

No. 18-956

IN THE
Supreme Court of the United States

GOOGLE LLC,

Petitioner,

v.

ORACLE AMERICA, INC.,

Respondent.

ON WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**BRIEF OF *AMICUS CURIAE* THE ASSOCIATION
OF AMERICAN PUBLISHERS, INC. IN
SUPPORT OF RESPONDENT**

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INTEREST OF THE *AMICUS CURIAE*¹

The Association of American Publishers, Inc. (“AAP”) represents book, journal, and education publishers in the United States on matters of law and policy, including major commercial houses, small and independent houses, and university presses and other noncommercial scholarly publishers.² AAP has a particular mandate and expertise in copyright law, seeking to promote an effective and enforceable framework that enables publishers and their technology partners to create and disseminate original works of authorship through ever-evolving business models to the benefit of their customers and the worldwide public. AAP believes it is vital to maintain the traditional balance that Congress and this Court have established between authors and users of creative works, including by maintaining effective norms of licensing for downstream use.

SUMMARY OF ARGUMENT

The judgment of the Federal Circuit should be affirmed. The Court below held that the activities

1. Pursuant to Rule 37.6, counsel for *amicus curiae* states that no counsel for a party authored this brief in whole or in part. No counsel or party made a monetary contribution intended to fund the preparation of this brief, and no person other than *amicus* or its counsel made such a contribution. The parties have consented to the filing of this brief.

2. Maria A. Pallante is President and Chief Executive Officer of the Association of American Publishers and served as U.S. Register of Copyrights from 2011 to 2016. Allan Adler is Executive Vice President and General Counsel of the Association of American Publishers. Robert Clarida is a partner at Reitler Kailas & Rosenblatt LLC.

of Petitioner Google violated the exclusive rights of Respondent Oracle by copying significant amounts of code from Oracle's Java SE software ("Java Code") into Google's Android software without authorization. The Court correctly rejected the two principal affirmative defenses proffered by Google, *i.e.*, the merger doctrine and the fair use defense under § 107 of the Copyright Act.

As the Federal Circuit explained, the merger doctrine does not apply to Google's conduct because it is undisputed that the expression in the Java Code could have been written in many different ways without impairing its functionality. The Federal Circuit also correctly held that Google's activities did not constitute a fair use under § 107 of the Act. The use of the Java Code by Google was purely commercial, abundant and did not transform the Code at all, either as to its content or its purpose. Google's reproduction and distribution of the Java Code as incorporated into Android directly superseded the legitimate market for the Java Code.

ARGUMENT

The Federal Circuit correctly applied fundamental copyright principles to find that Google's copying of the Java Code was an infringement of Oracle's exclusive rights in that Code. This Court should affirm the Federal Circuit's decision.

When creating the statute that became the Copyright Act of 1976 (the "Act"), Congress engaged in an extensive legislative process under the so-called CONTU

Commission³ and concluded that no *sui generis* protection was necessary or appropriate for computer programs.⁴ As recommended by CONTU, such works are protected under the Act as literary works. A straightforward application of the Act here, consistent with the rulings of this Court and the lower courts in countless copyright disputes under the Act, requires affirmance.

I. UNDER FUNDAMENTAL COPYRIGHT PRINCIPLES, GOOGLE DIRECTLY INFRINGES ORACLE'S EXCLUSIVE RIGHTS IN THE JAVA CODE

Section 106 of the Act enumerates six exclusive rights enjoyed by the owner of a copyrighted work, including at §106(2) the right “to prepare derivative works based on the copyrighted work.” A “derivative work” is defined in §101 as “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which,

3. NAT'L COMM'N ON NEW TECH. USES OF COPYRIGHTED WORKS, FINAL REPORT (1979)(“CONTU Report”).

4. CONTU Report at 12; Computer Software Copyright Act of 1980, Pub. L. No. 96-517, §10, 94 Stat. 3015, 3018 (1980). See generally, Oman, Ralph, COMPUTER SOFTWARE AS COPYRIGHTABLE SUBJECT MATTER: ORACLE V. GOOGLE, LEGISLATIVE INTENT, AND THE SCOPE OF RIGHTS IN DIGITAL WORKS, 31 Harvard Journal of Law & Technology, Special Issue (Spring 2018).

as a whole, represent an original work of authorship, is a ‘derivative work.’”⁵

Android is a derivative work of the Java Code, because it incorporates significant portions of the Java Code *verbatim*. The standard for determining whether a derivative work infringes copyright in the underlying work is substantial similarity, *i.e.* whether the second work copies “material of substance and value“ from the original.⁶ Here, Google copied more than 11,000 lines of code that Google itself characterizes as vital to the success of Android. Petitioner’s Brief (“Pet. Br.”) at 26. Google also distributed that copied code as incorporated into Android. Thus Google infringes Oracle’s exclusive rights in the Java Code.

