchise, and its predecessors-in-interest have registered copyrights in hundreds of books, modules, guides, maps, and other materials.[158] However, as noted above, the underlying rules themselves (as distinct from their expression) are uncopyrightable. Moreover, the *scènes-à-faire* doctrine precludes protection for aspects of a work that are standard or common to a topic or genre.[159] For example, in a case involving alleged copyright infringement of a video arcade golf game, the Seventh Circuit held that elements such as golf clubs, greens, sand traps, water hazards, and information about wind speed and distance to the hole were all necessary for a realistic video golf game and thus were uncopyrightable.[160] Likewise, for a high-fantasy RPG, standard elements like races (human, elf, dwarf), character classes (warrior, wizard, thief), attributes (strength, dexterity, intelligence, hit points), monsters (orcs, demons, dragons), weapons (swords, daggers, maces, staffs, bow-and-arrow), armor (shield, mail, helmet), loot (gold, magical items), and quests or missions (slay a monster, find hidden treasure, transport an item, save an innocent person) likely would be considered unprotectable *scènes-à-faire*.

Fictional characters that appear in tabletop games may be copyrightable as well.[161] In general, fictional characters are copyrightable if they have

play."); *see also* COMPENDIUM (THIRD), *supra* note 151, § 910 (containing an example where the instructions for a game "consist of two pages of text" and are copyrightable). Several cases have similarly held that the arrangement and expression of rules can be copyrighted. *See* Affiliated Hosp. Prods., Inc. v. Merdel Game Mfg. Co., 513 F.2d 1183, 1188 (2d Cir. 1975) (explaining that the plaintiff's copyright "only protects [its] arrangement of the [game's] rules and the manner of their presentation, and not their content"); Hoopla Sports & Ent., Inc. v. Nike, Inc., 947 F. Supp. 347, 354 (N.D. Ill. 1996) (noting that "instruction books" for a game may be copyrightable).

157. *See* COMPENDIUM (THIRD), *supra* note 151, § 714 ("A game may be registered as a literary work if the predominant form of authorship in the work consists of text"—for example, word games, riddles, or brain teasers—"including the instructions or directions for playing a particular game.").

158. Hasbro, Inc. v. Sweetpea Ent., Inc., No. 13-CV-3406, 2014 WL 12586021, at *1 (C.D. Cal. Feb. 25, 2014); *see also infra* Part V.A (discussing in more detail the IP rights in *D&D*).

159. *See, e.g.*, Walker v. Time Life Films, Inc., 784 F.2d 44, 50 (2d Cir. 1986) ("Neither does copyright protection extend to copyright or 'stock' themes commonly linked to a particular genre."); Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp., 672 F.2d 607, 616 (7th Cir. 1982) ("Scenes a faire refers to 'incidents, characters or settings which are as a practical matter indispensable, or at least standard, in the treatment of a given topic.'" (quoting Alexander v. Haley, 460 F. Supp. 40, 45 (S.D.N.Y.1978)).

160. Incredible Techs., Inc. v. Virtual Techs., Inc., 400 F.3d 1007, 1014–15 (7th Cir. 2005).

161. *See* NIMMER & NIMMER, *supra* note 142, § 2.12[A][2] ("[T]he prevailing view has become that characters *per se* are entitled to copyright protection." (footnotes omitted)); COMPENDIUM (THIRD), *supra* note 151, § 911 ("The original, visual aspects of a character may be protected by copyright if they are sufficiently original."). *See generally* Zahr K. Said, *Fixing Copyright in Characters: Literary Perspectives on a Legal Problem*, 35 CARDOZO L. REV. 769 (2013) (discussing the legal problem surrounding copyright protection for fictional characters and proposing an interdisciplinary solution).

"distinctive character traits and attributes" and are "sufficiently delineated to be recognizable as the same character whenever it appears."[162] Courts have found Tarzan,[163] Mickey Mouse,[164] James Bond,[165] Rocky Balboa,[166] Godzilla,[167] Superman,[168] Batman,[169] and even inanimate objects such as the Batmobile[170] and Freddy Krueger's glove[171] to be independently copyrightable of the works in which they appear. Although many tabletop games do not involve copyrightable characters, some do.[172] For example, a recent district court case concluded that "games can have a progression of events and a roster of developed characters that make the game expressive, just as the progression of a book or movie plot can be expressive even when the basic elements are common."[173] In particular, modules and campaigns for tabletop RPGs often have rich storylines with detailed characters, locations, and items that may be independently protectable under copyright law.[174]

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162. D.C. Comics v. Towle, 802 F.3d 1012, 1019–21 (9th Cir. 2015) (internal quotation marks omitted). In contrast, stock characters are unprotectable. *See id.* at 1021; *see also* Gaiman v. McFarlane, 360 F.3d 644, 659 (7th Cir. 2004) ("A stock character is a stock example of the operation of the [*scenes-a-faire*] doctrine . . . ."); Rice v. Fox Broadcasting Co., 330 F.3d 1170, 1176 (9th Cir. 2003) (holding that a magician who revealed tricks was an unprotectable stock character because it "shared attributes of appearance and mysterious demeanor [that] are generic and common to all magicians").

163. Burroughs v. Metro-Goldwyn-Mayer, Inc., 519 F. Supp. 388, 394 (S.D.N.Y. 1981), *aff'd on other grounds*, 684 F.2d 610 (2d Cir. 1982).

164. Walt Disney Prods. v. Air Pirates, 345 F. Supp. 108, 116 (N.D. Cal. 1972), *aff'd*, 581 F.2d 751, 755, n.11 (9th Cir. 1978).

165. Metro-Goldwyn-Mayer, Inc. v. Am. Honda Motor Co., 900 F. Supp. 1287, 1291 (C.D. Cal. 1995).

166. Anderson v. Stallone, No. 87-0592, 1989 WL 206431, at *18 (C.D. Cal. Apr. 25, 1989).

167. Toho Co. v. William Morrow & Co., 33 F. Supp. 2d 1206, 1215 (C.D. Cal. 1998).

168. Warner Bros. v. Am. Broad. Cos., 530 F. Supp. 1187, 1199 (S.D.N.Y. 1982), *aff'd*, 720 F.2d 231, 242 (2d Cir. 1983).

169. Sapon v. DC Comics, No. 00-cv-8992, 2002 WL 485730, at *3–4 (S.D.N.Y. Mar. 29, 2002).

170. DC Comics v. Towle, 802 F.3d 1012, 1021–23 (9th Cir. 2015).

171. New Line Cinema Corp. v. Russ Berrie & Co., 161 F. Supp. 2d 293, 302 (S.D.N.Y. 2001); New Line Cinema Corp. v. Easter Unlimited, Inc., No. CV 89–2017, 1989 WL 248212, at *3–4 (E.D.N.Y. July 19, 1989).

172. Some tabletop games import fictional characters from other media, presumably under license from the copyright owner. *See, e.g.*, FORREST-PRUZAN CREATIVE, KAMI MANDELL & ANDREW WOLF, HARRY POTTER: HOGWARTS BATTLE (USAopoly 2016) (involving characters from the *Harry Potter* universe); JASON LITTLE & FRANK BROOKS, STAR WARS: X-WING (SECOND EDITION) (Fantasy Flight Games 2018) (involving spacecraft and characters from the *Star Wars* universe); NATE FRENCH, THE LORD OF THE RINGS: THE CARD GAME (Fantasy Flight Games 2011) (involving characters from the works of J.R.R. Tolkien). This Article instead focuses on fictional characters who first appear in tabletop games.

173. DaVinci Editrice S.R.L. v. ZiKo Games, LLC, 183 F. Supp. 3d 820, 832 (S.D. Tex. 2016).

174. For instance, the *Forgotten Realms* campaign setting for *D&D* has spawned numerous books, novels, video games, and even a popular board game, *Lords of Waterdeep*. These media include numerous iconic characters, including Drizzt Do'Urden, Wulfgar, Elminster, and Halaster Blackcloak, and cities and locations such as Baldur's Gate, Waterdeep, Icewind Dale, and the Underdark.

The copyright rights in a tabletop game prohibit others from copying the game's protected elements, which extends to both literal copying and reproductions that are substantially similar.[175] It also grants the rights to distribute and sell the game,[176] "to prepare derivative works,"[177] and to publicly perform or display certain aspects of the game.[178] Of these, the derivative work right is particularly valuable, as it grants the copyright owner the right to create adaptations of the game and to transform or recast it in other forms.[179] For example, many mass-market publishers have created expansions or new or revised editions of classic games that fall within the derivative work right.[180] In addition, numerous tabletop games have been ported to digital platforms, such as computer software or smartphone apps,[181] which can be a significant source of revenue.[182] A few well-known

175. 17 U.S.C. § 106(1) (2018); Arnstein v. Porter, 154 F.2d 464, 468 (2d Cir. 1946) (evaluating improper appropriation based on access to the copyright work and degree of similarity between the copyright work and allegedly infringing work).

176. 17 U.S.C. § 106(3).

177. *Id.* § 106(2).

178. *Id.* §§ 106(4)–(5). However, several courts have rejected the argument that playing a game in public amounts to an infringement of the public performance right. *See, e.g.*, Allen v. Acad. Games League of Am., Inc., 89 F.3d 614, 616–17 (9th Cir. 1996); Seltzer v. Sunbrock, 22 F. Supp. 621, 627–28 (S.D. Cal. 1938); *see also* Boyden, *supra* note 18, at 472–75 (further discussing this issue and asserting that "[g]ames are meant to be played, and playing one does not violate any of the rights of a game's copyright owner").

179. *See* 17 U.S.C. § 101 ("A 'derivative work' is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work'."); *see also* Castle Rock Ent., Inc. v. Carol Publ'g Grp., Inc. 150 F.3d 132, 138–39 (2d Cir. 1998) (holding that a trivia book with questions regarding the TV show *Seinfeld* violated the derivative work right in the show). For a comprehensive history of the derivative work right and an argument that it should be interpreted more narrowly, see generally Pamela Samuelson, *The Quest for a Sound Conception of Copyright's Derivative Work Right*, 101 GEO. L.J. 1505 (2013).

180. Schaeffer, *supra* note 18, at 43.

181. *See id.* ("Computer program versions of board games—loaded onto a computer and played by one player against the computer—have been around for some time."); *see also* Complaint at 11–13, Hasbro, Inc. v. RJ Softwares, No. 08-CIV-6567 (S.D.N.Y. July 24, 2008) (asserting that the Facebook game *Scrabulous* infringed Hasbro's copyright and trademark rights in *Scrabble*).

182. *See* Jason Wilson, *Sensor Tower: U.S. Spending Up 40% for Mobile Tabletop Games*, VENTUREBEAT: GAMESBEAT (Aug. 9, 2021, 3:52 PM), https://venturebeat.com/2021/08/09/sensor-tower-u-s-spending-up-40-for-mobile-tabletop-games [https://perma.cc/64V4-HS8Z] (explaining "that tabletop mobile gaming rose 40% over the past 12 months in the United States, bringing in $703.8 million between August 1, 2020 and July 31").

games have even been transformed into derivative works like movies[183] and television shows.[184]

As an additional limitation, copyright protection for tabletop games may be limited by the fair use doctrine. "[F]air use 'permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.'"[185] Section 107 of the Copyright Act lists four factors to be considered

> [i]n determining whether the use made of a work in any particular case is a fair use[:] (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work.[186]

Although not expressly listed as a factor, courts also consider whether an alleged fair use is "transformative" in nature. For instance, in *Campbell v. Acuff-Rose Music, Inc.*, the Supreme Court reasoned that the central purpose of the fair use inquiry is to assess "whether the new work merely 'supersede[s] the objects' of the original creation or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message."[187]

Fair use may limit the availability of copyright protection for tabletop games. As one example, in *Allen v. Academic Games League of America, Inc.*, the Ninth Circuit concluded that the fair use doctrine would preclude a finding of infringement of the plaintiff's academic games, in part because the defendant's alleged infringing conduct of hosting similar games was for a nonprofit, educational purpose.[188] However, at least the first factor—the purpose and character of the use—will ordinarily weigh against a finding of fair use, at least when the alleged infringer is engaging in a commercial

183. *See, e.g.*, BATTLESHIP (Universal Pictures 2012); DUNGEONS & DRAGONS (New Line Cinema 2000); CLUE (Paramount Pictures 1985).

184. *See, e.g.*, *The Game of Life* (The Hub television broadcast 2011–2012); *Trivial Pursuit* (The Family Channel television broadcast 1993–1994); *Scrabble* (NBC television broadcast 1984–1990); *Dungeons & Dragons* (CBS television broadcast 1983–1985).

185. NIMMER & NIMMER, *supra* note 142, § 13.05 (quoting Iowa State Univ. Rsch. Found., Inc. v. Am. Broad. Cos., 621 F.2d 57, 60 (2d Cir. 1980)).

186. 17 U.S.C. § 107 (2018).

187. Campbell v. Acuff-Rose Music, Inc., 510 U.S. 569, 579 (1994) (alteration in original) (citations omitted) (quoting Folsom v. Marsh, 9 F.Cas. 342, 348 (C.C.D. Mass. 1841) (No. 4,901)).

188. Allen v. Acad. Games League of Am., Inc., 89 F.3d 614, 617 (9th Cir. 1996). This conclusion was arguably dicta, however, as the Ninth Circuit concluded that the playing of games was not an infringing performance under 17 U.S.C. § 106(4). *Allen*, 89 F.3d at 616–17.

use.[189] For instance, in *Horn Abbot Ltd. v. Sarsaparilla Ltd.*, the defendant's claim of fair use failed when "it copied, verbatim, every question an [sic] answer from the Genus Edition of Trivial Pursuit" by engaging in the commercial purpose of republishing these questions in the form of a "reference book" or "supplement" to the game.[190]

Finally, copyright law's termination right may allow game creators who assign the rights in their games to a publisher to eventually recapture them. Under the 1976 Copyright Act, the author(s) of a work (or her statutory heirs if deceased) has the power to terminate the grant of a copyright right after a certain period of time,[191] relieving them "of the consequences of ill-advised and unremunerative grants that had been made before the author had a fair opportunity to appreciate the true value of [their] work."[192] However, termination rights do not extend to works made for hire,[193] which includes "a work created by an employee acting within the scope of employment."[194] For instance, the heirs of a game designer who helped create *The Game of Life* unsuccessfully sued to terminate the copyright assignment in the game to Hasbro; the court denied termination on the grounds that that the game was made at the instance and expense of Milton Bradley, Hasbro's predecessor, and thus was a work made for hire.[195] But the termination right might be applicable to game designers who independently create a game and subsequently assign their copyright in it to a publisher.

In sum, while copyright protects some aspects of tabletop games, such as illustrations and expressive content, it leaves much room open for other creators to innovate and improve upon existing games.

B. PATENT

Second, patent law may be available to protect a number of aspects of tabletop games. However, it is significantly more difficult to obtain a utility patent than a copyright because the legal requirements for patent protection are much higher than copyright law.[196] Furthermore, practical realities such as the cost of obtaining and enforcing patent rights mean that

189. *But cf.* Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978–2005*, 156 U. PA. L. REV. 549, 602 (2008) (explaining that, based on an empirical analysis of fair use decisions, "a finding that the defendant's use was for a commercial purpose . . . did not significantly influence the outcome of the fair use test").

190. Horn Abbot Ltd. v. Sarsaparilla Ltd., 601 F. Supp. 360, 362, 367–68 (N.D. Ill. 1984).

191. 17 U.S.C. §§ 203, 304(c)–(d).

192. Mills Music, Inc. v. Snyder, 469 U.S. 153, 172–73 (1985).

193. 17 U.S.C. § 304(c).

194. Forward v. Thorogood, 985 F.2d 604, 606 (1st Cir. 1993) (referencing 17 U.S.C. § 101).

195. Markham Concepts, Inc. v. Hasbro, Inc., 1 F.4th 74, 77–79 (1st Cir. 2021).

196. *See* Mary LaFrance, *Something Borrowed, Something New: The Changing Role of Novelty in Idea Protection Law*, 34 SETON HALL L. REV. 485, 486 n.5 (2004) (observing that "[i]n contrast [to copyright law], novelty in federal patent law has a specific and stringent definition").

even when patenting might be an option, many game creators voluntarily forego it.[197]

In general, patent protection is available for inventions that are novel,[198] nonobvious,[199] and drawn to patent eligible subject matter.[200] In addition, the invention must be adequately disclosed in the patent document.[201] The owner of a patent has "the right to exclude others from making, using, offering for sale, or selling . . . or importing" products which practice the patented invention.[202] If granted, a utility patent can last for up to 20 years from the date of application.[203]

Board games can be patented if they satisfy these requirements. For example, in 1935, Charles Darrow obtained a patent for *Monopoly*,[204] perhaps the most famous board game in the world.[205] Darrow's patent disclosed the rules and parts of the game, including the game board, playing pieces like hotels and houses, property cards with rent and mortgage values, and in-

197. *See infra* notes 270–75 and accompanying text.

198. 35 U.S.C. § 102 (2018).

199. *Id.* § 103.

200. *See id.* § 101 ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."). However, the broad categories of patent eligible subject matter in the Patent Act have been significantly narrowed by judicially created exceptions for inventions directed to abstract ideas, laws of nature, and natural or physical phenomena. *See infra* notes 240–43 and accompanying text.

201. *See id.* § 112(a) (containing the enablement, written description, and best mode requirements); *see also* Jason Rantanen, *Patent Law's Disclosure Requirement*, 45 LOY. U. CHI. L.J. 369, 371–78 (2013) (explaining how these requirements serve the objective "that inventors must disclose information about their inventions—the technological advances that they have made—in order to obtain a patent.").

202. 35 U.S.C. §§ 154(a)(1), 271(a). The right to exclude, however, does not mean that a patentee has a right to automatically obtain injunctive relief from a court if it proves infringement. *See* eBay Inc. v. MercExchange, L.L.C., 547 U.S. 388, 392 (2006) (explaining "the creation of a right is distinct from the provision of remedies for violations of that right" and that "injunctive relief may issue only in accordance with the principles of equity" (internal quotation marks omitted) (quoting 35 U.S.C. § 283)); *see also* Christopher B. Seaman, *Permanent Injunctions in Patent Litigation After* eBay*: An Empirical Study*, 101 IOWA L. REV. 1949, 1983, 1988 (2016) (finding that district courts awarded permanent injunctions 72.5% of the time following *eBay* but only 16% when the patentee was a non-practicing entity).

203. 35 U.S.C. § 154(a)(2).

