

COURT OF APPEAL FINDS ALL ROADS LEAD TO ROM

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If there ever were doubts as to whether law was a science or an art, the reading of the reasons for judgment of the Federal Court of Appeal of Canada in *MACKINTOSH COMPUTERS LTD. et al. v. APPLE COMPUTER INC. et al.* and *JAMES BEGG et al. v. APPLE COMPUTER INC. et al.* (Court No. A-275-86 Judgment rendered at Ottawa on 13 October 1987) should convince everyone that it is an art. Rarely have such distinguished jurists come to the same conclusions via so many different routes.

These were two appeals from judgments rendered by Madam Justice Reed (1986), 10 C.P.R. (3d) 1. As Mr. Justice Hugessen puts it: "The Appellants have in popular parlance, pirated two computer programs used by the Respondents in their Apple II computer. It is common ground that the programs in question, when written, as they originally were, in letters, symbols and figures known as 6502 assembly code, were original literary works subject to copyright and that the copyright therein vests in respondent Apple Computer Inc. But the Appellants have not copied the programs written in assembly code. They have not copied any writing at all. What they have done is reproduce apparently by mechanical means, the electrical circuitry of a silicon chip (ROM chip) in which, by the magic of computer science, the programs are embodied. The question at issue is to know whether the Appellants have infringed the Respondents' copyright in the original assembly code programs."

At trial, the question was answered in the affirmative. On appeal, it was also answered in the affirmative by Justices Mahoney, Hugessen, and MacGuigan, but for different reasons. Three distinct copyright issues are of interest in the decision: the issue of translation, the issue of reproduction, and the question of infringing contrivances .

Translation. Madam Justice Reed had found at trial that the conversion of the programs in issue from assembly language in which they were originally written to hexadecimal machine language was a translation falling within s.

3(1)(a) of the Copyright Act. Mr Justice Mahoney disagreed with that finding and stated that such a conversion was not a translation contemplated by the Act.

Mr. Justice Hugessen also found that Madam Justice Reed had gone wrong on the translation issue. He wrote: "I cannot accept, as the trial judge seems to have done, that the Appellants' chips were a 'translation' of the Respondents' programs, contrary to paragraph 3(1)(a). In my view, 'translation' is used here in its primary sense of the turning of something from one human language into another. "

Mr. Justice MacGuigan was not as categorical as the other Justices. He did quote, without disagreeing, passages of Madam Justice Reed's judgment on the question. He did not, however, find it necessary to decide the issue because of conclusions based on the question of reproduction.

Reproduction. Mr. Justice Mahoney found that the embodiment of the programs in the ROM chips can be considered a reproduction of the original programs, and that the exclusive right to reproduction was the Respondents' prerogative. In coming to this conclusion, he said, he was in full agreement with Mr. Justice MacGuigan, who had in his reasons for judgment distinguished the judgments of a majority of the High Court of Australia in *COMPUTER EDGE v. APPLE* (1986), 65 A.L.R. 33. Both Messrs. Justice Mahoney and MacGuigan had little hesitation in arriving at such a conclusion. It was not as easy for Mr. Justice Hugessen.

The latter also came to the conclusion that the Appellant's chips are a reproduction of the assembly code programs in which the Respondents held the copyright. He found, however, that it was necessary for him to expand somewhat on the process by which he arrived at that conclusion. It seemed obvious to him that when one reproduces a work, that result must be a "work" in order that the reproduction be considered an infringement. If what is being reproduced is a literary work, as is the case here, the result must necessarily be a literary work, i. e., expressed in print or writing. However, in the present case, he found that the result of the reproduction was not a literary work but "open-and-closed electrical circuits" embodied in a silicon chip. One would have expected Mr. Justice Hugessen to conclude, because of the foregoing that there was no infringement of the copyright. He did not.

On the contrary, he then went through a wellstructured reasoning, at the end of which he concluded that anyone who makes and sells to the public anything (*i.e.*, the Appellants' ROM chips) designed or intended to reproduce a copyrighted work gives an implied authorization to the purchaser to effect such reproduction. He found that the means of reproduction did not itself

constitute a reproduction within the meaning of subsection 3(1) of the Act, but that the implied authorization to reproduce constituted infringement.

Chips as Infringing Contrivances. Mr. Justice Mahoney gave indications that he saw some merit in the argument that the ROM chips were infringing contrivances within the meaning of s. 3(1)(d). However, Mr. Justice Mahoney, agreeing with Mr. Justice MacGuigan, found that it was not necessary to decide that issue, in view of his finding that the Respondents' computer programs embodied in their ROM chips were reproductions of the computer programs written in assembly language in which copyright is admitted to have subsisted.

For Mr. Justice Hugessen, ROM chips are not contrivances by means of which the work may be mechanically performed or delivered within the meaning of s. 3(1)(d). He came to this conclusion based on his analysis of the definitions of the words "performance" and "delivery".

Conclusion. Even though Bill C-60, a bill to amend the Copyright Act, should become law in the foreseeable future and therefore cure many of the deficiencies of the present Copyright Act concerning computer software, this judgment of the Federal Court of Appeal will remain an important decision, not so much for its conclusions as for the reasoning behind them. All roads lead to ROM

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