

No. 17-____

IN THE
Supreme Court of the United States

ROBIN ANTONICK,
Petitioner,

v.

ELECTRONIC ARTS INC.,
Respondent.

**On Petition for Writ of Certiorari to the
United States Court of Appeals
for the Ninth Circuit**

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

In a copyright dispute stemming from the path-breaking *John Madden Football* video games, this petition raises two important issues. The Ninth Circuit opinion deepens a circuit split on whether expert witnesses may aid juries in understanding computer programs, and creates a new evidentiary rule at odds with the Copyright Act:

1. To determine infringement between original and allegedly infringing works of computer code, is it sufficient that the jury, assisted by expert testimony, finds the copyrightable elements to be substantially similar? Conversely, as the Ninth Circuit held, is expert testimony prohibited simply because juries assess infringement from the perspective of the “ordinary reasonable person”? App. 8a-9a & n.4.

2. In a case involving computer code where access to the original work is conceded, other reliable proof demonstrates the content, and the defendant does not object under the Federal Rules of Evidence, can the factfinder determine that copying took place? Conversely, as the Ninth Circuit held, does the Copyright Act mandate that the original and infringing works be in evidence at trial? App. 6a-10a.

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PETITION FOR WRIT OF CERTIORARI

This case presents a clear legal error by the Ninth Circuit that directly conflicts with the well-reasoned law of every other circuit that has addressed the role of expert testimony in computer software copyright cases. The panel reaffirmed and applied an anachronistic bar on expert testimony—originating in *Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977)—which prohibits experts from assisting juries in copyright disputes involving highly technical works. The panel decision acknowledged the circuit split as well as the illogic of the Ninth Circuit rule.

Further, the Ninth Circuit adopted a second inflexible rule, with no textual basis in the Copyright Act and contrary to the record, that the jury could not have found infringement without the original and infringing works in evidence at trial.

This petition presents an opportunity to clarify a muddled area of law: the proper standards for determining infringement of computer software. It involves a crucial technology industry, much of which is based in the Ninth Circuit. This case is a good vehicle to address the issues given the proceedings below. By denying en banc review, the Ninth Circuit made plain that its *Krofft* prohibition will control in all cases despite being out of step and out of date—until this Court instructs otherwise.

This dispute, like other cases involving computer software code and highly technical subject matter, required an expert translator—someone who could explain the meaning of hexadecimal code, computer language, computing terms, and software “behavior” to lay jurors. Nonetheless, relying on the Ninth

Circuit's *Krofft* precedent relating to similarities between imaginatively decorated costumed characters from a children's television series (H.R. Pufnstuf) and McDonaldland characters, the district court ruled that it was improper to permit an expert witness to explain software code to a jury.

This case could not be more different from *Krofft* in *the* critical consideration: Whereas lay jurors can readily assess the similarities between costumed characters such as Wilhelmina W. Witchiepoo and Mayor McCheese, they are ill-prepared to assess similarities and differences between hexadecimal lines of computer source code written in different assembly code languages.

Wooden reliance on the Pufnstuf/McDonaldland precedent for a software copyright case makes a mockery of logic and turns software copyright cases into a coin flip. As all other circuits to address the application of copyright infringement analysis to software code cases have wisely recognized, it makes no sense to adjudicate substantial similarity of technical works without providing jurors with the capacity to comprehend the subject matter at issue. As the Second Circuit explained in *Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992), the ordinary observer standard "may well have served its purpose when the material under scrutiny was limited to art forms readily comprehensible and generally familiar to the average lay person." *Id.* at 713. But as to computer programs, district courts must have "discretion . . . to decide to what extent, if any, expert opinion, regarding the highly technical nature of computer programs, is warranted in a given case." *Id.*

The questions presented for review are accordingly straightforward.

First, may an expert witness assist a jury in comprehending technically complex expressive works—computer programs are just one illustration—that are beyond the knowledge of laypeople? Historically, federal courts have been disinclined to allow expert testimony on familiar forms of expression that were, until the past few decades, usually not technical. The plagiarizing of many consumer goods, for example, can be determined without specialized knowledge. The legally mandated perspective was thus that of a lay audience without a need for expertise.

As other circuits following *Altai* have recognized, juries may otherwise be at sea in copyright disputes over computer programs. A qualified expert can translate the material into lay terms and provide an anchor for comprehension. The *Altai/Antonick* split is of national significance and ripe for resolution.

Second, does the Copyright Act impose the strict evidentiary rule applied by the Ninth Circuit? By mandating that the original and allegedly infringing works be in evidence to render an infringement claim viable, the court of appeals engrafted a nonexistent proof prerequisite to the statute. The panel's holding undercuts the Copyright Act's very protections. Among them, a work may be protected by copyright even if it exists only for "more than transitory duration." 17 U.S.C. § 101. The panel assumed an evidentiary permanency unnecessary for an infringement claim.

The Ninth Circuit also misapprehended the nature of a copyright. One exists, and enjoys legal protection, apart from whether the work itself still exists or how infringement is proved. The panel erroneously conflated these distinct concepts.

Factually, this case illustrates why the Ninth Circuit's wooden rules are unsound. It involves computer code underlying the popular videogame *John Madden Football*. The jury was instructed as to the elements of the original work found copyrightable: the plays and design of the virtual playing field. The computer software program implementing these choices were written in highly technical computer languages specific to different computer processors. Aided by expert testimony, the jury found that the expression of plays in the allegedly infringing works was substantially similar to those in the original work. Expert assistance played just the role it should. It helped jurors understand works of computer code written in different programming languages that, otherwise, would have been indecipherable to laypeople. The entirety of the code, comprehensible only to computer programmers trained in the particular assembly code languages used, would not have added materially to the evidence.

The jury verdict should have ended the case. The Court should grant certiorari to hold that this was an appropriate use of expert testimony and that further evidence of the respective works was unnecessary.

OPINIONS BELOW

The Ninth Circuit opinion is reported at 841 F.3d 1062 and reproduced at App. 1a-13a. The district court order is available at 2014 WL 245018 and reproduced at App. 15a-46a.

JURISDICTION

The Ninth Circuit issued its published decision on November 22, 2016. App. 1a. Rehearing en banc was denied on March 16, 2017. App. 14a. On June 7, 2017, Justice Kennedy granted a 30-day extension of time to

petition for certiorari and, on July 14, 2017, he granted an additional 14-day extension of time. *Antonick v. Electronic Arts, Inc.*, No. 16A1197. This Court accordingly has jurisdiction under 28 U.S.C. §1254(1).

LEGAL PROVISIONS INVOLVED

Relevant constitutional and statutory provisions are reproduced at App. 47a-49a.

STATEMENT OF THE CASE

Unless otherwise specified, this background section is taken from the opinions below. It is supplemented from the record as “material to consideration of the questions presented.” S. Ct. R. 14(g).

A. Antonick Developed John Madden Football And Protected His Creation Through Copyright Law In His Contract

Petitioner Robin Antonick is a computer programmer whose technical creativity laid the foundation for the legendary football video game series named after for famed coach and broadcaster John Madden.¹

Antonick developed the computer source code for the original *John Madden Football* video game, which was implemented on the Apple II computer (“Apple II Madden”). Antonick’s game took the video game genre from primitive abstract games with few players and simple actions to sophisticated simulation of multi-

¹ As Forbes magazine described this litigation: “You may not have heard of Robin Antonick, but he’s the man who spawned one of the most prolific video game series in history.” Paul Tassi, *EA Must Pay Original Madden Programmer \$11M In Damages*, FORBES (July 24, 2013), <https://www.forbes.com/sites/insertcoin/2013/07/24/ea-must-pay-original-madden-programmer-11m-in-damages/#2860f16e4c32> (last visited July 25, 2017).

faceted, 11 on 11 football action integrating player data, complex strategies, and user manipulation of player controls.

In 1988, respondent Electronic Arts Inc. (“EA”) released Apple II Madden to meteoric success. It quickly became the bestselling sports video game in history.

On the heels of this acclaim, Antonick programmed Madden games for other computer platforms, the Commodore 64 and IBM-compatible computers. In 1989, he began work on Madden games for the Nintendo and Sega Genesis entertainment systems. In August 1990, however, EA informed Antonick that it had contracted with another company, Park Place Productions (“Park Place”) to complete the Sega Genesis game.

Just three months later—barely in time for the holiday shopping season—EA released its first version of Sega Madden. Each year from 1992 to 1996, EA issued Madden games for Sega Genesis and Super Nintendo (“Super Nintendo Madden”).

Copyright law is implicated due to Antonick’s contract with EA. Their agreement defined the copyrighted “Work” as the first game that Antonick designed for EA: a “custom computer software program known as John Madden Football” for the “Apple [II] Family of Computers.” There was no dispute that Antonick had copyright rights in Apple II Madden.

Importantly for this petition, the contract further provided that Antonick would receive royalties on any “Derivative Work.” This was defined as “any computer software program or electronic game which . . . constitutes a derivative work of the Work” —Apple II

Madden—“within the meaning of the United States copyright law.”

But Antonick received no royalties for sales of either Sega Madden or Super Nintendo Madden. When EA hired Park Place, EA advised Antonick that Sega Madden would be developed independently and, as Antonick testified at trial, Sega Madden would not be “using my intellectual property.”² Hence, for royalty purposes, EA did not treat Sega Madden as a Derivative Work of Apple II Madden.

B. Antonick Sued For Unpaid Royalties And Prevailed In A Jury Trial

In 2011, Antonick filed a diversity action against EA for breach of contract in the United States District Court for the Northern District of California. The complaint sought damages for unpaid royalties for the allegedly Derivative Works—Sega Madden and Super Nintendo Madden.

After Antonick defeated several dispositive motions, the district court bifurcated the trial. In Phase I, the jury determined that the statute of limitations did not bar Antonick’s claims. Phase II determined the merits.

The questions presented here arise out of Phase II. The jury had to decide whether Antonick proved, in copyright parlance, substantial similarity. Under the Ninth Circuit’s formulation, Antonick had to prove substantial similarities between Sega Madden and

² Dkt. 11-5 at ER 773. “Dkt.” refers to the record in Ninth Circuit No. 14-15298. Although the opinion was not entirely faithful to the principle, *e.g.*, App. 8a-10a, the record is viewed most favorably to Antonick. *Reeves v. Sanderson Plumbing Prod., Inc.*, 530 U.S. 133, 150 (2000).

Apple II Madden with respect to the expression in source code for two game elements that the district court found copyrightable: (1) field width; or (2) plays and formations. Then, for any Sega Madden game for which the jury found substantial similarities, the jury had to decide whether Antonick proved that the particular Sega Madden game, when considering the two as a whole, was virtually identical to Apple II Madden.³

To prove his claims on the merits, Antonick presented percipient witness testimony and other evidence that Place Park, with EA's assistance, used Antonick's code and design from Apple II Madden to meet the imminent deadline for the release of Sega Madden in time for the crucial holiday season. The jury also heard testimony from a software expert about software development, coding, comparing codes for different processors, and similarities in the software.

The evidence at trial demonstrated that a highly creative and original effort was required to develop plays—meaning the copyrightable expression—that would create a fun and balanced game within the computing limitations of the day. EA's founder and CEO, Trip Hawkins, testified that “you can make an infinite number of football plays,” and there was a “whole lot of organizing and refinement and editing to come up with a good scheme” in the original Madden game.⁴ Antonick similarly testified that in developing

³ “Virtual identity” is another term of art in copyright law. Although Antonick disagreed with the ruling, the district court concluded that his work for Apple II Madden was entitled to only thin copyright protection. On this premise, Antonick had to prove, and did, that the original and infringing works were virtually identical instead of just substantially similar. App. 8a n.3.

⁴ Dkt. 11-2 at ER 150.

Apple II Madden, he created and discarded “hundreds” and “[p]erhaps even thousands” of plays as he refined the game.⁵

EA employee Michael Kawahara also testified regarding the conditions under which the first Madden game was created. As he stated, “I don’t think we even came close to reaching the limit” to “the number of plays” that could be created from the principles and “skeleton plays” outlined in John Madden’s “playbook” and, further, that there was “no” overlap of plays in Apple II Madden and another company’s football simulation game on which he had previously worked.⁶

To help the jury understand the original and allegedly infringing works of computer code, Antonick drew upon expert witness Michael Barr. His qualifications and expertise were unchallenged. As Barr explained, the computer programs for the two games were written for different processors using different assembly languages. With respect to the plays, Barr explained that memory limitations of the Apple II computer forced Antonick to express the plays in binary code data files, consisting of ones and zeros that could not be decompiled into more readable program language.⁷ Only the formations—meaning the initial starting positions for the avatars—were stored in the source code.⁸ By contrast, in the allegedly infringing versions,

⁵ Dkt. 11-5 at ER 742-43, 825.

⁶ *Id.* at ER 816-17; *cf.* App.8a-9a (Ninth Circuit discussing Kawahara’s testimony).

⁷ Dkt. 11-5 at ER 925-26; Dkt. 29-3 at SER 776, 781-82.

⁸ Dkt. 11-5 at ER 922-25.

both the formations and the subsequent avatar movements were stored in the source code.⁹

To take one example of what could have confused the jury without an expert translator, this is an excerpt of Antonick's computer code (binary and source) written for the Apple II Madden game:¹⁰

```

;      0  1  2  3  4  5  6  7  8  9  10
BACKSTX DB $81,$75,$8D,$69,$99,$81,$81,$99,$A5,$39,
BACKSTY DB $7E,$80,$80,$80,$80,$81,$89,$89,$80,$80,
BACKSTP DB 14. 16. 15. 20. 19. 00. 02. 04. 11. 08.