5. Even though the statute uses the term “transformed” in the definition of “derivative work,” it is not the case that every derivative work is “transformative” in the sense used by this Court in *Campbell v. Acuff-Rose Music Corp.*, 510 U.S. 569 (1994), which was in turn based on a 1990 law review article by Judge Pierre N. Leval, *see infra*, not on the text of the statute. As Judge Leval recognized in *Authors Guild v. Google, Inc.*, 804 F.3d 202, 216 (2d Cir. 2015), “oversimplified reliance” on the term transformative ignores the fact that “paradigmatic examples of derivative works include the translation of a novel into another language, the adaptation of a novel into a movie or play, or the recasting of a novel as an e-book [citations omitted]. While such changes can be described as transformations, they do not involve the kind of transformative purpose that favors a fair use finding.”

6. *Jacobson v. Deseret Book Co.*, 287 F.3d 936, 943 (10th Cir. 2002); *Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1296 (D.C. Cir. 2002); *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.*, 672 F.2d 607, 614 (7th Cir. 1982).

Android also contains significant amounts of original expression created by Google, but that additional expression does not provide a defense to the infringement. A film derived from a book likewise contains significant new expression, such as cinematography, music and set design, but these do not enter into the infringement analysis if an author asserts a claim against the film. As Learned Hand long ago recognized, “no plagiarist can excuse the wrong by showing how much of his work he did not pirate.”⁷ Nor does the downstream creativity of third-party developers play any role in analyzing Google’s infringement. The code written by these developers may or may not be infringing, but that issue is not before the Court. This case is accordingly unlike *Sony Corp. of Am. v. Universal City Studios, Inc.*⁸ (“*Sony*”), frequently cited by Google and its *amici*. In *Sony*, this Court assessed the potential liability of Sony as an indirect, contributory infringer. Sony did not copy or otherwise use the copyrighted works of Respondent Universal, but merely sold equipment that allowed users to do so. The case turned on whether the *users* of the Sony equipment were making infringing uses. Here, the conduct of the third-party Android developers is irrelevant to establishing Google’s infringement liability.

This case also bears no relation to the so-called “reverse engineering” cases like *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992) and *Sony Computer Entm’t, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000), because in those cases the copied code

7. *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936).

8. 464 U.S. 417 (1984).

was not incorporated into the defendant's own product. It was used only to gain access to unprotectable ideas and processes in the plaintiffs' works for purposes of achieving interoperability. The alleged infringement was the defendant's "intermediate" copying of plaintiff's code as a step in creating a non-infringing, interoperable end product. Here, it is undisputed that Google's Android incorporates the Java Code into the end product, and that the end product is not interoperable with Java.

II. THE COURT SHOULD REJECT GOOGLE'S MERGER ARGUMENT

In the initial appeal of this action to the Federal Circuit,⁹ that Court correctly held that the Java Code was copyrightable under the standard of copyrightability established by this Court in *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*¹⁰ Google here raises the merger doctrine as a defense, Pet. Br. at 19-34, arguing that the copied declarations in the Java Code "can only be written one way to perform their function of responding to the calls already known to Java developers." *Id.* at 19. That argument is premised on a definition of "function" that has no support in the Act or the decisions of this or any other Court. When CONTU and Congress referred to "function" in connection with computer programs, they spoke in terms of the "electromechanical functioning of a machine," CONTU Report at 20, or the "certain result" that is brought about when the program is used in a computer, as set forth in the definition of "computer program" in § 101 of the Act: "A 'computer program' is

9. 750 F.3d 1339, 1381 (Fed. Cir. 2014).

10. 499 U.S. 340 (1991).

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

The function on which Google rests its merger argument is not the “electromechanical functioning of a machine” but simply the “function” of replicating elements of Java. The CONTU Report recognizes (at 20) that merger might apply if specific instructions in computer code were “the only and essential means of accomplishing a given task,” but provides no support whatsoever for the idea that the “given task” can itself be defined in such a way that there is only one way to accomplish it. Google’s definition is a tautology: The “task” as Google defines it is to perform a function (any function) using the Java Code, therefore the Java Code is the only and essential means of accomplishing that task. Google argues that there is only one way to write code that “correctly” or “properly” responds to the developers calls, Pet. Br. at 21, but the only thing that makes the copied code in Android “correct” or “proper” is that it duplicates Java. In short, Google is conflating the task with the means of expression used to carry it out.

If Google’s novel definition of “function” were accepted, it would eviscerate copyright protection for software. To illustrate by example, Microsoft PowerPoint is a very popular program, and many students learn to use it in school. If a student decides that she would like to be able to do PowerPoint projects at home, on her laptop, any third party developer could, under Google’s merger theory, sell that student an exact, unauthorized copy of PowerPoint because its “function,” according to the developer, is to respond to the commands already known

to PowerPoint users. The ability of a piece of software to appeal to users who already know certain other software is a feature, not a function.

