

Meeting of the Minds

Emerging Challenges in Tabletop Gaming: Player Modifications, Third-Party Parts, and Disruptive Technology

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Modifying board games is a time-honored practice and has resulted in countless variations of popular titles. For example, everybody knows that you get \$500 if you land on Free Parking, even though the official *Monopoly* rules don't say so. House rules are not the only way players modify games. The popular Milton Bradley game *HeroScape*, a turned-based strategy game in which players pit armies of units against each other on a three-dimensional (3D) hex grid, spawned a cottage industry of custom user-designed units, ranging from entirely original pieces to figures based on third-party properties, such as *Star Wars*. Still other tabletop gaming products are specifically intended for user customization. Combat-centric tabletop games, like role-playing games and war games, prominently feature unpainted miniatures that are custom-painted by the player. Games Workshop's *Warhammer 40K* system in particular is famous for the extent to which players modify stock products—even the paint colors chosen by the player can in some instances impact gameplay.

While modifying, often known colloquially as “modding,” appears innocent, it presents complex intellectual property (IP) issues. Game designers may perceive modifications (often shortened to “mods” in the industry) as a threat to their creative control, and third-party IP owners tend to frown upon unlicensed use of their trademarks and characters. Those who produce modifications and other third-party parts, generally referred to as “modders,” may want to register IP rights to their custom creations, and commercialize them. Caught in middle is the end-user, who just wants a *Dungeons and Dragons* miniature that looks like Tyrion from *Game of Thrones* (as portrayed by Peter Dinklage, of course). These problems become all the more real as the age of affordable consumer-grade 3D printers draws nearer.

Games are a unique hybrid of intellectual property, and may incorporate almost every major category thereof. Rules and instructions, as well as board layout, artwork, or game token or miniature design, may be protected (at least in part) by copyright. Branding and, in some cases, the look-and-feel of the game may be protected by trademark. In some instances, the game may also be the subject matter of an

issued patent, or implicate rights of publicity. Each of these forms of intellectual property serves different purposes, and modding can impact each. This article focuses on copyright, as it implicates almost every tabletop gaming product, but it should be noted that trademark law, while having certain advantages over copyright, is no panacea.

Are Tabletop Games Copyrightable?

Whether representing a game designer or a modder, two threshold issues must be considered: (1) whether the work at issue is eligible for copyright protection at all, and (2) the idea-expression dichotomy. As to the first, copyright law cannot protect a game's name, title, or the idea or method for playing it, nor the game "system." Thus, if a modder is producing independent products not based on or derivative of any copyrightable element of your game, but which are *compatible* with your game or game system, you are unlikely to find relief in the Copyright Act.¹

For example, if a third party publishes alternative or customized rules for use with your system, which do not substantially incorporate copyrightable elements of your instruction manual, there is little you can do about it from a copyright perspective. While one might be tempted to argue this is a derivative work, the game rules are not protectable by copyright in the first place, though a particular expression of them may be, provided it contains sufficient original, creative content, such as pictorial or substantive literary expression (even if in the form of explanation).²

Thus, it is common in gaming instruction manuals, particularly games with a backstory, to include original artwork and/or narrative "fluff" to impart clearly copyrightable elements to the manual. This, at a minimum, provides ammunition against wholesale copying and redistribution of the rules. However, with some exceptions, most tabletop games have reasonably simple rules that can be explained in alternative expressive terms, and a third-party rules modification may be able to include a description of the basic gameplay without infringing any copyrightable matter from the instruction manual.

Another concern for many game designers is that third parties may create products for use with the game, or modifications or replacement parts for stock game components. While the physical elements of virtually any game could be modified or replaced without infringing a copyright (e.g., using a paperclip as a *Monopoly* token), commercially viable third-party modifications are more commonly found in miniature-based gaming, such as strategic war games. For example, players may perceive (correctly or not) that the official game units leave strategic holes or favor particular strategies or play styles, and seek to address these issues with third-party customizations. Alternatively, players may dislike how a particular miniature appears, and wish to sell third-party replacements or modifications to improve the aesthetics.

While this would appear to violate the copyright in the game tokens or miniatures as sculptures, the inquiry is more complex. A recent case out of the Northern District of Illinois involving *Warhammer 40K* is instructive. *Warhammer 40K* is a tactical science fiction war game played out using miniatures to represent the various units and vehicles involved in the battle. The official *Warhammer 40K* miniatures are sold unpainted and often require assembly. *Warhammer 40K* players often take great pride in developing color themes for their armies, and many also develop original backstories for their armies.