```

The expert testimony included examination of Antonick's code in contrast to EA's source code, written in a different assembly language, for the first Sega Madden in 1990:¹¹

```

dc 160,-16 ;rwr
dc.b 5,16 ;in
dc 48,-56,16 ;hb
dc 0,-56,16 ;fb
dc 90,-12,23 ;te
dc -60,-12,23
dc -30,-12,16
dc 0,-08,16
dc 30,-12,17
dc 60,-12,16

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Although EA opposed en banc review to bring the Ninth Circuit into line with other circuit courts, EA did not contend that a lay jury could understand,

⁹ *Id.* at ER 924.

¹⁰ Dkt. 11-2 at ER 40.

¹¹ *Id.* at ER 41.

without expert assistance, what these numbers and letters mean or how they interrelate to convey commands to a computer. Antonick's expert witness Barr elaborated for the jury, which chose to credit him, why these two sets of code generated "effectively the same play."¹²

More broadly, Barr identified "multiple bases" for concluding that "the Sega Genesis game relied on the source code from the Antonick game."¹³

By explaining Antonick's original drafts of source code, data files, and design documents for Apple II Madden, and comparing those with source code for Sega Madden games, Barr was able to illustrate numerous similarities to the jury. The uncanny parallels included selection and expression of plays and formations, ordering and numbering of plays, player ratings, nonstandard and disproportionate field width, names of plays and variables, and misspellings that could not have occurred absent copying.¹⁴

In Phase II of the bifurcated trial, the jury determined liability by answering two questions on a verdict form. In response to Question 1, the jury found that Antonick proved substantial similarities between the expression of the source code for plays and formations. In response to Question 2, the jury found that each of the seven Sega Madden games at issue was virtually identical to Antonick's version.

By its verdict, the jury accordingly determined that the Sega Madden games are Derivative Works under

¹² Dkt. 47-3 at ER 180.

¹³ Dkt. 11-5 at ER 932.

¹⁴ Dkt. 11-5 at ER 910-17, 931-42, 946-47, 963.

Antonick's contract. By failing to pay him royalties, EA had breached and owed him damages.¹⁵

C. Nullifying The Jury Verdict, The District Court Relied On Ninth Circuit Law Barring Expert Testimony On Copyright Similarity

Having faltered before the jury, EA moved for judgment as a matter of law. Because the Ninth Circuit largely adopted the district court's order, a summary of the trial court ruling is helpful.

The district court denied EA's motion as to Phase I on the ground that a reasonable jury could have found Antonick's claims were timely. Until 2009, Antonick did not know that the first Sega Madden was *not* developed independently as EA had claimed at the time. Moreover, only in 2009 did Antonick learn of "the acknowledgment by EA" that its Madden video game series, to the contrary, "began with his game." App. 24a. He further learned that Park Place had access to his design and code for Apple II Madden.¹⁶

As regards Phase II, the district court acknowledged the jury findings that for each version of Sega Madden at issue—seven between 1990 and 1996—Antonick proved substantial similarities with respect to his computer source code for "plays and formations." App. 26a & n.5. Nonetheless, the district court ruled that Antonick could not present expert testimony as part of his proof of infringement: "Question 2 [of the verdict form] required the jury to compare 'the works to determine whether, as a whole, they are sufficiently similar to support a finding of illicit copying.'" App. 27a (citation omitted).

¹⁵ Dkt. 11-3 at ER 321-23 (completed verdict form).

¹⁶ Dkt. 11-5 at ER 758-60, 772-77; Dkt. 47-3 at FER 53-54.

The Ninth Circuit calls this second step the “intrinsic test.” *Id.* This test “examines an ordinary person’s subjective impressions of the similarities between two works” and is “exclusively the province of the jury” without assistance from expert witnesses. *Id.* (citation omitted).

The district court acknowledged that in answering Question 2, the “jury found all seven versions of Sega Madden at issue virtually identical to Apple II Madden” under the intrinsic test. App. 28a. Nonetheless, the district court ruled that there was “no legally sufficient basis for the jury’s verdict that any of the Sega Madden games as a whole are virtually identical to Apple II Madden as a whole,” App. 29a, because the jury heard expert testimony.

Following Ninth Circuit law, the order explained that “expert testimony is not admissible evidence of similarity for purposes of the intrinsic test.” App. 33a. Barr’s opinion, although credited by the jury, did not suffice to prove virtual identity of Sega Madden and Apple II Madden. The jury was forbidden from considering Barr’s testimony to determine whether Antonick satisfied the intrinsic test (Question 2 of the Phase II verdict form) for copyright infringement.

According to the district court, without the computer source code itself in evidence, there was inadequate proof: “Barr’s opinion that all seven Sega Madden games are ‘essentially the same’ as a whole cannot substitute for the jury’s subjective comparison of each of the seven Sega Madden games as a whole to Apple II Madden as a whole.” App. 34a.

D. Perpetuating Its Prohibition On Expert Testimony To Computer Programs, The Ninth Circuit Affirmed

Upholding the district court’s rationale in a published opinion, the court of appeals made two points relevant to this petition.

First, the Ninth Circuit addressed its intrinsic test precluding expert testimony. The panel was bound by precedent—announced well before personal computers became ubiquitous—that “expert testimony cannot satisfy a plaintiff’s burden of proof under the intrinsic test, which ‘depend[s] on the response of the ordinary reasonable person.’” App. 8a-9a. But the panel took no pleasure in adhering to *Krofft*.

At oral argument, the authoring circuit judge called *Krofft*’s categorical prohibition a “nutty rule.”¹⁷ The panel acknowledged that other circuits, and even judges within the Ninth Circuit, had recognized the value of expert assistance to juries comparing computer software. “Antonick is not alone,” the opinion noted, “in contending that experts should be allowed to help juries assess the holistic similarity of technical works such as computer programs.” App. 9a n.4 (citing decisions discussed below).

With its hands tied, the panel suggested en banc review. “[G]iven our precedents,” the opinion stated, Antonick’s argument regarding expert testimony “must be addressed to an en banc court.” *Id.* Denying his rehearing petition, however, the full Ninth Circuit

¹⁷ *Antonick v. Electronic Arts, Inc.*, 9th Cir. No. 14-15298 (Mar. 16, 2016) (oral argument video), http://www.ca9.uscourts.gov/media/view_video.php?pk_vid=0000009278 (last visited July 25, 2017). The comment was made during the 26th minute of the hearing.

declined to take up the role of expert testimony in computer program cases. App. 14a.¹⁸

Second, in contrast to the district court, the panel acknowledged a point assumed as foundational at trial. To prove the works' embodiment and duration, 17 U.S.C. §§ 101 & 102(a), the parties proceeded with the available evidence of what Antonick had created. During discovery, neither Antonick nor EA was able to produce a complete and final version of the Apple II Madden source code.¹⁹ Antonick did, however, introduce an "as-sold" packaged version of the game into evidence that contained the data files associated with the plays.²⁰ For its part, EA played for the jury a video of Sega Madden but not a video of Apple II Madden.

Although acknowledging that limited evidence of the works was not Antonick's fault, the Ninth Circuit deemed this evidentiary record decisive. As distilled in the opinion's first paragraph, Antonick's claims "failed as a matter of law" because the computer code for both the original and allegedly infringing works was absent. App. 3a.

In addition to the expert issue, Antonick's en banc petition raised the evidentiary issue.²¹ By denying further review, the Ninth Circuit declined to reevaluate its precedent on both questions presented.

¹⁸ Dkt. 77-1 at 9-17.

¹⁹ Dkt. 47-3 at FER 67-70.

²⁰ Dkt. 11-4 at ER 551-52 (Apple II Madden game exhibit); Dkt. 29-1 at SER 70 (exhibit list showing admission into evidence); Dkt. 13 at 1 (Antonick's motion to transmit from district court because this exhibit was "highly relevant to the issues on appeal"); Dkt. 61 (order granting motion).

²¹ Dkt. No. 77-1 at 17-20.

REASONS FOR GRANTING THE PETITION**I. THIS COURT SHOULD RESOLVE A SHARP
CIRCUIT SPLIT ON WHETHER EXPERTS
MAY ASSIST JURIES IN UNDERSTAND-
ING COMPUTER PROGRAMS IN COPY-
RIGHT ACTIONS**

This Court has never addressed *how* copyright infringement may be proved. Likewise, the Court has given only general instruction on the substantive prerequisites: “To establish infringement, two elements must be proven: (1) ownership of a valid copyright, and (2) copying of constituent elements of the work that are original.” *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340, 361 (1991). Judicial guidance is essential because Congress left the contours of infringement to decisional law. Neither the Copyright Act of 1976, the last major revamp, nor its predecessor included “an explicit definition of infringement.” *Teleprompter Corp. v. Columbia Broad. Sys., Inc.*, 415 U.S. 394, 398 n.2 (1974).

The wellspring for the infringement inquiry is widely regarded to be *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946). But this Court has never commented on *Arnstein*’s framework, discussed below, for parsing copyright infringement claims. In the seven decades since *Arnstein*, the two preeminent circuits for digital innovation have sharply divided on the legal standards for determining copyright infringement for computer software works. This case puts front and center the *Altai/Antonick* circuit split on whether experts may aid juries evaluating computer programs in copyright suits. The Second Circuit (joined by others) says yes; the Ninth Circuit alone, as this case demonstrates, says no.

The time is ripe for this Court to resolve this fundamental split over the appropriateness of permitting expert testimony regarding highly technical subject matters that are beyond the ken of lay juries.

A. The Ninth Circuit Has Diverged From The Well-Reasoned Approach Of All Circuits That Have Addressed The Use of Expert Witnesses In Software Copyright Cases

National infringement standards have their genesis in the Second Circuit's *Arnstein* opinion. That case set forth a two-part test focused on what became known as "illicit" copying. App. 27a, 34a n.10, 39a (district court's order). As formulated then, the plaintiff had to prove "(a) that defendant copied from plaintiff's copyrighted work and (b) that the copying (assuming it to be proved) went too far as to constitute improper appropriation." *Arnstein*, 154 F.2d at 468.

The first prong allowed expert testimony. "On this issue, analysis ('dissection') is relevant, and the testimony of experts may be received to aid the trier of the facts." *Id.* The second prong required proof of "illicit copying (unlawful appropriation)." *Id.* Judge Jerome Frank declared that "the test is the response of the ordinary lay hearer; accordingly, on that issue, 'dissection' and expert testimony are irrelevant." *Id.*

With this Court neither approving nor disapproving of Judge Frank's majority opinion, many circuits have cited *Arnstein* to varying ends.

In 1977, the Ninth Circuit drew heavily upon *Arnstein*'s two-part framework and appended new labels. The plaintiff must first show substantial similarity under an "extrinsic test." *Krofft*, 562 F.2d at

1164. The plaintiff must then show substantial similarity under an “intrinsic test” akin to *Arnstein*’s second prong focused on a lay audience. As the panel reiterated in this case, App. 6a, 8a & n.4, *Krofft* holds that expert testimony is “not appropriate” on the latter. 562 F.2d at 1164.

Given California’s prominent and growing role in the entertainment industries, *Krofft* was a significant development in copyright law. The Ninth Circuit was the first to use the “extrinsic” and “intrinsic” terminology to describe the infringement inquiry. While some circuits have followed this general formulation, see *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 734 (4th Cir. 1990); *Hartman v. Hallmark Cards, Inc.*, 833 F.2d 117, 120 (8th Cir. 1987), they have not endorsed *Krofft*’s prohibition on the use of expert witnesses to assist juries in applying the intrinsic inquiry in computer software cases.

Notably, the Fourth Circuit expressly diverged from the *Krofft* approach with regard to the admissibility of expert testimony on the intrinsic inquiry in computer software cases. *Dawson*, 905 F.2d. at 735. Modifying the intrinsic prong, the Fourth Circuit shifted from *Arnstein*’s perspective of the “ordinary observer” to the “intended audience.” *Id.* at 737. The court emphasized that “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 two works.” *Id.* Holding that witnesses with “expertise” could testify, the Fourth Circuit explained that the infringement inquiry “should be informed by people who are familiar with the media at issue.” *Id.*

Most circuits and commentators have warmly embraced the *Altai* decision. See *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1543-45 (11th Cir. 1996); *Gates Rubber v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834-42 (10th Cir. 1993); Mark A. Lemley, *Convergence in the Law of Software Copyright?*, 10 High Tech. L.J. 1 (1995); David Bender, *Computer Associates v. Altai: Rationality Prevails*, 9 The Computer Lawyer 1 (Aug. 1992). Most importantly, other circuits have followed the Second Circuit's approval of the use of expert testimony to explain similarities in technical works. The legal landscape is now clearly divided due to the Ninth Circuit's *Antonick* decision.

Some circuits have questioned whether two prongs—one allowing expert testimony, the other not—are necessary or even desirable. See, e.g., *Atari, Inc. v. N. Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982). Although discredited for other reasons, see *Altai*, 982 F.2d at 705-07, the Third Circuit's software jurisprudence wisely recognized the need for expert witnesses in software copyright cases three decades ago. *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222-23 (3d Cir. 1986) (relying on Federal Rule of Evidence 702 to permit expert testimony where it will be useful to a trier of fact); see also *Williams Elec. v. Arctic Int'l, Inc.*, 685 F.2d 870 (3d Cir. 1982) (applying single-prong inquiry without citing *Arnstein*).

The Sixth Circuit has weighed in to like effect. See *Kohus v. Mariol*, 328 F.3d 848, 857 (6th Cir. 2003) (“Expert testimony will usually be necessary to educate the trier of fact in those elements for which the specialist will look.”).

In sum, the Ninth Circuit has markedly diverged from all other circuits on the use of expert witnesses

in software copyright cases. As this case exemplifies, the Ninth Circuit's *Antonick* decision has fortified its anachronistic extension of the wooden *Krofft* test to computer software cases in direct contradiction of the sound approach followed by all other circuits to confront software infringement cases. This circuit split will create greater problems for the software industry and the courts as computer software in modern life becomes ever more omnipresent.