Even Google seems to recognize the absurdity of such a definition of “function,” because it defines the term differently elsewhere in Petitioner’s Brief. Google asserts (at 44) that the function of the Java Code, or indeed of any declaring code, is “to point a computer to the creative implementing code.” It then asserts at 46 that declarations “serve two relevant functions: connecting the developer’s applications to the methods’ implementing code and defining the organizational structure in which the methods are stored.” These are electromechanical functions, this is what CONTU and Congress spoke to, and what the merger doctrine addresses. These electromechanical functions can be accomplished many different ways, however, and Google admits that Sun could have written Java differently to accomplish these functions. Pet Br. at 31. *Ex ante*, there was no reason, no functional constraint, that required the Java Code to be expressed in exactly the way Sun wrote it. Merger is therefore inapplicable. Google’s contention that the Java Code “can only be written one way to perform [its] function of responding to the calls *already known to Java developers*,” Pet. Br. at 19 (emphasis added), is beside the point. What Java developers may or may not know is irrelevant to the “electromechanical functioning of a machine.” The machine doesn’t care. Neither does the Copyright Act, and neither should this Court.

The true “function” that is served by Google’s use of the Java Code is not performed by a computer at all; it is the purely marketplace-driven, profit-maximizing function of attracting third-party developers to write

Android apps. Google argues (at 31) that “once Sun released Java SE, Google *had to* use the declarations from the Java SE libraries to respond properly to the existing calls that developers then knew” (emphasis added), but the only consequence of doing otherwise would have been slower adoption of Android by developers, as Google admits: “any *successful* new product must be as compatible as possible with the relevant existing skills and experience of the users it seeks to support.” *Id.* at 26 (emphasis added). Later in its brief (at 39) Google describes the use of the Java Code as an “accelerant” for Android in the marketplace. Not an electromechanical necessity, but a feature that would help attract developers, because they could “avoid the drudgery” of learning new code.¹¹ Google further argues (at 48) that Java was “not suitable” to the smartphone market, so it appears that Google wanted this marketplace advantage badly enough to incorporate sub-optimal code into Android, rather than writing new code better suited to the electromechanical realities of modern smartphones, which Google admits (at 14) it could “easily” have done. That looks less like innovation, and more like the pursuit of a larger market by riding the coattails of an earlier innovator, one who was ready, willing and able to enter into a license agreement with Google for precisely this use.

Even among the developer community, Google admits that there were “countless new developers” of Android products who did not even know Java before Android

11. *Campbell v. Acuff-Rose Music Corp.*, 510 U.S. 569, 579 (1994) (“*Campbell*”). As *Campbell* makes clear, “avoid[ing] the drudgery of working up something fresh” is exactly what the Copyright Act prohibits the creators of derivative works from doing.

launched. Pet. Br. at 9. This, in itself, refutes Google’s proposed definition of the “function” served by the Java Code, unless Google contends that the Code somehow performs a different function depending on whether the developer using it previously knew Java. Again, the machine doesn’t care. The existence of “countless” Android developers without Java experience belies the argument that the Java Code’s expression is the only way for Android to operate, because Java provided no benefit to them at all. Those developers could just as well have written their Android apps without using the Java Code. The Code cannot be subject to merger for some developers, but not for others.

Google relies on *Feist v. Rural Tel. Serv. Co.*¹², in which this Court held that facts are unprotectable by copyright, but the Java Code is Sun-created expression, not a fact discovered in the world. It is instead more akin to the alleged “facts” of the *Seinfeld* television series that the Second Circuit found protectable in *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*¹³ In *Castle Rock*, defendant published a book of trivia questions about the series, called *The Seinfeld Aptitude Test*, which contained 643 questions about the characters, dialogue, and plot details of 84 of the show’s 86 episodes. The defendant argued, *inter alia*, that the questions dealt only with facts –what did character X do in episode Y? The district court granted summary judgment for Castle Rock, and the Second Circuit affirmed, reasoning that the facts depicted in a *Seinfeld* episode are utterly unlike the facts depicted in a biography, historical text, or compilation. *Seinfeld* is fiction; both the “facts” in the various episodes,

12. 499 U.S. 340 (1991).

13. 150 F.3d 132 (2d Cir. 1998).

and the expression of those facts, were created by the show's producers. So too here. It may be a "fact" that Java requires a programmer to use declaration X to call process Y, just as it's a fact that Kramer buys a cigar store Indian in episode XYZ of *Seinfeld*. And while there may well be scenarios where the use of such "facts" that "owe their origin to an act of authorship" would constitute fair use, it is inconceivable that fair use would apply to the incorporation of such author-created "facts" in a subsequent work where, as with the *Seinfeld* trivia book, the later work is commercial, lacks any transformative purpose, and takes such "facts" for use in an amount that is significant in both quantitative and qualitative terms.

