

Plaintiff in Gridiron Battle Over Place of Expert Testimony in Software Copyright Claim Requests Supreme Court to Be Referee

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by Brad Hattenbach



The software engineer who first coded the popular “John Madden Football” (now Madden NFL) computer video game has asked the U.S. Supreme Court to allow expert witness testimony to support his software copyright claim, over 25 years after the original work was completed and published. This lengthy stoppage in play resulted in

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a problem of proof for the petitioner, at least according to the trial court and the 9th Circuit Court of Appeals—apparently neither party still has a copy of the original source code for the software in question.

Petitioner Robin Antonick developed the John Madden Football game for the Apple II computer in 1988 under a contract with Electronic Arts, Inc. (EA). It was released to popular success and present versions of Madden NFL are still huge sellers. Antonick began coding versions of the game for Commodore 64, IMB, Sega, and Nintendo

platforms soon after the Apple II release. However, in 1990 EA hired another firm to code versions of the game for Nintendo and Sega Genesis systems and terminated Antonick's contract. Antonick alleges that he is due royalties on sales of these later versions of the Madden game, sold between 1992 and 1996, pursuant to his contract with EA. Antonick was originally told that the firm EA hired had started from scratch. However, he later came to believe that EA actually used his original code as the playbook for the early 90's Nintendo/Sega versions and filed suit in 2011.

(As part of the trial, it was determined that the statute of limitations did not bar the claims and this finding was not challenged on appeal.)

In his petition, Antonick alleges the contract provided for royalties from the sale of any derivative work. The U.S. Copyright Act defines a "derivative work" as:

a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represent an original work of authorship, is a 'derivative work'." 17 U.S.C. § 101.

Antonick argues that EA used his original Apple II work as the basis for the early '90s Nintendo and Sega works. He bases this claim solely on the testimony of an expert witness. As the 9th Circuit noted in its opinion, "Neither the source code for Apple II Madden...nor the source code of any allegedly infringing works were introduced into evidence. Nor were images of the games at issue introduced." Apparently, only a partial draft version of the Apple II Madden code was found and decompiling code from the different versions of the games does not render the source code as it was originally written.

Without the ability to actually compare code, Antonick's expert testified as to substantial similarities between the Apple II and Nintendo/Sega versions that suggested copying. These similarities included formations, plays, play numberings, player ratings, field design, variable names, and identical misspellings in variable names. The expert also compared the portions of binary code found for the Apple II version with sections of assembly code found for the first Sega version. The jury found this to be adequate proof of copying to create a derivative work and found in favor of Antonick. The trial court then threw a penalty flag on the play.

EA moved for a verdict as a matter of law asserting there was insufficient evidence for the jury to have reached its conclusion. The trial court agreed, basing its decision on 9th Circuit precedent in Krofft vs. McDonald's, a case in which the creators of the H.R. Pufnstuf television characters alleged copyright infringement by McDonald's "McDonaldland" commercial characters, particularly "Mayor McCheese". In that case, the 9th Circuit found that it was improper to introduce expert testimony to prove

infringement under the second prong of its two part test, *i.e.*, whether any copying rises to the level of an “unlawful appropriation”. The court characterizes this as an “intrinsic” test and has held that judgment must be made by an ordinary lay observer without expert guidance.

Antonick argues that the 9th Circuit test is out of date, or at least inapplicable when it comes to determining copying of software code. He argues that it is likely crucial to have an expert witness in a software case, as lay witnesses would be unable to determine whether two versions of software code are similar. He analogizes the argument to translation of a novel into a different language—clearly the translation is a derivative work, but unless the lay person is fluent in both languages, they would be unable to determine whether there is substantial similarity between two works without assistance from a language expert. Software copying is no different. In support, he cites cases from the 4th Circuit that allow expert testimony in software cases to prove infringement because, as one court noted in *Dawson v. Hinshaw Music Inc.*, 905 F.2d. 731, 737 (4th Cir. 1990):

Only a reckless indifference to common sense would lead a court to embrace a doctrine that requires a copyright case to turn on the opinion of someone who is ignorant of the relevant differences and similarities between the two works.

Antonick argues that the difference in treatment of software cases among the circuits compels the Supreme Court to come onto the field of play to referee the rest of this match.

An interesting side note is that David Nimmer, a law professor who writes arguably the most respected legal treatise on U.S. copyright law, is quarterbacking the Supreme Court appeal for Antonick, while the 9th Circuit quoted his treatise in support of its decision. Nimmer’s father, Melville Nimmer, the original author of the treatise, argued on behalf of H.R. Pufnstuf in 1977 and lost the argument for acceptance of expert testimony. Perhaps his son will win in this contest and vindicate the earlier loss.