

Reinventing trademarks and designs in the gaming industry

Dr. Tomasz Gawliczek of JWP Patent & Trademark Attorneys highlights key considerations for crafting a trademark and design protection strategy in the gaming industry. Drawing on past lessons, he discusses essential factors to keep in mind and offers insights on how upcoming legal changes could be leveraged to strengthen IP strategies in this sector.

For years, the gaming industry has relied on trademark and design registration to safeguard its creations. However, the true impact of these protections lies in how strategically they are applied. Much like in RTS games, a carefully crafted IP protection strategy is crucial, one that adapts to the evolving legal and technological landscape. The industry's past experiences offer valuable lessons, and there are also new challenges on the horizon that are worth anticipating and preparing for today.

Be distinctive

When thinking about protecting the name of a game, a character's identity, or even a console, one should recall the guiding principle of trademark law. The more distinctive your trademark is, the more protection it can benefit from later.

In this respect, one must be more cautious about verbal elements that may be considered descriptive or commonly used in the industry. In some cases, acquired distinctiveness can be demonstrated in relation to certain trademarks, but this only becomes possible when they have been used extensively on the market for many years.

Within this framework, it is valuable to reflect on a case that was decided before the European Intellectual Property Office (EUIPO) some years back. Nintendo Co., Ltd filed an opposition to the EUTM application No. 002586980 "Fire Boy," claiming its previous registrations of the GAME BOY trademarks. Despite the similarity of the goods for which they were



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Résumé

Dr. Tomasz Gawliczek is a partner at JWP Patent and Trademark Attorneys and a dual-qualified patent and trademark attorney and attorney-at-law in Poland. With over 10 years of experience in intellectual property, he specializes in strategic planning and litigation. Tomasz has represented clients in numerous cases before the Polish Patent Office, Polish IP courts, and EU institutions. He is among the most seasoned Polish attorneys in handling trademark and design disputes before the EU General Court.



Dr. Tomasz Gawliczek

intended, the EUIPO did not identify any similarity between the trademarks themselves. The grounds for the decision indicated that "(...) both signs contain the English word »boy« which is likely to be understood in all relevant territories. However, it is not a striking element applied to computer games which are meant for children and boys in particular" (decision No. 2091/2005 of 15/16/2005). Ultimately, registration of the contested trademark was not granted due to its withdrawal by the applicant at a later stage. Nevertheless, this case shows how reliance on distinctive word elements is important when assessing the risk of confusion.

Moving beyond the scheme

Current efforts to secure protection through trademark registrations also face challenges concerning the evaluation of distinctiveness. One excellent example is the application for a multimedia EU trademark 017282203, which resonated with the market. Seven years after the application had been filed with the EUIPO, a decision was finally made this year to refuse its registration. The EUIPO argued, among other reasons, the insufficient distinctiveness of the game fragment intended to function as a trademark.

As for the reasoning behind this decision, we can read that "the Office does not doubt that the specific »slow motion X-ray kill cam« is somewhat unique. However, in the light of the above, the relevant public will merely perceive it as a newly combined and possibly improved feature of the game at hand, still resembling features known from other games or previous versions of the same game" (refusal of application for a European Union trademark of 08/07/2024).

There are at least two lessons to be learned from this case. Firstly, the EUIPO confirmed that the same rules for assessing distinctiveness can be applied to multimedia trademarks as had previously been developed in case law concerning

shape marks. Secondly, it is apparent that a mere fragment of a game can constitute a trademark if it deviates from the market standard. Therefore, it is also worth considering this form of protection if the game scene is indeed so distinctive (fanciful), that it will, from the consumers' perspective, succeed in indicating the origin of this product from one particular company.

Importance of graphic elements

A compelling approach to establishing protection for gaming-related products is to register specific graphic elements as trademarks. At the same time, it must be borne in mind that such an element must fulfill the functions of a trademark in the game itself if the right holder wishes to claim protection against infringements on that grounds at a later stage.

In addition, the way in which the graphic element is presented remains an important issue. In today's games, reality is depicted multi-dimensionally and players are becoming increasingly immersed in the game via augmented reality. This means that registering a graphic element (e.g., a specific game asset) as a trademark in only one dimension limits its protection. This is because a comparison with other similar assets that have a three-dimensional form may reveal a lack of similarity between them.

In existing litigation concerning the infringements of purely figurative EU trademark registrations, the likelihood of confusion on the part of the relevant public has not always been established, even when the compared goods were identical. In this regard, an interesting case was decided by the Austrian Supreme Court in 2020 (ref. 4 Ob 27/20d). The case concerned the infringement of a figurative trademark for a book (EUTM-12414975) which was compared with another book appearing in a competitive game. The Court highlighted that trademark law does not grant protection to simple motifs. Consequently, simply depicting the same object does not automatically create graphic similarity between the compared signs.

On the other hand, in this type of case, the assessment of conceptual similarity and the question of whether the graphic sign contained in the game actually appears as a trademark in the game remains a separate issue.