204. U.S. Patent No. 2,026,082 (filed Aug. 31, 1935).

205. *See generally* PHILIP E. ORBANES, MONOPOLY: THE WORLD'S MOST FAMOUS GAME—AND HOW IT GOT THAT WAY (2006) (explaining the history and significance of *Monopoly*); *see also* MARY PILON, THE MONOPOLISTS: OBSESSION, FURY, AND THE SCANDAL BEHIND THE WORLD'S FAVORITE BOARD GAME 151–52 (2015) (noting that while the creation of *Monopoly* is generally attributed to Charles B. Darrow, game historians observe that Darrow evidently added new elements to *The Landlord's Game*, patented in 1904 by Lizzie J. Magie); Mary Pilon, *Monopoly's Inventor: The Progressive Who Didn't Pass 'Go'*, N.Y. TIMES (Feb. 13, 2015), https://www.nytimes.com/2015/02/15/business/behind-monopoly-an-inventor-who-didnt-pass-go.html [https:// perma.cc/QCC5-B9ZV].

game currency. The patent claimed[206] "a board game apparatus . . . having marked spaces constituting a path or course [around] the board," with "certain of said spaces being designated as by position or color so as to constitute a distinguishable group," and "the apparatus having indications of the rentals required for the use and occupancy, by opponent players, of spaces of one or more such groups, which rentals are subject to increase by the acquisition of an additional space or spaces of the same group by the same individual player."[207] Additional claims covered game pieces like Chance or Community Chest cards, buildings on properties like houses and hotels, tokens (playing pieces), and spaces on the board game that conferred benefits ("Free Parking") or imposed penalties ("Income Tax," "Luxury Tax," and "Go to Jail").[208] Other classic games covered by patents include *Life*,[209] *Sorry*,[210] *Battleship*,[211] *Scrabble*,[212] *Mouse Trap*,[213] and *Twister*.[214]

Games with a novel playing surface or apparatus may be patented as well. *Jenga*—a game involving the manipulation of wooden blocks organized vertically in layers—was patented in 1997.[215] Other patented game boards include a path-based game with moveable, three-dimensional obstacles, such as bridges and walls;[216] a board game with model buildings that simulate an earthquake;[217] and a strategy-type board game with pieces that reflect laser beams.[218] Game parts also can be patented. For example, there are numerous patents covering non-cuboid dice (i.e., dice with greater or less than six sides),[219] spinners,[220] and miniature figurines.[221]

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206. In a patent, the claims delineate the scope of the patentee's rights. *See* 35 U.S.C. § 112(b); *see also* Markman v. Westview Instruments, Inc., 517 U.S. 370, 372 (1996) (explaining that a "patent claim" is "the portion of the patent document that defines the scope of the patentee's rights").

207. '082 Patent, col. 11 ll. 28–43.

208. *Id.* col. 3 l. 8–col. 4 l. 34.

209. U.S. Patent No. 53,561 (filed Mar. 30, 1866). For an informative history of the original *Game of Life* (not the 1960s to 1980s remake that most readers are familiar with), see Phil Edwards, *Why the Game of Life Used to Have Poverty, Suicide, and Ruin*, VOX (Jan. 13, 2020, 9:39 AM), https://www.vox.com/2015/1/28/7924487/game-of-life-history.

210. U.S. Patent No. 1,903,661 (filed Aug 4, 1930).

211. U.S. Patent No. 1,988,301 (filed Feb. 23, 1933); *see also* U.S. Patent No. 1,932,524 (filed Nov. 23, 1932) (describing a similar game).

212. U.S. Patent No. 2,752,158 (filed Oct. 28, 1954).

213. U.S. Patent No. 3,298,692 (filed Aug. 24, 1962).

214. U.S. Patent No. 3,454,279 (filed Apr. 14, 1966).

215. U.S. Patent No. 5,611,544 (filed Nov. 27, 1995).

216. U.S. Patent No. 7,766,335 (filed Jan. 6, 2006).

217. U.S. Patent No. 4,394,017 (filed June 5, 1981).

218. U.S. Patent No. 7,264,242 (filed Feb. 13, 2006); *see also* Innovention Toys, LLC v. MGA Ent., Inc., 611 F. App'x 693, 699 (Fed. Cir. 2015) (affirming the lower court's conclusion of nonobviousness of the '242 Patent), *vacated* 579 U.S. 915 (2016).

219. *See, e.g.*, U.S. Patent No. 3,208,754 (filed Feb. 20, 1963); U.S. Patent No. 5,909,874 (filed Aug. 12, 1997).

220. *See, e.g.*, U.S. Patent No. 1,300,315 (filed Dec. 4, 1917).

Methods of game play also may be patentable. For example, there are numerous patents on wargames, which involve a playing surface composed of various shapes (such as squares or hexagons) overlaid on a map depicting terrain that depicts a fictional or real-life location, along with game pieces representing military units and rules about how to resolve combat between units.[222] Patents also have been obtained for various implementations of tile-based games,[223] cooperative-style games,[224] deck-building card games,[225] and word-based games.[226] In addition, modifications to existing board games, such as chess variants,[227] three-dimensional tic-tac-toe,[228] and extensions to *Monopoly*,[229] have been patented.

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221. *See, e.g.*, U.S. Patent No. 6,659,463 (filed July 3, 2002).

222. *See, e.g.*, U.S. Patent No. 2,464,819 (filed Oct. 30, 1945) (describing "a war game to be played on a game board and has for an object to provide an improved game board on which the players may simulate substantially all the features of modern warfare"); U.S. Patent No. 2,703,713 (filed June 18, 1951) (describing "a simulated war game apparatus in which the hazards of chance are minimized by player choice, selection, planning, and strategy"); U.S. Patent No. 3,831,944 (filed Aug. 27, 1974) (describing and claiming a wargame "comprising a pair of identical game boards" with different regions and game pieces representing tanks, airplanes, and various naval vessels); U.S. Patent No. 3,860,241 (filed May 9, 1973) (describing and claiming a simulated battle game on a board comprising a plurality of squares with opposing army units); U.S. Patent No. 4,093,236 (filed Nov. 22, 1976) (describing a tactical war game and method for playing that includes 1/285 scale vehicles and weapons); U.S. Patent No. 4,227,695 (filed Jan. 22, 1979) (patent for "Battle of the Alamo" game); U.S. Patent No. 5,020,805 (filed Dec. 6, 1989) (describing and claiming a "Vietnam war board game"); U.S. Patent No. 5,042,817 (filed June 21, 1990) (claiming "[a] method of playing an air-to-ground strategic bombing board game"); U.S. Patent No. 5,465,973 (filed Mar. 7, 1995) (describing a war game apparatus that includes a map depicting the Middle East); U.S. Patent No. 5,570,887 (filed May 22, 1995) (describing and claiming a board game apparatus and method of play designed to simulate the medieval European period); U.S. Patent No. 5,879,005 (filed Feb. 26, 1998) (describing and claiming a method of playing a game system including military units, coins, dice simulating movement and weather, and a game board representing terrain); U.S. Patent No. 6,561,513 (filed Mar. 5, 2001) (describing and claiming "[a] conflict resolution system for strategy games [comprising] a defender and an attacker" that does not require a random number generator like dice); U.S. Patent No. 7,077,400 (filed Nov. 18, 2004) (describing and claiming "[a] method of playing a combat-style game for a plurality of players"); U.S. Patent No. 8,282,103 (filed July 6, 2010) (describing an apparatus and method for an airplane combat game); U.S. Patent No. 10,610,767 (filed Feb. 12, 2019) (claiming "[a] board game for simulating unconventional warfare").

223. *See, e.g.*, U.S. Patent No. 6,170,825 (filed Nov. 23, 1998); U.S. Patent No. 6,305,688 (filed Apr. 22, 1999); U.S. Patent No. 6,938,899 (filed Nov. 1, 2002); U.S. Patent No. 8,215,642 (filed Oct. 1, 2017).

224. *See, e.g.*, U.S. Patent No. 9,333,417 (filed Nov. 9, 2012).

225. *See, e.g.*, U.S. Patent No. 6,601,851 (filed Nov. 17, 2000) (*Pokémon*); U.S. Patent No. 5,662,332 (filed Oct. 17, 1995) (*Magic: The Gathering*).

226. *See, e.g.*, U.S. Patent No. 6,692,002 (filed Aug. 21, 2002); U.S. Patent No. 6,986,512 (filed Jan. 18, 2002); U.S. Patent No. 7,140,613 (filed Aug. 9, 2002).

227. *See, e.g.*, U.S. Patent No. 1,030,521 (filed Nov. 24, 1909) (*Game of War*); U.S. Patent No. 1,141,909 (filed Dec. 29, 1914) (*Angel Chess*); U.S. Patent No. 4,033,586 (filed Aug. 13, 1975) (*Ministers Chess*); *see also* U.S. Patent Application No. 2007/0126179 (filed June 7, 2007) (Betting Chess and Methods of Play).

Despite this, numerous hurdles make it impractical or impossible to secure patent protection for many tabletop games. First, the novelty and, in particular, nonobviousness requirements can be difficult to satisfy.[230] Many new tabletop games are re-implementations of, or variations on, the game play mechanics of existing games,[231] or borrow elements that are common to the genre—such as the use of six-sided dice, tokens or miniatures to represent players and objects, and the progression of game pieces along one or more pathways on the game board. Under current nonobviousness jurisprudence, the implementation of "predictable variation[s]" and use of "familiar elements according to known methods" is likely to be obvious.[232]

For instance, in *In re Bryan*, the applicant sought to patent a "game board and game having a touring band theme," which comprised a game board with multiple paths from the starting area to the middle of the game board, a series of tokens that would advance along the pathways, at least one die for determining token movements, and decks of labeled cards representing band members, band equipment, and actions or events that a player must take.[233] The patent examiner rejected the applicant's claims as obvious in light of two prior art patents, which between them taught all the parts of the applicant's board game,[234] and the Board of Patent Appeals and Inferences upheld the rejection.[235] The Federal Circuit affirmed, concluding that the applicant's claims were not patentable because the claimed features were obvious in light of the prior art.[236] "[T]he . . . slight claim distinctions noted by [the applicant]"—such as using three decks of game cards instead of two and color-coding the game cards—did not render the claims

228. *See, e.g.*, U.S. Patent No. 2,313,473 (filed Mar. 9, 1943); U.S. Patent No. 2,676,018 (filed Apr. 20, 1954); U.S. Patent No. 3,888,487 (filed Nov. 5, 1974).

229. *See, e.g.*, U.S. Patent No. 5,810,359 (filed Apr. 22, 1997).

230. *See* Hales, *supra* note 18, at 247 n.33 (noting that the novelty and nonobviousness requirements "present high bars to overcome for a creative but simple board game").

231. For example, *Dune: Imperium* combines deck-building, a mechanic found in numerous popular games such as *Dominion* and *Star Realms*, with worker placement, a quintessential mechanic found in many Eurogames such as *Agricola* and *Lords of Waterdeep*. *See* PAUL DENNEN, DUNE: IMPERIUM (Dire Wolf Digital 2020); UWE ROSENBERG, AGRICOLA (Lookout Games 2007); PETER LEE & RODNEY THOMPSON, LORDS OF WATERDEEP (Wizards of the Coast 2012). Likewise, *Praetor* puts a novel spin on worker placement by having workers represented by dice with the amount of resources gathered dependent on the "level" of the worker. *See* ANDREI NOVAC, PRAETOR (NSKN Games 2014).

232. KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 416–18 (2007).

233. *In re* Bryan, 323 F. App'x 898, 899–900 (Fed. Cir. 2009) (per curiam).

234. *Id.* at 900 (citing U.S. Patent No. 4,998,736 (filed July 23, 1990), and U.S. Patent No. 6,279,908 (filed Mar. 16, 1998)).

235. *Ex parte* Bryan, Appeal 2007-1590, 2008 WL 1057622, at *7 (B.P.A.I. Apr. 9, 2008).

236. *In re Bryan*, 323 F. App'x at 901–02.

nonobvious because they amounted to "nothing more than a 'predictable use of prior art elements . . . .'"[237]

Second, current patent eligibility jurisprudence significantly limits the availability of patent protection for tabletop games. While the text of the Patent Act is quite broad, making "any new and useful process, machine, manufacture, or composition of matter" potentially eligible for patent protection,[238] these statutory categories have been significantly narrowed by judicially created exceptions for inventions directed to abstract ideas, laws of nature, and natural or physical phenomena.[239] In a series of recent decisions culminating in *Alice Corp. v. CLS Bank Int'l*, the Supreme Court has articulated a two-step test for determining whether an invention claims ineligible subject matter.[240] First, the court evaluates whether the claim(s) at issue are directed to a patent-ineligible concept, such as an abstract idea.[241] If so, then the elements of the claim(s) are examined, both individually and as a whole, "to determine whether [the abstract idea] contains an 'inventive concept' sufficient to 'transform' [it] into a patent-eligible application."[242] "Purely 'conventional or obvious'" steps in a claim are "normally not sufficient" to satisfy this second step.[243]

Tabletop games may struggle to overcome this hurdle to patentability, as the rules for a game can be considered an abstract idea, and many games include conventional or well-known steps or elements like dice, cards, tokens representing players or objects, and/or playing surfaces having one or more pathways for players to progress from start to finish. For instance, in *In re Smith*, the Federal Circuit affirmed the USPTO's rejection of claims for a method of playing a wagering game using a standard deck of playing cards.[244] Applying the first step of the *Mayo/Alice* test, the court concluded

237. *Id.* at 902 (quoting *KSR*, 550 U.S. at 401). The Federal Circuit also held that "the printed matter" on applicant's game cards was nonfunctional and thus not a basis for rendering the claims patentable over the prior art. *Id.* at 901.

238. 35 U.S.C. § 101 (2018).

239. *See* Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980) ("This is not to suggest that § 101 has no limits or that it embraces every discovery. The laws of nature, physical phenomena, and abstract ideas have been held not patentable."); *see also* Christopher B. Seaman & Sheena X. Wang, *An Inside History of the Burger Court's Patent Eligibility Jurisprudence*, 53 AKRON L. REV. 915, 927–78 (2019) (recounting the historical evolution of the Supreme Court's patent eligibility jurisprudence).

240. Alice Corp. v. CLS Bank Int'l, 573 U.S. 208, 217–21 (2014); Mayo Collaborative Servs. v. Prometheus Lab'ys, Inc., 566 U.S. 66, 90 (2012); Ass'n for Molecular Pathology v. Myriad Genetics, Inc., 569 U.S. 576, 589–90 (2013); Bilski v. Kappos, 561 U.S. 593, 601–02 (2010).

241. *Alice*, 573 U.S. at 218.

242. *Id.* at 221 (quoting *Mayo*, 566 U.S. at 72, 80).

243. *Mayo*, 566 U.S. at 79 (quoting Parker v. Flook, 437 U.S. 584, 590 (1978)); *see also Alice*, 573 U.S. at 222 ("'Simply appending conventional steps, specified at a high level of generality,' was not 'enough' to supply an 'inventive concept.'" (quoting *Mayo*, 566 U.S. at 82, 77, 72) (emphasis omitted)).

244. *In re* Smith, 815 F.3d 816, 820 (Fed. Cir. 2016).

that the applicants' claims for "rules for conducting a wagering game" were similar "to other 'fundamental economic practice[s]' found abstract by the Supreme Court."[245] In the second step, it held that elements like shuffling and dealing playing cards were "purely conventional steps" that were insufficient to transform the claims "into a patent-eligible application of the abstract idea."[246] The panel decision, however, stated that "not . . . all inventions in the gaming arts would be foreclosed from patent protection under [35 U.S.C.] § 101," and in *dicta* noted that "claims directed to conducting a game using a new or original deck of cards" could "potentially surviv[e] step two of [the *Mayo/Alice* test]."[247]

Similarly, in *In re Marco Guldenaar Holding B.V.*, a panel of the Federal Circuit affirmed the PTO's rejection of claims in a patent application covering a wagering game involving three six-sided dice that had only certain faces marked.[248] Relying heavily on *In re Smith*, the court first held that the claims were "directed to . . . an abstract idea"—namely, "rules for playing a . . . game."[249] On the second step of the *Mayo/Alice* test, the court concluded that, as in *Smith*, the claimed activities—the steps of placing a wager, rolling the dice, and paying a payout amount if at least one wagered outcome occurs—were "purely conventional and are insufficient to recite an inventive concept."[250] Although the majority reaffirmed the *dicta* in *Smith* that "inventions in the gaming arts are not necessarily foreclosed from patent protection under § 101,"[251] it appears that tabletop games likely will not qualify as patentable subject matter unless they include new and nonobvious game pieces or mechanics—a difficult bar to surmount.

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245. *Id.* at 818 (quoting *Alice*, 573 U.S. at 219) (alteration in original). The Federal Circuit cited the BPAI's reasoning that "[a] wagering game is, effectively, a method of exchanging and resolving financial obligations based on probabilities created during the distribution of the cards," analogous to the method of hedging risk found patent-ineligible in *Bilski* and the method of exchanging financial obligations found patent-ineligible in *Alice*. *Id.* at 818–19 (alteration in original).

246. *Id.* at 819.

247. *Id.*

248. *In re* Marco Guldenaar Holding B.V., 911 F.3d 1157, 1158–59 (Fed. Cir. 2018). Specifically, in the claimed game, the first die had only one face marked, the second die had two faces marked, and the third die had three faces marked. *Id.* at 1159.

249. *Id.* at 1160–61.

250. *Id.* at 1161.

251. *Id.* at 1162. Notably, Judge Mayer, who concurred in the outcome, would have gone even further and held that "claims directed to dice, card, and board games can never meet the section 101 threshold because they endeavor to influence human behavior rather than effect technological change." *Id.* (Mayer, J., concurring); *see also id.* at 1166 ("While games may enhance our leisure hours, they contribute nothing to the existing body of technological and scientific knowledge. They should therefore be deemed categorically ineligible for patent."). However, Judge Mayer's contention directly conflicts with the long history of patent protection for tabletop games. *See supra* notes 204–29 and accompanying text.

Third, even if the novelty, nonobviousness, and patent eligibility requirements can be met, patent protection may be unavailable if the game is "in public use, on sale, or otherwise available to the public" more than a year before the filing of a patent application.[252] Although the public use determination is highly fact-specific,[253] the Supreme Court has held that even a single unrestricted use of the invention may be sufficient to preclude patenting.[254] Similarly, a single offer to sell the invention—even if made in private—can invalidate a patent.[255] This may occur, for example, if a game is playtested[256] by others without any restriction or obligation of secrecy,[257] or if a game designer attempts to sell a physical copy of the game to a publisher.[258] For example, a design patent[259] covering a coin drop-style game

252. 35 U.S.C. § 102(a)(1) (2018).

253. *See, e.g.*, Dey, L.P. v. Sunovion Pharms., Inc., 715 F.3d 1351, 1355 (Fed. Cir. 2013) (listing numerous factors to be considered in whether a prior use is sufficiently public to preclude patenting, including "'the nature of the activity that occurred in public; the public access to and knowledge of the public use; [and] whether there was any confidentiality obligation imposed on persons who observed the use'" (alteration in original) (quoting Berhardt, L.L.C. v. Collezione Europa USA, Inc., 386 F.3d 1371, 1379 (Fed. Cir. 2004))).