In *Games Workshop Ltd. v. Chapterhouse Studios, LLC*, the designer of *Warhammer 40K* sued Chapterhouse Studios, a third party that was manufacturing and selling accessories and replacement components for use with the official *Warhammer 40K* miniatures.³ Games Workshop alleged that many of Chapterhouse's third-party accessories, such as replacement shoulder pads for the official *Warhammer 40K* "Space Marine" miniature sold by Games Workshop, infringed Games Workshop's copyright in its miniatures.

On summary judgment, Chapterhouse argued that the Games Workshop shoulder pads were ineligible for copyright protection as *scènes à faire*—rudimentary and commonplace elements so unavoidable as to be incapable of distinguishing one work within the genre from others.⁴ In particular, Chapterhouse argued that the shape of the shoulder pads was little more than a generic geometric shape, had historical antecedents, and was a necessary byproduct of their function, being designed to shield human shoulders.

The court rejected this argument, noting that the Games Workshop shoulder pads "involve enough originality to afford them copyright protection," chiefly because of the "unusually large proportional size . . . as compared to the Space Marine's head," which the court found to be "a creative addition to the common shoulder pads sometimes worn by real-life soldiers in battle."⁵ However, for a handful of other replacement parts sold by Chapterhouse, such as a vehicle door depicting a pile of skulls, the court found the design lacked "the originality required for copyright protection" and granted summary judgment in favor of Chapterhouse as to those designs.⁶ Ultimately, the court declined to rule on the question of whether the Chapterhouse products actually infringed the Games Workshop products, finding that a reasonable jury could arrive at either conclusion. The case went to trial and, of the 116 copyrighted Games Workshop works at issue, the jury found 49 were infringed, 43 were not, and 24 more were infringed, but fair uses.

This case provides useful guidance for modders and game designers alike. For the designer, replacement parts or modifications to generic game elements are probably unavoidable. The modder should be cautioned that the court was willing to find sufficient originality and creativity in something relatively minor—exaggerated proportions—even though the elements were otherwise of questionable copyrightability.

Disruptive Technologies Pose New Threats

The *Games Workshop* case had at least one major advantage for Games Workshop: because Chapterhouse was selling modifications and replacement parts, the consumer was required to first acquire an officially licensed Games Workshop miniature, thus providing at least some revenue to Games Workshop for its intellectual property. However, emerging disruptive technologies pose new threats to game designers, as they may obviate the need to purchase the game at all.

In particular, 3D printers allow players to create complex board game tokens and other 3D game elements without paying anything to the game designer. All the player needs is a design file for the game piece and access to a 3D printer. A very small 3D printer is sufficient to replicate typical board game

pieces, and a \$100 3D printer may soon hit the market.⁷ The retail price of popular titles continues to rise, and new games sometimes retail for \$50 or more. If players can download and print game pieces on a \$100 printer, the era of board game piracy may nearly be upon us.

In fact, this scenario has already begun to play out. Turning to more traditional tabletop gaming, perhaps one of the most popular tabletop games of the last 20 years is *Settlers of Catan*. *Settlers* is famous for its basic rules, short session time, rustic game tokens, and rich social elements. The game “board” for *Settlers* is a hexagonal grid consisting of a few dozen cards representing different types of terrain, which may be arranged differently for each play session. Based on random dice rolls, players receive various resources depending on what type of terrain cards are adjacent to the player’s game tokens, and the players trade and spend those resources to build villages, cities, and (in later expansions) knights and ships. The official terrain cards are made of thick cardboard with printed designs representing the type of terrain, and the game tokens are elementary geometric shapes devoid of any detail or pictorial elements, such as a long rectangular prism for a “road.”

In July 2012, design files for 3D-printable replacement parts for *Settlers of Catan* were released on the website Thingiverse.⁸ These files could be used to print a complete set of 3D replacement terrain for *Settlers* which, unlike the original game, featured elevated components with 3D detail and recesses for holding game tokens in place. Because rules are merely an idea, and thus not independently copyrightable, anybody who knows the rules of *Settlers of Catan* can use these files to 3D print a board and play the game without ever paying the designer a penny.⁹

Finding a way to protect a game like *Settlers* by copyright is tricky. First, it is at least debatable that the images on the official *Settlers* terrain cards are *scènes à faire*, as they depict general suggestions of terrain types—forest, mountains, plains, etc. Second, assuming the terrain cards are copyrightable, the particular expression on the official cards is not necessary for gameplay. For example, one could cut hexagons out of colored construction paper and effectively play the game with those pieces. Certainly, no action for copyright infringement could lie, or every first grade geometry project would infringe. In any case, the 3D printed components bear little resemblance to the official game cards, and it is doubtful that a copyright interest in the official game terrain could be used to prevent a player from 3D printing a blue hexagon with a wave-textured top for “ocean.”