Although this disconnect between the circuits alone warrants certiorari, there is an even more compelling reason to grant this petition. The same court that issued *Arnstein* relaxed its prohibition on expert testimony for cases involving computer programs. The Ninth Circuit's refusal to do so in this case has made the circuit split that began 25 years ago too sharp to ignore.

B. Expert Testimony Should Be Permitted To Aid Juries Determining Infringement In Computer Program Disputes

In its landmark opinion in *Altai*, the Second Circuit addressed at length copyright infringement standards for computer programs. Allowing juries to consider expert testimony in such cases, the court explained that *Arnstein*'s ordinary observer standard "may well have served its purpose when the material under scrutiny was limited to art forms readily comprehensible and generally familiar to the average lay person." *Altai*, 982 F.2d at 713. As to computer programs, however, the court invoked "Holmes' admonition that, '[t]he life of the law has not been logic: it has been experience.'" *Id.* (citation omitted). The Second Circuit left to "the discretion of the district court to decide to what extent, if any, expert opinion, regarding

the highly technical nature of computer programs, is warranted in a given case.” *Id.*

Altai’s rationale is compelling. “In deciding the limits to which expert opinion may be employed in ascertaining the substantial similarity of computer programs,” the Second Circuit reasoned, “we cannot disregard the highly complicated and technical subject matter at the heart of these claims.” *Id.* “Rather, we recognize the reality that computer programs are likely to be somewhat impenetrable by lay observers . . . and, thus, seem to fall outside the category of works contemplated by those who engineered the *Arnstein* test.” *Id.*

An example illustrates. The Copyright Act expressly grants authors the exclusive right to prepare derivative works, *see* 17 U.S.C § 106(2), which includes “translation[s]” into foreign languages, *see* 17 U.S.C § 101 (definition of “derivative work”). Suppose that someone were to translate J.K. Rowling’s iconic *Harry Potter and the Philosopher’s Stone* into Japanese and the publisher brought a copyright infringement action. Under the Ninth Circuit’s *Krofft* rule, as reinforced by the *Antonick* decision, the plaintiff would not be able to call a bilingual translator to testify about the overlap. Given the dissimilarities of Kanji and English characters, there would be no basis for a jury to assess substantial similarity. Such an absurd result defies the clear text and logic of the Copyright Act.

Similarly, barring computer software translators from aiding the jury in a case involving software programs written in different assembly code languages deprives the copyright owner, or in this case, the author of a computer program whose royalties depend on whether a later developed program is a derivative work, of the protection that Congress clearly

intended. This case provides an ideal vehicle for faithfully applying the clear language and intent behind the Copyright Act and bringing the Ninth Circuit into line with the eminently sound logic of the other circuits that have confronted software copyright cases.

C. Sound Management Of The Burgeoning Arena Of Computer Program Disputes Requires Expert Testimony

Giving district judges discretion on the matter has salutary consequences for copyright litigation.

Experts benefit both sides in a copyright dispute. Among the upsides for the defense, an expert can underscore for the trier of fact which elements of a work are *not* protected by copyright. This determination is for the judge, but is nonetheless a distinction that jurors may accidentally conflate in rendering a verdict. To the same end of fairness and accuracy, the author of a computer program entitled to compensation for derivative works should not be deprived of royalties owed under the Copyright Act.

The *Altai* approach enables the jury to better perform its responsibility. It ensures that members of the public who are not trained in the intricacies of computer software are not bamboozled or overwhelmed by the technical complexity of many computer programs. This fosters greater predictability for parties seeking to gauge how a jury might rule. And allowing expert testimony when jurors compare computer programs generates better-reasoned verdicts. The *Altai* approach enhances public confidence in jury trials—a cornerstone of our legal system.

Unsurprisingly, then, *Altai* has been a watershed decision on evaluating the similarity of computer programs. Other circuits have agreed that expert testimony

under *Altai*'s approach is permissible. *See, e.g., Gates*, 9 F.3d at 834-35; *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 142-43 (5th Cir. 2004).

Modernized legal criteria for computer programs are preferable to the Ninth Circuit's continued focus, as here, on the "total concept and feel of the works." App. 6a. "Concept" is exactly what copyright law does *not* protect: ideas, in contrast to their expression. Asking juries to determine the "feel" of a work, although seemingly sensible in the context of costumed characters, simply does not fit computer programs.

Indeed, it is apt that this dispute is on review from the Ninth Circuit because the software industry is predominantly based there. The first question presented is important to the national economy. The software and information technology industry accounts for 7.1 percent of Gross Domestic Product and 11.6 percent of private-sector employment.²² When recourse to litigation is necessary to enforce copyrights on computer programs, juries determining valuable proprietary rights should not be left to flounder without expert assistance if the parties and the judge concur that it would be helpful.

Altai is just one analytical approach for copyright disputes involving computer programs. Judge William Orrick Sr. (who heard cases in the Silicon Valley) urged "an integrated substantial similarity test pursuant to which both lay and expert testimony would be admissible." *Broderbund Software, Inc. v. Unison World, Inc.*, 648 F. Supp. 1127, 1136 (N.D. Cal. 1986).

²² Software and Technology Spotlight: The Software and Information Technology Services Industry in the United States, <https://www.selectusa.gov/software-and-information-technology-services-industry-united-states> (last visited July 25, 2017).

In a subsequent concurrence, Ninth Circuit Judge Joseph Sneed agreed with Judge Orrick that this alternative would be superior. *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1478 (9th Cir. 1992). His blunt criticism resonates even more today. Judge Sneed faulted *Krofft* as “a poor analytic structure by which to determine the substantial similarity of an allegedly infringing computer program.” *Id.*

These jurists were correct that litigants should be able to aid the jury through witnesses with expertise on the subject. Such testimony is expressly permitted when an expert’s “scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue.” Fed. R. Evid. 702(a). The Ninth Circuit’s reinforcement of *Krofft* is inconsistent with “relaxing the traditional barriers to ‘opinion’ testimony.” *Beech Aircraft Corp. v. Rainey*, 488 U.S. 153, 169 (1988).

At the same time, there are safeguards against juries being misled or overly swayed by expert witnesses. Unqualified experts or dubious testimony are always subject to exclusion under *Daubert v. Merrill Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993). The evidence rules “afford ample assurances against the admission of opinions which would merely tell the jury what result to reach, somewhat in the manner of the oath-helpers of an earlier day.” Fed. R. Evid. 704, Advisory Committee Notes (1972 proposed rules).

Two of the most important circuits for computer innovation are in direct conflict on this issue. It has percolated long enough. This Court should grant a writ of certiorari here to consider the infringement standards for computer programs.

II. THIS COURT SHOULD CLARIFY WHETHER THE COPYRIGHT ACT REQUIRES DIRECT EVIDENCE OF COMPUTER PROGRAMS TO PROVE INFRINGEMENT

The Ninth Circuit opinion established a second rigid rule for copyright actions involving computer programs. It held that unless the “contents of the copyrighted work and the allegedly infringing works” are “introduced into evidence,” a copyright infringement claim has “failed as a matter of law.” App. 3a. This rule is wrong and should be corrected for two reasons.

First, the Ninth Circuit’s categorical evidentiary requirement finds no support in the Copyright Act. The panel impermissibly appended an evidence requirement to the statute.

Second, the Ninth Circuit fundamentally misconceived the nature of copyrights as intellectual property. The panel conflated a copyright entitled to legal protection with the myriad ways to prove infringement. A copyright can have legal force, and be infringed, without the entire work being introduced into evidence.

A copyright applicant must establish “two distinct but related requirements” known as embodiment and duration. *Cartoon Network LP, LLLP v. CSC Holdings, Inc.*, 536 F.3d 121, 127 (2d Cir. 2008). These are modest preconditions for a copyright. In this Court’s words, copyright protection mandates only “some minimal degree of creativity,” or “the existence of . . . intellectual production, of thought, and conception.” *Feist*, 499 U.S. at 362.

As to the embodiment requirement, copyright protection extends to “original works of authorship *fixed in any tangible medium of expression*, now known or

later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.” 17 U.S.C. § 102(a) (emphasis added). As to the duration requirement, “fixed” mandates only that the work “is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of *more than transitory duration*.” 17 U.S.C. § 101 (emphasis added).

There was no dispute that Antonick created a protected work fixed in a tangible medium of expression. Under his contract with EA, the “custom computer software program” he designed for Apple II Madden was the agreed “Work.” App. 4a. He also had intellectual property rights in any “Derivative Work.” App. 4a-5a, 17a.

Because EA had access to Antonick’s code while creating Sega Madden, Antonick’s protected work clearly endured for more than a transitory duration. Antonick wrote the source code on computer media and his code was ultimately used to generate the Apple II Madden Football product that was widely distributed in object code form. EA could not locate the source code that Antonick assigned to EA. That should not bar Antonick’s action, especially since he proffered clear evidence of his software code in the form of earlier draft programs, design documentation, and other proof.

The statutory requirements for a copyright plainly establish that Antonick’s protected work, the code itself, did not need to endure indefinitely (to serve as evidence in litigation, a development the district court found he could not have foreseen). App. 24a. The statute requires only that the original work be ‘fixed’ for a period of ‘more than transitory duration,’ not for

the entire term of the copyright.” *Pac. & S. Co. v. Duncan*, 744 F.2d 1490, 1494 (11th Cir. 1984).

A viable infringement claim thus does not turn, as the Ninth Circuit assumed, on the existence of the entire protected work in a particular format. This would reduce copyright protection to the happenstance of whatever proof may exist, possibly none, of the original work. With good reason, Congress rejected any form of “absolute permanence” to invoke the Copyright Act. *Advanced Computer Servs. of Michigan, Inc. v. MAI Sys. Corp.*, 845 F. Supp. 356, 363 (E.D. Va. 1994). If copyrights hinged on evidentiary fortuities, infringers would unfairly get off the hook—as in this case.

By statute, liability for copyright violations turns on whether certain “exclusive rights” have been infringed. 17 U.S.C. § 106. “A copyright is violated or infringed when, without permission, someone other than the copyright holder exercises one of these fundamental rights.” *Toney v. L’Oreal USA, Inc.*, 406 F.3d 905, 909-10 (7th Cir. 2005). Therefore, a side-by-side comparison of the original and allegedly infringing works is not the only way to establish liability. It is one way to prove a violation of the holder’s rights.

Indeed, the main decision the Ninth Circuit cited does not support its stringent evidentiary requirement. In *Seiler v. Lucasfilm, Ltd.*, 808 F.2d 1316 (9th Cir. 1987), the plaintiff “purposefully destroyed or withheld in bad faith” the allegedly copied works; so his “reconstructions” of the works were inadmissible under the Best Evidence Rule. *Id.* at 1318-20. Addressing *Seiler*, another circuit held that “if the Best Evidence Rule is satisfied, evidence other than the original may be sufficient to establish the content of a copyrighted work.” *Airframe Sys., Inc. v. L-3 Commc’s. Corp.*, 658 F.3d 100, 107 n.9 (1st Cir. 2011).

Antonick's infringement claim, then, would have encountered no proof problem in the First Circuit. Yet it fails as a matter of law under the Ninth Circuit's rigid rule.

Through no fault of Antonick, EA apparently did not retain the full source code that Antonick created for Apple II Madden. Nonetheless, as discussed above, the parties were able to assemble competent proof of the original and infringing works to present Antonick's claim to the jury (with scant objection from EA until the verdict was for Antonick). App. 10a-11a.

Again, when creating the first Sega Madden, EA had access to Antonick's source code. In just a few months, Park Place managed to craft code generating substantially similar plays and formations (and compilations) as those created by Antonick for Apple II Madden. In the language of the Copyright Act, Antonick's code was capable of being "reproduced . . . with the aid of a machine or device," 17 U.S.C. § 102(a)—meaning copied—to create the Sega Madden code for those plays and formations. The jury found that EA, through Park Place, had unlawfully copied, thereby infringing on the original work for Apple II Madden. With assistance from Antonick's expert Barr on the technical aspects, the jury rendered not just a sound but an informed verdict.

At trial, moreover, EA did not object under Federal Rules of Evidence 1002 or 1004 governing originals and best evidence. Had it done so, the district court presumably would have applied those rules consistent with the Copyright Act's lenient substantive requirements for embodiment and duration. Flexibility is the hallmark of copyright jurisprudence. *See Sony Corp. v. Universal City Studios, Inc.*, 464 U.S. 417, 430 (1984). Contrary to the holdings below, "general rules

of practice and procedure and rules of evidence” cannot “abridge” a substantive right. 28 U.S.C. § 2072(a)-(b).

The Ninth Circuit erroneously declared a unitary evidentiary prerequisite for trying copyright infringement claims involving computer programs. The panel’s requirement conflicts with, in fact negates, substantive protections under the Copyright Act. To clarify the law for copyright infringement trials, this Court should also grant certiorari on the second question presented.