To that extent, Java-experienced Android developers are analogous to fans who write *Seinfeld* fan fiction of this nature. Just as the latter know the backstory and character attributes of Jerry, Kramer, George and Elaine, and use that knowledge to create new expression without "the drudgery of working up something fresh," the developers use their knowledge of Java, and the Java expression provided to them by Google, to create new code in Android. But in neither case is the pre-existing expression necessary to the function of the new expression. It may be convenient, an "accelerant," but the merger doctrine does not exist for the sake of increasing the convenience of making derivative works.

III. THE COURT SHOULD REJECT GOOGLE'S FAIR USE ARGUMENT

A. Google's Use Is Not Transformative

Apart from and in addition to considering the statutory factors in 17 U.S.C. 107, *see infra*, the Circuit

Courts have followed this Court's holding in *Campbell v. Acuff-Rose Music Corp.*¹⁴ that a court should consider whether the defendant's use of copyrighted expression is "transformative," that is, whether it "employ[s] the quoted matter in a different manner or for a different purpose from the original." The language is drawn from a 1990 Harvard Law Review article by Judge Pierre N. Leval (now of the Second Circuit), *Toward a Fair Use Standard*, which proposed the term "transformative use" to describe acceptable types of fair uses:

The use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original. A quotation of copyrighted material that merely repackages or republishes the original is unlikely to pass the test; in Justice Story's words, it would merely "supersede the objects" of the original. If, on the other hand, the secondary use adds value to the original—if the quoted matter is used as raw material, transformed in the creation of new information, new aesthetics, new insights and understandings—this is the very type of activity that the fair use doctrine intends to protect for the enrichment of society. Transformative uses may include criticizing the quoted work, exposing the character of the original author, proving a fact, or summarizing an idea argued in the original in order to defend or rebut it. They also may include parody, symbolism, aesthetic declarations, and innumerable other uses.¹⁵

14. 510 U.S. 569 (1994).

15. 103 Harv. L. Rev. 1104, 1111 (March 1990).

This Court adopted this approach in *Campbell*¹⁶ as a non-statutory consideration that can affect analysis of both the first and fourth statutory factors. If the defendant’s use is transformative, this can reduce the effect of factors, such as commerciality and market harm, which would otherwise weigh against the defendant’s use under the statute. The Federal Circuit correctly held (886 F.3d 1179, 1199) that Google’s use of the Java Code was not transformative, because “(1) it does not fit within the uses listed in the preamble to §107; (2) the purpose of the API packages in Android is the same as the purpose of the packages in the Java platform; (3) Google made no alteration to the expressive content or message of the copyrighted material; and (4) smartphones were not a new context.”

This Court’s only extant decision on a claim of transformative use was in the specific context of parody in *Campbell*, where the expressive content of plaintiff’s work itself was altered for purposes of commenting on that particular work. No such commentary is claimed by Google here. Android made no comment on the Java Code, but merely incorporated it into Android for the same purpose that it serves in Java, *i.e.* to “call” operations by use of the same expression that Java uses to call them. Google and *Amicus* Microsoft Corp. assert that the Federal Circuit erred by taking a “rigid view of the ‘purpose’ of Google’s reuse” of the Java Code,¹⁷ but the Federal Circuit’s view is no different than that of this Court in *Campbell*. The purpose of the Java Code copied into Android is precisely the same as the purpose it serves in Java.

16. 510 U.S. 569 (1994).

17. See Brief of *Amicus Curiae* Microsoft Corporation at 27.

Since *Campbell*, several Circuits have extended the transformative use analysis to reach various forms of electronic duplication of copyrighted works in their entirety, with no change in their content, where the use arguably serves a fundamentally different purpose. This Court has not yet accepted a case where it could have ruled on applying transformative use in this manner. Prior to *Campbell*, a similar argument had been rejected by the Second Circuit in *Infinity Broadcast Corp. v. Kirkwood*,¹⁸ for example, which held that the transmission of radio programming to distant cities by telephone, for purposes such as allowing sponsors to verify the airing of ads, was not transformative. *Infinity Broadcast* emphasized the fact that the defendant did not transform the plaintiff's works, but merely repackaged them, in their entirety, in a different format.

Even where such an expansive notion of transformativeness has been applied in the Circuits, however, merely making a work available on new platform to increase its accessibility or utility is not enough. As the Second Circuit held in *Authors Guild, Inc. v. HathiTrust*,¹⁹ “added value or utility is not the test: a transformative work is one that serves a new and different function from the original work.” *See also id.* at 97 (no transformative use found where defendant merely recasts “an original work into a new mode of presentation,” quoting *Castle Rock Entm't, Inc. v. Carol Publ'g Grp., Inc.*, 150 F.3d 132, 143 (2d Cir. 1998)).