254. *See* U.S. PAT. & TRADEMARK OFF., MANUAL OF PATENT EXAMINING PROCEDURE § 2133.03(a)(I) (9th ed. 2020) ("'[T]o constitute the public use of an invention it is not necessary that more than one of the patent articles should be publicly used. The use of a great number may tend to strengthen the proof, but one well defined case of such use is just as effectual to annul the patent as many.' Likewise, it is not necessary that more than one person use the invention." (alteration in original) (citing Egbert v. Lippman, 104 U.S. 333, 336 (1881))); *see also* R. CARL MOY, MOY'S WALKER ON PATENTS § 8:239 (4th ed. 2020) ("The threshold associated with these activities is quite low; the cases often assert that the number of uses is immaterial, and that a single use can be sufficient.").

255. *See* Helsinn Healthcare S.A. v. Teva Pharms. USA, Inc., 139 S. Ct. 628, 633–34 (2019) (holding that the on sale bar means the same thing pre-AIA and post-AIA, including that so-called "'secret sales' can invalidate a patent"); *see also In re* Caveney, 761 F.2d 671, 676 (Fed. Cir. 1985) (holding that just one offer to sell or sale triggers § 102's "on sale" statutory bar that renders the patent invalid).

256. Playtesting is the process of evaluating a prototype of a tabletop game by having others play it, collecting their feedback, and then adjusting or refining the game. Game designers often conduct multiple rounds of playtesting for a game. *See* SHARON BOLLER & KARL M. KAPP, PLAY TO LEARN: EVERYTHING YOU NEED TO KNOW ABOUT DESIGNING EFFECTIVE BOARD GAMES 99–112 (2017).

257. *See In re* Smith, 714 F.2d 1127, 1134 (Fed. Cir. 1983) (holding that a "public use" occurs when the inventor allows another person to use the invention without "limitation, restriction or obligation of secrecy to the inventor"); *see also* Schaeffer, *supra* note 18, at 42 (explaining that "playtesting—particularly in a public setting, such as at a game convention or trade show—could be considered a public disclosure that will bar patentability").

258. *See* Pfaff v. Wells Elecs., Inc., 525 U.S. 55, 67 (1998) (holding that two requirements must be met under § 102's "on sale" bar: (1) "the product must be the subject of a commercial offer for sale" and (2) "the invention must be ready for patenting"). However, an offer to license or sell the *rights* in a game, by itself, would not trigger the "on sale" bar of § 102. *See In re* Kollar, 286 F.3d 1326, 1331 (Fed. Cir. 2002) ("[M]erely granting a license to an invention, without more, does not trigger the on-sale bar of § 102(b)."); Moleculon Rsch. Corp. v. CBS, Inc., 793 F.2d 1261, 1267 (Fed. Cir. 1986) ("[A]n assignment or sale of the rights in the invention

was found invalid when the inventor had put the design on sale at least four years before filing the design patent's application.[260]

However, not all playtesting of a game necessarily precludes patenting. In *Moleculon Research Corp. v. CBS, Inc.*, the inventor "conceived of a three-dimensional puzzle capable of rotational movement," comprising "eight cubes attached in a 2 x 2 x 2 arrangement, with each of the six faces of the" cube having different color.[261] While in graduate school, the inventor constructed several prototypes of the puzzle and showed them to several people, including roommates and a colleague at work.[262] Moleculon then sent Parker Brothers a model and description of the puzzle cube. Just short of a year later,[263] the inventor filed a patent application on the puzzle cube, which the PTO subsequently granted.[264] When Moleculon sued CBS, the maker of the famous Rubik's Cube puzzle, CBS contended the patent was invalid because the subject matter of the patent had been in public use prior to the critical date.[265] Both the district court and the Federal Circuit rejected these arguments. On the public use issue, they held that because the inventor had not given others "free and unrestricted use" of the invention "[b]ased on the personal relationships and surrounding circumstances," which suggested the inventor had "at all times retained control over the puzzle's use and the distribution of information concerning it."[266]

Fourth, even if a tabletop game is patent eligible subject matter, the novelty and nonobviousness requirements, plus the existence of large amounts of prior art (both in the form of previously issued patents and published patent applications as well as other games), means that the scope of possible patent rights is often quite narrow. The patent's claims "define the scope of the patentee's rights under the [law]."[267] In a field crowded with prior art, a skilled patent attorney will attempt to draft the patent's

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and potential patent rights is not a sale of 'the invention' within the meaning of [pre-AIA] section 102(b).").

259. U.S. Patent No. D643,474 (filed Feb. 18, 2011). Design patents are generally subject to the same legal requirements for patentability as utility patents, except that a design patent covers the ornamental (non-functional) aspects. *See* 35 U.S.C. § 171(b) (2018).

260. Spencer v. Taco Bell Corp., No. 12-cv-387-T-23TGW, 2013 WL 5499609, at *9 (M.D. Fla. Oct. 2, 2013), *aff'd without opinion*, 560 F. App'x 997, 997 (Fed. Cir. 2014).

261. *Moleculon*, 793 F.2d at 1263.

262. *Id.*

263. The disclosure to Parker Brothers occurred on March 7, 1969, and the patent application was filed on March 3, 1970. *Id.*

264. U.S. Patent No. 3,655,201 (filed Mar. 4, 1970).

265. *Moleculon*, 793 F.2d at 1265. The defendants raised a similar claim regarding the "on sale" bar, which was also rejected. *Id.* at 1267.

266. *Id.* at 1266.

267. Markman v. Westview Instruments, Inc., 52 F.3d 967, 971 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996); *see also* 35 U.S.C. § 112(b) (2018) (providing that a patent "shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention").

claims narrowly to avoid a possible rejection at the PTO or invalidation in litigation.[268] Today, a game designer would be unlikely to obtain protection anywhere near as broad as Charles Darrow's patent, which covered nearly every aspect of *Monopoly*'s board, game play, and game pieces.[269]

Fifth, a board game designer or publisher may conclude that obtaining a patent is simply not cost effective, especially in light of the legal issues previously described and the availability of other forms of IP protection. Most game designers are independent contractors rather than employees and often work another job on a part- or full-time basis.[270] Thus, few game designers are independently wealthy enough to pay the attorneys' fees and other costs associated with applying for a patent, which can run into the tens of thousands of dollars,[271] or the attorneys' fees and costs to enforce patent rights in court, which can run much higher.[272] In addition, the uncertain prospects of a new game, plus the low profit margin of many games,[273] may make it impractical to pursue patent protection. Furthermore, the patent prosecution process can last many months.[274] Finally, although the term of patent protection is lengthy—up to 20 years from date of application—it is considerably shorter than copyrights or trademarks.[275]

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268. *See* Kristen Osenga, *Linguistics and Patent Claim Construction*, 38 RUTGERS L.J. 61, 67 (2006) ("The patent applicant, in drafting claims, is trying to walk a thin line of fashioning a claim sufficiently narrow that it is not invalid over the prior art, but at the same time trying to obtain a sufficiently wide scope of protection that may include coverage of future devices.").

269. *See supra* notes 204–08 and accompanying text.

270. *See* TINSMAN, *supra* note 78, at 53 ("[M]ost game design companies don't have a staff of full-time inventors creating new games.").

271. *See* AM. INTELL. PROP. L. ASS'N, REPORT OF THE ECONOMIC SURVEY 2021, at 42 (2021) (detailing average costs for preparing a U.S. utility patent application, including $7,500 for an original, minimally complex application, $2,000 for an amendment, $2,000 for a novelty search, and $5,000 to $8,000 for an appeal to the Patent Trial and Appeal Board).

272. *See id.* at 60 (stating that patent litigation expenses can run from an average of $675,000 through trial and appeal when less than $1 million is at risk, up to an average of $4 million when over $25 million is at risk).

273. For example, a self-published game designer may incur substantial design, pre-production, fundraising, manufacturing, marketing, and distribution/shipping costs before any profits are earned. *See* Carol Mertz, *The Dirty Details of Self-Publishing an Indie Tabletop Game*, CAROL MERTZ: BLOG (May 10, 2016), http://carolmertz.com/2016/05/the-dirty-details-of-self-publishing-an-indie-tabletop-game [https://perma.cc/7DBT-W3E8]. If a game designer submits the game to an established publisher, he or she will likely receive only a small percentage of profits in royalties. *See* TINSMAN, *supra* note 78, at 220 (noting that royalty rates for a smaller company may be 10–12%, while a larger publisher may be 2–4%).

274. As of December 2021, the average patent pendency (time from filing to issuance or termination) is nearly two years. *See* U.S. PAT. & TRADEMARK OFF., *Patents Pendency Data December 2021*, https://www.uspto.gov/dashboard/patents/pendency.html [https://perma.cc/AE78-N7HB].

275. *Compare* 35 U.S.C. § 154(a)(2) (2018) (providing that a patent's duration "shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed"), *with* 17 U.S.C. § 302(a) (2018) ("Copyright in a work created on or after January 1, 1978, subsists from its creation and . . . endures for a term consisting of the life of the author and 70 years after the author's death."), *and* 15 U.S.C.

In sum, although patents theoretically can protect numerous aspects of a tabletop game, including the game apparatus and method of play, in reality, the legal and practical hurdles to obtaining a patent for a game means that relatively few game designers or publishers pursue this path.

C. *TRADEMARK*

Trademarks are words, symbols and devices that indicate a source of origin for a good or service.[276] A trademark protects the owner against others using the same or a confusingly similar mark for their own goods or services in commerce without the owner's permission.[277] Although trademarks do not need to be federally registered with the USPTO to confer protection,[278] there are numerous advantages to registration, including: presumption of ownership of the mark and the exclusive right to its nationwide use for goods and services;[279] the possibility of achieving incontestable status of the mark after five years;[280] the right to request that customs officials bar imported goods bearing infringing marks;[281] and certain additional remedies.[282]

Trademark law is frequently used to protect the names, logos, slogans, and other distinctive aspects of tabletop games. For example, Hasbro (the legal successor to Parker Brothers) owns federally registered trademarks related to *Monopoly*, including the word mark itself;[283] an image of the game board;[284] the "Go to Jail," "Free Parking," "In Jail/Just Visiting," and "Boardwalk"

§§ 1058–59 (2018) (explaining that federally registered trademarks are available in renewable 10-year terms). *See* Yurman Design, Inc. v. PAJ, Inc., 262 F.3d 101, 115 (2d Cir. 2001) ("Patent and copyright law bestow limited periods of protection, but trademark rights can be forever.").

276. 15 U.S.C. § 1127. Nontraditional marks, including colors, sounds, or smells, are eligible for trademark protection if they indicate a source of origin to customers. *See* Qualitex Co. v. Jacobson Prods. Co., 514 U.S. 159, 174 (1995) (holding that a color alone may be protectable as a trademark); *see also* Kenneth L. Port, *On Nontraditional Trademarks*, 38 N. KY. L. REV. 1, 2 (2011); Lisa P. Ramsey, *Non-Traditional Trademarks and Inherently Valuable Expression*, *in* THE PROTECTION OF NON-TRADITIONAL TRADEMARKS: CRITICAL PERSPECTIVES 337, 345 (Irene Calboli & Martin Senftleben eds., 2018).

277. 15 U.S.C. §§ 1114, 1125(a); *see also* AMF Inc. v. Sleekcraft Boats, 599 F.2d 341, 348 (9th Cir. 1979) (discussing and applying the standard for determining trademark infringement based on likelihood of confusion), *abrogated by* Mattel Inc. v. Walking Mountain Prods., 353 F.3d 792 (9th Cir. 2003).

278. 15 U.S.C. § 1125(a)(1); *see also* Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992) ("[I]t is common ground that § 43(a) protects qualifying unregistered trademarks . . . .").

279. 15 U.S.C. § 1072.

280. *Id.* § 1065.

281. *Id.* § 1124.

282. *Id.* § 1117(b)–(c) (authorizing triple damages and statutory damages for counterfeits of registered marks).

283. MONOPOLY, Registration No. 326,723.

284. MONOPOLY, An illustration drawing which includes word(s)/ letter(s)/ number(s), Registration No. 1,536,501; MONOPOLY, The overall shape of the game board, Registration No. 1,591,120.

squares;[285] Chance and Community Chest cards;[286] the Railroad logo;[287] and the Mr. Monopoly character.[288] Hasbro has also trademarked use of the word MONOPOLY for goods and services beyond board games,[289] as well as various adaptations and spinoffs from the classic version of the game.[290]

One limitation on trademark protection is that a mark is not protectable if it becomes "the generic name for the goods or services or a portion thereof, for which it registered."[291] This can occur if the mark is synonymous with the product or service itself at the time of first use (i.e., "born generic"), or if the mark subsequently becomes understood to refer to the class of goods or services of which it is a part, rather than a source of origin (i.e., genericide).[292] For example, the word mark PARCHEESI is generic, as it refers to a game originally played in India prior to its importation into the United States.[293] Similarly, BACKGAMMON, CHECKERS,

285. GO TO JAIL, Registration No. 1,810,912; FREE PARKING, Registration No. 1,809,353; IN JAIL JUST VISITING, Registration No. 1,819,061; COLLECT $200.00 SALARY AS YOU PASS GO, Registration No. 1,782,815; BOARDWALK, Registration No. 1,969,532.

286. CHANCE?, Registration No. 1,971,002; COMMUNITY CHEST FOLLOW INSTRUCTIONS ON TOP CARD, Registration No. 1,973,665.

287. MONOPOLY, An illustration drawing without any word(s)/ letter(s)/ number(s), Registration No. 1,969,531.

288. *See, e.g.* MONOPOLY, An illustration drawing without any word(s)/ letter(s)/ number(s), Registration No. 1,634,215; MONOPOLY, An illustration drawing without any word(s)/ letter(s)/ number(s), Registration No. 1,634,214.

289. *See, e.g.*, MONOPOLY, Registration No. 5,728,056 (for use with backpacks, tote bags, book bags, handbags, purses, and wallets); MONOPOLY, Registration No. 5,728,055 (for use with bed blankets, bed sheets, bedspreads, comforters, quilts, and textile wall hangings); MONOPOLY, Registration No. 4,818,781 (for use with gambling equipment and machines); MONOPOLY, Registration No. 4,796,523 (for use in lottery tickets); MONOPOLY, Registration No. 2,654,349 (for use in computer game programs).

290. *See, e.g.*, MONOPOLY REVOLUTION, Registration No. 3,994,532; MONOPOLY DEAL, Registration No. 3,851,950; *see also* ADVANCE TO BOARDWALK, Registration No. 5,681,117.

291. 15 U.S.C. § 1065(4) (2018); *see also* Sandra L. Rierson, *Toward a More Coherent Doctrine of Trademark Genericism and Functionality: Focusing on Fair Competition*, 27 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 691, 701 (2017) ("The current version of the Lanham Act extends no protection to words or terms considered generic, even if the word or term was, at one point, a registered, inherently distinctive trademark.").

292. *See* Dan L. Burk, *Trademarks Along the Infobahn: A First Look at the Emerging Law of Cybermarks*, 1 RICH. J.L. & TECH. 1, 27 (1995) ("Some terms, such as 'toothpaste' are born generic; others such as 'escalator,' have genericness thrust upon them by becoming a common descriptive name in the mind of the public.").

293. *See* Selchow & Righter Co. v. W. Printing & Lithographing Co., 29 F. Supp. 569, 570–71 (E.D. Wis. 1939), *aff'd*, 112 F.2d 430 (7th Cir. 1940); *see also* Selchow v. Chaffee & Selchow Mfg. Co., 132 F. 996, 999 (C.C.S.D.N.Y. 1904) ("[I]t seems that a person ought not to be permitted to introduce into this country an article of manufacture of any description, including a game such as is in question here, and gain a monopoly either of the game, article, or name thereof, by registering its name as a trade-mark under our trade-mark laws, either using the foreign name or one so similar as to leave no doubt of the game or article intended on hearing the name pronounced or on seeing it written.").

and CHESS would be generic if used to describe the respective games but may be protectable if used for other goods and services unrelated to gaming.[294]

Indeed, one of the most important genericide cases involved the board game *Monopoly*. In the 1970s, Ralph Anspach, an economist, created a board game named Anti-Monopoly that was "designed to emphasize the values of the competitive private enterprise system."[295] The basic goal of Anti-Monopoly—in contrast to *Monopoly*, which encouraged the aggregation of property ownership and wealth into the hands of one person—was to bring indictments against monopolistic owners of firms in various industries and restore competition.[296] Anspach applied for trademark protection for the name "Anti-Monopoly,"[297] but the USPTO rejected the application on the grounds that it would be likely to cause "confusion, mistake, or deception."[298]

After receiving a cease-and-desist letter from Parker Brothers regarding the game's name,[299] Anspach filed suit in federal court, asserting that the MONOPOLY trademark had become generic and requesting its cancellation.[300] The district court rejected this claim,[301] but on appeal, the Ninth Circuit initially remanded for reconsideration,[302] and then reversed, holding that Parker Brothers' "successful[] promot[ion of] 'Monopoly' as 'the name of [a] game'" where the ultimate goal is to be a monopolist had led it to "bec[o]me generic in the sense in which we use that term in trademark law."[303]

The court reasoned that even though survey evidence found that a majority of the public associated *Monopoly* with Parker Brothers, the mark was nonetheless generic because most customers "who purchased the game wanted 'Monopoly' and did not care who made it."[304] In response, Congress enacted legislation that effectively overturned the Ninth Circuit's decision by providing that a registered mark shall not be considered generic "solely

294. For example, Chess Records, or Checkers Drive-In restaurant.

295. Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., 611 F.2d 296, 300 (9th Cir. 1979).

296. *See* PILON, *supra* note 205, at 2–17 (describing Anspach's development and marketing of the Anti-Monopoly game); *see also* U.S. Patent No. 3,961,795 (filed Mar. 3, 1975) (further explaining the game's objectives and mechanics).

297. According to the Ninth Circuit, Anspach initially "intended to market his game under the title, 'Bust the Trust, The Anti-Monopoly game,' but he later decided that 'Anti-Monopoly' would be a better title." *Anti-Monopoly*, 611 F.2d at 300.

298. *Id.*; *see also* PILON, *supra* note 205, at 15 (noting the grounds on which the USPTO rejected Anspach's application).

299. This letter is reprinted in PILON, *supra* note 205, at 15–16.

300. *Anti-Monopoly*, 611 F.2d at 300.

301. Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., Inc., No. C-74-0529, 1977 WL 22724, at *1 (N.D. Cal. Apr. 4, 1977), *rev'd sub nom.*, 611 F.2d 296 (9th Cir. 1979).