CONCLUSION

For the reasons stated, the petition for writ of certiorari should be granted.

Respectfully submitted,

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July 28, 2017

APPENDIX

1a

APPENDIX A

FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

No. 14-15298

D.C. No. 3:11-cv-01543-CRB

ROBIN ANTONICK, an Illinois Citizen,

Plaintiff-Appellant,

v.

ELECTRONIC ARTS, INC., a California corporation,

Defendant-Appellee.

Appeal from the United States District Court
for the Northern District of California
Charles R. Breyer, Senior District Judge, Presiding

Argued and Submitted March 16, 2016
San Francisco, California

Filed November 22, 2016

Before: Andrew J. Kleinfeld, Johnnie B. Rawlinson,
and Andrew D. Hurwitz, Circuit Judges.

Opinion by Judge Hurwitz

OPINION

SUMMARY*

Copyright

The panel affirmed the district court's judgment as a matter of law in favor of Electronic Arts, Inc., in a diversity action seeking unpaid royalties pursuant to a contract, arising from alleged copyright infringement.

Plaintiff Robin Antonick developed the computer code for the original *John Madden Football* game for the Apple II computer, which was released by Electronic Arts. Electronic Arts subsequently released Madden games for Sega Genesis and Super Nintendo for which plaintiff received no royalties under a 1986 contract.

Concerning plaintiff's Sega claims, the panel held that the plaintiff did not provide sufficient evidence of copyright infringement because neither the source code used for Apple II Madden nor Sega Madden was in evidence. The panel also rejected plaintiff's argument that Electronic Arts's post-verdict Fed. R. Civ. P. 50(b) motion for judgment as a matter of law regarding the intrinsic test for copyright infringement should not have been considered.

Concerning plaintiff's Super Nintendo claims, the panel held that the district court did not err in dismissing plaintiff's derivative work claims because the Apple II and Super Nintendo processors were not in the same microprocessor family, as defined by the parties' contract. The panel also affirmed the district court's conclusion that the jury could not have deter-

* This summary constitutes no part of the opinion of the court. It has been prepared by court staff for the convenience of the reader.

mined plaintiff's damages from the alleged breach of contract to a reasonable certainty. The panel further held that, even if the district court erred, there was no harm, because plaintiff's failure to introduce any source code precluded a finding that Super Nintendo Madden was a derivative work.

Finally, the panel held that plaintiff offered no evidence of purported damages arising from plaintiff's claim that Electronic Arts used development aids to create non-derivative works without seeking a negotiated license.

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Eric H. MacMichael (argued), Tia A. Sherringham, R. Adam Lauridsen, Steven A. Hirsch, and Susan J. Harriman, Kecker & Van Nest LLP, San Francisco, California, for Defendant-Appellee.

OPINION

HURWITZ, Circuit Judge:

In this case, the plaintiff claimed copyright infringement. But the contents of the copyrighted work and the allegedly infringing works were never introduced into evidence. The district court held that the claim failed as a matter of law. We agree, and affirm.

I. Background

Robin Antonick developed the computer code for the original *John Madden Football* game for the Apple II computer (“Apple II Madden”). Electronic Arts, Inc. (“EA”) released Apple II Madden in 1988. Apple II Madden, the first football video game with 11 players on each side, was an instant hit, the best seller of any sports video game of its time. Antonick subsequently programmed Madden games for the Commodore 64 and IBM-compatible computers (“IBM Madden”).

In 1989, Antonick began working for EA on Madden games for the Nintendo and Sega Genesis entertainment systems. But in August 1990, EA told him to stop—Nintendo was becoming obsolete, and EA had decided on a new direction for the Sega game, hiring Park Place Productions to create a version with “more of an arcade style.” In November 1990, EA released its first version of Sega Madden. In late 1991 or early 1992, EA released Antonick’s last Madden game, an update of IBM Madden.

Each year from 1992 to 1996, EA released Madden games for Sega Genesis and Super Nintendo (“Super Nintendo Madden”). The Madden games have remained incredibly lucrative, selling millions of copies and even attracting a loyal fan base among professional football players.

Antonick’s 1986 contract with EA defined “a custom computer software program known as John Madden Football” designed for the “Apple [II] Family of Computers” as the “Work,” and provided that Antonick would receive royalties on any “Derivative Work,” defined as “any computer software program or electronic game which . . . constitutes a derivative work of the Work within the meaning of the United States copyright

law.” Antonick received no royalties for Sega Madden or Super Nintendo Madden, which EA assured him were not Derivative Works.

In 2011, Antonick brought this diversity action against EA, seeking contract damages in the form of unpaid royalties for Sega Madden and Super Nintendo Madden. The district court bifurcated the trial. In Phase I, the jury found that the statute of limitations did not bar Antonick’s claims. Phase II involved the merits of Antonick’s claims. Antonick produced evidence that Park Place was rushed and inadequately staffed, and argued that it copied his code to meet the demanding deadline for the first Sega Madden. Antonick’s expert, Michael Barr, opined that Sega Madden was substantially similar to certain elements of Apple II Madden. In particular, Barr opined that the games had similar formations, plays, play numberings, and player ratings; a similar, disproportionately wide field; a similar eight-point directional system; and similar variable names, including variables that misspelled “scrimmage.”¹ But neither the source code for Apple II Madden—the “Work”—nor the source code of any allegedly infringing works were introduced into evidence. Nor were images of the games at issue introduced.²

Nonetheless, the jury found that the Sega Madden games were Derivative Works under the 1986 contract. The district court then granted judgment as a

¹ Barr was only able to examine a partial draft version of the Apple II Madden source code, because the complete final version could not be found. The draft version he examined was not introduced into evidence.

² EA showed the jury a video of Sega Madden, but the jury did not view a video of Apple II Madden.

matter of law (“JMOL”) to EA, holding that Antonick had not provided sufficient evidence of copyright infringement, because neither the source code used for Apple II Madden nor Sega Madden was in evidence.

II. Discussion

A. The Sega Claims

Although this is a contract case, because royalties are available to Antonick under the 1986 contract only for a derivative work of Apple II Madden “within the meaning of the United States copyright law,” he had to prove copyright infringement to prevail on his contract claims. Antonick was thus required to prove that EA “copied protected elements of the work.” *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 636 (9th Cir. 2008) (citations omitted). “Absent direct evidence of copying, proof of infringement involves fact-based showings that the defendant had ‘access’ to the plaintiff’s work and that the two works are ‘substantially similar.’” *Three Boys Music Corp. v. Bolton*, 212 F.3d 477, 481 (9th Cir. 2000) (citation omitted).

“The Ninth Circuit employs a two-part test for determining whether one work is substantially similar to another.” *Benay v. Warner Bros. Entm’t, Inc.*, 607 F.3d 620, 624 (9th Cir. 2010) (citation omitted).

[A plaintiff] must prove *both* substantial similarity under the “extrinsic test” and substantial similarity under the “intrinsic test.” The “extrinsic test” is an objective comparison of specific expressive elements. The “intrinsic test” is a subjective comparison that focuses on whether the ordinary, reasonable audience would find the works substantially similar in the total concept and feel of the works.

Id. (citations and question marks omitted). The district court granted JMOL to EA under the “intrinsic test” because “the jury had no evidence of Apple II Madden or Sega Madden as a whole to enable it to make this subjective comparison.”

The district court was correct. Antonick’s claims rest on the contention that the source code of the Sega Madden games infringed on the source code for Apple II Madden. But, none of the source code was in evidence. The jury therefore could not compare the works to determine substantial similarity. *See Seiler v. Lucasfilm, Ltd.*, 808 F.2d 1316, 1319 (9th Cir. 1987) (“There can be no proof of ‘substantial similarity’ and thus of copyright infringement unless Seiler’s works are juxtaposed with Lucas’ and their contents compared.”) (applying the best evidence rule in a copyright action); *id.* (“[P]roof of the infringement claim consists of the works alleged to be infringed.”); *accord Airframe Sys., Inc. v. L-3 Commc’ns Corp.*, 658 F.3d 100, 107 (1st Cir. 2011) (“Having presented no evidence sufficient to prove the content of its registered source code versions, Airframe cannot show that any of its registered works is substantially similar to the allegedly infringing M3 program.”); *Gen. Universal Sys., Inc. v. Lee*, 379 F.3d 131, 146 (5th Cir. 2004) (per curiam) (“Without providing its own source code for comparison, GUS did not satisfy the requirement that the infringed and infringing work be compared side-by-side.”). And, absent evidence of the copyrighted work and the allegedly infringing works, the record is insufficient to allow appellate review of the jury’s verdict. *See, e.g., Olson v. Nat’l Broad. Co.*, 855 F.2d 1446, 1448, 1451 (9th Cir. 1988) (granting JMOL to copyright defendant because no reasonable jury could have found substantial similarity); *cf. Shaw v. Lindheim*,

919 F.2d 1353, 1355 (9th Cir. 1990) (“We have frequently affirmed summary judgment in favor of copyright defendants on the issue of substantial similarity.”).

Antonick argues there was no need to introduce the source code (or even the games at issue), because Park Place had access to the Apple II Madden code and a motive to copy it, and his expert and others testified to the similarity of the works. These arguments fail for three reasons.

First, the evidence at most demonstrates access and a possible motive to copy; it does not establish that the “protected portions of the works are substantially similar.” *Jada Toys*, 518 F.3d at 637.³ Access alone cannot establish copyright infringement. *Shaw*, 919 F.2d at 1361.

Second, our law is clear that expert testimony cannot satisfy a plaintiff’s burden of proof under the intrinsic test, which “depend[s] on the response of the

³ If the range of possible expression is narrow, the copyrighted work is entitled to thin protection, and a plaintiff must show virtual identity between the copyrighted work and the allegedly infringing work. *See Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913–14 (9th Cir. 2010). If the range of possible expression is wide, the work is entitled to broad protection and the plaintiff must show only substantial similarity. *Id.*

The district court held that “[d]ue to the narrow range of possible expression for a football video game and the fact that only two of the ten similar elements are protectable,” Antonick’s work was entitled only to thin protection, requiring him to show virtual identity of the works as a whole. Antonick disputes that conclusion, arguing that he needed to show only substantial similarity. We need not resolve that dispute, because we conclude that Antonick, having presented insufficient evidence of the works as a whole, loses under either standard.

ordinary reasonable person.” *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1475 (9th Cir. 1992) (quoting *Sid & Marty Krofft Television Prods., Inc. v. McDonald’s Corp.*, 562 F.2d 1157, 1164 (9th Cir. 1977)).⁴ Barr’s testimony may have been enough to establish substantial similarity under the extrinsic test, but it cannot satisfy Antonick’s burden of production under the intrinsic test. *Id.*

Third, the lay testimony was about how the games appeared, not how they were coded—and Antonick does not assert a copyright interest in Apple II Madden’s audiovisual appearance, only in its coding.

Antonick argues that copying was shown by testimony of Michael Kawahara, an Apple II Madden assistant producer. When asked whether he recognized any of the plays in Sega Madden from Apple II Madden, Kawahara answered affirmatively, stating that “[it] was – well, since the interface was – well, it was the same as we used in the Apple II. It was very easy to look at all of the plays in the Genesis version and they looked identical . . . to the original Apple II version.” This comment, however, does not establish

⁴ Antonick’s contrary cases are from other circuits; of the two Ninth Circuit cases he cites, one is a memorandum disposition holding expert testimony admissible in a case in which the relevant works themselves were in evidence, *Lucky Break Wishbone Corp. v. Sears Roebuck & Co.*, 373 F. App’x 752, 755–56 (9th Cir. 2010), and the other concerned a special master’s report, not expert testimony, *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1176 (9th Cir. 1989).

Antonick is not alone in contending that experts should be allowed to help juries assess the holistic similarity of technical works such as computer programs. See *Brown Bag*, 960 F.2d at 1478 (Sneed, J., concurring); *Comput. Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2d Cir. 1992). But, given our precedents, that argument must be addressed to an en banc court.

that the source code for the two games were substantially similar. Kawahara had no programming responsibilities for Apple II Madden; did not understand the Apple II Madden code; did not see the Sega Madden code; and admitted that he had no knowledge about differences in the games' codes.

Antonick also cites a statement by Richard Hilleman, an EA representative, that it was “possible” he had told an interviewer that “the Sega game took the system’s approach from Mr. Antonick’s game and just simply put a different aesthetic on top of it.” But, an “approach” is an idea that cannot be copyrighted—only its expression in code is protectable—and Sega Madden could have used Apple II Madden’s “approach” to football video games without violating the copyright laws. *See Bikram’s Yoga Coll. of India, L.P. v. Evolution Yoga, LLC*, 803 F.3d 1032, 1037–38 (9th Cir. 2015) (“[R]ecognizing this vital distinction between ideas and expression, courts have routinely held that the copyright for a work describing how to perform a process does not extend to the process itself.”).

Finally, Antonick argues that EA’s post-verdict Rule 50(b) motion for JMOL regarding the intrinsic test should not have been considered because the pre-verdict Rule 50(a) motion argued only that the evidence was insufficient to show substantial similarity between the two elements of the code that the district court had ruled protectable, rather than discussing similarity of the works as a whole. *See EEOC v. Go Daddy Software, Inc.*, 581 F.3d 951, 961 (9th Cir. 2009) (“Because it is a renewed motion, a proper post-verdict Rule 50(b) motion is limited to the grounds asserted in the pre-deliberation Rule 50(a) motion.”). But, both motions argued that the failure to place the source code in evidence was fatal to Antonick’s claim

