Failure to Introduce Source Code of Original Work Fatal to Claim Against Alleged Derivative Work

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The US Court of Appeals for the Ninth Circuit affirmed an order dismissing a breach of contract action, finding that the plaintiff failed as a matter of law to establish copyright infringement under the copyright law—upon which his contract claim depends. *Antonick v. Electronic Arts, Inc.*, Case No. 14-015298 (9th Cir., Nov. 22, 2016) (Hurwitz, J). This case highlights the failure to introduce critical evidence.

Antonick developed the computer code for the original John Madden Football game that Electronic Arts (EA) released in 1988 for the Apple II computers. The game was an instant hit. In 1989, Antonick began working on Madden games for Nintendo and Sega Genesis. In 1990, EA told him to stop, and hired Park Place Productions to work on the Sega game instead. The Madden games became quite lucrative; each year from 1992 to 1996, EA sold millions of copies of Madden games for Sega Genesis and Super Nintendo, and attracted a loyal fan base.

Antonick's 1986 contract with EA provided that he would receive royalties for any "Derivative Work . . . of the Work within the meaning of the United States copyright law." The contract defined the "Work" as the "John Madden Football" designed for the "Apple [II] Family of Computers."

In 2011, Antonick brought a diversity action against EA seeking contract damages in the form of unpaid royalties for the Sega and Super Nintendo games, which he claimed were derivatives of his work. Because royalties are available only for a derivative work within the meaning of the US copyright law, Antonick had to prove copyright infringement under the Ninth Circuit's two-part extrinsic/intrinsic test by showing that the defendant had "access" to the plaintiff's work and that the two works are "substantially similar."

Antonick argued that Park Place had copied his source code in order to meet the deadline for the first Sega game and presented expert testimony that the Sega game was substantially similar to the Apple II game, including, but not limited to, similar formations, plays, player ratings and variable names, as well as variables that misspelled "scrimmage." After the jury's verdict for Antonick was vacated on EA's motion for judgment as a matter of law, Antonick appealed.

The Ninth Circuit affirmed, explaining that Antonick's failure to put into evidence the source code for the "Work" (*i.e.*, Apple II Madden), the source code of any allegedly infringing works and/or any

images of the games at issue was fatal to his case. As the Court explained, absent that evidence, the jury could not compare the works to determine substantial similarity. Also, the Court found that the evidence Antonick did introduce was insufficient: access to source code alone cannot establish infringement, nor can evidence that demonstrated, at most, a "possible motive to copy." Finally, the Court agreed that the expert testimony presented failed to satisfy Antonick's burden under the intrinsic test that depends on the response of the ordinary reasonable person.

The Ninth Circuit also found that Antonick's claims regarding the Super Nintendo game were flawed. Because the Super Nintendo game was not on a platform in the "Same Microprocessor Family" as the Apple II, it was not a derivative work under the contract. Further, although EA failed to give him the opportunity to develop the game as required under the contract, there was insufficient evidence for the jury to determine Antonick's damages from the alleged breach to a "reasonable certainty." Finally, Antonick's failure to introduce source code precluded a finding that the Super Nintendo game was a derivative work, which in turn rendered any error in the district court's damages decision harmless.

Practice Note: When drafting development contracts, copyright holders should carefully consider whether to define "derivative work" outside the context of the Copyright Act.

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