302. *Anti-Monopoly*, 611 F.2d at 300–06.

303. Anti-Monopoly, Inc. v. Gen. Mills Fun Grp., Inc., 684 F.2d 1316, 1321–23 (9th Cir. 1982).

304. *Id.* at 1323.

because such mark is also used as a name of or to identify a unique product or service."[305]

Another significant limitation is that trademark protection often does not extend to parodies. Although it is not an affirmative defense to a claim of trademark infringement, a successful parody usually will not infringe because there is no likelihood of confusion.[306] Instead, the ordinary viewer "will understand that an entity separate and distinct from the trademark owner is poking fun at the trademark of the policies of its owner."[307] As a result, a successful parody "would merely amuse, not confuse."[308] Not surprisingly, however, trademark owners often have a poor sense of humor when it comes to parodies, asserting that they harm the value of their brand.[309] There are numerous examples of parodies in the world of tabletop gaming, ranging from unauthorized parodies where the trademark owner pursued litigation[310] to "official parodies" made by the same company as the

305. Trademark Clarification Act of 1984, Pub. L. No. 98-620, § 102, 98 Stat. 3335, 3335 (codified at 15 U.S.C. § 1064(c) (2018)). Congress also clarified that "[t]he primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining" genericide. *Id. See generally* A. Samuel Oddi, *Assessing "Genericness": Another View*, 78 TRADEMARK REP. 560 (1988) (discussing the significance of *Anti-Monopoly* and summarizing the resulting legislative changes by Congress).

306. J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:153 (5th ed. 2022); *see also* David A. Simon, *The Confusion Trap: Rethinking Parody in Trademark Law*, 88 WASH. L. REV. 1021, 1026 (2013) ("In copyright, the parody analysis occurs *after* the infringement analysis, as a defense. Parody in trademark law, by contrast, operates *during* the infringement analysis. It is not, as courts and commentators tell us, a real defense."). Parody, however, is a statutory defense to a trademark dilution claim. *See* 15 U.S.C. § 1125(c)(3) ("The following shall not be actionable as dilution . . . identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner.").

307. MCCARTHY, *supra* note 306, § 31:153; *see also* Hormel Foods Corp. v. Jim Henson Prods., Inc., 73 F.3d 497, 503 (2d Cir. 1996) ("[A] parody depends on a lack of confusion to make its point. 'A parody must convey two simultaneous—and contradictory—messages: that it is the original, but also that it is *not* the original and is instead a parody.'" (citing Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ'g Grp., Inc., 886 F.2d 490, 494 (2d Cir. 1989))).

308. MCCARTHY, *supra* note 306, § 31:153 (citing Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC, 507 F.3d 252, 267 (4th Cir. 2007)).

309. *See, e.g.*, Louis Vuitton Malletier, S.A. v. My Other Bag, Inc., 156 F. Supp. 3d 425, 436 (S.D.N.Y. 2016) ("[T]he fact that Louis Vuitton at least does not find the comparison funny is immaterial; Louis Vuitton's sense of humor (or lack thereof) does not delineate the parameters of its rights . . . under trademark law."); *see also* Sandra L. Rierson, *The Myth and Reality of Dilution*, 11 DUKE L. & TECH. REV. 212, 270 (2012) ("Like the authors of creative works, these corporate entities would like to control all uses of their marks, particularly those that are offensive to them . . . .").

310. *See generally, e.g.*, Hasbro, Inc. v. Chang, C.A. No. 03-482-T, 2006 WL 8456958 (D.R.I. Feb. 17, 2006) (recommending entry of default judgment against defendant on Hasbro's claims of trademark and copyright infringement based upon defendant's manufacture and sale of a racially offensive board game name; also mentioning defendant's parody defense).

original game.[311] Tabletop role-playing games are also a source of parodies, poking fun at everything from *D&D*[312] to *Star Trek*.[313]

Not every parody, however, is successful. For example, a company called Vampire Squid Cards made and sold an "expansion pack of cards" with "an . . . off-beat sense of humor" to the well-known *Cards Against Humanity* game.[314] The company adopted the name "Crabs Adjust Humidity" and a logo of a crab claw adjusting a thermostat-like dial for their product.[315] After Vampire Squid Cards applied to the USPTO to register the word mark and logo, the owner of *Cards Against Humanity*—which had its own registered trademarks[316]—filed an opposition, asserting that consumers would likely be confused by the similarities between the two marks.[317] The Trademark Trial and Appeal Board rejected the applicant's argument that the CRABS ADJUST HUMIDITY marks were not likely to confuse because they were a parody, explaining "that parody is a viable defense in a likelihood of confusion analysis only if the involved marks are otherwise not found confusingly similar."[318] Here, however, "the parties' goods are identical and the marks are similar in their overall commercial impressions due to the shared elements in each."[319] As a result, the claim that the CRABS ADJUST HUMIDITY "marks constitute[d] a parody [was] unavailing."[320]

Finally, the trade dress of a tabletop game may be protectable. Trade dress refers to the overall "image [and appearance] of a product[,] . . . includ[ing] . . . [its] size, shape, color[s,] . . . graphics," and packaging.[321] To be protectable,

311. *See, e.g.*, MONOPOLY: SOCIALISM (Hasbro 2019); CLUE: LOST IN VEGAS (Hasbro 2018); BOTCHED OPERATION (Hasbro 2018).

312. *See, e.g.*, BUNKERS & BADASSES (Nerdvana Games 2020); *see also* Charlie Hall, *Borderlands' In-Fiction Dungeons & Dragons Spoof Is Being Turned into a Real-Life RPG*, POLYGON (Sept. 12, 2020), https://www.polygon.com/2020/9/12/21433048/borderlands-bunkers-and-badasses-rpg-book-release-date-price-dungeons-dragons [https://perma.cc/7A35-G2E2] (commenting on a D&D spoof).

313. *See, e.g.*, STAR WRECK ROLEPLAYING GAME (Energia Productions 2006).

314. Cards Against Human., LLC v. Vampire Squid Cards, LLC, Opposition No. 91225576, 2019 WL 1491525, at *4 (T.T.A.B. Feb. 28, 2019).

315. *Id.* at *12. One of the principals of Vampire Squid Cards explained that he adopted the mark CRABS ADJUST HUMIDITY because he "wanted a phrase that would evoke [CARDS AGAINST HUMANITY] by rhyming with it, but in an absurdist and surreal way." *Id.* at *4 (alteration in original) (citation omitted).

316. *See* CARDS AGAINST HUMANITY, Registration No. 4,304,805; CAH, Registration No. 3,354,769; *see also* CARDS AGAINST HUMANITY A PARTY GAME FOR HORRIBLE PEOPLE, Registration No. 4,623,613 (describing the graphical mark as "a three-dimensional black rectangular product packaging featuring the words 'CARDS AGAINST HUMANITY' in white letters located in the upper left-hand corner of the rectangular design").

317. *Cards Against Humanity, LLC*, 2019 WL 1491525, at *1.

318. *Id.* at *11.

319. *Id.*

320. *Id.*

321. Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 764 n.1 (1992) (quoting John H. Harland Co. v. Clarke Checks, Inc., 711 F.2d 966, 980 (11th Cir. 1983)); *see also* MCCARTHY,

trade dress must be "either . . . inherently distinctive or . . . ha[ve] acquired distinctiveness through secondary meaning."[322] Distinctive, nonfunctional trade dress can be registered as a trademark,[323] but many trade dress claims involve infringement of unregistered marks under section 43(a) of the Lanham Act.[324]

Games can qualify for trade dress protection if they satisfy these elements.[325] For instance, Shuffle Master, the maker of a table game for casinos called "Four Card Poker," sued to stop a competitor from infringing its trade dress.[326] The district court issued a preliminary injunction, finding that Four Card Poker was likely inherently distinctive based on its combination of elements, including use of a semi-circular table, and the availability of alternative designs.[327] In addition, it pointed to evidence of secondary meaning, including advertising expenditures and survey evidence finding that 35 percent "of table game managers . . . [in] casinos [across] the United States . . . associated [the game] with a single source."[328]

D. OTHER IP RIGHTS

A number of other IP and IP-adjacent bodies of law may also provide legal protection for some aspects of tabletop games, as well as presenting potential issues for game designers and publishers.

First, design patents are available for "new, original[,] and ornamental design[s] for an article of manufacture."[329] Like utility patents, design

supra note 306, § 8:4 ("[I]n modern parlance, 'trade dress' includes the total look of a product and its packaging and even includes the design and shape of the product itself.").

322. *Two Pesos, Inc.*, 505 U.S. at 769; *see id.* at 769–75. However, trade dress in a single color or in product shape or design can never be inherently distinctive, so secondary meaning must be established. *See* Wal-Mart Stores, Inc. v. Samara Bros., Inc., 529 U.S. 205, 212 (2000) ("It seems to us that design, like color, is not inherently distinctive."); *see also* MCCARTHY, *supra* note 306, § 8:12.

323. *In re* Forney Indus., Inc., 955 F.3d 940, 945 (Fed. Cir. 2020) ("Trade dress is registrable as a trademark if it serves the same source-identifying function as a trademark."); *see also* TMEP § 1202.02 (2021) ("Trade dress constitutes a 'symbol' or 'device' within the meaning of §2 of the [Lanham] Act . . . .").

324. *Two Pesos, Inc.*, 505 U.S. at 767–75; *see also id.* at 780 (Stevens, J., concurring) ("The federal courts are in agreement that § 43(a) creates a federal cause of action for trademark and trade dress infringement claims."); MCCARTHY, *supra* note 306, § 8:7 ("[Section] 43(a) has often been used as a vehicle by which to assert claims for infringement of unregistered trade dress in the federal courts.").

325. *See, e.g.*, Tetris Holding, LLC v. Xio Interactive, Inc., 863 F. Supp. 2d 394, 415–16 (D.N.J. 2012) (holding that the trade dress in the video game Tetris, including the size and color of the blocks and the long rectangular playing field, are distinctive and nonfunctional).

326. Shuffle Master Inc. v. Awada, No. 05-CV-01112, 2006 WL 2547091, at *1 (D. Nev. Aug. 31, 2006).

327. *See id.* at *2.

328. *Id.* at *3.

329. 35 U.S.C. § 171(a) (2018).

patents must satisfy the novelty and nonobviousness requirements,[330] but design patent applications are more likely to be granted,[331] and very few rejections are based on the prior art.[332] A major limitation on design patents is functionality; "[i]f the patented design is primarily functional rather than ornamental, the patent is invalid."[333] Design patents last for 15 years,[334] and the patentee may recover the infringer's "total profit" from the sale of any "article of manufacture" that applies "the patented design[] or any colorable imitation thereof."[335]

Design patents can protect the ornamental (i.e., visual and nonfunctional) aspects of tabletop games.[336] For instance, there are numerous examples of chess pieces and chess sets covered by design patents.[337] The appearance of game parts like dice,[338] spinners,[339] game tiles,[340] and game

330. *See* 35 U.S.C. § 171(b) ("The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."); *see also In re* Borden, 90 F.3d 1570, 1574 (Fed. Cir. 1996) ("Design patents are subject to the same conditions on patentability as utility patents, including the nonobviousness requirement of 35 U.S.C. § 103.").

331. *Compare Design Data December* 2021, U.S. PAT. & TRADEMARK OFF., https://www.uspto.gov/dashboard/patents/design.html [https://perma.cc/YZS8-WS6Z] (Nov. 19, 2020) (showing that the allowance rate for design patent applications for fiscal year 2022 is 86.4 percent), *with* Michael Carley, Deepak Hegde & Alan Marco, *What is the Probability of Receiving a U.S. Patent?*, 17 YALE J.L. & TECH. 203 (2015) (finding that 55.8 percent of utility patent applications filed between 1996 and 2005 and examined before mid-2013 issued as patents without the use of continuation procedures).

332. *See* Janice M. Mueller & Daniel H. Brean, *Overcoming the "Impossible Issue" of Nonobviousness in Design Patents*, 99 KY. L.J. 419, 425 (2011) ("The USPTO . . . very rarely discovers and cites prior art designs as rendering a design application unpatentable.").

333. PHG Techs., LLC v. St. John Cos., Inc., 469 F.3d 1361, 1366 (Fed. Cir. 2006) (quoting Power Controls Corp. v. Hybrinetics, Inc., 806 F.2d 234, 238 (Fed. Cir. 1986)).

334. 35 U.S.C. § 173.

335. *Id.* § 289; *see also* Samsung Elecs. Co. v. Apple, Inc., 137 S.Ct. 429, 431 (2016) (holding that for a "multicomponent product, the relevant 'article of manufacture' [under] § 289 . . . need not be the end product sold to the consumer but may be only a component of that product").

336. *See* Schaeffer, *supra* note 18, at 42 ("[A] design patent may be an avenue for protecting novel game components, allowing the owner to prevent others from using similar-looking components.").

337. *See, e.g.*, U.S. Design Patent No. 767,041 (filed Sept. 2, 2014); U.S. Design Patent No. 695,355 (filed Mar. 15, 2012); U.S. Design Patent No. 493,198 (filed Oct. 31, 2002); U.S. Design Patent No. 392,269 (filed Apr. 6, 1995); U.S. Design Patent No. 326,285 (filed Aug. 2, 1990); U.S. Design Patent No. 279,390 (filed Nov. 8, 1982); U.S. Design Patent No. 275,869 (filed Nov. 5, 1982); U.S. Design Patent No. 266,012 (filed Oct. 4, 1979).

338. *See, e.g.*, U.S. Design Patent No. 864,309 (filed Aug. 24, 2018); U.S. Design Patent No. 799,602 (filed Dec. 8, 2016); U.S. Design Patent No. 746,381 (filed Aug. 14, 2014); U.S. Design Patent No. 745,930 (filed Oct. 1, 2014); U.S. Design Patent No. 713,470 (filed June 6, 2013); U.S. Design Patent No. 603,458 (filed May 1, 2008).

339. *See, e.g.*, U.S. Design Patent No. 883,392 (filed Nov. 6, 2018); U.S. Design Patent No. 483,076 (filed Feb. 12, 2003).

340. *See, e.g.*, U.S. Design Patent No. 867,465 (filed Feb. 25, 2019); U.S. Design Patent No. 802,680 (filed Oct. 31, 2016); U.S. Design Patent No. 795,352 (filed Oct. 31, 2016).

boards[341] also have received design patent protection. And some well-known handheld games, such as *Simon*[342] and *Rush Hour*,[343] have been covered by design patents.

Second, the right of publicity may be implicated when a person's identity is included in a tabletop game without their consent. The right of publicity prevents the unauthorized appropriation of a "person's name, likeness, [and] other indicia of identity for [commercial] purposes."[344] Indeed, several right of publicity cases have involved the unauthorized use of names and other identifying information of well-known figures in games, including professional athletes and billionaire businesspersons.[345] While states have adopted a number of exceptions to the right of publicity,[346] these are of little help for tabletop games that include famous or historic figures, as the use is for a commercial purpose that does not appear to clearly fit into one of the statutory exceptions. As a result, tabletop game publishers generally steer clear of including real-life people in their games without obtaining their express consent (usually in exchange for a licensing fee).[347]

Third, trade secrecy may provide protection for game designers and publishers against misappropriation of confidential information related to tabletop games, but not the game itself once it is placed on sale to the

341. *See, e.g.*, U.S. Design Patent No. 722,650 (filed Mar. 23, 2014); U.S. Design Patent No. 717,879 (filed Apr. 11, 2014); U.S. Design Patent 714,873 (filed Jan. 24, 2013); U.S. Design Patent No. 692,062 (filed Sept. 26, 2012); U.S. Design Patent 660,372 (filed Feb. 2, 2011); U.S. Design Patent No. 150,191 (filed June 10, 1946); U.S. Design Patent No. 103,697 (filed Jan. 6, 1937).

342. U.S. Design Patent No. 253,786 (filed Apr. 13, 1978).

343. U.S. Design Patent No. 395,468 (filed June 23, 1998).

344. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (AM. L. INST. 1995); *see also* 1 J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY 3, § 1:3 (2d ed. 2009) (describing the right of publicity as "a right inherent to everyone to control the commercial use of identity and persona"). In some states such as California and New York, the right of publicity extends to deceased persons as well. CAL. CIV. CODE § 3344.1 (West 2022); S.B. 05959D, 2019 Leg. (N.Y. 2019).

345. *See, e.g.*, Uhlanender v. Henricksen, 316 F. Supp. 1277, 1283 (D. Minn. 1970) (inclusion of professional baseball players' names and statistics in a game without their permission); Rosemont Enters., Inc. v. Urban Sys., Inc., 340 N.Y.S.2d 144, 145 (Sup. Ct. 1973) (billionaire businessman Howard Hughes objected to unauthorized board game entitled *The Howard Hughes Game*); Palmer v. Schonhorn Enters., Inc., 232 A.2d 458, 459 (N.J. Super. Ct. Ch. Div. 1967) (board game about professional golf included the names and profiles of 23 professional golfers, including Arnold Palmer, Gary Player, and Jack Nicklaus, without their consent); *see also* Ford & Liebler, *supra* note 18, at 22–33 (discussing these cases in detail).

346. *See, e.g.*, CAL. CIV. CODE § 3344(d); 765 ILL. COMP. STAT. ANN. 1075/35(b)(2) (West 2022) (permitting use of names, photographs, and likenesses in news reports, public affairs, and sports broadcasts).

347. As one example, in requesting submissions for new characters for their game *Unmatched*, Restoration Games required that all submissions must include characters in the public domain, including "stay away from real modern figures." RESTORATION GAMES, UNMATCHED DESIGN CONTEST RULES AND ENTRY FORM, https://restorationgames.com/wp-content/uploads/2020/07/Unmatched-Design-Contest-Rules.pdf [https://perma.cc/5P9L-M375].

public.[348] Federal and state trade secrets law protects a wide variety of information—including but not limited to patterns, plans, formulas, methods, processes, procedures, and programs—that provides economic value from not being generally known or readily ascertainable through proper means.[349] Furthermore, the trade secret owner must take reasonable precautions to keep this information secret.[350] Trade secret information is protected against misappropriation by others, which includes acquisition by improper means and disclosure or use without the owner's permission or in violation of a duty of confidentiality.[351]

Trade secrets law can protect a board game designer who submits a game to a publisher with an expectation that the publisher will not make or sell the game without the designer's consent. For instance, in *Burten v. Milton Bradley Co.*, two game designers created a prototype of an electronic board game called "Triumph" and submitted it to Milton Bradley for consideration.[352] As part of the submission process, the designers signed Milton Bradley's standard disclosure agreement.[353] After review, Milton Bradley declined to publish Triumph, but a year later, the game designers discovered that Milton Bradley was marketing a new electronic board game under the name "Dark Tower" that they believed contained significant structural and design similarities to Triumph.[354]

At trial, the jury initially found in favor of Triumph's designers, awarding over $700,000 in damages for trade secret misappropriation by Milton Bradley, but the district court set the verdict aside on the grounds that Milton Bradley had not entered into a confidential relationship with the designers and thus owed no duty to them.[355] On appeal, however, the First Circuit reversed, finding that the written disclosure agreement did not contain an express disclaimer of confidentiality by Milton Bradley.[356] Rather, the issue of whether the parties had entered into an implied duty of confidentiality was a factual question that the jury was entitled to resolve, and sufficient evidence supported the jury's conclusion that Milton Bradley had misused the Triumph game materials that were submitted in confidence

348. Trade secret protection is unavailable for products (like board games) that are self-disclosing when publicly used or sold. Lemley, *supra* note 31, at 313.