18. 150 F.3d 104 (2d Cir. 1998).

19. 755 F.3d 87, 96 (2d Cir. 2014).

The Second Circuit’s decision in *Authors Guild v. Google, Inc.*,²⁰ (Leval, J.) (“*Google Books*”) makes clear, at 214, that even when a use “expands [the] utility” of the original work, the second work must be “different in purpose, character, expression, meaning and message” from the copied material. In that case, Google had scanned large numbers of copyright-protected books in order to make a searchable database, which the Court found did not allow users to access a significant amount of the content. Under those specific conditions, the Second Circuit held that the purpose of Google’s book copying was “to make available significant information *about those books*” (emphasis original), and not merely to reproduce the text in electronic form. *See id.* at 217 and 221 (“while Google *makes* an unauthorized copy of the entire book, it does not reveal that digital copy to the public”) (emphasis original). In fact, the *Google Books* court states in so many words that “recasting of a novel as an e-book or an audiobook” does not “involve the kind of transformative purpose that favors a fair use finding.” *Id.* at 215.

The Second Circuit has since made clear in *Capitol Records LLC v. ReDigi Inc.*²¹ that any use which serves as an “effective substitute” for the original cannot properly qualify as transformative. *ReDigi* at 27, 29 (unauthorized creation of “effective substitute” for plaintiff’s work impedes the purpose of copyright). The record in this case indicates that Android was an effective substitute for Java, to the extent that Oracle’s own market for issuing paid licenses for Java was diminished once Google began making Android available for free.

20. 804 F.3d 202 (2d Cir. 2015).

21. 910 F.3d 649 (2d Cir. 2018).

Accordingly, the Federal Circuit was correct to hold that Google's use of the Java Code was not transformative.

B. The Federal Circuit Reached The Correct Conclusion Under The Statutory Factors

The 1976 Copyright Act codifies the defense of fair use, which courts had recognized as a non-statutory equitable defense since early in the 19th century.²² The text of Section 107 of the Act reads as follows:

Notwithstanding the provisions of section 106, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and

22. See *Folsom v. Marsh*, 9 F. Cas. 342 (D. Mass. Oct. 1841).

(4) the effect of the use upon the potential market for or value of the copyrighted work.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.²³

Because the statute recognizes fair use as an affirmative defense to a claim of infringement, the burden of persuading the court that a use is fair ultimately rests with the defendant.²⁴

1. The Federal Circuit Correctly Weighed the First Factor

The Federal Circuit correctly weighed the first factor against Google. Whether or not Google charges users and developers directly for its Android software, the courts have established that commercial gain by the defendant is not limited to the direct receipt of revenue from the sale of the infringing work.²⁵ In *A&M Records, Inc. v. Napster*,

23. 17 U.S.C. §107.

24. *American Geophysical Union v. Texaco, Inc.* 60 F.3d 913 (2d Cir. 1994), at 918 (“Fair use serves as an affirmative defense to a claim of copyright infringement, and thus the party claiming that its secondary use of the original copyrighted work constitutes a fair use typically carries the burden of proof as to all issues in the dispute.”). See also *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 590 (1994).

25. See *Harper & Row v. Nation Enters.*, 471 U.S. 539 (1985) (“*Harper & Row*”). See also *Television Digest Inc. v. United States Tel. Ass’n*, 841 F. Supp. 5, (D.D.C. 1993) (photocopying of plaintiff’s

Inc.,²⁶ for example, the Ninth Circuit held that users of the defendant Napster’s peer-to-peer file sharing service were making commercial use of the plaintiff’s sound recordings whether or not the users sold or otherwise exploited the recordings for private gain—“repeated and exploitative unauthorized copies of copyrighted works were made to save the expense of purchasing authorized copies.” This Court has held in *Harper & Row*²⁷ that “[t]he crux of the profit/nonprofit distinction is not whether the sole motive of the use is monetary gain but whether the user stands to profit from exploitation of the copyrighted material without paying the customary price.”

Because the copying of the Java Code was not transformative, the first factor weighs heavily against fair use, and the Federal Circuit correctly so held. 886 F.3d at 1203 (“the highly commercial and non-transformative nature of the use strongly support the conclusion that the first factor weighs against a finding of fair use”).

2. Amicus Takes No View With Respect to the Federal Circuit’s Weighing of the Second Factor

Under the second statutory fair use factor, the Federal Circuit held that the Java Code copied by Google was

newsletter for use by multiple staff members held not fair use; even if copying was done only for educational and research purposes, defendant saved money by photocopying one subscription instead of purchasing the number of subscriptions it actually required).

