

# **Tetris Holding, LLC v. Xio Interactive, Inc.**

## **863 F. Supp. 2d 394 (D.N.J. 2012)**

TAMIKA LIPFORD\*

### BACKGROUND

Plaintiffs, Tetris Holding, LLC and Tetris Company, LLC, (collectively, “Tetris Holding”) brought five claims against defendants, Xio Interactive, Inc. (“Xio”), surrounding their famous puzzle block electronic video game, Tetris. The court addressed only two out of five claims brought forward: 1) Xio’s infringement of Tetris Holding’s copyright protection of Tetris and 2) Xio’s infringement of Tetris Holding’s trade dress protection.

Tetris, the electronic video game, sprung to popularity in the late 1980’s-early 1990’s and was created by a Russian computer programmer, Alexy Pajitnov. He has since expanded to various platforms making the game available to consumers all over the world. He later formed, Tetris Holding, LLC with Henk Rogers, a game designer. Tetris Holding owns the copyrights to Tetris as well licensing rights to Tetris Company, which in turn sublicenses certain rights to outside companies. Tetris Holding has consistently protected its intellectual property through the legal process against infringers and has removed hundreds of imitation games from the market.

Desiree Golden formed Xio after creating a multiplayer puzzle game for the iPhone with the intention of producing another version of Tetris. Xio called its game Mino. Xio attempted to obtain a license from Tetris Holding, but Tetris Holding refused. Xio proceeded to create a game that it believed would not copy any protected elements.

Tetris Holding discovered the possible infringement and sent “take-down” notices to Apple, Inc (Apple). under the Digital Millennium Copyright Act and Apple removed Mino and Mino lite from its marketplace. After Xio responded with a counter-notification, Apple informed Tetris Holding the games would be reinstated unless Tetris Holding filed a legal action. Tetris Holding filed suit in December 2009 alleging numerous causes of action.

---

\* Ms. Lipford is a 2013 Juris Doctor candidate at the University of San Francisco School of Law.

## ISSUE

Because there were no genuine issues of fact, the United States District Court for the District of New Jersey considered which party was entitled to summary judgment on both the copyright infringement claim under 17 U.S.C. §§ 101 et seq. and the trade dress infringement claim under 15 U.S.C. § 1125(a)(1)(A).

## DECISION

The court granted summary judgment in favor of Tetris for both the copyright infringement claim and the trade dress claim. Both parties requested that the court submit summary judgment in their favor. The court rejected Xio's argument that summary judgment was proper because it had not copied any protectable, expressive elements of the game, but rather imitated the game's rules and functionality. The court instead found Tetris Holding's evidence more persuasive: Xio blatantly infringed upon Tetris Holding's copyright protection and caused confusion amongst consumers with its identical packaging and advertising.

## REASONING

First, the court considered Tetris Holding's allegation that Xio infringed upon its copyright. To successfully bring a copyright claim Tetris Holding must establish: 1) ownership of a valid copyright; and 2) unauthorized copying of original elements of the plaintiff's work. Here, Xio acknowledged Tetris Holding's ownership of copyright to iterations of Tetris, however, Xio believed the material it copied from the video game was not protected under copyright law because it was functional. Before determining whether Xio infringed upon Tetris Holding's copyright, the Court established which elements of the Tetris game were protected under copyright law. Under 17 U.S.C. § 102, expressions of original works are protected but not ideas. The court recognized copyright protection extends to computer programs, specifically the program code and the graphical elements<sup>1</sup>

Next, the court clarified the circuit split on what test to apply for the idea-expression dichotomy. The Third Circuit explained, "the purpose or function of a utilitarian work would be the work's idea [not protected], and everything that is not necessary to that purpose or function would be part of the expression of the idea [protected]."<sup>2</sup> This was the structure the Third Circuit introduced to determine what was protected as an expression and what was not protected as an idea. Outside the Third Circuit the Whelan opinion has been heavily criticized and referred to as "simplistic and overbroad" or courts have completely abandoned the holding because the

---

1. Apple Computers, Inc. v. Franklin Corp., 714 F. 2d 1240, 1249 (3d Cir. 1983)

2. Whelan Assocs., Inc. v. Jaslow Dental Laboratory, Inc., 797 F. 2d 1222, 1234 (3d Cir. 1986).

2012] *TETRIS HOLDING, LLC V. XIO INTERACTIVE, INC.* 101

court failed to place emphasis on practical considerations and focused on metaphysical distinctions.

The Second Circuit used the abstraction-filtration-comparison test.<sup>3</sup> As a widely accepted test, the *Altai* test looked at elements of a work to determine if there was a substantial similarity in violation of copyright protection. The three-step test included: 1) abstracting the alleged problematic program; 2) filtering out the unprotected material; and 3) comparing whatever remained to the copied work. Despite the differences in the two Circuits, the same task remained ahead of the court: to determine copyrightable expression versus unprotected ideas and then assess whether there was a substantial similarity between the protected expression and Xio's product. If the ideas and expressions of the video game fall within the merger or *scènes à faire* doctrine, the court will not extend protection to these elements (rules of a game or game mechanics). If an idea and expression become inseparable the court will not find the elements of the program protected under the merger doctrine. Merger exists when there are no or few other ways of expressing a certain idea. Similarly, if a specific expression is so associated with a particular idea that one is compelled to use such expression, there will be no protection under the *scènes à faire* doctrine.

Looking at the products in gross rather in minutiae, the court found that Mino mimicked the overall feel and look of Tetris with the visual expression of Mino and Tetris almost identical. Specifically, Mino's style, design, shape and movement of the games pieces were nearly indistinguishable. While Tetris Holding's copyright did not extend to the style and movement of the pieces, the expression associated with the elements was protected. Against Xio's argument that Tetris' pieces were unprotected as functional and rule related pieces, the Court found limitless options for Xio to produce a similar acceptable functioning game. By creating a different sized playing board, different colored pieces and different depiction indicating game over, Xio would have avoided violating Tetris Holding's copyright. The court found the doctrine of merger or *scènes à faire* inapplicable and summary judgment proper for Tetris Holding's copyright infringement claim.

Additionally, Xio raised an argument for fair use to the extent Xio infringed upon a miniscule quantity of the overall copyrighted work. However, the court rejected Xio's fair use argument because Xio indeed infringed upon a substantial amount of the overall copyrighted work.

The court then considered Xio's alleged federal trade dress violation. To establish trade dress infringement there are three factors to prove: 1) the trade dress is distinctive in that it has acquired secondary meaning; 2) the trade dress is not functional; and 3) there is a likelihood that consumers will confuse the Mino product for the Tetris product. Here, the court focused on the last element and found Mino would easily confuse consumers as to

---

3. *Computer Assocs. Int'l v. Altai*, 982 F. 2d 693, 705 (2d Cir. 1992).

whether Mino was an authorized iteration of Tetris due to similar packaging and advertising, therefore, Tetris Holding was also successful on their trade dress claim.