349. *See* 18 U.S.C. § 1839(3) (2018) (defining "trade secret" under federal law); UNIF. TRADE SECRETS ACT § 1(4) (UNIF. L. COMM'N, amended 1985) (defining "trade secret" under the Uniform Trade Secrets Act).

350. 18 U.S.C. § 1839(3)(A) (requiring a trade secret owner to take "reasonable measures to keep such information secret"); UNIF. TRADE SECRETS ACT § 1(4)(ii) (requiring that a trade secret be "the subject of efforts that are reasonable under the circumstances to maintain its secrecy").

351. *See* 18 U.S.C. §§ 1836(b)(1), 1839(5); UNIF. TRADE SECRETS ACT § 1(2).

352. Burten v. Milton Bradley Co., 763 F.2d 461, 462 (1st Cir. 1985).

353. *Id.*

354. *Id.*

355. *Id.* at 462–64.

356. *Id.* at 464–67.

by the designers and that Milton Bradley had "plagiarized the plaintiffs' idea[s]."[357]

Finally, idea submission claims may provide another state-law based means for protecting game creators who submit their work to publishers.[358] Idea submission cases typically involve "someone [who] discloses an idea to a company in the hopes of effectuating a transaction, and the company uses that idea for its own benefit without permission or compensation . . . ."[359] Although the contours vary significantly in the states that recognize it,[360] idea submission claims are "rooted in the notion that it is unfair to deny the creator of an idea with compensation when another takes and profits from the idea without permission."[361] In California, for instance, an idea submission claim is based on an implied-in-fact contract that arises when an idea is submitted, there is offer for payment based on use of the idea and an acceptance, followed by use without payment.[362] New York recognizes a similar claim, but it also requires proof that the idea is novel.[363]

Several decisions have recognized the viability of idea submission claims for tabletop game submissions.[364] For instance, *in Vantage Point, Inc. v. Parker Brothers, Inc.*, the plaintiff mailed information about an oil exploration game called "Wildcat," including photographs, rules, and a patent application description to defendant Milton Bradley with an accompanying letter inviting review.[365] Milton Bradley responded with a form letter explaining that it did not consider unsolicited submissions like the plaintiff's.[366] Plaintiff

357. *Id.* (quoting Burten v. Milton Bradley Co., 592 F. Supp. 1021, 1038 (D.R.I. 1984)).

358. *See* Arthur R. Miller, *Common Law Protection for Products of the Mind: An "Idea" Whose Time Has Come*, 119 HARV. L. REV. 705, 709 (2006) ("Over the course of more than a century, judges have cobbled together a 'law of ideas' from the ad hoc application of various common law doctrines.").

359. Charles Tait Graves, *Should California's Film Script Cases Be Merged into Trade Secret Law?*, 44 COLUM. J.L. & ARTS 21, 23 (2020).

360. *See* LaFrance, *supra* note 196, at 485 ("[S]tates vary considerably in the scope of, and prerequisites for, legal protection granted to ideas" and "[t]he states most often highlighted for their contrasting approaches are New York and California.").

361. MARK S. LEE, ENTERTAINMENT AND INTELLECTUAL PROPERTY LAW § 5:16 (2021).

362. This is called a *Desny* claim, based on the California Supreme Court's decision in *Desny v. Wilder*, 299 P.2d 257, 260 (Cal. 1956). *See* Graves, *supra* note 359, at 23.

363. *See* Hudson Hotels Corp. v. Choice Hotels Int'l, 995 F.2d 1173, 1178 (2d Cir. 1993) ("New York law dictates that an idea . . . must demonstrate novelty . . . to be protectible . . . under '[any] cause of action for [its] unauthorized use.'" (quoting Murray v. Nat'l Broad. Co., 844 F.2d 988, 994 (2d Cir. 1988)) (alterations original)), *abrogated by* Nadel v. Play-By-Play Toys & Novelties, Inc., 208 F.3d 368 (2d Cir. 2000).

364. *See, e.g.*, Simmons v. W. Publ'g Co., 834 F. Supp. 393, 395–97 (N.D. Ga. 1993); Vantage Point, Inc. v. Parker Bros., Inc., 529 F. Supp. 1204, 1216 (E.D.N.Y. 1981); *see also* Burten v. Milton Bradley Co., 763 F.2d 461, 462 (1st Cir. 1985) (noting that plaintiffs brought an implied-in-fact contract claim along with a misappropriation of trade secrets claim for the submission of their electronic board game "Triumph" to Milton Bradley).

365. *Vantage Point, Inc.*, 529 F. Supp. at 1027–28.

366. *Id.* at 1208.

also sent submissions to other game companies, including Parker Brothers, where a game designer named Robert Baron had access to it.[367] Shortly after leaving Parker Brothers, Baron and two collaborators, Robert Charlesworth and Jerrould Smith, developed and refined a new oil exploration game called "Oil Baron," which Charlesworth submitted to Milton Bradley. Milton Bradley then refined, licensed, and published this game under the name "King Oil."[368] Plaintiff then sued Milton Bradley and Parker Brothers, asserting various claims for relief, including idea misappropriation and breach of a confidential relationship.[369]

In its opinion on Milton Bradley's motion for summary judgment, the District Court held that "the so-called law of ideas embraces . . . grounds to afford protection to persons who, like plaintiff, have disclosed their ideas to others in the expectation that the idea would be used, and the use compensated."[370] It recognized that liability for uncompensated use of ideas may exist under both an express contractual agreement as well as "an implied agreement . . . based upon industry custom or usage regarding submission and use of ideas."[371] The District Court found that, despite Milton Bradley's form response to the submission, there was an inference of such an industry custom to compensate to pay for use of submitted ideas in the board game industry, and that Milton Bradley's response "was ineffective as to plaintiff, since the company never undertook to revoke the offer outstanding on its part, for example, by public advertisement or announcement."[372] However, the court ultimately concluded that recovery for misappropriation of plaintiff's ideas was ultimately time barred and granted summary judgment in Milton Bradley's favor.[373]

V. CASE STUDIES

As exemplars of the role that IP can play in facilitating innovation in the tabletop gaming industry, this Part contains three case studies: (1) *Dungeons & Dragons* ("*D&D*"); (2) *Magic: The Gathering* ("*Magic*"), and (3) *Settlers of Catan*. Each of these games represents a particular genre: RPGs, collectable card games, and Eurogames, respectively. A brief history of each game's development is provided, followed by a discussion of IP-related issues.

367. *Id.*
368. *Id.* at 1208–09.
369. *Id.* at 1210–11.
370. *Id.* at 1216.
371. *Id.*
372. *Id.* at 1217–18.
373. *Id.* at 1218.

A. DUNGEONS & DRAGONS

1. Overview

D&D is a fantasy tabletop RPG, originally designed by Gary Gygax and Dave Arneson in 1973.[374] In 1974, Tactical Studies Rules, Inc. ("TSR"), a partnership formed by Gary Gygax and Don Kaye, published *D&D* and issued an initial handmade run of 1,000 games that sold out within months.[375] In the following years, TSR issued a sequel, *Advanced D&D*, and several new editions of *D&D*, eventually selling millions of copies before a downturn in sales and infighting among executives led to TSR's near-bankruptcy and sale to Wizards of the Coast ("Wizards") in 1999.[376]

Now owned by Hasbro, *D&D* has become a worldwide phenomenon and is recognized as the first modern RPG.[377] In recent years, *D&D* has seen a resurgence of popularity. Currently in its 5th edition, *D&D* experienced double-digit growth in 2018 and 2019.[378] Designed to streamline the rules to attract new players who were turned off by its nerdy reputation while still engaging old players, the 5th edition of *D&D* now centers more on storytelling than previous versions.[379]

2. IP Rights

From *D&D*'s inception, IP rights have been at the center of the game's popularity and business model. A fantasy roleplaying game at its core, *D&D* has a variety of books, such as the *Player's Handbook*, the *Monster Manual*, and the *Dungeon Master's Guide*, that include illustrations and written descriptions of creatures, classes, locations, and background lore.[380] This litany of

374. Jon Peterson, *Forty Years of Adventure*, WIZARDS, https://dnd.wizards.com/dungeons-and-dragons/what-dd/history/history-forty-years-adventure [https://perma.cc/S46G-XZNH].

375. *Id.*

376. EWALT, *supra* note 72, at 145–52, 162–74.

377. Jon Michaud, *The Tangled Cultural Roots of Dungeons & Dragons*, NEW YORKER (Nov. 2, 2015), https://www.newyorker.com/books/page-turner/the-tangled-cultural-roots-of-dungeons-dragons [https://perma.cc/4GHW-GJE4].

378. Ethan Gilsdorf, *In a Chaotic World, Dungeons & Dragons Is Resurgent*, N.Y. TIMES (Nov. 13, 2019), https://www.nytimes.com/2019/11/13/books/dungeons-dragons.html [https://perma.cc/LQJ7-SKUS].

379. Sarah Whitten, *How Critical Role Helped Spark a Dungeons & Dragons Renaissance*, CNBC (Mar. 14, 2020, 6:44 PM), https://www.cnbc.com/2020/03/14/critical-role-helped-spark-a-dungeons-dragons-renaissance.html [https://perma.cc/WDY5-CDB9].

380. *See generally* DUNGEONS & DRAGONS PLAYER'S HANDBOOK (5th ed. 2014) (containing "the rules for character certation and advancement, backgrounds and skills, exploration and combat, equipment, spells, and much more"); DUNGEONS & DRAGONS DUNGEON MASTER'S GUIDE (5th ed. 2014) (including "world-building advice, tips and tricks for creating memorable dungeons and adventures, optional game rules, . . . magic items, and many other tools"); DUNGEON & DRAGONS MONSTER MANUAL (5th ed. 2014) (including "easy-to-use game statistics and thrilling stories" of monsters over "the D&D game's illustrious history").

information and illustrations are copyrightable under section 102(a) of the Copyright Act.[381]

D&D's game mechanics, however, are a different story. This system of play is commonly known as the d20 system, since it involves rolling various multisided dice (usually a 20-sided die) to resolve actions, intentions, and combat. As a gameplay mechanic, the d20 system is an uncopyrightable process, system, or method of operation under section 102(b). However, this has not kept Hasbro from trademarking it as the d20 SYSTEM.[382] In addition, Hasbro has obtained federally registered trademarks for DUNGEONS & DRAGONS,[383] D&D,[384] the dragon ampersand image,[385] PLAYERS HANDBOOK,[386] MONSTER MANUAL,[387] and DUNGEON MASTER'S GUIDE.[388] To our knowledge, however, Hasbro and its predecessors did not obtain utility patent protection for *D&D*.

3. IP Enforcement

The owners of *D&D* have acted aggressively to protect their IP rights over the years, including through litigation. However, there also have been instances where lax enforcement worked to the game's benefit. In the early days of TSR's initial print run of *D&D*, many fans who were not willing or financially able to pay $10 for the manual resorted to copying the material on school machines.[389] At the time, TSR was well aware of this phenomenon, and in fact found the "pirated" material was helpful since it introduced many new fans to the game.[390]

Later, however, TSR developed a reputation as being litigious against potential infringers of its IP rights.[391] One notable lawsuit was against a

381. *See* 17 U.S.C. § 102(a) (2018) (explaining that copyright subsists in original works of authorship that are fixed in a tangible medium of expression, including "literary works" and "pictoral, graphic, and sculptural works"); *see also* PLAYER'S HANDBOOK, Copyright Office Registration No. TX0007957586 (Sept. 12, 2014); DUNGEON MASTER'S GUIDE, Copyright Office Registration No. TX0008009871 (Jan. 21, 2015); MONSTER MANUAL, Copyright Office Registration No. TX0008009874 (Jan. 21, 2015).

382. D20 SYSTEM, Registration No. 2,630,360.

383. DUNGEONS & DRAGONS, Registration No. 1,092,786.

384. D&D, Registration No. 1,779,033.

385. The mark consists of an ampersand consisting of a dragon blowing fire, Registration No. 4,879,716.

386. PLAYER'S HANDBOOK, Registration No. 3,207,138.

387. MONSTER MANUAL, Registration No. 3,197,902.

388. DUNGEON MASTER'S GUIDE, Registration No. 3,128,532.

389. Ciro Alessandro Sacco, *The Ultimate Interview with Gary Gygax*, KYNGDOMS, http://www.keithrobinson.me/thekyngdoms/interviews/garygygax.php [https://perma.cc/C5MY-6E8M].

390. *Id.*

391. In fact, TSR became so litigious that "[g]amers joked that TSR stood for 'they sue regularly.'" David Hartlage, *1994: TSR Declares War on the Internet's D&D Fans*, DM DAVID (Sept. 8, 2020), https://dmdavid.com/tag/1994-tsr-declares-war-on-the-internets-dd-fans [https://perma.cc/BL8C-VHX8].

publisher called Game Designer's Workshop ("GDW"). After departing TSR following conflicts with corporate management, Gary Gygax joined GDW and began work on a new project called "Dangerous Dimensions."[392] In 1992, TSR promptly issued a cease-and-desist letter to GDW for alleged trademark infringement due to potential confusion with TSR's *D&D* trademarks.[393] To avoid a potentially costly lawsuit, GDW changed the new game's name to "Dangerous Journeys."[394] Despite this, TSR sued GDW for infringement, alleging that "Dangerous Journeys" was derivative of TSR's *D&D* and *Advanced D&D* games.[395] This claim was suspect, to put it lightly. As RPG historian Shannon Appelcline explained, "if *Dangerous Journeys* was [an infringing] derivative [work], then so was every roleplaying game in existence."[396]

In another case, TSR sued Mayfair Games regarding *D&D*-compatible supplements.[397] Mayfair attempted to avoid liability for trademark infringement by making clear that it was not the trademark holder of *Advanced D&D* by printing on the cover of their books: "*Advanced Dungeons & Dragons* is a trademark of TSR Hobbies Inc. Use of the trademark NOT sanctioned by holder."[398] After an initial settlement, TSR later reopened its dispute with Mayfair when it alleged that Mayfair's publication of a product called "City State of the Invincible Overlord" violated their agreement.[399] Before a final decision was rendered, however, Mayfair sold their entire supplements line to TSR.[400] By 1994, TSR aggressively went after individuals who wrote *D&D* articles online, alleging that they infringed TSR's copyright and trademark rights and demanding they be taken down.[401] As a result, TSR was criticized for attacking its own customers.[402]

In addition, TSR was involved in a long-running legal dispute with Dave Arneson, one of the coauthors of the original version of *D&D* along with Gygax. In 1979, Arneson filed suit against TSR and Gygax after TSR allegedly failed to pay Arneson royalties for its series of *Advanced D&D* books, which comprised four volumes and listed Gary Gygax as the sole author.[403] The suit alleged that these books were copied and derived from

392. EWALT, *supra* note 72, at 171.

393. APPELCLINE, *supra* note 72, at 101.

394. Sacco, *supra* note 389.

395. *Id*; APPELCLINE, *supra* note 72, at 101.

396. *Id.* at 101.

397. SHANNON APPELCLINE, DESIGNERS & DRAGONS: A HISTORY OF THE ROLEPLAYING GAME INDUSTRY: THE '80S 201 (2014).

398. *Id.*

399. TSR, Inc. v. Mayfair Games, Inc., No. 91 C 0417, 1993 U.S. Dist. LEXIS 3355, at *7 (N.D. Ill. Mar. 15, 1993).

400. APPELCLINE, *supra* note 397, at 207.

401. APPELCLINE, *supra* note 72, at 102.

402. *Id.*

403. *Id.* at 31–32.

D&D, which Arneson had coauthored, and that TSR had falsely represented that Gygax was the sole author of the *Monster Manual* and the *Players' Handbook*, thereby denying Arneson the "commercially and artistically valuable right" to be identified as a coauthor.[404] Arneson, Gygax, and TSR eventually settled their dispute.[405]

TSR also occasionally was on the receiving end of threats of litigation over IP rights. The first edition of *D&D* included numerous creations from J.R.R. Tolkien's *Lord of the Rings* series, including hobbits as a playable race.[406] Although Gygax claimed that Tolkien's works were not a major influence on *D&D*, in 1977, film producer Saul Zaentz—who had acquired the non-literary rights to *Lord of the Rings* and *The Hobbit*—sent a cease-and-desist letter to TSR.[407] In response, TSR removed references to hobbits (now called halflings) and other Tolkien-created creatures in future editions of *D&D*.[408]

4. IP Licensing and User-Generated Content

After Wizards acquired TSR in 1997, it took a more permissive approach toward content creators for *D&D*. Indeed, by adopting a permissive licensing system based on the widely acclaimed 3rd edition of *D&D*, it facilitated a vibrant ecosystem of new content that helped spur greater interest in the game itself.

In 2000, Wizards' release of *D&D*'s Open Game License ("OGL") created a major shift in the RPG industry.[409] Like open source software and other "copyleft" systems,[410] the OGL allowed third parties to create, modify, and publish content based on the basic rules and system of the 3rd edition of *D&D* royalty free, provided that a copy of the license be included with the content.[411] The Systems Reference Document containing the OGL included

404. Arneson v. Gygax, 473 F. Supp. 759, 761 (D. Minn. 1979).

405. Arneson v. TSR Hobbies, Inc., No. 4-84-1180, 1985 U.S. Dist. LEXIS 21340, at *1 (D. Minn. Mar. 17, 1985).

406. APPELCLINE, *supra* note 72, at 27.

407. *Id.* at 27, 29.

408. *Id.* at 29.

409. *See Open Game Definitions: Frequently Asked Questions Version 2.0*, WIZARDS OF THE COAST (Jan. 26, 2004), http://www.wizards.com/default.asp?x=d20/oglfaq/20040123d [https://perma.cc/468E-HPXB].

410. *See* Andrew J. Hall, *Open-Source Licensing and Business Models: Making Money by Giving It Away*, 33 SANTA CLARA HIGH TECH. L.J. 427, 430 (2017) ("'Copyleft' . . . refers generally to a philosophy first espoused by the Free Software Foundation (FSF) criticizing the use of copyrights and patents to restrict the free modification, copying, and distribution of software.").