26. 239 F.3d 1004 (9th Cir. 2001).

27. 471 U.S. at 562.

sufficiently creative to qualify for copyright protection under the *Feist* standard, but based on the evidence of record determined that a reasonable juror “could have concluded that functional considerations were both substantial and important. Based on that assumed factual finding, we conclude that factor two favors a finding of fair use.” 886 F.3d at 1205. *Amicus* takes no view with respect to this conclusion.

3. The Federal Circuit Correctly Determined That the Third Factor Does Not Favor Google

Because the third factor considers both the quantitative and qualitative significance of the copied portion, even a very small taking can weigh against the defendant, as the Federal Circuit recognized. 886 F.3d at 1207. This principle was illustrated most notably in *Harper & Row, supra*, where this Court held a 300- to 400-word passage²⁸ from Gerald Ford’s book *A Time to Heal* was sufficient to constitute infringement and could not be defended as a fair use in light of its importance to the work. *Harper & Row* established that “a taking may not be excused merely because it is insubstantial with respect to the *infringing* work,” which in that case was an entire issue of *The Nation* magazine.

Here, the Federal Circuit recognized under the third factor that “there is no inherent right to copy in order to

28. This Court did not indicate the precise word count of the taking, because it included both verbatim copying and close paraphrase, which the Court set forth in an appendix to the decision.

capitalize on the popularity of the copyrighted work or to meet the expectations of intended customers. Taking those aspects of the copyrighted material that were familiar to software developers to create a similar work designed to be popular with those same developers is not fair use.” 886 F.3d at 1206-1207.

4. The Federal Circuit Correctly Weighed the Fourth Factor

Under the fourth statutory factor, the Federal Circuit correctly found that the unauthorized use of the Java Code in Android caused both actual and potential market harm to Oracle, therefore the fourth factor weighed “heavily” in Oracle’s favor. 886 F.3d at 1210. Cognizable market harm under the fourth factor includes not only actual or potential harm to the market for the copyright owner’s work itself, but also actual or potential harm to “potential derivative uses” including “those that creators of original works would in general develop or license others to develop,” as this Court held in *Campbell*.²⁹

It was also relevant to the Federal Circuit that a copyright owner has the exclusive right to determine “when, whether and in what form to release” the work into new markets, whether directly or through licensing agreements. 886 F.3d at 1208, quoting *Monge v. Maya Magazines, Inc.*³⁰

As this Court recognized in *Campbell*, it is well established that market harm can arise from a defendant’s

29. *Campbell*, 510 U.S. at 592.

30. 688 F.3d 1164, 1182 (9th Cir. 2012).

unlicensed use of material for which a license is readily available. Beyond the context of parody, which was at issue in *Campbell, American Geophysical Union v. Texaco Inc.*³¹ offers the most thorough analysis of lost licensing fees as a form of fourth-factor market harm. In *Texaco*, the defendant's scientists photocopied journal articles for use in their research, well beyond the amount of copying permitted by the license Texaco held from the Copyright Clearance Center, a non-profit organization that offers blanket photocopying licenses for many print publications, including the science journals at issue. The defendant asserted fair use, claiming, *inter alia*, that it would be circular for a court to consider lost license revenues as part of the fair use determination when no license would be required if the use were fair. The Second Circuit rejected that argument:

[N]ot every effect on potential licensing revenues enters the analysis under the fourth factor. Specifically, courts have recognized limits on the concept of "potential licensing revenues" by considering only traditional, reasonable, or likely to be developed markets when examining and assessing a secondary use's "effect upon the potential market for or value of the copyrighted work." See *Campbell*, 114 S. Ct. at 1178 ("The market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop."); *Harper & Row*, 471

31. 37 F.3d 881 (2d Cir. Oct. 28, 1994), *as amended*, 60 F.3d 913 (2d Cir. Oct. 28, 1994), *reh'g denied*, 1994 U.S. App. LEXIS 36735 (2d Cir. Dec. 23, 1994).

U.S. at 568 (fourth factor concerned with “use that supplants any part of the normal market for a copyrighted work”) (quoting S. Rep. No. 473, 94th Cong., 1st Sess. 65 (1975)).

. . . Similarly, other courts have found that the fourth factor will favor the secondary user when the only possible adverse effect occasioned by the secondary use would be to a potential market or value that the copyright holder has not typically sought to, or reasonably been able to, obtain or capture. See *Twin Peaks Prods., Inc. v. Publications Int’l Ltd.*, 996 F.2d 1366, at 1377 (2d Cir. 1993)(noting that fourth factor will favor secondary user when use “filled a market niche that the [copyright owner] simply had no interest in occupying”); *Pacific and Southern Co. v. Duncan*, 744 F.2d 1490, 1496 (11th Cir. 1984), *cert. denied*, 471 U.S. 1004, 85 L. Ed. 2d 161, 105 S. Ct. 1867 (1985) (noting that the fourth factor may not favor copyright owner when the secondary user “profits from an activity that the owner could not possibly take advantage of”).³²

The *Texaco* court went on to conclude that the Copyright Clearance Center provided an efficient mechanism for licensing the precise rights at issue. Therefore the lost license revenue could be considered as market harm under the fourth factor.³³ *See also Cambridge*

32. *Texaco*, 60 F.3d at 929–30 (footnotes omitted) (emphasis added).