that EA had copied his work. That preserved the argument. *Id.* (“Rule 50(b) ‘may be satisfied by an ambiguous or inartfully made motion’ under Rule 50(a).”) (quoting *Reeves v. Teuscher*, 881 F.2d 1495, 1498 (9th Cir. 1989)).

B. The Super Nintendo Claims

Antonick sought royalties for the Super Nintendo Madden games under Amendment 1 to his contract, which provided for royalties for derivative works for platforms in the “Same Microprocessor Family” as the Apple II. The Amendment defined “Microprocessor Family” as “a single microprocessor and all related microprocessors that utilize the same instruction set and have the same instruction and data word size.”

Antonick’s expert, Garry Kitchen, testified that the Apple II used the 6502 processor, which had an 8-bit data word size and 56 instructions of up to 3 bytes in length. The Super Nintendo used the more advanced 5A22 processor, which in its native mode used a 16-bit data word size and at least 92 instructions of up to 4 bytes in length; but which could also act as a 6502 processor for purposes of backwards compatibility. Kitchen testified that this backwards compatibility meant that the microprocessors were in the same “family,” as the industry uses the term. He acknowledged that Super Nintendo Madden was designed to use that system’s advanced capabilities, utilizing a larger instruction set, longer data word sizes, and longer instructions than Apple II Madden.

After Kitchen’s testimony, the district court dismissed the Super Nintendo claims, holding that the Super Nintendo was not in the same Microprocessor Family as the Apple II under the contractual definition, because it used a larger instruction set,

instruction size, and data size. Antonick argues that the two processors were in the same family as a practical matter because they *could* use the same instruction set, instruction size, and data size. Antonick's factual premise may well be correct. But we deal here with contract interpretation, and the word "could" is not in the contractual definition. Instead, the contract requires that, to be in the same family, two processors must "utilize the *same* instruction set and have the *same* instruction and data word size." The Apple II and Super Nintendo processors have different instruction sizes and data word sizes.⁵ The district court therefore did not err in dismissing the Super Nintendo derivative work claims.

Antonick argues in the alternative that EA breached the contract by failing to give him the opportunity to develop the Super Nintendo Madden game. The contract provided that, if Antonick developed any Derivative Works for new microprocessor families, he would be entitled "to written notice and the opportunity to develop additional Derivative Works for the New Microprocessor Family." Antonick developed a Madden game for the Apple II GS, which he argues, and EA does not appear to deny, is in the same microprocessor family as the Super Nintendo. As damages, he seeks royalties based on the actual Super Nintendo game sales.

The district court dismissed this claim because a fact-finder would have to speculate on whether Antonick could have developed such a work, how well an Antonick-developed Super Nintendo game would have sold, and what royalty rate the parties would have agreed upon; Antonick's expert report did not address

⁵ Arguably, the chips "utilize the same instruction set" because the 6502 uses a subset of the 5A22's instructions.

these issues. The district court was correct; the jury could not have determined Antonick's damages from the alleged breach to a "reasonable certainty." *Sargon Enters., Inc. v. Univ. of S. Cal.*, 288 P.3d 1237, 1254 (Cal. 2012). Moreover, even if the district court erred, there was no harm, because Antonick's failure to introduce any source code precluded a finding that Super Nintendo Madden was a Derivative Work.

C. The Development Aids

The contract also gave EA a license to create derivative works using certain tools designed by Antonick ("Development Aids"), and provided that the parties would "negotiate in good faith" for further licenses if EA wanted to use the aids to create non-derivative works. Antonick alleges that EA used the aids to create non-derivative works without seeking that license.

The district court dismissed this claim because Antonick offered no evidence of purported damages. Antonick did not show the value of similar licenses or the benefit that EA received from using the Development Aids. Instead, Antonick cited only the report of his damages expert, which simply made generic royalty calculations based on existing sales without explaining how those calculations were relevant to the Development Aid claim. The district court correctly kept this unsubstantiated claim from the jury. *See Amelco Elec. v. City of Thousand Oaks*, 38 P.3d 1120, 1130, 1132 (Cal. 2002).

CONCLUSION

The judgment of the district court is **AFFIRMED**.

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APPENDIX B

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

[Filed: March 16, 2017]

No. 14-15298

D.C. No. 3:11-cv-01543-CRB
Northern District of California, San Francisco

ROBIN ANTONICK, an Illinois Citizen,
Plaintiff-Appellant,

v.

ELECTRONIC ARTS, INC., a California corporation,
Defendant-Appellee.

ORDER

Before: KLEINFELD, RAWLINSON, and HURWITZ,
Circuit Judges.

Judges Rawlinson and Hurwitz voted to deny the petition for rehearing en banc, and Judge Kleinfeld so recommended.

The full court was advised of the petition for rehearing en banc and no judge has requested a vote on whether to rehear the matter en banc. Fed. R. App. P. 35. The petition for rehearing en banc is denied.

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA

[Filed January 22, 2014]

No. C 11-1543 CRB

ROBIN ANTONICK,
Plaintiff,

v.

ELECTRONIC ARTS INC.,
Defendant.

ORDER GRANTING EA'S AMENDED
RENEWED PHASE II MOTION FOR
JUDGMENT AS A MATTER OF LAW, OR,
ALTERNATIVELY, FOR A NEW TRIAL

Following a two-phase trial in which the jury found EA breached its contract with Plaintiff Robin Antonick, the parties filed several post-trial motions, which are now before the Court. Defendant Electronic Arts ("EA") moves for judgment as a matter of law as to both phases of the trial or, in the alternative, for a new trial. *See generally* dkts. 443, 540. Antonick moves for prejudgment interest on the royalties he is owed as a result of the Phase II verdict, *see* dkt. 528, and for entry of final judgment as to his fraud claim, *see* dkt. 542. Upon consideration of the motions, the oppositions thereto, and the entire record of the case, the Court DENIES EA's motion for judgment as a matter of law as to Phase I, GRANTS EA judgment as a

matter of law as to Phase II, and conditionally GRANTS EA's motion for a new trial of Phase II.

I. BACKGROUND

In 1984, EA hired Antonick to write source code for a video game to be called "Football." After EA negotiated with John Madden to use his name and likeness for the game, Antonick and EA entered into a new contract to develop a game for the Apple II computer called *John Madden Football*. Trial Ex. 15 (1986 Contract). The Contract also gave Antonick the right to royalties on "Derivative Works," defined as "any computer software program or electronic game which . . . constitutes a derivative work of the Work within the meaning of the United States Copyright law." *Id.* § 1.03.

In 2011, Antonick brought this suit against EA alleging breach of contract and fraud based on EA's failure to pay him royalties on allegedly derivative works. *See generally* Compl. (dkt. 1). Following a motion to dismiss and three motions for summary judgment, the Court held a jury trial in two phases. In Phase I, the jury was asked to decide whether the statute of limitations barred Antonick's claims. At the close of evidence, the jury found that Antonick proved by a preponderance of the evidence that before November 21, 2005, he did not discover, and did not know of facts that would cause a reasonable person to suspect, that EA had allegedly breached the 1986 Contract or made the allegedly fraudulent statements. *See* Verdict (dkt. 441).

In Phase II, the same jury was asked to determine whether Antonick proved that there are substantial similarities between Sega Madden and Apple II

Madden¹ with respect to the expression in the source code of (1) field width or (2) plays and formations. Then, for any Sega Madden game for which the jury found substantial similarities in either of those elements, the jury was asked to determine whether Antonick proved that that particular Sega Madden game is virtually identical to Apple II Madden when considering the games as a whole. In response to Question 1, the jury found that Antonick did not prove that there are substantial similarities in the expression of field width in the source code, but did prove there are substantial similarities between the expression of the source code for plays and formations. *See* Verdict (dkt. 516) at 1. In Question 2, the jury found that each of the seven Sega Madden games at issue were “virtually identical” to Antonick’s version. *Id.* at 2. By this verdict, the jury found that the Sega Madden games are derivative works under the 1986 Contract, and that EA breached the contract by failing to pay Antonick royalties on their sales.

EA now moves for judgment as a matter of law as to both phases of the trial under Federal Rule of Civil Procedure 50(b), or, in the alternative, for a new trial under Federal Rule of Civil Procedure 59. Antonick moves for prejudgment interest and for entry of final judgment as to his fraud claim, which the Court dismissed prior to Phase II.

¹ For purposes of the jury instructions and verdict form, the Court instructed the jury that it would “refer to John Madden Football for the Apple II as ‘Apple II Madden,’ and . . . to all of the versions of John Madden Football for the Sega Genesis at issue in this case as ‘Sega Madden.’” *See* Jury Instructions at 4-5.

II. LEGAL STANDARDS

A. Motion for Judgment as a Matter of Law under Federal Rule of Civil Procedure 50(b)

“Judgment as a matter of law is appropriate when the evidence, construed in the light most favorable to the nonmoving party, permits only one reasonable conclusion, which is contrary to the jury’s verdict.” *Hagen v. City of Eugene*, 736 F.3d 1251, 1256 (9th Cir. 2013) (quoting *Omega Envtl., Inc. v. Gilbarco, Inc.*, 127 F.3d 1157, 1161 (9th Cir. 1997)). The court may grant a motion for judgment as a matter of law only where “there is no legally sufficient basis for a reasonable jury to find for [the non-moving] party on that issue.” *Krechman v. Cnty. of Riverside*, 723 F.3d 1104, 1109-10 (9th Cir. 2013) (internal quotation marks omitted); *see also, e.g., Byrd v. Maricopa Cnty. Sheriff’s Dep’t*, 629 F.3d 1135, 1138 (9th Cir. 2011) (“[A] motion for judgment as a matter of law is properly granted only if no reasonable juror could find in the non-moving party’s favor.”) (internal quotation marks omitted).

If, however, “there is such relevant evidence as reasonable minds might accept as adequate to support the jury’s conclusion,” the motion should be denied. *Hagen*, 736 F.3d at 1256 (internal quotation marks omitted); *see also Barnard v. Theobald*, 721 F.3d 1069, 1075 (9th Cir. 2013). When considering a motion for judgment as a matter of law, the court may not make credibility determinations, weigh the evidence, or substitute its own view of the evidence for the jury’s. *See, e.g., Krechman*, 723 F.3d at 1110.

B. Motion for a New Trial Under Federal Rule of Civil Procedure 59

The court “may grant a new trial if, having given full respect to the jury’s findings, the judge on the entire

evidence is left with the definite and firm conviction that a mistake has been committed” *Tortu v. Las Vegas Metro. Police Dep’t*, 556 F.3d 1075, 1087-88 (9th Cir. 2009) (internal quotation marks and alteration omitted); see Fed. R. Civ. P. 59(a)(1)(A) (providing that district courts may grant a motion for a new trial “on all or some of the issues . . . after a jury trial, for any reason for which a new trial has heretofore been granted in an action at law in federal court.”). “The primary basis for granting a new trial is that the jury’s verdict was against the clear weight of the evidence.” *Computer Access Tech. Corp. v. Catalyst Enters., Inc.*, 273 F. Supp. 2d 1063, 1065 (N.D. Cal. 2003) (citing *Landes Constr. Co., Inc. v. Royal Bank of Canada*, 833 F.2d 1365, 1371 (9th Cir. 1987)). In contrast to its role with respect to a motion for judgment as a matter of law, when considering a motion for a new trial, the court “can weigh the evidence and assess the credibility of witnesses, and need not view the evidence from the perspective most favorable to the prevailing party.” *Landes Constr. Co.*, 833 F.2d at 1371 (citations omitted).

III. DISCUSSION

EA seeks judgment as a matter of law on Phase I, arguing that (1) the doctrine of judicial estoppel should bar Antonick from changing his position as to when he first became aware that he might have a claim against EA, and (2) no reasonable jury could have found that Antonick was not on notice of his claim before November 2005. In its motion for judgment as a matter of law on Phase II, EA contends that Antonick failed to prove (1) that there are substantial similarities in the expression in the source code plays and formations between Apple II Madden and Sega Madden, or (2) that any Sega Madden game is virtually

identical to Apple II Madden when each game is considered as a whole.

In response to each motion, Antonick contends that EA waived many of its Rule 50(b) arguments by failing to raise them in its Rule 50(a) motion,² and that, even if preserved, they should be rejected on the merits because substantial evidence supports the Phase I and Phase II verdicts.³

A. EA Is Not Entitled to Judgment as a Matter of Law on Phase I

1. Judicial Estoppel Doctrine Does Not Apply

The issue raised by EA's judicial estoppel motion is whether Antonick impermissibly changed his position at trial regarding when he became aware of a possible claim against EA for purposes of the discovery rule⁴

² The Court has considered Antonick's waiver arguments and concludes that EA adequately preserved the arguments this Order addresses.

³ Also before the Court is EA's motion to strike the segments of the trial testimony of Antonick's expert, Michael Barr. *See* dkt. 502. The Court has considered EA's motion to strike portions of Barr's testimony in which he opined about matters outside of his initial report and rebuttal report, and finds that the statements to which EA objects were sufficiently disclosed in his report or his deposition. The motion to strike is therefore DENIED.

⁴ Quoting the California Supreme Court, the Ninth Circuit explained that under the discovery rule:

[T]he plaintiff discovers the cause of action when he at least suspects a factual basis, as opposed to a legal theory, for its elements, even if he lacks knowledge thereof—when, simply put, he at least suspects that someone has done something wrong to him, wrong being used, not in any technical sense, but rather in accordance with its lay understanding. He has reason