411. WIZARDS OF THE COAST, V5.1 SYSTEMS REFERENCE DOCUMENT, at 2, ¶¶ 2–4 [hereinafter OGL], http://media.wizards.com/2016/downloads/DND/SRD-OGL_V5.1.pdf [https://perma.cc/5AF4-JCKF]. For a detailed history of the OGL and its impact, see generally Giuseppe Roberto Tarantino, If You Love Something, Set It Free? Open Content Copyright Licensing and Creative Cultural Expression (May 14, 2019) (Ph.D. dissertation, York University), https://yorkspace.lib

a detailed set of rules for creating *D&D*-compatible characters, equipment, and monsters.[412] Ryan Dancey, Wizards Vice President and cocreator of the OGL, explained that the net effect of the competition in the RPG industry with an open license would be positive for *D&D* because

> [R]educing the 'cost' to other people to publishing and supporting the core [*D&D*] game to zero should eventually drive support for all other game systems to the lowest level possible in the market, create customer resistance to the introduction of new systems, and . . . steadily increase the number of people who play D&D, thus driving sales of the core books.[413]

The OGL led to a boom in the RPG industry in the early 2000s, with numerous publishers producing their own *D&D*-compatible supplements.[414] It also led to the development of a widely adopted RPG, the *Pathfinder Roleplaying Game*, based on version 3.5 of *D&D* under OGL terms.[415] In 2016, the SRD was updated to be compatible with the latest (5th) edition of *D&D*.[416]

There were, however, limits to the *D&D* content licensed by the OGL. Most notably, certain words, terms, and symbols were designated as "product identity" under the OGL, including "Dungeons & Dragons," "D&D," "Player's Handbook," and names of various locations, creatures, and spells, and were excluded from the scope of the license.[417] This list appears to identify many of *D&D*'s notable trademarks and therefore restricts creators from even referencing "*Dungeons & Dragons*" explicitly, less customers be led to believe that content published under the OGL is actually Wizards-created content. Instead, these marks were covered by d20 System Trademark License ("d20 STL"), which allowed publishers to place a d20 System logo on their works if they adhered to more stringent rules, such as the exclusion

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rary.yorku.ca/xmlui/bitstream/handle/10315/36665/Tarantino_Giuseppe_R_2019_PhD.pdf [https://perma.cc/7XA2-LLRH].

412. OGL, *supra* note 411, at 3–357.

413. Ryan S. Dancey, *Open Gaming Interview with Ryan Dancey*, WIZARDS OF THE COAST: DUNGEONS AND DRAGONS, http://www.wizards.com/dnd/article.asp?x=dnd/md/md20020228e [https://perma.cc/9FYF-WWQD].

414. *Id.*

415. PATHFINDER ROLEPLAYING GAME (Paizo, 2009). Pathfinder is now in its second edition. *See Pathfinder Second Edition: Unleash Your Hero!*, PAIZO, https://paizo.com/pathfinder [https://perma.cc/TJX6-A66E].

416. OGL, *supra* note 411, at 2.

417. *Id.* at 1, ¶ 1(e).

of erotic content.[418] Unlike the OGL, the d20 STL was revocable by Wizards, which ultimately occurred in 2008.[419]

In addition, there is a vibrant community of fans who "homebrew" their own *D&D*-based content. A "homebrew" can be defined as any content with an RPG game that cannot be found in an official rulebook.[420] Today, Wizards not only tacitly permits "homebrewing," but sometimes puts its seal of approval on content through the Dungeon Masters Guild program,[421] making it part of the official *D&D* canon.[422]

Furthermore, some *D&D* players have created their own intellectual property by playing the game and commercializing their content. "Actual play" or "liveplay" involves a repeat group of *D&D* players who live-stream sessions of their campaigns through podcasts and videos.[423] Top-rated actual play shows like *Critical Role*, *High Rollers*, and *Dimension 20*, which depict characters in long-running campaigns lasting months or years, attract hundreds of thousands or even millions of views on paid streaming services like Twitch and ad-supported platforms like YouTube.[424] The recordings of these shows and the original characters and settings depicted in them are protected by copyright law.[425] In addition, *Critical Role* has created or authorized numerous derivative works based on their actual play show,

418. *D20 System Trademark License*, FANDOM: OPEN GAME CONTENT WIKIA, https://opengamecontent.fandom.com/wiki/D20_System_Trademark_License [https://perma.cc/4E4C-CSY4].

419. *Interview With Scott Rouse, Part 1: Changes to WotC Licenses*, ICV2 (Apr. 24, 2008, 11:00 PM), https://icv2.com/articles/games/view/12449/interview-scott-rouse-part-1 [https://perma.cc/T4XM-VWWR] (stating that the d20 STL license would be terminated in June 2008).

420. Kristen Seikaly, *D&D 5e Homebrew: The Complete Beginner's Guide*, CATS & DICE, https://catsanddice.com/dnd-5e-homebrew-beginners-guide [https://perma.cc/MHZ6-5F5A].

421. *See* DUNGEON MASTERS GUILD, https://www.dmsguild.com [https://perma.cc/PQ8S-D965].

422. Christian Hoffer, *Critical Role Is Officially Part of Dungeons & Dragons Canon*, COMICBOOK (Sept. 5, 2019, 8:59 AM), https://comicbook.com/gaming/news/dungeons-and-dragons-critical-role-exandria-canon [https://perma.cc/Y7K9-UNMZ].

423. Kam Burns & Kayla Sharpe, *Live Dungeons & Dragons Shows Are Inviting More Players to the Table*, WIRED (Oct. 21, 2021, 7:00 AM), https://www.wired.com/story/live-dungeons-and-dragons-actual-play-shows-inclusive-diversity [https://perma.cc/U754-W6SR]; Chris DeVille, *The Rise of D&D Liveplay Is Changing How Fans Approach Roleplaying*, THE VERGE (Nov. 16, 2017, 2:45 PM), https://www.theverge.com/2017/11/16/16666344/dungeons-and-dragons-twitch-roleplay-rpgs-critical-role-streaming-gaming.

424. *See* Christian Hoffer, *Critical Role's Campaign 3 Is Drawing Big Audiences*, COMICBOOK (Nov. 3, 2021, 5:39 PM), https://comicbook.com/gaming/news/critical-role-campaign-3-total-views-episode-1 [https://perma.cc/9X9W-T644] (stating that the first episode of Campaign 3 of *Critical Role* has over 2.1 million views on Twitch and another 2.67 million views on YouTube).

425. *See Critical Role Content Policy*, CRITICAL ROLE (Sept. 16, 2021), https://critrole.com/critical-role-content-policy [https://perma.cc/R94H-VFGS] ("Our IP includes any unique material our team creates—things like the names of our campaigns (for example, Vox Machina and Mighty Nein), our characters (for example, Grog Strongjaw or Beauregard Lionett), story locations (like Whitestone or Nicodranas), company slogans (such as How Do You Want to Do This?), as well as written content and all related artwork, music, etc.").

including sourcebooks,[426] graphic novels,[427] and even an animated television show.[428] *Critical Role* also has obtained federally registered trademarks.[429]

B. MAGIC: THE GATHERING

1. Overview

Magic is a collectible trading card game created in 1991 by Dr. Richard Garfield, who was then a doctoral candidate in combinatorial mathematics at the University of Pennsylvania.[430] Peter Adkison, CEO of Wizards, met with Garfield about another game that Garfield had designed (Robo Rally) and explained that it did not fit his company's profile of RPGs, and asked whether Garfield could create a simple, portable game that could be played in minutes.[431] After Garfield tinkered with his product in his free time with the help of numerous playtesters, *Magic* debuted in 1993 at the Origins Game Fair in Dallas, Texas.[432]

Wizards releases new card sets for *Magic* on a regular basis.[433] The rarest and most valuable *Magic* cards can resell for thousands of dollars on the secondary market.[434] Since its inception, *Magic* has printed over 20 billion cards and is played by millions of Americans.[435] Wizards also hosts a

426. MATTHEW MERCER, HANNAH ROSE & JAMES J. HAECK, TAL'DOREI CAMPAIGN SETTING REBORN (2022); MATTHEW MERCER, EXPLORER'S GUIDE TO WILDEMOUNT (2020).

427. 1 MATTHEW MERCER, OLIVIA SAMSON, MATTHEW COLVILLE & CHRIS NORTHROP, CRITICAL ROLE VOX MACHINA ORIGINS (F. Avedon Arcadio Barrera II & Rachel Roberts eds., 2019); 2 MATTHEW MERCER, JODY HOUSER, OLIVIA SAMSON, MSASSYK & ARIANA MAHER, CRITICAL ROLE VOX MACHINA ORIGINS (Rachel Roberts ed., 2020).

428. *The Legend of Vox Machina* (Amazon Prime television broadcast 2022).

429. CRITICAL ROLE, Registration No. 4,908,306 (for streaming video material on the Internet); CRITICAL ROLE LOGO, Registration No. 5,263,618 (for t-shirts, tops, and entertainment); CRITICAL ROLE, Registration No. 6,125,583 (for various uses, including printed publications, comic books, beverage glassware, clothing, and toys); HOW DO YOU WANT TO DO THIS, Registration No. 5,623,161 (for t-shirts, tops, and entertainment).

430. *The History of Magic*, WIZARDS, https://magic.wizards.com/en/content/history [https://perma.cc/VK9W-P5J6].

431. *Id.*; *see also* TITUS CHALK, GENERATION DECKS: THE UNOFFICIAL HISTORY OF GAMING PHENOMENON: MAGIC: THE GATHERING 7–10, 17–19 (2017) (further describing Garfield and Adkison's interactions).

432. *The History of Magic*, *supra* note 430.

433. Callum Bain, *MTG Sets: Every Magic: The Gathering Set in Order*, WARGAMER (Jan. 17, 2022), https://www.wargamer.com/magic-the-gathering/mtg-sets-in-order [https://perma.cc/DYX7-8FLW].

434. For instance, the most valuable card fetched hundreds of thousands of dollars. *See e.g.*, Charlie Hall, *Magic: The Gathering Black Lotus Card Sells for $511,100 at Auction*, POLYGON (Jan. 27, 2021, 9:05 PM), https://www.polygon.com/2021/1/27/22253079/magic-the-gathering-black-lotus-auction-price-2021 [https://perma.cc/B3NQ-CYZC].

435. *Magic's 25th Anniversary: Facts and Figures*, MAGIC: THE GATHERING, https://magic.wizards.com/en/content/magic-25th-anniversary-page-facts-and-figures [https://perma.cc/R64Z-MDT2]; *see also* Neima Jahromi, *The Twenty-Five-Year Journey of Magic: The Gathering*, NEW YORKER

professional league, the Magic Pro League, where players can earn hundreds of thousands of dollars by winning events.[436] *Magic* has been one of the most profitable products for Hasbro, Wizard's parent company, earning $561.2 million in 2020, an increase of 27 percent compared to the prior year,[437] despite the pandemic limiting in-person events.[438]

2. IP Rights

Magic occupies a unique position in the tabletop gaming industry in that it is one of the few games that is covered by patent, copyright, and trademark protection. Richard Garfield received U.S. Patent No. 5,662,332 ("the '322 Patent") in 1997 for a "[t]rading card game method of play."[439] This patent set out the primary method of gameplay in the form of trading cards, but also kept it broad enough for later use in different media, such as computer games.[440] The patent outlines the general trading card element and goal of the game, which is reducing an opponent player's life force to zero.[441] It also describes certain attributes of the game such as energy values, command cards, and various spell cards, such as mana cards and spell cards.[442]

The original '332 patent has six claims: three independent claims and three dependent claims. The first claim describes the "method of playing games" and outlines the sequence of turns.[443] The second claim describes the "method of playing a trading card game" and outlines the rules of play involving a reservoir of trading cards.[444] The third claim describes the "method of playing card games" as applied to card games with rules of play, "multiple copies of a plurality of cards," and "a predetermined number of cards" in the players' library.[445] The three dependent claims refer "to a second orientation" of card rotation,[446] known colloquially in the *Magic*

(Aug. 28, 2018), https://www.newyorker.com/culture/culture-desk/the-twenty-five-year-journey-of-magic-the-gathering [https://perma.cc/A3QU-PWMJ].

436. *See* Niccolò Carradori, *What It Takes to Be a High Earning 'Magic: The Gathering' Pro*, VICE (Nov. 19, 2020, 5:10 AM), https://www.vice.com/en/article/z3b4n9/magic-the-gathering-professional-earnings [https://perma.cc/V797-D4SB].

437. HASBRO, Q4 & FULL YEAR 2020 EARNINGS 12, 33 (2021), https://investor.hasbro.com/static-files/1bf09f2e-5078-4a6b-8428-799816e512f3 [https://perma.cc/RU9T-66TA].

438. Keller Gordon, *In the Pandemic Era, This 'Gathering' Has Lost Some of Its Magic*, NPR (July 30, 2020, 7:00 AM), https://www.npr.org/2020/07/30/896439944/in-the-pandemic-era-this-gathering-has-lost-some-of-its-magic [https://perma.cc/7QSP-2KEP].

439. U.S. Patent No. 5,662,332 (filed Oct. 17, 1995).

440. *Id.* at [57].

441. *Id.* col. 1 l. 59–col. 2 l. 2.

442. *Id.* col. 4 l. 7–14.

443. *Id.* col. 19 l. 66–col. 20 l. 29.

444. *Id.* col. 20 l. 30.

445. *Id.*

446. *Id.* col. 22.

community as "tapping," which indicates a card has been played by turning it 90 degrees on the game board.[447]

Subsequently, Garfield expanded the scope of the claimed invention through a reissue application, which was granted in 2003 ("the '957 patent").[448] "The '957 patent issued with 60 claims, including over 25 independent claims, which define both a card game that uses either trading cards or a computer-generated image thereof and a method of playing the game."[449] The '957 patent expired on June 22, 2014.

As a game full of artwork and creative content, there are also a number of components to a *Magic* card to which copyright protection applies. These include the card names, card illustrations, card texts, flavor texts, and card face and back designs. Initially, outside artists were commissioned to design the cards' artwork and paid royalties, but this switched in the late 1990s when Wizards adopted "an upfront payment system" and required assignment of all copyright rights to it.[450] With over 20,000 unique cards in existence, and hundreds of new cards added each year, copyright plays a major part in protecting *Magic*'s IP rights. In addition, copyright protection extends to the vast amount of written lore about the fictional universe surrounding *Magic*, including numerous novels based on the game, under the derivative work right.[451]

In addition, Wizards of the Coast has obtained dozens of federally registered trademarks related to *Magic*.[452] These include the stylized version of the *Magic* name,[453] the *Magic* logo,[454] names of released sets,[455] names and

447. *See* Gavin Verhey, *Tap, Tap . . . Oops!*, MAGIC: THE GATHERING (Apr. 20, 2017), https://magic.wizards.com/en/articles/archive/beyond-basics/tap-tap-oops-2017-04-20 [https://perma.cc/4RM3-TUP7] (explaining the tapping mechanic).

448. U.S. Patent No. RE 37,957 (filed June 29, 1999).

449. Second Amended Complaint for Copyright, Patent and Trade Dress Infringement at 11, ¶ 37, Wizards of the Coast LLC v. Cryptozoic Ent., LLC, 309 F.R.D. 645 (W.D. Wash. 2015).

450. *See* Pete Mohrbacher, *The Problems With Artist Pay on Magic*, VANDALHIGH (July 3, 2015), https://vandalhigh.com/blog/2015/7/3/the-problems-with-artist-pay-on-magic [https://perma.cc/R2JN-WAD8]; Jesse Mason, *An Interview with Sue Ann Harkey, Magic's Greatest Art Director*, KILLING A GOLDFISH BLOG (Apr. 21, 2015, 7:33 PM), http://blog.killgold.fish/2015/04/an-interview-with-sue-ann-harkey-magics.html [https://perma.cc/J36L-AT45].

451. *See, e.g.*, WILLIAM R. FORSTCHEN, ARENA (1994); CLAYTON EMERY, WHISPERING WOODS (1995); TERI MCLAREN, THE CURSED LAND (1995); JEFF GRUBB, THE BROTHERS' WAR (1998); LYNN ABBEY, PLANESWALKER (1998); J. ROBERT KING, TIME STREAMS (1999); J. ROBERT KING, PLANESHIFT (2000); *see also Magic: The Gathering Novels*, WIZARDS OF THE COAST (Sept. 13, 2012), https://magic.wizards.com/en/articles/archive/feature/magic-gathering-novels-2012-09-13 [https://perma.cc/4UN3-8UJ3] (listing additional novels).

452. *See Wizards of the Coast LLC Trademarks*, TRADEMARKIA, https://www.trademarkia.com/company-wizards-of-the-coast-llc-1383309-page-1-2 [https://perma.cc/VS2B-K56K] (listing 440 trademark records owned by Wizards of the Coast, many of which relate to *Magic*).

453. MAGIC, Registration No. 2,172,085.

454. The mark consists of a curved, upside down triangle shape with five trident-like spikes protruding from the top of the upside down triangle, Registration No. 5,317,915.

symbols of Guilds within the world of Ravnica (one of the "planes," or fictional worlds, depicted in the game),[456] and the symbols for mana, which represent a source of energy for playing the game's cards and abilities.[457] Notably, Wizards of the Coast also unsuccessfully applied to trademark the "tap" symbol used in the game for the game mechanic covered by the '957 patent.[458] Many *Magic*-related names or logos that are not registered likely would receive common law trademark rights and thus be enforceable under section 43(a) of the Lanham Act.[459]

3. IP Enforcement

Wizards of the Coast has occasionally resorted to litigation or threats of litigation to enforce its IP rights in *Magic*. Most notably, in 2014, Wizards of the Coast sued Cryptozoic Entertainment and Hex Entertainment, the makers of the crowdfunded, free-to-play, massively multiplayer online trading card game, *Hex: Shards of Fate* ("*Hex*").[460] First, the complaint alleged that Cryptozoic "copied the physical layout and ornamental aspects of *Magic* cards . . . ; the sequence and flow of the game, the scoring system used by the game, and the overall look and feel of the game," in violation of Wizards' copyright rights.[461] Second, it asserted unfair competition, false endorsement, and false designation of origin under the Lanham Act, claiming Cryptozoic "deliberately and intentionally copied the game play, rules, player interaction with the game, layout and arrangement, . . . sequence and flow, scoring system, and Magic's overall look," which allegedly infringed Wizards' trade dress and created confusion among the public about whether Wizards had

455. *See, e.g.*, MAGIC ORIGINS, Registration No. 4,846,803; T-TRONIC, Registration No. 3,114,360; THEROS, Registration No. 4,548,244.