33. “Though the publishers still have not established a conventional market for the direct sale and distribution of individual

Univ. Press v. Albert, 906 F.3d 1290, 1300 (11th Cir. 2018) (in case involving electronic library reserves, present availability of electronic licenses for libraries “strongly disfavor[s]” fair use). The profitability of the market at issue is not directly relevant under this formulation. Also, where a market is “traditional, reasonable or likely to be developed,” it is generally found cognizable under the fourth factor even where a particular plaintiff has decided not to participate in it, such as with the television trivia books in *Castle Rock Entertainment* discussed above.³⁴

Here, there was no need for the Court to weigh potential market harm because the evidence of actual harm was “overwhelming,” 886 F.3d at 1209. Prior to Android, Java had for years been in use on mobile devices, including smartphones, and the Federal Circuit

articles, they have created, primarily through the Copyright Clearance Center, a workable market for institutional users to obtain licenses for the right to produce their own copies of individual articles via photocopying.” *Id.* at 936–37; see also *Princeton Univ. Press v. Michigan Document Serv.*, 99 F.3d 1381, (6th Cir. 1996) (*en banc*) (rev’g 74 F.3d 1512, (6th Cir. 1996) and 855 F. Supp. 905, (E.D. Mich. 1994), *cert. denied*, 520 U.S. 1156 (1997)(rejecting contention that consideration of lost licensing revenues under fourth factor was “circular,” at least where copyright owner had genuine interest in exploiting same market and had succeeded in doing so).

34. See *Castle Rock Entm’t, Inc. v. Carol Publ’g Group, Inc.*, 150 F.3d 132 (2d Cir. 1998); *Clean Flicks of Colo. v. Soderbergh*, 433 F. Supp. 2d 1236 (D. Colo. 2006); see also *Higgins v. Detroit Educ. Television Found.*, 4 F. Supp. 2d 701 (E.D. Mich. 1998) (market harm shown, *inter alia*, by fact that plaintiff never collected compulsory license fees offered by defendant under §118 for broadcast of educational public TV show containing excerpt of plaintiff’s song).

accordingly held “[t]hat Android competed directly with Java SE in the market for mobile devices is sufficient to undercut Google’s market harm arguments.” *Id.*

5. The Federal Circuit Correctly Balanced the Statutory Factors

In weighing the statutory factors, the Federal Circuit (at 1191) correctly cited *Campbell*’s requirement that all of them must be weighed together “in light of the *purposes of copyright*”³⁵ (emphasis added). Google and its *amici*, however, ask this Court to address numerous policy objectives – competition, efficiency, device compatibility, consumer choice – which have little or nothing to do with the “purposes of copyright,” and which are in any event properly addressed by Congress in an appropriate legislative process, as it did with the CONTU Commission, or when enacting the library provisions in §108, or the compulsory licenses for the cable television, music and satellite broadcasting industries, or the Digital Millennium Copyright Act, as provisions within the Copyright Act.

Amicus National Federation for the Blind provides a perfect example of Congress’ willingness to consider such issues, with its call to allow copying of protected material in connection with “[t]echnology that adapts devices for use by blind people.” *Brief of Amici Curiae Center for Democracy and Technology, Institute for Intellectual Property and Social Justice, National Consumers League, and National Federation for the Blind Supporting Petitioner*, at 7.

35. Quoting *Campbell*, 510 U.S. at 578.

In fact, Congress considered this precise issue in drafting the Act, noting in the legislative history of §107 that the goal of making works broadly available for the blind presents “unique circumstances” that could properly be addressed under fair use, if publishers failed to make works available in modified formats for such readers.