such that (1) his trial testimony was clearly inconsistent with his prior position; (2) the prior position persuaded the Court to deny EA's motions to dismiss and for summary judgment; and (3) if not estopped from asserting the inconsistent position, Antonick would derive an unfair advantage and EA would face an unfair disadvantage. *See Ah Quin v. Cnty. of Kauai Dep't of Transp.*, 733 F.3d 267, 270-71 (9th Cir. 2013).

In his Complaint, Antonick alleged that

Only with the extensive publicity surrounding Electronic Arts' Madden NFL 20th Anniversary celebrations did Antonick become aware that Electronic Arts had continued to create derivative works from his work and considered its current software to have derived from Antonick's intellectual property. Specifically, in its publicity materials surrounding the 20th Anniversary[,] Electronic Arts, to Antonick's surprise[,] traced its current

to discover the cause of action when he has reason at least to suspect a factual basis for its elements. He has reason to suspect when he has notice or information of circumstances to put a reasonable person on *inquiry*; he need not know the specific facts necessary to establish the cause of action; rather, he may seek to learn such facts through the process contemplated by pre-trial discovery; but, within the applicable limitations period, he must indeed seek to learn the facts necessary to bring the cause of action in the first place—he cannot wait for them to find him and sit on his rights; he must go find them himself if he can and file suit if he does.

Platt Elec. Supply, Inc. v. EOFF Elec., Inc., 522 F.3d 1049, 1057 (9th Cir. 2008) (quoting *Norgart v. Upjohn, Co.*, 21 Cal. 4th 383, 397-98 (1999)).

software back to his software[,] *not* the version developed by Park Place.

Compl. ¶ 92. Also in 2009, at the suggestion of an acquaintance, Antonick viewed a CNBC interview of Electronic Arts founder Trip Hawkins, in which Hawkins traced the Madden franchise back to Antonick's version by observing that the first version "took four years" to create. *Id.* ¶ 93. The interview

caused Antonick to do some additional research during which he came across the website of Park Place co-founder Troy Lyndon. Ex. 19, Response to Defendant's First Set of Interrogatories at 18. On the website, Lyndon credited Hilleman with helping him develop the 1990 Sega Genesis version of Madden and referred to the "countless hours" Hilleman spent assisting Jim Simmons to develop the game. Ex. 15, Troy Lyndon Website at 2. At this point, Plaintiff was stunned. He knew that Hilleman had also spent "countless hours" working with him on the 1989 version of Madden. Hilleman's significant involvement in the Park Place version contradicted EA's assurances that that version had been independently developed without any reference to Antonick's work. Ex. 19, Response to Defendant's First Set of Interrogatories at 18; see also Ex. 1, Antonick Dep. at 243-44.

All of these facts in the aggregate caused Antonick to suspect, for the first time in July 2009, that EA may not have been completely forthright with him about its past royalty obligations.

See 1st MSJ Opp'n (dkt. 125) at 9.

At trial, Antonick testified that the moment “that the big red flag . . . went off” that EA may have used his intellectual property was when he viewed the Troy Lyndon website. Tr. 276:6-8. Antonick pointed to three facts he learned for the first time from the website: (1) Lyndon stated that Park Place developed Sega Madden in less than six months, which Lyndon considered “record time;” (2) the programmer of Sega Madden, Jim Simmons, was a high school friend of Lyndon’s, who had never programmed a professional game; and (3) producer Richard Hilleman spent “countless hours” with programmer Jim Simmons making the game more realistic. Tr. at 275:6-25. In particular, the statement that Hilleman spent “countless hours” with Simmons indicated to Antonick that the first Sega Madden was not developed in a clean room, amounting to a violation of his intellectual property rights. Tr. at 275:18-25-276:1-5. As for viewing the twentieth anniversary materials and the CNBC interview, Antonick testified at trial that these two events did not make him suspicious that he had a claim against EA because neither indicated that EA had used his intellectual property. Rather, they merely connected the later versions to his game, and, as Antonick acknowledged, he did not own the “John Madden” name. Tr. 274-19-25.

In support of its judicial estoppel motion, EA argues that Antonick’s admission at trial that he learned nothing new from the anniversary materials or the CNBC interview is plainly inconsistent with his prior position that these two events spurred him to begin research that led to his discovery of his potential claim. In EA’s view, Antonick changed his position to gain an advantage at trial: anticipating that EA would prove that neither the anniversary materials nor the CNBC interview provided Antonick with information in 2009 that he did not have before the statute of

limitations ran, Antonick focused on his viewing of the Troy Lyndon website—rather than the anniversary materials or CNBC interview—as the “aha” moment that “knocked [him] off his feet.” *See* Tr. 275.

The Court concludes that Antonick’s trial testimony is not “clearly inconsistent” with his earlier position. *See Ah Quin*, 733 F.3d at 270. Prior to trial, Antonick represented that the anniversary materials and CNBC “interview seemed inconsistent with EA’s earlier promises—and caused Antonick to do some additional research, during which he came across” Lyndon’s website. *See* 1st MSJ Opp’n at 9. When viewing the information on Lyndon’s website, Antonick “was stunned.” *Id.* This version of events is not inconsistent with his trial testimony that it was not until viewing Lyndon’s website that he believed the clean room concept was violated during Sega Madden’s creation. Tr. 276:6-8.

While Antonick admitted at trial that he knew since 1990 that every game subsequent to Apple II Madden shared the *Madden* name, it was not until 2009 that he heard the acknowledgment by EA and Hawkins that the *Madden* series began with his game. That new fact caused Antonick to investigate further and led him to the Lyndon website. Accordingly, the Court does not find that Antonick’s positions are inconsistent and will not grant EA’s motion for judgment as a matter of law as to Phase I on the basis of judicial estoppel.

2. There Is Sufficient Evidence for a Reasonable Jury to Find Antonick's Claims Are Not Barred by the Statute of Limitations

In further support of its motion for judgment as a matter of law, EA contends that “[e]ven if one were to take Antonick’s trial testimony at face-value, no reasonable jury could conclude that Antonick did not know about the relevant facts on [Troy Lyndon’s] website before 2005,” Phase I JMOL at 20, and “a reasonable person would have suspected the factual basis of his claim before November 2005,” *id.* at 18. In EA’s view, as soon as Antonick knew—no later than 1990—that all the games after his were called *John Madden Football*, that the first Sega Madden took less than a year to create while his took four, and that Richard Hilleman was the producer of both his game and the first Sega Madden, the statute of limitations began to run. Whether he learned additional information from the Lyndon website in 2009 is irrelevant if he was already on notice.

The Court cannot conclude that no reasonable juror viewing the testimony and evidence at trial could have found that prior to November 21, 2005, Antonick did not know, or know of facts that would cause a reasonable person to suspect, that he had a claim against EA. Even though reasonable minds may differ as to what a reasonable person would have suspected, there was sufficient evidence to support the jury’s finding. *See Johnson v. Paradise Valley Unified Sch. Dist.*, 251 F.3d 1222, 1227 (9th Cir. 2001) (“Substantial evidence is evidence adequate to support the jury’s conclusion, even if it is also possible to draw a contrary conclusion from the same evidence.”) (citation omitted); *see also Lewis v. Musicians Union, AFM Local 6*, C-90-3099

MHP, 1993 WL 356903, at *3 (N.D. Cal. Sept. 7, 1993) (“It is not up to the court to second-guess the jury on its conclusions. While reasonable minds may differ as to what constitutes ‘reasonable’ efforts, there was evidence to support the jury’s decision.”).

For these reasons, the Court denies EA’s motion for judgment as a matter of law as to Phase I.

B. EA is Entitled to Judgment as a Matter of Law on Phase II

The Court now turns to EA’s motion for judgment as matter of law as to Phase II. In this phase, the jury was asked two questions to determine whether (1) EA copied the expression of any protected element in any of the Sega Madden games at issue, and (2) if so, whether that copying made Sega Madden an infringing work of Apple II Madden.

To this end, Question 1 asked whether Antonick proved that there are substantial similarities between Sega Madden and Apple II Madden with respect to the two elements of Apple II Madden that the Court previously held were protectable: the expression in Antonick’s source code of “field width” and of “plays and formations.” See Order on 3d MSJ at 32. The jury found that for each version of Sega Madden at issue,⁵ Antonick proved that there are substantial similarities with respect to the expression in Antonick’s source code of “plays and formations,” but did not prove that there are substantial similarities with respect to the

⁵ The Sega Madden games at issue are: *John Madden Football*, *John Madden Football* ‘92, two versions of *John Madden Football* ‘93, *John Madden Football* ‘94, *Madden NFL* ‘95, and *Madden NFL* ‘96. See Phase II Verdict at 2. The Court refers to six games created after the first *John Madden Football* for Sega in 1990 as the “subsequent” Sega Madden games.

expression in Antonick’s source code of “field width.” See Phase II Verdict (dkt. 516) at 1.

The jury’s task did not end there, because while it found that EA copied some of Antonick’s code, not all copying of protected expression is copyright infringement. See, e.g., *Newton v. Diamond*, 388 F.3d 1189, 1193 (9th Cir. 2004) (“The principle that trivial copying does not constitute actionable infringement has long been a part of copyright law.”). “For an unauthorized use of a copyrighted work to be actionable, the use must be significant enough to constitute infringement.” *Id.* at 93.

To determine whether the copying of the source code that expressed “plays and formations” amounts to infringement, Question 2 required the jury to compare “the works to determine whether, as a whole, they are sufficiently similar to support a finding of illicit copying.” See *Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d 904, 913-14 (9th Cir. 2010); *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1442-43 (9th Cir. 1994). This second step, called the intrinsic test, “which examines an ordinary person’s subjective impressions of the similarities between two works, is exclusively the province of the jury.” *Funky Films, Inc. v. Time Warner Entm’t Co., L.P.*, 462 F.3d 1072, 1077 (9th Cir. 2006) (citation omitted).

The works must be compared as a whole because the relevant inquiry is “whether a substantial portion of the protectable material in the *plaintiff’s* work was appropriated—not whether a substantial portion of *defendant’s* work was derived from plaintiff’s work.” *Newton*, 388 F.3d at 1195. The sheer amount of protected information copied from plaintiff’s work is not necessarily dispositive. Rather, courts are to focus on the significance of the protected expression to

plaintiff's entire work. *See InDyne, Inc. v. Abacus Tech. Corp.*, 876 F. Supp. 2d 1278, 1284 (M.D. Fla. 2012), *aff'd*, 513 F. App'x 858 (11th Cir. 2013) (explaining that the relevant inquiry for the second prong of the infringement inquiry is “whether the elements of [plaintiff's] software copied are protected expression and ‘of such importance to the copied work that the appropriation is actionable.’”). If the copying of the protected expression is so extensive that it renders the plaintiff's work and the allegedly infringing work virtually identical, then the copying is actionable and the resulting work infringing.

Here, because the Court determined that Apple II Madden was entitled to thin—rather than broad—copyright protection,⁶ a work would be infringing only if an ordinary reasonable observer comparing Apple II Madden as a whole to Sega Madden as a whole would consider the works virtually identical. *See* Phase II Order at 3-4. The jury found all seven versions of Sega Madden at issue virtually identical to Apple II Madden, indicating its conclusion that all seven versions of Sega Madden at issue are infringing works, and therefore derivative works under the 1986 Contract for which Antonick is owed royalties.

⁶ In its order on EA's third motion for summary judgment, the Court used analytic dissection to determine if any of the allegedly similar elements of Apple II Madden and Sega Madden are protected by copyright and concluded that only two of ten elements were protectable. *See* Order on 3d MSJ at 15-32. The Court then filtered out the unprotectable elements to define the scope of copyright protection to afford Apple II Madden: broad or thin. Phase II Pretrial Order at 2. “Due to the narrow range of possible expression for a football video game and the fact that only two of the ten similar elements are protectable, the Court conclude[d] that Antonick's work is entitled to only thin protection.” *Id.* at 3.

The Court, having reviewed the trial record, concludes that EA is entitled to judgment as to Question 2. Even construing the evidence in the light most favorable to Antonick, there is no legally sufficient basis for the jury's verdict that any of the Sega Madden games as a whole are virtually identical to Apple II Madden as a whole. The Court now addresses the evidentiary deficiencies as to Question 2.

1. The Jury Had No Evidence of Sega Madden as a Whole

In Question 2, the jury was asked to conduct the second prong of the infringement inquiry: whether Sega Madden as a whole is virtually identical to Apple II Madden as a whole. The Ninth Circuit has not defined "virtually identical," but some district courts have attempted to provide guidance as to the standard. *See, e.g., Merch. Transaction Sys., Inc. v. Nelcela, Inc.*, No. CV02-1954-PHX- MHM, 2009 WL 723001, at *17 (D. Ariz. Mar. 18, 2009) (defining virtual identity as "differ[ing] from one another by no more than a trivial degree"); *Berkla v. Corel Corp.*, 66 F. Supp. 2d 1129, 1143-44 (E.D. Cal. 1999) ("Clearly, the plain meaning of the words ["virtually identical"] will not allow any significant dissimilarities," but "will be satisfied at some point short of photographic reproduction.").

As the court in *Berkla* observed, "it is difficult to pin down a definition more precise than the narrow spectrum" between having no significant dissimilarities but being short of a photographic reproduction. *Id.* Indeed, because the intrinsic test calls for an ordinary observer's subjective comparison, virtual identity must be in the eye of the beholder. *See id.* (Whether two works are virtually identical is a "decision made on subjective observation."). For the same reason a court cannot strictly define what it means for works to