456. RAVNICA CITY OF GUILDS, Registration No. 3,218,468.

457. The mark consists of a fireball curved in an upward motion, Registration No. 4,447,980; The mark consists of a stylized skull, Registration No. 4,447,981; The mark consists of a stylized sun, Registration No. 4,698,054; The mark consists of a stylized oak tree, Registration No. 4,447,982; The mark consists of a stylized drop of water with small droplet shadow on the center, right side, Registration No. 4,447,983.

458. *See* U.S. Trademark Application Serial No. 86013788 (filed July 18, 2013). The trademark examiner's rejection of this application explained that "[t]he applied-for mark, as shown on the specimen, does not function as a trademark because it is buried in the middle of the playing card and appears to merely indicate a play or move in the game rather than the source of the cards themselves. . . . As used on the specimen . . . it would not be viewed by consumers as a source indicator for the relevant goods." Letter from U.S. Pat. & Trademark Off. to Wizards of the Coast LLC (Aug. 16, 2013), https://tsdr.uspto.gov/documentviewer?caseId=sn86013788&docId=OOA20130816165744#docIndex=2&page=1 [https://perma.cc/5H8Z-KKFE] (office action about application serial no. 86013788).

459. 15 U.S.C. § 1125(a) (2018).

460. Complaint for Copyright, Patent and Trade Dress Infringement, Wizards of the Coast LLC v. Cryptozoic Ent., LLC, No. 14-CV-00719 (W.D. Wash. Mar. 14, 2014).

461. *Id.* at 19, ¶ 38.

endorsed or sponsored *Hex*.[462] Third, the complaint alleged infringement of the '957 patent. Wizards sought injunctive relief, monetary damages, disgorgement of defendants' profits, and treble damages and attorneys' fees as remedies.[463]

In response, the makers of *Hex* accused Wizards of the Coast of engaging in anticompetitive conduct by "us[in]g the legal process to achieve market dominance and eliminate a competitor which is creating truly competitive and innovative products."[464] More specifically, it alleged that Wizards was "assert[ing] its now-expired ['957] patent in an apparent attempt to intimidate Hex and Cryptozoic," and that its copyright claims were vague, sought to assert protection over an uncopyrightable idea, and improperly sought to extend its (now-expired) patent right "by asserting copyright protection over functional concepts."[465] Finally, defendants sought to rebut Wizards' Lanham Act claim by asserting that there was no evidence of actual confusion in the marketplace.[466] Defendants denied any liability in the case, and asserted numerous affirmative defenses, including noninfringement, invalidity of patent and copyrights in suit, functionality, and fair use.[467]

Ultimately, the Cryptozoic dispute was settled without any public admission of liability; the terms of the settlement agreement were not made public.[468] *Hex* continued to operate as an online collectible card game until the end of 2020, when it was discontinued.[469] Meanwhile, Wizards launched its own digital version of *Magic*, called *Magic: The Gathering Arena*, in 2019.

4. IP Licensing and User-Generated Content

While Wizards of the Coast retains the sole right to reproduce content containing its *Magic*-related IP, it has permitted some fan-created content

462. *Id.* at 21, ¶¶ 45–49.

463. *Id.* at 23–24, ¶¶ 1–8.

464. Defendant Cryptozoic Ent. LCC's Answer & Affirmative Defenses to Amended Complaint at 2, No. 14-CV-00719 (W.D. Wash. Aug. 29, 2014).

465. *Id.*

466. *Id.*

467. *Id.* at 14–20, ¶¶ 61–95.

468. *See* Wizards of the Coast LLC v. Cryptozoic Ent. LLC, 309 F.R.D. 645, 654 (W.D. Wash. 2015) (granting Wizard of the Coast leave to amend); *see also* Michael McWhertor, *Wizards of the Coast and Cryptozoic Settle Magic: The Gathering Lawsuit*, POLYGON (Sept. 25, 2015, 8:30 PM), https://www.polygon.com/2015/9/25/9399821/wizards-of-the-coast-cryptozoic-magic-the-gathering-lawsuit-settlement [https://perma.cc/LE2U-NAM6] (discussing settlement and containing statements from each party).

469. Mason Sansonia, *What Hex: Shards of Fate Is and Why It's Shutting Down*, GAMERANT (Nov. 1, 2020), https://gamerant.com/hex-shards-fate-kickstarter-shut-down [https://perma.cc/6ASW-QCXJ].

under its Fan Content Policy.[470] Specifically, Wizards provides that consumers may use its IP to make content that they share with the community for free, provided that they include a written disclaimer.[471] Wizards also requests that creators of fan content "[not] use Wizards' logos and trademarks."[472]

In addition, there is a bevy of fan-created content based around *Magic*, including fan art, videos, podcasts, websites, and streaming content. Under the fair use doctrine, many of these sites and businesses which cover *Magic* in the form of news stories, blogs, and streaming content do so under fair use for purposes of commentary, criticism, or parody. As evidenced by its Fan Content policy, Wizards grants these sites latitude when it comes to covering *Magic* because they view it as promoting their business and brand.

C. *SETTLERS OF CATAN*

1. Overview

Settlers of Catan (currently known simply as *Catan*) was created by Klaus Teuber, a dental technician from Rossdorf, Germany.[473] Inspired by the Vikings' settling of Iceland and Greenland, Teuber originally conceived of a game centered around "an uncharted island . . . [where] players would slowly discover the island by flipping over tiles, then establish colonies using the indigenous natural resources."[474] First "[r]eleased at the annual Essen fair [a major board game event held in Germany] in 1995, . . . [*Settlers of Catan*] won the [prestigious] Spiel des Jahres [award] and every other major prize in German gaming, [with] [c]ritics call[ing] it a masterpiece."[475]

Since then, *Settlers of Catan* has sold over 30 million copies worldwide and has been translated into over 40 different languages.[476] It is widely credited as America's gateway into Eurogames, a genre of tightly designed, strategy-based products, which have fairly simple rules and are intellectually demanding but not overly complicated.[477] In addition, *Settlers of Catan* has

470. *Wizards of the Coast's Fan Content Policy*, WIZARDS OF THE COAST, https://company.wizards.com/en/legal/fancontentpolicy [https://perma.cc/W9DZ-H98T] (last updated Nov. 15, 2017).

471. *Id.* The required disclaimer must state: "[Title of your Fan Content] is unofficial Fan Content permitted under the Fan Content Policy. Not approved/endorsed by Wizards. Portions of the materials used are property of Wizards of the Coast. ©Wizards of the Coast LLC." *Id.*

472. *Id.*

473. Andrew Curry, *Monopoly Killer: Perfect German Board Game Redefines Genre*, WIRED (Mar. 23, 2009, 12:00 PM), https://www.wired.com/2009/03/mf-settlers [https://perma.cc/74RJ-EDLU]; Adrienne Raphel, *The Man Who Built Catan*, NEW YORKER (Feb. 12, 2014), https://www.newyorker.com/business/currency/the-man-who-built-catan [https://perma.cc/9MHJ-57AN].

474. *Id.*

475. *Id.*

476. *About the Catan GMBH*, CATAN, https://www.catan.com/about-us [https://perma.cc/EEK6-CABP].

477. *See supra* notes 76–77 and accompanying text.

spawned numerous expansions,[478] spinoffs,[479] geographically themed versions,[480] a card-based game,[481] a version suitable for younger children,[482] and digital versions.[483]

2. IP Rights

Like other board games, *Settlers of Catan* is protected by various IP rights. While not patented, *Settlers of Catan* has a number of components to which copyright protection likely applies, including box art, the artwork on the cards which contain the resources (wool, lumber, brick, grain, and coal), the artwork on the hexagonal tiles, and the artwork on the special development cards (i.e., knight, university, road building, etc.). Following its rebranding from *Settlers of Catan* to simply *Catan* as part of its 5th edition,[484] the new artwork for the box covers, tiles, and cards also are protected by copyright law. However, many of its simpler components, such as the shape of the game pieces (rectangles and houses) and the hexagonal shapes of the tiles, are likely not copyrightable due to lack of originality and/or the *scenes a faire* doctrine as a standard part of many board games. Copyright protection also would not apply to the game rules as an unprotected process, system, or method of operation under section 102(b). In addition, *Settlers of Catan* has numerous trademarks associated with its brand in the United States, including its logo, title of various designs, and computer versions of its games.[485]

3. IP Enforcement

Catan's enforcement of its IP rights has drawn criticism from some commentators, who have reported that it is "abusing intellectual property law to stifle competition."[486] For instance, a lawyer at Public Knowledge

478. *See, e.g.*, KLAUS TEUBER, CATAN: SEAFARERS (Catan Studio 1997); KLAUS TEUBER, CATAN: CITIES & KNIGHTS (Catan Studio 1998); KLAUS TEUBER, CATAN: TRADERS & BARBARIANS (Catan Studio 2007); KLAUS TEUBER, CATAN: EXPLORERS & PIRATES (Catan Studio 2013).

479. *See, e.g.*, KLAUS TEUBER, THE STARFARERS OF CATAN (Mayfair Games 1999); KLAUS TEUBER, STAR TREK: CATAN (Catan Studio 2012).

480. *Regional Editions*, CATAN, https://www.catan.com/board-games/settlers-catan/variants-and-scenarios/regional-editions [https://perma.cc/8B58-WPXR].

481. KLAUS TEUBER, RIVALS FOR CATAN (Catan Studio 2010).

482. KLAUS TEUBER, CATAN: JUNIOR (Catan Studio 2011).

483. *Digital CATAN Games*, CATAN, https://www.catan.com/explore-catan/digital-games [https://perma.cc/G6P9-ZANN].

484. Charlie Hall, *The Settlers of Catan Has a New Name, New Look for 5th Edition*, POLYGON (June 23, 2015, 12:30 PM), https://www.polygon.com/2015/6/23/8661435/the-settlers-of-catan-has-a-new-name-new-look-for-5th-edition [https://perma.cc/3EJ8-JNU6].

485. *See, e.g.*, THE SETTLERS OF CATAN, Registration No. 4,328,606; The mark consists of an image of a yellow and white sun overlapped by two orange thin clouds and the silhouette of a fortress on a hill in black all on an orange and red sky background, Registration No. 5,652,223; CATAN, Registration No. 5,633,058.

486. Mike Masnick, *How Lawyers for Settlers of Catan Abuse IP Law to Take Down Perfectly Legal Competitors*, TECHDIRT (Feb. 22, 2011, 1:47 PM), https://www.techdirt.com/articles/20110211

reported that in 2011, *Catan*'s lawyers had emailed a cease-and-desist notice to the creator of an Android clone of Catan called "Island Settlers," alleging copyright and trademark infringement, ultimately causing the creator to pull it from the market.[487] The cease-and-desist notice, however, was criticized for attempting to claim that *Catan*'s rules were protected by copyright law.[488]

When faced with a similar situation almost a decade later, however, Catan declined to act. Shortly after the COVID-19 pandemic began in early 2020, a website called Colonist.io released an online game very similar in both gameplay and graphics to *Catan*.[489] Indeed, the website itself calls Colonist.io the "#1 Free Online Alternative to Settlers of Catan."[490] Colonist.io also contains a prominent disclaimer section, which—in an apparent attempt to avoid liability—states that "[t]he web game Colonist.io has no association with the board game Settlers of Catan" and that "[c]opyright does not protect the idea for a game, its name or title, or the method or methods for playing it."[491] Colonist.io has been widely played since its introduction two years ago, with over 13 million online games.[492]

4. IP Licensing and Fair Use Policy

Catan GmbH, which owns the IP rights to *Catan*, licenses it to numerous publishers, including Catan Studio in the United States, which is a wholly owned subsidiary of Asmodee.[493] As previously mentioned, a number of derivative works have spawned from the game's success.[494] In addition, Catan Studio has licensed Creative Goods to produce a wide variety of *Catan*

/212002130 66/how-lawyers-settlers-catan-abuse-ip-law-to-take-down-perfectly-legal-competitors.shtml [https://perma.cc/4V6C-ZF4Z].

487. Michael Weinberg, *Settlers of Catan Makes Legal Threats: Can it Back Them Up? (Hint: No)*, PUBLIC KNOWLEDGE (Feb. 11, 2011), https://www.publicknowledge.org/blog/settlers-of-catan-makes-legal-threats-can-it-back-them-up-hint-no [https://perma.cc/K9UU-G57W].

488. *Id.*

489. COLONIST, https://colonist.io [https://perma.cc/P5S7-H4FX]. For instance, the game used 20 hexagonal tiles in a shape identical to *Catan*, with similar resources (wood, brick, sheet, wheat, ore), similar gameplay, and similar victory conditions. *See id.* In fact, the hyperlink to the Rules page on *Colonist* uses the phrase "Catan Rules." *Base Game*, COLONIST, https://colonist.io/catan-rules [https://perma.cc/Y2WJ-J9ZZ].

490. COLONIST, *supra* note 489.

491. *Press Kit*, COLONIST, https://colonist.io/presskit [https://perma.cc/UFY3-7EYD].

492. Jake Kleinman, *How a Settlers of Catan-Style Game Grew by 1,200% During COVID-19 Lockdown*, INVERSE (Mar. 17, 2021, 10:30 AM), https://www.inverse.com/gaming/colonist-settlers-of-catan-online-free-game [https://perma.cc/9EUB-NQTQ].

493. *See* W. Eric Martin, *Asmodee Acquires English-Language Rights to Catan; Mayfair Games to Continue on Its Own*, BOARDGAMEGEEK (Jan. 7, 2016, 12:01 PM), https://boardgamegeek.com/blogpost/49680/asmodee-acquires-english-language-rights-catan-may [https://perma.cc/8SR4-XLNU].

494. *See supra* text accompanying notes 478–83.

products, from pins and paraphernalia to branded luggage.[495] Aside from merchandise, there is also a *Settlers of Catan* novel,[496] and a movie and television show based on the game are purportedly in production.[497]

With respect to its IP policy and rights, Catan GmbH and Catan Studio have adopted a fair use policy that "encourage[s] our consumers and trade customers to employ our IP freely for personal use. In some limited cases . . . we may even encourage creation of 'derivative works' (i.e., material based upon CATAN GmbH's or CATAN Studio' intellectual property) or satire and/or commentary."[498] This has allowed other creators to create their own works that incorporate aspects of *Catan*.

For example, artist Simon Denny created a game called *Founders* which reinterprets *Settlers of Catan* as part of an art exhibition.[499] Similarly in 2019, researchers Sam Illingworth and Paul Wake explored using the game of *Catan* to educate and hold meaningful discussions about global warming.[500] The authors designed "a 'science-based' game with the primary aim of creating a discussion about global warming," using scientific concepts or ideas as part of the game's theme and mechanics.[501] In designing the game, the authors explicitly cited *Catan*'s "very generous fair use policy."[502] Content creators have also utilized *Catan*'s fair use policy to create other media based on *Catan*, such as the short movie "The Lord of Catan," which depicts a husband-and-wife rivalry over the game.[503] However, there are limitations to *Catan*'s fair use policy, including a requirement that any derivative work created under the policy include a prominent notice regarding *Catan*'s copyright and trademark rights, and a statement that the work is "[b]ased upon 'Catan,' a creation and design of Klaus Teuber and property of Catan GmbH."

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495. Josh Mandell, *World's Biggest Board Game? Catan Studios Won't 'Settle' for Less*, CHARLOTTESVILLE TOMORROW (Mar. 9, 2018, 6:45 PM), https://www.cvilletomorrow.org/articles/worlds-biggest-board-game-catan-studio-wont-settle [https://perma.cc/4RGK-RNRW].

496. *See generally* REBECCA GABLE, THE SETTLERS OF CATAN (Lee Chadeayne trans., 2003) (2011) (consisting of an "adventure [set in 850 A.D.], based on the wildly popular board game of the same name").

497. Dave McNary, *'Settlers of Catan' Movie, TV Project in the Works*, VARIETY (Feb. 19, 2015, 11:13 AM), https://variety.com/2015/film/news/settlers-of-catan-movie-tv-project-gail-katz-1201437121 [https://perma.cc/Y2VP-9AAK].

498. *CATAN GmbH and CATAN Studio IP Policy*, CATAN STUDIO (Jan. 1, 2017), https://www.catanstudio.com/ip-policy [https://perma.cc/B3DT-87R7].

499. Tim Schneider, *How Artist Simon Denny Is Turning Board Games into Hilarious Critiques of Digital Capitalism*, ARTNET NEWS (Mar. 1, 2018), https://news.artnet.com/art-world/simon-denny-board-games-1233644 [https://perma.cc/9LPV-APAK].

500. Sam Illingworth & Paul Wake, *Developing Science Tabletop Games: Catan and Global Warming*, 18 J. SCI. COMMC'N 1, 3 (July 2019).

501. *Id.* at 4.

502. *Id.* at 6.

503. THE LORD OF CATAN (Hamster Valhalla 2014).

VI. IMPLICATIONS

In this final Section, we explore several implications from the foregoing discussion of IP rights and tabletop games.

First, IP law appears to work fairly well at balancing the important interests of incentivizing the creation of tabletop games and preserving the freedom of others to innovate. In particular, the basic building blocks of a game—its mechanics and rules—are generally unprotected by IP, as they cannot be copyrighted,[504] and patent protection is usually difficult if not impossible to obtain, particularly under the Federal Circuit's current approach to patent eligibility.[505] This means that other creators are generally free to modify or adapt a game's underlying mechanics to new themes, settings, and topics.

For instance, the creation of tabletop wargames in the 1950s led to an entirely new category of games of varying degrees of sophistication, duration, and settings. Today, wargames span the gamut from ancient Rome[506] to interstellar conflict,[507] and from small-scale tactical battles[508] to global war.[509] More recently, the development of collectible card games—which combine the collecting and trading aspects of sports cards with fantasy role-playing—with *Magic*'s publication in the early 1990s, spawned numerous other collectible card games, such as the *Pokémon Trading Card Game* and *Yu-Gi-Oh!*.[510] Despite these competitors, *Magic* itself remains highly successful, earning billions of dollars over the past quarter century.[511]

Notably, the economic-based incentives created by IP law appear to be less important for game designers than game publishers. Many game designers appear more motivated by the intrinsic reward of creating new and enjoyable games they can play, enjoy, and share with their family, friends, and others, rather than prospective financial rewards backed by the exclusivity provided by IP law.[512] For instance, Brian Tinsman, the award-winning designer of over 50 tabletop and digital games,[513] explained that:

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504. *See supra* notes 147–51 and accompanying text.

505. *See supra* notes 244–51 and accompanying text.

506. *See, e.g.*, RICHARD H. BERG & MARK HERMAN, SPQR (GMT Games 1992); RICHARD BORG, COMMANDS & COLORS: ANCIENTS (GMT Games 2006).