The legislative history of § 107, as relied upon by this Court in *Sony*, states that making copies accessible “for the use of blind persons” posed a “special instance illustrating the application of the fair use doctrine.”³⁶ The Committee noted at the time that “special [blind-accessible formats] . . . are not usually made by the publishers for commercial distribution.” *Id.* In light of its understanding of the market (or lack thereof) for books accessible to the blind *circa* 1976, the Committee explained that “the making of a *single copy* or phonorecord by an individual as a *free service* for a blind persons [sic] would properly be considered a fair use under section 107.” *Id.* (emphasis added). The court in *HathiTrust* cited this passage to conclude “[w]e believe this guidance supports a finding of fair use in the unique circumstances presented by print-disabled readers.”³⁷

36. H.R. REP. NO. 94-1476, at 73 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5686.

37. *HathiTrust*, 755 F.3d 87, 102. As the Second Circuit further explains in *HathiTrust*, “[s]ince the passage of the 1976 Copyright Act, Congress has reaffirmed its commitment to ameliorating the hardships faced by the blind and the print disabled. In the Americans with Disabilities Act, Congress declared that our ‘Nation’s proper goals regarding individuals with disabilities are to assure equality of opportunity, full participation, independent living, and economic self-sufficiency for such individuals.’ 42 U.S.C. § 12101(7). Similarly, the Chafee

Therefore, the legislative history of § 107 itself shows a specific Congressional understanding that providing appropriately limited access to copyrighted works to the print-disabled is a valuable public purpose that courts should recognize when applying fair use under § 107. With respect to Petitioner Google here, however, there is no evidence of record that suggests any particular concern for blind readers in its copying of the Java Code into Android. The incorporation of the Java Code, as opposed to any other functionally equivalent code, does not make Android any more accessible to the blind. In any event, the people’s elected representatives in Congress are the proper decisionmakers for issues of such social import, involving such numerous and disparate stakeholders. *Amicus* AAP respectfully urges this Court not to distort the Copyright Act Congress wrote in pursuit of the non-copyright policy objectives raised by Google and its supporting *amici*.³⁸

IV. THE FEDERAL CIRCUIT CORRECTLY REVERSED THE JURY AS TO FAIR USE

The Federal Circuit properly reversed the decision of the jury with respect to fair use. Fair use is a mixed question of fact and law,³⁹ so even if the jury’s fact-finding

Amendment illustrates Congress’s intent that copyright law make appropriate accommodations for the blind and print disabled. *See* 17 U.S.C. § 121.” *Id.* It is thus the role of Congress to address these issues, and it has done so on multiple occasions.

38. *See Ledbetter v. Goodyear Tire & Rubber Co, Inc.* 127 S. Ct. 2162, 2177 (2007) (“We are not in a position to evaluate Ledbetter’s policy arguments, and it is not our prerogative to change the way in which the [statute] balances the interests...”)

39. *Harper & Row*, 471 U.S. 539, 560.

were not to be disturbed, the Federal Circuit’s reversal on issues of law is nonetheless proper.⁴⁰ This Court, quoting the legislative history, has also described fair use as an “equitable rule of reason,”⁴¹ and the Federal Circuit below was correct to conclude that “[i]f fair use is equitable in nature, it would seem to be a question for the judge, not the jury, to decide, even when there are factual disputes regarding its application.”⁴²

Outside the copyright context, this Court has frequently affirmed Circuit Court decisions that set aside jury verdicts on grounds of insufficient evidence or errors of law below. *See, e.g., Baltimore & Carolina Line v. Redman*⁴³; *Ledbetter v. Goodyear Tire & Rubber Co., Inc.*⁴⁴; *Mac’s Shell Service, Inc v. Shell Oil Products Co. LLC*⁴⁵; *Snyder v. Phelps*.⁴⁶

40. *Id.* (even where facts are sufficient to evaluate all four factors, court may conclude as a matter of law that the use is not fair.)

41. *Id.* quoting H.R. Rep. 94-1476, at 65, U.S.Code Cong. & Admin.News 1976, p. 5678.

42. 886 F.3d at 1194.

43. 55 S. Ct. 890 (1935) (denying *certiorari* where Second Circuit reversed general jury verdict; “[w]hether the evidence was sufficient or otherwise is a question of law for the court”).

44. 127 S.Ct. 2162 (2007) (affirming reversal of jury verdict; abrogated by statute).

45. 130 S.Ct. 1251 (2010) (affirming in part reversal of jury verdict).

46. 131 S.Ct. 1207 (2011) (affirming Fourth Circuit reversal of jury verdict). In *Snyder*, a jury imposed liability because the defendant’s alleged conduct was “outrageous,” but this Court affirmed reversal of that result because “outrageousness is a

Google’s own view of the sanctity of jury results in this case is hardly consistent with its own positions below. Below, Google made exactly the argument it opposes here, in an effort to overturn the initial jury verdict of prima facie infringement.

CONCLUSION

Based on the above reasons and authorities, *amicus curiae* Association of American Publishers respectfully urges this Court to affirm the decision of the Federal Circuit in this action.

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Respectfully submitted,

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highly malleable standard with an inherent subjectiveness about it which would allow jurors to impose liability on the basis of jurors’ tastes or views, or perhaps on the basis of their dislike of a particular expression.” *Amicus* posits that “transformative use,” the principal issue in dispute here, is no less malleable and subjective.