be “virtually identical,” a jury must be permitted to make its own subjective observation of the works.

However, in this case, the jury had no evidence of Apple II Madden or Sega Madden as a whole to enable it to make this subjective comparison. By failing to offer evidence of the games in their entirety, Antonick’s proof on Question 2 was insufficient.

In response to EA’s motion, Antonick does not point to any evidence of the works “as a whole.” His opposition to EA’s motion for judgment as a matter of law discusses each element in Apple II Madden, and recounts the testimony showing their similarity to their counterparts in Sega Madden. *See* Phase II JMOL Opp’n (dkt. 545) at 21-23. Similarly, in closing, counsel addressed the question posed to the jury as to whether or not Apple II Madden “as a whole is virtually identical to the Sega Madden game,” and stated:

[T]hey both use a version of player ratings. They both use a system where you reach decision points and make a decision on what should happen in the game. They both have the same plays, the same sequencing, the same order; same plays pretty much to a T. They both have the same field size. Same formations. Same directional control system.

Tr. 2078:19-25-2079:1-4.

Comparing the works element by element is plainly counter to Ninth Circuit law. *See Rodesh v. Discronics, Inc.*, 8 F.3d 29, at *2 (9th Cir. 1993) (“Unlike the objective, extrinsic test, in the intrinsic test ‘analytic dissection’ is forbidden. The whole idea is to view the work as a whole, not to break it apart into pieces for individual scrutiny.”) (internal citations omitted). If the jury’s comparison of the works could be

accomplished by merely comparing each of the elements head-to-head without considering the significance of the protected expression copied, “there would be no point to the extrinsic test, or to distinguishing ideas from expression” and a copyright holder could impermissibly rely on similarities in expression resulting from unprotectable elements. *Apple Computer*, 35 F.3d at 1446.

Antonick asserts that “a jury may appropriately undertake a ‘qualitative’ evaluation of similarities,” rather than the quantity of copied material. *See* Phase II JMOL Opp’n at 21. He even quotes a book written by EA’s expert for the proposition that “it is not ‘the percentage of code that determines whether the [copying] is substantial’ because ‘code can be critical’ to a program’s operation but ‘consist of a relatively small percentage of total lines of code.’” *Id.* at 21 n.24 (citing dkt. 325-13 at 331). The Court does not dispute the proposition that infringement can result from the significance of the expression copied rather than the sheer quantity. *See, e.g., Newton*, 388 F.3d at 1195 (“Substantiality is measured by considering the qualitative and quantitative significance of the copied portion in relation to the plaintiff’s work as a whole.”) (citing *Worth v. Selchow & Righter Co.*, 827 F.2d 569, 570 n.1 (9th Cir. 1987)). However, this proposition does not substitute for sufficient evidence to allow the jury to place the protected expression—Antonick’s source code for plays and formations—in the context of Apple II Madden as a whole.⁷

⁷ *See also, e.g., Greenspan v. Random House, Inc.*, 859 F. Supp. 2d 206, 218 (D. Mass. 2012), *aff’d*, No. 12-1594, 2012 WL 5188792 (1st Cir. Oct. 16, 2012) (concluding that “the five sentences that convey these ideas are quantitatively and qualitatively insubstantial in the context of [plaintiff’s work] as a whole. Any

2. The Jury Had No Evidence that Any Subsequent Sega Madden Game was Virtually Identical to Apple II Madden

The record is similarly devoid of evidence supporting the jury's conclusion that the six Sega Madden games subsequent to 1990 are virtually identical to Apple II Madden. Antonick's evidence on the subsequent games relied on the proposition that if (a) the first Sega Madden is virtually identical to Apple II Madden and (b) all seven Sega Madden games were virtually identical to each other, then (c) all of the Sega Madden games were infringing works of Apple II Madden. Even assuming that this approach was valid, the record contains no legally sufficient basis for the jury to find that all of the Sega Madden games are virtually identical to each other.

No reasonable jury could have concluded that the seven Sega Madden games were virtually identical to each other. The only information about the subsequent games as a whole was Barr's opinion that each Sega Madden version changed "just a few things" each year—specifically by (1) changing player ratings, (2) adding plays, (3) adding features such as instant replay, (4) improving the look of the game's graphical characters—but were "essentially the same software program." Tr. 1310:19-25-1311:1-5.⁸ Without the opportunity to view each of the versions of Sega Madden, the

copying claimed based on [the protectable elements] simply was not so extensive that an ordinary observer could conclude that the defendants unlawfully appropriated the plaintiff's original expressions.").

⁸ Barr also testified that the source code of the subsequent games showed that they "had more plays" than 1990 Sega Madden, and specifically that the 1993 Sega Madden "actually added additional plays" from Apple II Madden. Tr. 1400:8-15.

jury had no basis for evaluating whether the changes Barr addressed altered each subsequent game such that they should not be considered one and the same for purposes of the intrinsic test.⁹

Barr's opinion that all seven Sega Madden games are "essentially the same" as a whole cannot substitute for the jury's subjective comparison of each of the seven Sega Madden games as a whole to Apple II Madden as a whole. Because the intrinsic test requires the perspective of an ordinary, reasonable observer, *Funky Films, Inc.*, 462 F.3d at 1077, expert testimony is not admissible evidence of similarity for purposes of the intrinsic test. *See, e.g., Olson v. Nat'l Broad. Co., Inc.*, 855 F.2d 1446, 1448-49 (9th Cir. 1988) (stating that expert testimony is appropriate under the extrinsic test, but not under the intrinsic test); *Express, LLC v. Fetish Grp., Inc.*, 424 F. Supp. 2d 1211, 1228 (C.D. Cal. 2006) ("While expert testimony is generally appropriate in conducting the extrinsic test, expert testimony may not be considered in conducting the intrinsic test.") (internal citation omitted); *Trust Co. Bank v. Putman Publ'g Grp., Inc.*, No. CV 87 07393 AHS(JRX), 1988 WL 62755, at *6 (C.D. Cal. Jan. 4, 1988) ("Expert testimony is inadmissible on this intrinsic test.").¹⁰

⁹ In an apparent attempt to demonstrate that the later Sega Madden games were even more similar to Apple II Madden, counsel argued in closing that Barr "found no evidence that [EA] took plays out across the games he looked at," Tr. 2081:1-3. Even if it were relevant that EA did not delete plays in subsequent games, counsel's representation is belied by the record. When asked if he "ever [found] any evidence that plays were taken out of games," Barr testified that, he "didn't go specifically looking for game by game whether individual plays were taken out. . . . There were more plays in the later games." Tr. 1400:16-21.

¹⁰ *See also Computer Associates Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2d Cir. 1992) ("[E]xpert testimony may be used to assist

Just as Barr’s expert opinion that the games are “essentially the same” does not relieve Antonick from providing evidence of each Sega Madden game as a whole, counsel’s argument that all the Sega Madden games can be considered one and the same falls short providing evidence to allow the jury to compare the works as a whole. Counsel urged the jury to find that the Sega Madden games are virtually identical to each other if: “For all practical purposes, is it the same? . . . For the practical points that matter, is it the same thing?” Tr. 2079:7-9; *see also* Tr. 2079:16 (Sega Madden games “are all in the same family.”). Certainly, at some level, all seven Sega Madden games could be considered “the same thing” for “practical purposes”—indeed, they are all football video games, all football games for the Sega Genesis, and all John Madden Football games in particular. Those similarities among them, however, are not evidence that they are virtually identical to each other, because copyright law protects only similarity in protectable expression, not similarities in unprotectable ideas.¹¹ If counsel’s

the fact finder in ascertaining whether the defendant had copied any part of the plaintiff’s work. . . . However, once some amount of copying has been established, it remains solely for the trier of fact to determine whether the copying was ‘illicit’ Since the test for illicit copying is based upon the response of ordinary lay observers, expert testimony is thus ‘irrelevant’ and not permitted.”) (citations omitted).

¹¹ *See, e.g., Mattel, Inc. v. MGA Entm’t, Inc.*, 616 F.3d at 916-17 (“[W]hen works of art share an idea, they’ll often be ‘similar’ in the layman’s sense of the term. For example, the stuffed, cuddly dinosaurs at issue in *Aliotti [v. R. Dakin & Co.]*, 831 F.2d 898, 901 (9th Cir. 1987), were similar in that they were all stuffed, cuddly dinosaurs-but that’s not the sort of similarity we look for in copyright law. ‘Substantial similarity’ for copyright infringement requires a similarity of expression, not ideas. *See*

approach were permitted, a copyright holder could rely on a jury's finding that one work is infringing in order to prevail as to any number of other works, which would eviscerate plaintiff's burden of proving infringement as to each work.

Finally, Antonick's evidence as to the later games as a whole cannot rely on the stipulation that each Sega Madden game "used code from" the prior one. Tr. 1340:19-1341:22. In closing, counsel argued that the stipulation "show[s] that [EA] agrees that those games, year to year, shared the code that we talked about. They share code. The code drops down, it goes from game to game." Tr. 2080:14-17. But some shared code among Sega Madden games is not the issue. The stipulation offers no evidence about how much code was passed on to each subsequent game, or whether that code included Antonick's expression of source code as to plays and formations.

For these reasons, the Court concludes that the record contains no evidence from which a reasonable juror could conclude that Apple II Madden and any of the seven Sega Madden games are virtually identical when compared as a whole. Consequently, Antonick did not prove any of the Sega Madden games are infringing works, and EA is entitled to judgment as a matter of law.

C. In the Alternative, EA is Entitled to a New Trial of Phase II

In the alternative to its Motion for Judgment as a Matter of Law, EA seeks a new trial of Phase II. For the same reasons the Court grants EA's Judgment as

id. The key question always is: Are the works substantially similar beyond the fact that they depict the same idea?").

a Matter of Law, *see* Section III.B *supra*, the Court concludes that the jury’s verdict on Question 2 is against the clear weight of the evidence. Pursuant to Federal Rule of Civil Procedure 50(c)(1), the Court conditionally grants EA’s motion for a new trial.¹²

In addition, the Court concludes that EA is entitled to a new trial based on the jury’s finding on Question 1. Antonick’s expert, Michael Barr, used flawed methods to support his opinion that EA copied Antonick’s protectable expression. Specifically, Barr (1) used reversed-engineered binary data to produce and compare visual representation of the plays in Apple II Madden and Sega Madden, rather than comparing the source code itself, and (2) relied on similarities in unprotectable elements to suggest copying of protectable expression. As such, the jury’s finding that there are substantial similarities between Sega Madden and Apple II Madden with respect to the expression in the source code of plays and formations is against the clear weight of the evidence.

Barr explained that for the purpose of his analysis, he had fragments of source code for the play editor, which included assembly language code for the formations, but not for the player instructions. Tr. 1375:5-9, 1431:22-24, 1432:5-7. For the player instructions, he had only “binary data.” Tr. 1375:1-3; *see also* Tr. 1437:16-25-1438:8-9. The source code for the play editor “generated the binary data files that are used in the program.” Tr. 1432:22-24. Because “comparing the

¹² Under Rule 50(c)(1), “[i]f the court grants a renewed motion for judgment as a matter of law, it must also conditionally rule on any motion for a new trial by determining whether a new trial should be granted if the judgment is later vacated or reversed. The court must state the grounds for conditionally granting or denying the motion for a new trial.”

source code and the binary requires a lot of human effort and programmer effort, Barr “undertook actually to automate the process to a certain extent, to generate a visual comparison of what the formations would look like and what the instructions to the players would look like.” Tr. 1377:16-19.

First, Barr reverse-engineered the binary data for plays to perform his comparison.¹³ For the formations in the fragments of play editor source code available, he “extracted” “the binary [play] data file containing those formations.” Tr. 1445:18-25. A programmer on Barr’s staff wrote “software to read in the data from both games, the play data, and generate as best we could visual images comparing the two plays.” Tr. 1377:24-25-1378:1-2. These “visual images” showed “where do each of the players appear relative to the line of scrimmage and what do they do after the formation?” Tr. 1378:2-3. Presenting the play diagrams for ten offensive plays and ten defensive plays side-by-side in Exhibit 476, Barr concluded that the plays were “effectively the same.” Tr. 1383:19-14. Barr’s analysis is deficient in several respects.

¹³ Reverse-engineering binary data does not necessarily produce the source code that created it. Barr admitted that “two experienced experts trying to approximate original source code through the process of decompiling binary code will produce different approximations of the original source code.” Tr. 1436. In other words, “the process of decompiling binary code does not re-create the original source code.” Tr. 1437; *see also Syntek Semiconductor Co., Ltd. v. Microchip Tech. Inc.*, 307 F.3d 775, 779 (9th Cir. 2002) (“[S]ource code created by decompiling object code will not necessarily be identical to the source code that was compiled to create the object code.”).

1. Barr's Comparison Of Visual Images
Generated From Binary Data Does Not
Provide Evidence Of Source Code
Copying