507. *See, e.g.*, DANE BELTRAMI, COREY KONIECZKA & CHRISTIAN T. PETERSEN, TWILIGHT IMPERIUM (Fantasy Flight Games, 4th ed. 2017); RICHARD BORG, RED ALERT: SPACE FLEET WARFARE (PSC Games 2019).

508. *See, e.g.*, RICHARD BORG, MEMOIR '44 (Days of Wonder 2004).

509. *See, e.g.*, LARRY HARRIS, JR., AXIS & ALLIES: 1942 (Avalon Hill Games 2009).

510. Jahromi, *supra* note 435.

511. *See supra* note 437 and accompanying text.

512. *Cf.* Sony Corp. of Am. v. Universal City Studios, 464 U.S. 417, 429 (1984) (explaining that "[t]he monopoly privileges" created by copyright and patent law are "intended to motivate the creative activity of authors and inventors by the provision of a special reward").

513. Brian Tinsman, *15-Year Creative and Game Design Veteran*, WORDPRESS, https://brianreidtinsman.wordpress.com [https://perma.cc/N98Y-ELJ9].

> For me, the most personally rewarding aspect [of designing games] has been seeing my family, friends, and even strangers having a great time because I created a game. My mother called me up a few weeks ago and said[,] "We all played your game last night. I haven't seen your grandmother laugh so hard in twenty years." It's no exaggeration to say that phone call alone would have been enough reward for all the work I did, even if the game hadn't made a cent.[514]

Similarly, Elizabeth Hargrave, first-time designer of the top-ranked game *Wingspan*,[515] was frustrated by the perceived repetitiveness of Eurogame themes like medieval castles.[516] As a result, she created a new game based on her passion—bird-watching—which has since sold over a million copies worldwide.[517] And Richard Garfield, the creator of *Magic*, advised future game designers that "[o]ne should play games for more than just research, one should play because it is fun. And if it isn't fun[,] you should question your desire to make them."[518]

Indeed, some game designers have gone so far as to outright disclaim IP rights to their games by releasing them under a Creative Commons or another "open source" license.[519] Open source licensing is "a widely used method of creative collaboration that" permits creators to "copy, modify, and distribute" a creative work subject to certain conditions selected by the creator, such as attribution, noncommercial uses only, and/or sharing adaptations on similar terms.[520] For instance, the well-known (and irreverent)

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514. TINSMAN, *supra* note 78, at 36.

515. According to BoardGameGeek, *Wingspan* is currently the top-rated family game and rated 23 overall by users. *Wingspan*, BOARDGAMEGEEK, https://boardgamegeek.com/boardgame/266192/wingspan [https://perma.cc/ZL8E-57G2].

516. *See* Dan Kois, *How a Board Game About Birds Became a Surprise Blockbuster*, SLATE (Aug. 15, 2021, 8:38 PM), https://slate.com/culture/2021/08/wingspan-board-game-elizabeth-hargrave-review-profile.html [https://perma.cc/HK73-6QV5] ("As Hargrave played, though, she and her friends found themselves annoyed that all the games seemed to revolve around medieval villages, or trains, or trading economies in vaguely Mediterranean locales. 'At one point we placed a moratorium on games about castles,' she said.").

517. *Id.*; *see also* Siobhan Roberts, *She Invented a Board Game With Scientific Integrity. It's Taking Off*, N.Y. TIMES (Mar. 11, 2019), https://www.nytimes.com/2019/03/11/science/wingspan-board-game-elizabeth-hargrave.html [https://perma.cc/ADX6-9T2L].

518. Garfield, *supra* note 117, at 10.

519. Of course, a Creative Commons license would not abrogate non-copyright rights, such as patents or trademarks, that may exist in a game. *See* CREATIVE COMMONS, CREATIVE COMMONS ATTRIBUTION-NONCOMMERCIAL-SHAREALIKE 4.0 INTERNATIONAL PUBLIC LICENSE § 2(b)(2), https://creativecommons.org/licenses/by-nc-sa/4.0/legalcode [https://perma.cc/RY48-CMYD] ("Patent and trademark rights are not licensed under this Public License.").

520. Jacobsen v. Katzer, 535 F.3d 1373, 1378–79 (Fed. Cir. 2008). The full list of Creative Commons license options is posted on the organization's website. *See About CC Licenses*, CREATIVE COMMONS, https://creativecommons.org/about/cclicenses [https://perma.cc/4W7D-85SK].

card game *Cards Against Humanity* is published under a Creative Commons BY-NC-SA license, meaning that users can use, remix, and share the game for free with attribution to the game's creators, but cannot sell or otherwise commercialize it.[521] Similarly, *Secret Hitler*, a popular hidden identity social deduction party game, is also available for download under a Creative Commons license.[522] Dozens of lesser-known board and card games have been released under an open source license as well.[523]

The desire for recognition and acclaim also may motivate some game designers more than formal IP rights.[524] Although Rob Daviau, Richard Garfield, Uwe Rosenberg, and Klaus Teuber may not be household names, they are widely recognized in the tabletop gaming community as leading game designers and innovators. Prizes like the *Spiel de Jahres* and the *Golden Geek Awards* bring increased recognition and greater sales for winning games.[525] In addition, when an out-of-print game is reimplemented, there is a community norm that the original game designer will receive attribution, and often financial compensation (in the form of a royalty) as well, even when not required by copyright law.[526]

In contrast, publishers rely on IP rights to protect their investment in new tabletop games and recoup costs associated with the printing, marketing, and distribution of them.[527] The incentives provided by IP law are broader than just creation itself; they also include "the incentive to provide the public with the tangible products of creation."[528] The Supreme

521. *See Steal the Game*, CARDS AGAINST HUMANITY, https://www.cardsagainsthumanity.com #downloads [https://perma.cc/F8DV-P8K8] (linking to Creative Common's BY-NC-SA 4.0 open source license). The base game, family edition, and various international editions of *Cards Against Humanity* can be downloaded in print-ready format directly from its website. *Id.*; *see also Max Tempkin*, TEAM OPEN, https://teamopen.cc/max [https://perma.cc/4ZKS-BF4W] ("As a founder of *Cards Against Humanity*, Max Temkin spends time delighting his fans, not suing them. The creators selected a Creative Commons license instead of All Rights Reserved copyright, choosing to focus their energy where it matters most for their business—writing jokes.").

522. SECRET HITLER, https://www.secrethitler.com [https://perma.cc/454P-BLHZ].

523. *See* Daniel Wilcox, *Creative Commons/Open Source Games*, BOARDGAMEGEEK (Feb. 5, 2009, 10:31 AM), https://boardgamegeek.com/geeklist/33151/creative-commonsopen-source-games [https://perma.cc/K55W-VWMR].

524. *See* TINSMAN, *supra* note 78, at 46 ("Let's not fool ourselves. Like it or not, the most common reason people want to get games published is to gratify their egos. Imagine how good it feels to show people a published game and say, 'I created this.'").

525. *See supra* notes 96–97 and accompanying text.

526. Interview with Justin Jacobson, President, Restoration Games (Dec. 3, 2020).

527. Of course, the rise of crowdfunding has conflated the roles of game designer and publisher, as many creators are now electing to fundraise and self-publish their own games. *See supra* notes 107–11 and accompanying text. This suggests that IP rights may be more important for self-publishing game designers than those who license their games to others.

528. Sara K. Stadler, *Incentive and Expectation in Copyright*, 58 HASTINGS L.J. 433, 433 n.2 (2006); *see also* Douglas Lichtman, *Copyright as a Rule of Evidence*, 52 DUKE L.J. 683, 724 n.177 (2003) ("Copyright protection is designed to encourage dissemination as well as creation. Thus, there

Court itself has recognized that "dissemination of creative works is a goal of the Copyright Act."[529] Thus, IP rights help publishers bring games from creation to the marketplace, and eventually to players' homes.

Copyright and trademark law also protects publishers against slavish copying and unauthorized reproductions of their games.[530] Protection against copying is particularly important in industries like tabletop gaming, where the cost of creation (i.e., hundreds of hours of game design and playtesting) is relatively high, and the cost of reproduction of a work is low, as the components of a game often cost only a few dollars.[531] In addition, the costs of publication and dissemination for even a basic hobby game with a limited print run are often in the tens of thousands of dollars, including the cost of materials, molds, artwork, printing, shipping, and marketing.[532] More elaborate games with extensive components like *Gloomhaven* have even higher costs and correspondingly higher prices ($140 at retail).[533] The development of 3D printing has further increased the ease of copying, as 3D models for board games are widely available on sites like Thingiverse.[534] Absent the exclusivity provided by IP law, publishers would likely find it difficult to recoup their investments when faced with lower-cost knockoffs.

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might be reason to recognize copyright even in instances where the relevant author was not originally motivated by the allure of copyright protection.").

529. Stewart v. Abend, 495 U.S. 207, 228 (1990); *see also* Harper & Row, Publishers, Inc. v. Nation Enters., 471 U.S. 539, 558 (1985) ("By establishing a marketable right to the use of one's expression, copyright supplies the economic incentive to create *and disseminate* ideas" (emphasis added)); Mills Music, Inc. v. Snyder, 469 U.S. 153, 187 (1985) (White, J., dissenting) ("Achieving that fundamental objective of the copyright laws requires providing incentives both to the creation of works . . . and to their dissemination.").

530. *See, e.g.*, Matthew Gault, *How to Spot a Fake $1,000 Magic: The Gathering Card*, VICE (Oct. 30, 2017, 12:12 PM), https://www.vice.com/en/article/9kqk8d/how-to-spot-a-fake-magic-the-gathering-card [https://perma.cc/Z5JV-V3FD]; Larry Gordon, *Huge Shipment of Fake Pokemon Cards Seized at L.A. Port, Destroyed*, L.A. TIMES (July 13, 2012, 1:31 PM), https://latimesblogs.latimes.com/lanow/2012/07/feds-seize-huge-shipment-of-pokemon-cards-the-phony-type-.html [https://perma.cc/M59M-QUA7]; *see also supra* Sections IV.A, IV.C.

531. William M. Landes & Richard A. Posner, *An Economic Analysis of Copyright Law*, 18 J. LEGAL STUD. 325, 326 (1989); *see also* Christian Handke, *Intellectual Property in Creative Industries: The Economic Perspective*, *in* RESEARCH HANDBOOK ON INTELLECTUAL PROPERTY AND CREATIVE INDUSTRIES 57, 60–68 (Abbe E.L. Brown & Charlotte Waelde eds., 2018).

532. *See Making Board Games Your Business*, PINE ISLAND GAMES, (Sept. 28, 2021), https://www.pineislandgames.com/blog/making-board-games-your-business [https://perma.cc/UCS5-2FLP] (delineating these costs). Increases to shipping and storage costs for games—many of which are printed overseas—due to the ongoing coronavirus pandemic has compounded these issues. *See* Megan McCluskey, *The Board Game Business Is Booming, but the Global Shipping Crisis Could Be Disastrous*, TIME (Sept. 28, 2021, 12:11 PM), https://time.com/6096497/board-games-shipping-crisis [https://perma.cc/4KQ6-9C4Y].

533. Charlie Hall, *Hit Board Game Gloomhaven Costs $140 and Weighs 20 Pounds (For Now)*, POLYGON (Apr. 1, 2020, 4:40 PM), https://www.polygon.com/2020/4/1/21203354/gloomhaven-light-version-jaws-of-the-lion-summer-release-date-price [https://perma.cc/N283-8TLM].

534. *See* Forum, *3D Prints for Board Games*, BOARDGAMEGEEK (June 12, 2019, 3:02 PM), https://boardgamegeek.com/geeklist/186909/3d-prints-board-games [https://perma.cc/FQ35-TF7X].

Furthermore, the derivative work right of copyright law provides an incentive for the creation and publication of expansions, sequels, and new editions of existing games. As Michael Abramowicz has explained, "[c]opyright's derivative right gives [the owner] the exclusive right to prepare adaptations of copyrighted works, preventing competitors from preparing unauthorized sequels and other transformations."[535]

One consequence of the derivative work right is that it helps provide both the time and financial incentive to develop high-quality follow-on works by excluding others from rushing to create lower-quality sequels.[536] In the tabletop gaming industry, expansions to existing board games are an important way to continue to generate interest and sales by adding new features, mechanics, complexity, and/or additional players to the base game.[537] Similarly, for RPGs, the derivative work right can incentivize the development of new modules and guides for gamemasters and players.

Copyright and trademark law also incentivize tabletop game publishers to "port" their games to digital format and help prevent unauthorized (and often inferior) digital knockoffs from entering the market.[538] For instance, in 2005, a company released *Scrabulous*, an unauthorized version of Hasbro's popular word game *Scrabble*.[539] Hasbro filed suit and then released its own, authorized version of *Scrabble* for computers and smartphones, which became widely adopted.[540] Moreover, some game publishers have noticed that releasing a digital version of a tabletop game can increase interest and sales in physical copies of the game.[541] And online versions of tabletop games offer

535. Michael Abramowicz, *A Theory of Copyright's Derivative Right and Related Doctrines*, 90 MINN. L. REV. 317, 318 (2005).

536. *See id.* at 322 (explaining that "[t]he production of unauthorized derivatives may produce relatively little social value while steering creative resources from more original applications and causing the original author to rush official adaptations that will be lower quality than they otherwise would be"); *see also* Jacqueline D. Lipton & John Tehranian, *Derivative Works 2.0: Reconsidering Transformative Use in the Age of Crowdsourced Creation*, 109 NW. U. L. REV. 383, 386 (2015) (explaining that the derivative work right "secures the abilities of rights holders to control entire derivative franchises that span multiple sectors of the economy and categories of consumption" and "serve public policy by incentivizing the creation of certain types of works that may not otherwise be made").

537. *See supra* notes 478–83 and accompanying text (noting the various expansions to *Settlers of Catan*).

538. The converse occurs as well; there are numerous tabletop games based upon video games. *See, e.g.*, DOOM: THE BOARD GAME (Fantasy Flight Games 2016) (based upon the *Doom* series of video games); DRAGON AGE (Green Ronin Publishing 2010) (based on the *Dragon Age* video games); THE OREGON TRAIL CARD GAME (Pressman 2016) (based on the *Oregon Trail* series of video games).

539. *See* Schaeffer, *supra* note 18, at 43.

540. Complaint at 1, Hasbro, Inc. v. RJ Softwares, No. 08-CV-06567 (S.D.N.Y. 2008).

541. Dan Jolin, *The Rise and Rise of Tabletop Gaming*, THE GUARDIAN (Sept. 25, 2016, 3:00 PM), https://www.theguardian.com/technology/2016/sep/25/board-games-back-tabletop-gaming-boom-pandemic-flash-point [https://perma.cc/B6SL-D7J7].

a way for friends and colleagues to continue playing when physical proximity is unsafe or impossible, as during the COVID-19 pandemic.[542]

There is also significant evidence of user innovation in the tabletop gaming industry. Eric von Hippel, who coined the term "user innovation," explains this concept encompasses improvements made and features added by end users of a work.[543] Indeed, tabletop gaming is distinct from many other creative industries, such as Hollywood, the recorded music industry, and book publishing, in that there is not a clear divide between creators and consumers. Rather, many tabletop game designers start out as game players, and usually continue to play games once they become designers. Indeed, players serve an important role in the game development process by helping refine and improve a game's mechanics through playtesting.[544] In addition, players can directly assist the creation of new games by providing financial support through Kickstarter or other crowdfunding platforms.[545] User innovation also occurs through "house rules"—that is, unofficial modifications to a game's mechanics that can improve the gameplay experience by simplifying the rules, speeding up the game, and/or adding additional resources.[546] Furthermore, the emergence of open source licensing for RPGs facilitates user creativity and innovation, as dozens of *D&D*-compatible supplements have been created under the Open Game License.[547]

Ultimately, tabletop games appear to fall into that gray space between IP-intensive fields like biotechnology and motion pictures and "negative spaces" like fashion and fine cuisine that do not require formal IP rights at all. Instead of viewing IP's relationship to innovation in a particular field as a

542. Meilan Solly, *Twelve Board Games You Can Play With Friends from Afar*, SMITHSONIAN MAG. (Apr. 20, 2020), https://www.smithsonianmag.com/innovation/twelve-board-games-you-can-play-friends-afar-180974686 [https://perma.cc/JL6A-AKDL].

543. *See generally* ERIC VON HIPPEL, DEMOCRATIZING INNOVATION (2005) (discussing the ability of individual consumers to innovate for themselves).

544. This can occur in a variety of settings, such as informal playtesting among friends and at game conventions. For example, GenCon, the largest U.S. conference for tabletop gaming, offers a "First Exposure Playtest Online" program that game designers and players can participate in. *See First Exposure Playtest Online 2020*, GENCON, https://www.gencon.com/host/fepo2020 [https://perma.cc/YX5B-4REV]; *see also* Ben Begeal, *Nonepub Winter 2021*, UNPUB, https://unpub.net/announcing-nonepub-winter-2021 [https://perma.cc/5PXR-3XLD] (offering online playtesting).

545. *See supra* notes 107–11 and accompanying text.

546. For example, the longstanding but unofficial practice in *Monopoly* of collecting all taxes and fees into the middle of the game board and awarding them to the player who lands on the "Free Parking" square is an example of user innovation; Hasbro only adopted it as an official "house rule" in 2014. *See* Caitlin Dewey, *After 80 Years, Monopoly Is Officially Adding House Rules*, WASH. POST (Mar. 25, 2014), https://www.washingtonpost.com/news/arts-and-entertainment/wp/2014/03/25/after-80-years-monopoly-is-finally-adding-house-rules [https://perma.cc/3EJ5-RULT].

547. *See* M. Jason Parent, *D20 Product Listing*, FANDOM: D20 NPCS WIKI, https://d20npcs.fandom.com/wiki/D20_Product_Listing [https://perma.cc/4PAJ-SQ8U].

binary variable, it should be considered as a continuum between the two extremities.[548]

VII. CONCLUSION

In sum, it appears that IP law supports—or at least does not significantly hinder—the high level of innovation currently occurring in the tabletop gaming industry. While tabletop games are not a "negative space" in the sense that IP does provides meaningful protection to game publishers, the limits of copyright and trademark law, along with the practical absence of patent protection, means that game designers have sufficient freedom to continue to create and innovate. Indeed, the evidence suggests that non-IP incentives, such as the intrinsic value of creating and sharing new games and receiving attribution for them, may be more significant drivers of innovation for game creators than formal IP law. As a result, the tabletop gaming industry serves as an example of a field where IP law generally balances the interests of creators, publishers, and consumers effectively.

548. *Cf.* Tim Wu, *Tolerated Use*, 31 COLUM. J.L. & ARTS 617, 617 (2008) (noting the "giant grey zone in copyright" where there are potentially numerous infringing but tolerated uses by copyright owners).