This is a cruel irony for *Settlers*. The very elements of the game that made it a smashing success—simple, clean design and flexible gameplay—are its IP Achilles’ heel. There is no critical pictorial work required to play the game, such as a standard layout or arrangement of the board. There is no protectable literary content, such as game card text, required for play. While *Settlers* does include a large set of resource cards that would be laborious to reproduce, it only takes one person to create a PDF of the cards, and anybody can download it and reproduce the cards with, literally, the click of a button. The game tokens are generic (and uncopyrightable) geometric shapes. Finally, the rules are, for the most part, simple enough to memorize without frequent resort to the instruction manual (though anybody who has played *Settlers* knows that crafty opponents will send you reaching for the manual with alarm-

ing frequency). In short, virtually none of the intellectual property owned by the author of *Settlers* is actually needed to play the game, though in practical terms, duplicating all of the game elements, even crudely, would be time-consuming.

This phenomenon is not unique to *Settlers*, and this new normal has forced attorneys into creative mode, as there are no clear or simple answers. In an unrelated matter shortly before the 3D printer design files appeared online, an attorney for *Settlers of Catan* allegedly sent a cease-and-desist letter to the author of a software clone of *Settlers* called “Island Settlers.” According to the recipient, the attorney for *Settlers* argued that while the rules are not copyrightable, the “fable” behind the game is, and because the rules are derived from the fable, “[i]t doesn’t matter if you use the exact wording of the rulebook or not, the fable you use is the same as our client’s fable [and you] infringe the copyright.”¹⁰ While the legal force of this argument is perhaps debatable, it was enough for “Island Settlers,” which lacked the resources to fight and discontinued operations. However, this type of argument is unlikely to persuade an established commercial defendant like Chapterhouse to fold up and go away.

This should scare any game designer, as it leaves one wondering how games can be protected at all. 3D printing is an emerging disruptive technology for the tabletop gaming industry, and for the moment, the law has no plain answers. One simple solution is to design games that cannot be played without the use of copyrighted elements, such as a distinct game board, and, of course, to register those elements and pursue infringers. However, the modern day infringer is often not a commercial competitor, but the customer, and we should have learned from the music industry that infringement lawsuits against consumers are like using a sledgehammer to swat a fly. Moreover, this approach also forces game designers into a creative box, and may discourage fun and innovative titles like *Settlers of Catan*.

While the art, story, and theme of a game can add to the experience, ultimately, games are fun to play because the game mechanics are well-designed and make good use of the social aspect of tabletop gaming. The only form of intellectual property that can truly protect game mechanics is patent law, but few games pursue patents, as they are difficult and expensive to obtain. The lesson of *Games Workshop* and *Settlers of Catan* is that even where core elements of the game, such as the miniatures of *Warhammer 40K*, are copyrightable matter that must be purchased from the game designer, copyright protection is not absolute, and there are opportunities for third-party modders.

Creative Solutions for Game Designers

An alternative may be found in the old adage, “if you can’t beat ’em, join ’em.” The plight of intellectual property online, notably copyright, in other industries cannot be ignored. News and music in particular have undergone substantial change in business models to accommodate the new normal, and games may be next. If one accepts that infringement is going to take place, and that enforcement costs may be prohibitive (assuming enforcement is even possible), then finding ways to work with modders may be a viable option. For example, offering an official royalty licensing program may be attractive to commercial modders, as such a program can eliminate uncertainty about the legality of their business endeavors. The program can also generate additional revenue for the game designer and reclaim a measure of creative control. This approach is also less likely to alienate the player community.

Another option is to draw official distinctions between “canon” or “official” material and noncanon material. This approach is particularly suitable to games having multiple expansions or editions, and even more so to games played competitively in tournaments. By only permitting official game pieces and rules in official tournaments, players are incentivized to own an official copy of the game, and not to get accustomed to playing with unlicensed third-party units or modified rules. Even casual games tend to have a following of dedicated competitive players. For example, in 2004, more than 800 people competed for a share of almost \$100,000 in prize money at the National Scrabble Championship, which was aired on ESPN.¹¹

A still further option, related to the licensing option, is to “open source” some or all of the game content. Open source licenses are widely used in software and range wildly in scope from free reign to replicate, modify, and redistribute (including for a profit) any or all of the product, to restrictive licensing terms that effectively strip IP rights from authors. The open source model was used by *Cards Against Humanity*, a humorous game in which one player draws a “question” card from a deck, and each of the other players responds with the funniest “answer” card he or she can play. Players may buy the official card deck, or download (for free) a 31-page PDF¹² of the cards that can be taken to a print shop or simply printed on paper stock at home. The card content is licensed under a noncommercial Creative Commons license.

