

## **So You Want to Be a Guitar Hero**

Activision v. Gibson: A rockin' patent battle.

By Christopher Daley-Watson

**CONSIDER THIS SCENARIO:** An in-house counsel at a progressive guitar company gets an employee e-mail about a new idea—a device that allows budding musicians to play guitars while watching a concert video and that replaces a prerecorded guitar track with the potential customers' rocking riffs. In other words, karaoke for guitar. This idea could lead to a whole new product line as well as help sell more guitars. The idea is patented, but unfortunately the product never takes off.

Fast forward several years: A game designer develops a popular video game in which players use a guitar-like controller to insert their "guitar playing" into an animated video. The guitar company believes that this game infringes its patent and that it is entitled to patent royalties, but the video game manufacturer disagrees, and a lawsuit commences. Following months of expensive litigation, the judge grants the video game manufacturer's motion for summary judgment of noninfringement.

This summary roughly describes what happened in *Activision Publishing, Inc. v. Gibson Guitar Corp.* (2009), where Gibson's patent for a simulated guitar experience was asserted against Activision's *Guitar Hero* video game.

The real-life Gibson scenario began in 2006 when the guitar company licensed Activision to use its trademarks in connection with *Guitar Hero*'s "custom guitar-controller peripheral" for a one-time licensing fee. This license only applied to Gibson's trademarks, notably the design of its legendary guitars. The license allowed the video game maker to use trademarked Gibson guitars in the video game and in the design of the controllers for the game but did not extend to Gibson's patents. In January 2008 Gibson claimed that Activision infringed its patent for simulated musical performances. When filing the lawsuit, Gibson differentiated between its license with Activision, which only covered trademarks, and the alleged patent infringement, which Gibson argued Activision violated with *Guitar Hero*.

Activision defended its now wildly popular game series, and in February 2009 Judge Mariana Pfaelzer granted Activision's motion for summary judgment of noninfringement, finding that "no reasonable person of ordinary skill in the relevant arts would interpret [Gibson's patent] as covering interactive video games." The primary concern in this case was whether Activision's *Guitar Hero* violated Gibson's earlier patent concerning simulated musical performances. The judge decided that the game did not infringe, because Gibson's patent was too narrow and did not cover interactive video games.

This case highlights important lessons for corporate counsel handling patent issues. There are four essential best practices that corporate counsel can utilize to avoid an outcome similar to the Gibson result. Through these recommendations we will discover, as Gibson did too late, that the broadest possible patents offer the most protection for companies and their products.

First, corporate counsel should ensure that the patent includes numerous claims that capture the invention from different angles. Gibson's patent should have included various types of claims, including so-called means-plus-function claims, which simply recite the means (e.g., "means for generating an electrical signal"), rather than recite the specific device ("a musical instrument") to generate the signal. Instead, all claims in Gibson's patent included specific terms, such as "musical instrument," which the court interpreted narrowly. In her order, the judge restricted the term "musical instrument" to be something that: (1) is capable of making musical sounds and (2) produces an instrument audio signal representing those sounds. As the court later found in this

case, an electric guitar produces an audio output signal, while the Guitar Hero controller simply produces a computer signal that does not represent any musical sounds that the controller could make.

Second, corporate counsel should ensure that the patent claims directly cover a single infringer, without the need to omit any language in the claim. Gibson's patent did not accomplish this.

In-house attorneys need to work closely with inventors and patent counsel to ensure the claims omit superfluous language that a potential infringer could use as a loophole, and ensure that the claims cover the entire supply chain, from manufacturing of key components, to assembly of the system, to any foreseeable uses.

Rather than arguing literal infringement, Gibson was forced to fall back on a secondary theory of patent infringement: the "doctrine of equivalents." This doctrine of equivalents prohibits an infringer from making an insubstantial change to avoid literal patent infringement. Gibson tried to stretch its patent claims under this doctrine and argued that Guitar Hero's differences over Gibson's patent were insubstantial. Unfortunately for Gibson, the doctrine of equivalents has a low success rate. Worse still, the company could not remedy the failings in its original patent wording. Its broad reading of the patent "border[ed] on the frivolous," according to the judge, and covered even "a DVD remote."

A third best practice to derive from the Guitar Hero case: The patent should describe the invention and its alternatives, rather than provide details of prior systems. Gibson's U.S. Patent No. 5,990,405 described some similar products, including another company's virtual reality music system, and the benefits of Gibson's system over this earlier system. Gibson's patent also provided statements distinguishing between the prior system and its invention—but the judge used those statements to find that Activision's Guitar Hero game did not infringe Gibson's patent. Gibson did not need to provide the history lesson of prior systems and their shortcomings. Further, Gibson's patent described very few foreseeable alternate implementations, and notably, it made no mention of using the new interface in a game.

A final and possibly most important lesson that corporate counsel can learn from the Gibson case is to draft a broad-reaching patent that distinguishes its new system from past systems, covers the company's new product, and also covers any foreseeable future advances. Gibson's lack of a broad patent was one of its critical errors. While more costly than simply drafting a narrowly focused patent, taking the time to strategize with a creative patent lawyer and the inventors can help expand patent protection and lead to a broad patent that covers future developments. Gibson's patent could have included additional claims covering the process of substituting a player's musical input signal into a prerecorded video. Predicting the future is difficult, and thus it is easy to now say what Gibson should have done, but a broader patent would have offered more protection. Gibson did not develop as broad a patent as it could have, which may well have cost it a good deal of money on what might otherwise have been a profitable patent.

Overall, careful patent drafting with a creative patent attorney can overcome the type of problems Gibson faced. If you want to be a rock star to your clients, show them you know the score.

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