Antonick's burden was to prove substantial similarities between the expression of the plays and formations in the Apple II Madden source code and the expression of the plays and formations Sega Madden source code. What Barr presented, however, was a visual representation of the code for the plays and formations in Apple II Madden and its counterpart play in Sega Madden—in his words, “the output for that program that [Barr and his staff] wrote to generate what the plays would have looked like from the underlying data in both games.” Tr. 1378:23-25. By comparing the output, rather than the source code that creates it, Barr impermissibly compared the plays themselves, which, as this Court has already held and the law makes clear, are not protectable. *See* Order on 3d MSJ at 31, *see also, e.g.*, 17 U.S.C. § 102(b) (2006) (“In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery.”); *Nimmer on Copyright*, § 13.03A1 (“[C]opyright does not protect against the borrowing of abstract ideas contained in the copyrighted work. . . . if the only similarity between plaintiff's and defendant's works is that of the abstract idea, there is an absence of substantial similarity and hence, no infringement results.”). Because the protected expression here was source code in Apple II Madden, a visual depiction of the result of that source code, versus its counterpart in Sega Madden, is not evidence of substantial similarity.

Permitting Antonick to rely on the visual depiction resulting from his source code to show illicit copying would be tantamount to granting him ownership of the particular play itself. Copyright law recognizes that the same function or implementation—here, a football play—can be carried out by different authors in different ways. The Copyright Act “confers ownership only over the specific way in which the author wrote out his version. Others are free to write their own implementation to accomplish the identical function, for, importantly, ideas, concepts and functions cannot be monopolized by copyright.” *Oracle Am., Inc. v. Google Inc.*, 872 F. Supp. 2d 974, 989, 997-98 (N.D. Cal. 2012) (“[T]here might be a myriad of ways in which a programmer may . . . express the idea embodied in a given subroutine.”). In accordance with this basic principle, Antonick’s ownership is limited to the expression of the plays and formations in his source code, not the plays and formations themselves.¹⁴

For this reason, Barr’s opinion, based on “generat[ing] a visual comparison of what the formations would look like and what the instructions to the players would look like,” Tr. 1377: 17-19, is not evidence of substantial similarity in the relevant source code. Antonick offered no other source code comparison as to the expression of plays and formations.¹⁵

¹⁴ Barr admitted the printed playbook that was packaged with Apple II Madden included twenty plays similar to the twenty he compared. Tr. 1446:7-11. His analysis may be evidence that EA created plays that were visually similar to those in the printed playbook, but EA was free to do so because the printed playbook was not protected by copyright. *See* Jury Instr. (dkt. 509) at 5.

¹⁵ Antonick responds that presenting side-by-side printouts of source code would have been meaningless to the jury without the

2. Similarities In Unprotectable Elements Are Not Evidence That Protectable Elements Were Copied

When asked for his “opinion as to the similarity between Mr. Antonick’s play formations and Mr. Simmons’s play formations,” Barr testified that in his opinion, “the formations are for all practical purposes the same.” Tr. 1383:2-3. As for “the similarity between Mr. Antonick’s initial player movement and Mr. Simmons’ initial player movement,” Barr opined that most of the plays are “very similar or effectively the same, but not all the plays.” Tr. 1383:13-14. Regarding the “overall similarity” between the play numbers, play formations, and initial movement between Antonick’s game and Simmons’s, Barr “consider[ed] these plays in the Sega game to be basically a subset of the plays in the Antonick game.” Tr. 1383: 19-25:1384:1-2.

Barr further testified that “the Sega Genesis game relied on the source code from the Antonick game.” Tr. 1384:11-12. Barr’s “multiple bases” for that opinion were the similarities in: (1) field width; (2) *x* and *y* coordinates of the field; (3) misspelled terms representing the line of scrimmage; (4) subroutine names, label names, and strings; and (5) players’ formations

assistance of expert testimony, particularly because the codes were in different programming languages. *See* Phase II JMOL Opp’n at 11. This contention is baseless, as Barr did just that to compare the source code of a play in Sega Madden 1995 with its counterpart play in Super Nintendo Madden 1995. Tr. 1398:16-25-1399:1-24. Despite the difference in assembly languages used in those two games, Barr was able to explain to the jury why he concluded that the expressions of the play in the source code were identical. Tr. 1398:16-25-1399:1-17. The problem is not that Barr offered expert testimony about similarity in the source code, but rather that he opined about the similarity of the codes’ *output*.

and initial movements. Tr. 1384:13-25-13851-8. Explaining why he believed that Antonick's "source code was leveraged in making the Sega Genesis game, and not the playbook," Barr stated that it was because the playbooks did not indicate that the field should be 80 yards or any wider than a regulation field, that the variable x should represent field width and y field length, that the game should have a 0 to 7 plus 8 directional system, or particular phrases in the code, such as "double fl," "double se," or "short zone." Tr. 1484:20-23-1485:1-19.

In light of this testimony, the Court finds that Barr relied on similarities in unprotectable elements to opine about the substantial similarity of the protectable elements. This approach is plainly contrary to Ninth Circuit law, and not evidence that would properly support the jury's finding. It is well-settled that "the party claiming infringement may place *no* reliance upon any similarity in expression resulting from unprotectable elements." *Apple Computer, Inc.*, 35 F.3d at 1446 (internal quotation marks omitted). *Apple Computer, Inc.*, 35 F.3d at 1446. The very purpose of comparing protected elements is to determine whether the particular elements of each game are substantially similar. Using unprotectable elements to infer that protectable elements were copied is not proper evidence of whether the protected elements themselves are substantially similar. *See Brocade Commc'ns Sys., Inc. v. A10 Networks, Inc.*, 873 F. Supp. 2d 1192, 1218 (N.D. Cal. 2012) ("In determining whether 'copying' has been shown in the context of computer software, 'which ordinarily contains both copyrighted and unprotected or functional elements,' a court determines 'whether the *protectable elements, standing alone*, are substantially similar.'") (quoting

Sony Computer Entm't, Inc. v. Connectix Corp., 203 F.3d 596, 599 (9th Cir. 2000)) (emphasis added).

In defense of Barr's testimony, Antonick misconstrues the role of unprotectable elements in the jury's consideration of the works as a whole. The unprotectable elements must be identified and the works considered as a whole so that the trier of fact can determine whether the works are virtually identical as a whole as a result of defendant's copying or due to the similarities in unprotectable expression—not, as Antonick posits, to allow the trier of fact to infer copying of protectable expression. *See Shaw v. Lindheim*, 809 F. Supp. 1393, 1403 (C.D. Cal. 1992) (explaining that the Supreme Court made clear that a lack of similarity between original protected expression is fatal to a plaintiff's copyright claim; in other words, substantial similarities between unprotected elements, like those presented by plaintiff's expert witness at trial in this case, cannot be used to find substantial similarities in the protectible expression of two works.") (citing *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 379-80 (1991)). Nevertheless, in closing, Antonick's counsel urged the jury to make this inference. *See* Tr. 2073:12-17 ("You have to have those same [directional controls] if you're using Mr. Antonick's play data. You have to have those same numbers or the data won't work. So the fact that they have that directional control shows you, it's evidence of the fact that they are using the same play data because it's not a coincidence.").

The jury's finding of substantial similarity as to Antonick's plays and formations source code in the later versions of Sega Madden is also against the clear weight of the evidence. When asked for his "opinion about whether each 1990 to 1996 Sega Madden game

derived from or was based on the Antonick Apple II game,” Barr testified that “overall,” the games “that we have contain a set of plays that includes a subset of the plays in Mr. Antonick’s games.” Tr. 1401:18-25-1402:1-3. In addition to relying on the similarity of unprotectable plays, Barr’s opinion—essentially that Sega Madden’s plays included some plays from Apple II Madden as well as others—is not evidence that the expression of the plays and formations in these games’ source code is substantially similar to Antonick’s.

For these reasons, the Court concludes that the jury’s finding on Question 1 was against the clear weight of the evidence. Accordingly, EA is entitled to a new trial on the issue of whether there are substantial similarities between the expression of plays and formations in the Apple II Madden source code and the expression of plays and formations in Sega Madden.

D. Antonick’s Non-Copyright Claims Dismissed Before Trial

Prior to Phase II, the Court granted EA’s Third Motion in Limine, which sought to exclude evidence of ancillary contract breaches, *see* 6/26/13 Hr’g Tr. (dkt. 457) at 47, and held that Antonick failed to state a claim for fraud, *see* Phase II Pretrial Order (dkt. 460) at 5. The Court stated its intent to provide its reasoning for these rulings in a subsequent order, and does so now.

1. Antonick Did Not State Claims For Non-Copyright, Ancillary Contract Breaches

In the course of discovery, Antonick raised four additional breaches not alleged in his complaint, specifically, that EA failed to (1) put copyright notices on other Madden games that are Derivative Works

under the Contract; (2) give Antonick a right of first refusal to develop other Madden games that would have been Derivative Works under the Contract; (3) maintain Antonick's confidential information (4) register Antonick's copyrights. *See* Pl.'s 3rd Am. Resp. to Rog. 1 (dkt. 294-11) at 5-6; Pl.'s. Resp. to Rog. 5 at 5-6. Prior to Phase II, the Court granted EA's motion in limine to exclude evidence of these so-called ancillary breaches, *see* 6/26/13 Hr'g Tr. at 47; *see generally* Mot. Limine 3 (dkt. 374), concluding that Antonick failed to state a claim for these ancillary breaches because he did not demonstrate separate damages. Instead, the sole damages named in his interrogatory responses and damage expert report were royalties for Derivative Works under Section V of the 1986 Contract.

Contrary to Antonick's position that nominal damages combined with disgorgement of EA's profits would serve as his damages for these ancillary breaches, the Court finds that royalties on EA's sales as provided in the 1986 Contract are the appropriate measure. Disgorgement of EA's profits on derivative works, is not only unnecessary to make Antonick whole, but it would have provided a windfall by awarding him more than he would have collected absent the breach. As for Antonick's "lost opportunity" claim for EA's alleged failure to give him the right of first refusal, awarding Antonick the profits EA earned on a game Antonick had no role in developing assumes that Antonick would have not only accepted EA's offer to develop the derivative work but also that his game would have generated the same profits as EA's version. This is highly speculative. Because the allegations are all variations on the claim that EA breached the 1986 Contract, and royalties are an appropriate remedy of

a breach, there is no basis for awarding another form of damages.

2. Antonick Did Not State Claim For Fraud

Antonick's fraud claim does not survive independent of his breach of contract claim because he failed to allege that EA breached a duty independent of the contract or intentionally caused him harm beyond the contract breach. *See Oracle Am., Inc. v. Serv. Key, LLC*, No. C 12-00790 SBA, 2012 WL 6019580, at *9 n.5 (N.D. Cal. Dec. 3, 2012) ("Under California law, to maintain a fraud claim based on the same factual allegations as a breach of contract claim, a plaintiff must show that 'the duty that gives rise to tort liability is either completely independent of the contract or arises from conduct which is both intentional and intended to harm.'") (quoting *Robinson Helicopter Co., Inc. v. Dana Corp.*, 34 Cal. 4th 989, 990 (2004)).

Instead, the allegedly fraudulent statements on which Antonick's claim relies were simply representations that EA was adhering to the contract and therefore cannot form the basis of a separate fraud claim. *See JMP Sec. LLP v. Altair Nanotechnologies Inc.*, 880 F. Supp. 2d 1029, 1043 (N.D. Cal. 2012) (applying economic loss rule to dismiss fraud and negligent misrepresentation claims that "consist of nothing more than [defendant's] alleged failure to make good on its contractual promises."); *Oracle USA, Inc. v. XL Global Servs., Inc.*, No. C 09-00537 MHP, 2009 WL 2084154, at *4 (N.D. Cal. July 13, 2009) ("[T]he fundamental rule in California is that no tort cause of action will lie where the breach of duty is nothing more than a violation of a promise which undermines the expectations of the parties to an agreement.").

Nor can Antonick's claim rely on the allegation that EA fraudulently concealed their wrongdoing by assuring him that Sega Madden was being developed without reference to his intellectual property. Because the jury found in Phase I that his claim is not barred by the statute of limitations, he cannot show reliance or damages arising from these statements.

IV. CONCLUSION

For the foregoing reasons, EA's Motion for Judgment as a Matter of Law re Phase I is DENIED. EA's Motion for Judgment as a Matter of Law re Phase II is GRANTED and its Motion for a New Trial is conditionally GRANTED. Antonick's Motion for Prejudgment Interest (dkt. 528) and Motion for Entry of Final Judgment as to his Fraud Claim (dkt. 542) are DENIED AS MOOT.

IT IS SO ORDERED.

Dated: January 22, 2014

/s/ Charles R. Breyer
CHARLES R. BREYER
UNITED STATES DISTRICT JUDGE

APPENDIX D

Legal Provisions Involved

17 U.S.C. § 101

Definitions

Except as otherwise provided in this title, as used in this title, the following terms and their variant forms mean the following:

* * *

A “compilation” is a work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship. The term “compilation” includes collective works.

A “computer program” is a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result.

“Copies” are material objects, other than phonorecords, in which a work is fixed by any method now known or later developed, and from which the work can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. The term “copies” includes the material object, other than a phonorecord, in which the work is first fixed.

* * *

A work is “created” when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.

A “derivative work” is 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.”

* * *

A work is “fixed” in a tangible medium of expression when its embodiment in a copy or phonorecord, by or under the authority of the author, is sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.

* * *

“Literary works” are works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied.

17 U.S.C. § 102

Subject matter of copyright: In general

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works.

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* * *

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.