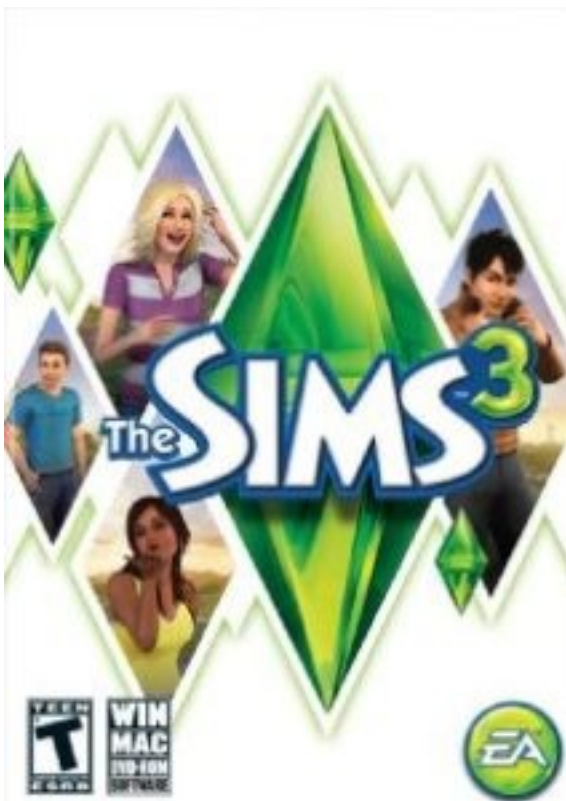


Ninth Circuit Finds “Gem-Shaped” USB Flash Drive Potentially Protectable Under the Copyright Act

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by David Tseng

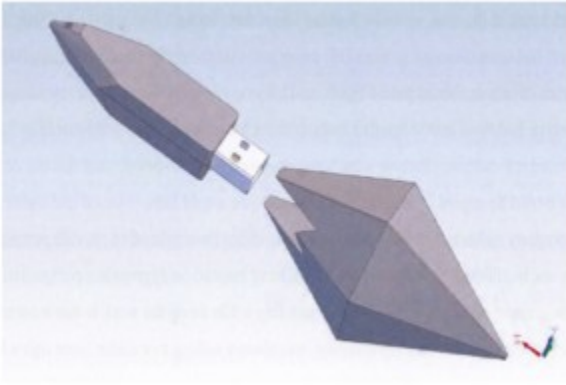


The Sims is a popular series of video games in which players create virtual people called “Sims,” design these virtual peoples’ homes and neighborhoods, and help them navigate their in-game relationships, careers, and social lives. When a player controls a specific character, a green, gem-shaped icon called a “PlumbBob” appears over the character’s head. EA owns a copyright in this two-dimensional gem. In *Direct Technologies LLC v. Electronic Arts, Inc.*, the question arose as to whether the design of a USB flash drive based on the PlumbBob is copyrightable. The trial court said no, but the 9th Circuit held there were material issues of fact for the jury to decide. Here’s what happened:

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To promote the release of The Sims 3, EA wanted to include a PlumbBob-shaped USB drive as a marketing trinket to be included with copies of the game. EA contracted with company called Direct Technologies (“Direct”) to design these PlumbBob-shaped USBs. As the following prototype illustration shows, Direct created a “cut-away” design where the USB flash drive would be embedded into the PlumbBob:



EA ultimately sent Direct's prototype to a company in China for production instead of Direct. Direct sued EA for copyright infringement, among other causes of action. Judge Guildford of the Central District of California held as a matter of law that the design of the flash drive was not sufficiently original to qualify for copyright

protection as a derivative work - that Direct's contributions to the drive were either trivial or functional.

The Ninth Circuit panel reversed. The Ninth Circuit held that there was a genuine issue of material fact regarding whether the manner in which Direct designed the USB flash drive stick to fit into the PlumbBob object was merely functional or utilitarian. The Ninth Circuit instructed that although the mere feature of having a USB flash drive that can be removed from the PlumbBob object is not copyrightable, the "cut-away" design of the USB flash drive may be.

The Ninth Circuit also found that there was a genuine issue of material fact as to whether Direct's derivative work was sufficiently original to warrant copyright protection. However, the Ninth Circuit warned that to the extent the scope of Direct's design was found to be original by the jury, the copyright would be limited to its unique contribution, i.e. "the artistic manner in which it designed the USB flash drive to fit into the PlumbBob object."

This decision encourages companies to be diligent in identifying potentially copyrightable derivative works. Though a USB thumb drive itself is functional, there may be non-functional attributes that are sufficiently original to qualify for copyright protection. Careful consideration of this issue by copyright holders may prevent disputes with business partners who are granted permission to use protected designs. Indeed, in this case, Direct submitted evidence to show that it considered at least four other designs that had different aesthetic characteristics, all of which are potentially copyrightable as original derivative works.