Creative Commons is an attempt at a simple and agile licensing schema which, in very broad terms, effects a nonexclusive, quasi-public domain license, though authors generally reserve at least some rights. Thus, *Cards Against Humanity* gives users nearly limitless sanction to distribute copies of the cards and to adapt, remix, transform, and build upon the stock material. The catch is that attribution must be given, the material cannot be used for commercial purposes, and your own contributions must also be licensed under these terms.

This approach sidesteps many issues with user modifications. This is particularly important for a game like *Cards*, whose intellectual property is almost entirely simple words, phrases, or questions. Like the terrain cards of *Settlers*, some of these components may not be individually copyrightable, though the ensemble likely is. By offering a Creative Commons license, *Cards Against Humanity* gives those who might otherwise be infringers a way to modify, alter, and add without the risk of widespread and unchecked infringement, while preserving brand integrity by requiring proper attribution.

Certainly, there will always be infringers, but returning to lessons learned from the music industry, part of a good anti-infringement campaign is to understand the changing market demand for your products, and to develop ways to monetize that demand. Twenty-five billion songs sold on the iTunes Music Store can't all be wrong.¹³ n

Endnotes

1. See, e.g., U.S. COPYRIGHT OFFICE FACTSHEET FL-108: COPYRIGHT REGISTRATION OF GAMES (Dec. 2011), available at <http://www.copyright.gov/fls/fl108.html>.

2. See, e.g., U.S. COPYRIGHT OFFICE FACTSHEET FL-122: RECIPES (Dec. 2011), available at <http://www.copyright.gov/fls/fl122.html>.

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3. No. 1:10-CV-08103 (N.D. Ill. Nov. 27, 2012), ECF No. 258, *available at* [http:// digitalcommons.law.scu.edu/cgi/viewcontent.cgi?article=1200&context=historical](http://digitalcommons.law.scu.edu/cgi/viewcontent.cgi?article=1200&context=historical).
4. *See, e.g.*, *Gaiman v. McFarlane*, 360 F.3d 644, 648–49 (7th Cir. 2004).
5. *Games Workshop*, No. 1:10-CV-08103, slip op. at 20.
6. *Id.*, slip op. at 22–23. Trademark arguments were also advanced, which are omitted here for the sake of brevity.
7. For example, preorders are now being accepted for the Peachy Printer, which is slated to debut with a \$100 price tag. *See* PEACHY PRINTER, <http://www.peachyprinter.com/> (last visited Jan. 3, 2015).
8. *See* Jose A. Wong, *3D Catan Terrain Pieces*, THINGIVERSE (July 18, 2012), <http://www.thingiverse.com/thing:26979>.
9. *Settlers* does include other components that would also have to be duplicated, such as resource cards and other game tokens, so this would not be a trivial undertaking.
10. *See, e.g.*, Michael Weinberg, *Settlers of Catan Makes Legal Threats: Can It Back Them Up? (Hint: No)*, PUB. KNOWLEDGE (Feb. 11, 2011), [https:// www.publicknowledge.org/news-blog/blogs/settlers-catan-makes-legal-threats-can-it-bac](https://www.publicknowledge.org/news-blog/blogs/settlers-catan-makes-legal-threats-can-it-bac). It should be noted that the letter allegedly sent by the IP attorney for *Settlers* is no longer available at its original website. The author was able to find an archived copy on the Internet Archive Wayback Machine. *See* Neil Isaac, *Island Settlers Development Comes to an Unfortunate End* (Dec. 24, 2010), <https://web.archive.org/web/20110511000914/http://omnionic.com/2010/12/island-settlers-development-comes-to-an-unfortunate-end/>.
11. *See National Scrabble Championship*, WIKIPEDIA, http://en.wikipedia.org/wiki/National_Scrabble_Championship (last modified Dec. 5, 2014).
12. HOW TO MAKE YOUR OWN CARDS AGAINST HUMANITY, *available at* http://s3.amazonaws.com/cah/CAH_MainGame.pdf (last visited Jan. 3, 2015).
13. *See iTunes Store Sets New Record with 25 Billion Songs Sold*, APPLE PRESS INFO (Feb. 6, 2013), <https://www.apple.com/pr/library/2013/02/06iTunes-Store-Sets-New-Record-with-25-Billion-Songs-Sold.html>.