IP reaches outside the game itself

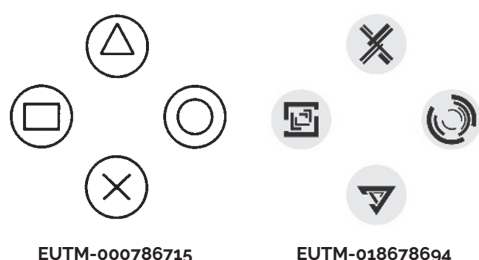
In the gaming industry, graphic signs can be used to identify not only the gameplay elements themselves but also, for example, consoles or other devices. Thus, they can be identified by players even before they start playing the game.

This was the protection that Sony Interactive Entertainment Inc. thought of when it registered the EU figurative trademark 000786715 back in

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1998. On this basis, an opposition was filed to the application for another figurative mark No. 018678694. A graphical comparison of the two signs was as follows:



When deciding the case, the EUIPO Board of Appeal noted in its decision of March 14, 2024 that “the differences in the marks are additional ornamental strokes added to the contested sign, showing the same easily recognizable symbols of a triangle, a circle, an ‘X’ and a square or rectangle in the same pattern, order and location. The Board also finds that when contemplated in their entirety, notwithstanding some stylistic differences, the marks have an identical graphic arrangement and overall convey a somewhat similar look” (ref. R 1951/2023-2).

This decision stands out for two key reasons. Firstly, the EUIPO’s earlier assessment of the similarity between these signs differed. Moreover, when evaluating the likelihood of confusion, the

Board of Appeal noted that companies today often make adjustments to previously used marks, which, in this instance, could suggest that the products bearing both marks come from the same source.

What to protect?

As noted above, when planning to protect a trademark in the gaming industry, it should not be limited to the game itself or even to gaming-related devices. Indeed, the gaming market encompasses many more goods or services that are dedicated to fans of a particular game.

According to the figures reported by the Independent in the context of the widely presented online gaming stats for 2024, the most connected and also revenue-generating markets are toys; film, TV, and soundtracks; books; and events and venues. This shows that thinking about the protection of intellectual property must be based on a broader perspective and, at the same time, it must anticipate the behavior of consumers who, encouraged by playing the game, may also be inclined to purchase other products “from the series.”

As a result, it is essential to establish the scope of protection of the trademark to be registered as early as possible. Delays can lead to future conflicts with other signs, making it impossible to secure protection later on.

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Who is targeted by the gaming market?

The answer to this question is just as important as the previous one. Knowing who you want to sell your goods and services to makes it much easier to create the right offer. In addition to the business perspective, this question is also significant in terms of assessing whether there may be a risk of misleading part of the public. This depends, among other things, on the level of attention of the relevant consumers.

Nowadays, it is reasonable to say that anyone can play a game. Does this align with the perspective shown in case law? Indeed, it does. In this respect, the position taken by the General Court of the European Union in the dispute involving the trademark "Dungeons and Dragons" cannot be ignored.

The judgment of October 10, 2019 in case T-700/18 addressed this issue by indicating that "the categories »games« and »computer games« cover a fairly large number of different goods, which are not luxury or niche products reserved for a limited number of people. On the contrary, those goods are available both online and on a self-service basis, they are widely promoted on different television channels, depending on the target age group, their price is relatively low, and special skills or knowledge are not essential or required for their purchase. In other words, games and computer games are easily accessible to all, including those without special knowledge, and may therefore be assimilated to everyday consumer items" (p. 36). This is an important observation, because the higher the level of attention of the target audience of the goods bearing the compared marks, the greater the chance that there will be no confusion between them.

The EU General Court's position encourages even more prudent and forward planning for trademark protection in this sector. Indeed, where there is a conflict between a trademark appearing in a game and another one for goods such as toys or books, for example, this can lead to difficulties.

Digital designs and the games market

It is not only trademarks that are allies in the gaming industry's struggle to gain a monopoly on particular elements of the game or the gaming world in general. Designs have also been successfully used for this purpose to date. Now, however, it seems worth taking a closer look at the strategy for their protection, as the forthcoming legislative changes may introduce a new quality in this area.

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the demands of evolving business landscapes more effectively. It is already clear at this point what changes will be introduced as part of the EU Design Legislative Reform Package. One of them is the revised definition of a product which will mean any industrial or handicraft item other than computer programs, regardless of whether it is embodied in a physical object or materializes in a digital non-physical form.

Until now, the most common approach in the industry has been to register a design to protect the graphical user interface. Will the introduction of digital designs prompt the gaming sector to start protecting individual virtual assets also through the use of this exclusive right? Certainly, as it provides additional opportunities for increased monopoly. What remains an open question, however, is how this protection will be enforced in practice.

On a final note

In recent years, much has shifted regarding IP protection in the gaming industry. Advancements in case law and legal reforms are paving the way for expanded possibilities in this area.

What is important to remember is that protection is not given once and for all, and the exploration of new solutions should never end. Once you have reached one level, you need to be ready for the next. This could be reminiscent of the famous quote from the *Super Mario Bros.* game: "Thanks, Mario! But our princess is in another castle!"

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