No. 18-956

IN THE

Supreme Court of the United States

GOOGLE LLC.,

Petitioner,

v.

ORACLE AMERICA, INC.,

Respondent.

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

BRIEF OF *AMICUS CURIAE* ELECTRONIC FRONTIER FOUNDATION IN SUPPORT OF PETITIONER

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QUESTIONS PRESENTED

1. In this case, has the Federal Circuit asserted *de facto* authority to create its own law in the field of copyright?

2. Should this Court grant certiorari to resolve conflicts between the copyright decisions of the Federal Circuit in this case with decisions from several other circuits? In particular, should the Court grant certiorari to resolve conflicts about the scope of copyright protection for computer interfaces or languages under 17 U.S.C. § 102(b), and the scope of fair use for computer interfaces or languages under 17 U.S.C. § 107?

TABLE OF CONTENTS

Table of Contents

Page

Table of Contents

TABLE OF CITED AUTHORITIES

Page

CASES

Page

Page

STATUTES

OTHER AUTHORITIES

Page

Page

Page

Page

STATEMENT OF IDENTITY AND INTEREST OF *AMICUS CURIAE*[1]

The Electronic Frontier Foundation ("EFF") is a non-profit civil liberties organization that has worked for 28 years to protect consumer interests, innovation, and free expression in the digital world. EFF and its more than 39,000 dues-paying members have a strong interest in helping the courts and policymakers ensure that copyright law serves the interests of creators, innovators, and the general public.

INTRODUCTION AND SUMMARY OF ARGUMENT

The Federal Circuit opinions at issue in this Petition have generated widespread attention and controversy, with good reason. As arbiter of a copyright case, the Federal Circuit was supposed to apply the law of the

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1. No counsel for a party authored this brief in whole or in part, and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than the amicus curiae, or its counsel, made a monetary contribution intended to fund its preparation or submission. In an abundance of caution and for the sake of transparency, counsel state that Petitioner, Google LLC, has made contributions to the Electronic Frontier Foundation; such funds have been allotted to support specific projects, but not this brief.

Pursuant to Supreme Court Rule 37.2(a), amicus curiae provided at least ten days' notice of its intent to file this brief to counsel of record for all parties. All parties have consented to the filing of this brief.

Web sites cited in this brief were last visited on February 19, 2019.

regional circuit; here, the Ninth Circuit. But that's not what the Federal Circuit did. In both of its decisions, the Federal Circuit not only failed to apply Ninth Circuit law, it created its own law of copyright regarding functional aspects of computer programs.

That would be bad enough, but it gets worse: the Federal Circuit decisions have improperly been treated as de facto binding precedent in copyright law, displacing regional circuit law that conflicts with what the lower court has done. That is particularly true for the Federal Circuit's copyrightability decision, *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339 (Fed. Cir. 2014) (*"Oracle I"*), *cert. denied*, 135 S. Ct. 2887 (2015). District courts have looked to *Oracle I* as binding authority rather than decisions from their respective regional circuits—even for copyright cases that, lacking any patent claims, will never be heard by the Federal Circuit. Moreover, *Oracle I's* mischief reaches beyond the courts, influencing administrative rulemaking and legal scholarship.

Unless this Court corrects the Federal Circuit, it is likely that the fair use decision of *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179 (Fed. Cir. 2018) (*"Oracle II"*) will have the same improper influence. The legal and technological press are already treating both *Oracle I* and *Oracle II* as binding precedent or, at a minimum, are treating them as both highly important and dangerous.

Accordingly, this Court should discount any claim Oracle might make, as it has before, that there is no need to review these decisions because future courts will still be bound primarily by regional circuit law. That may be the rule, but it is not the reality for copyright in software.

And it gets *even worse:* the Federal Circuit's influence is detrimental to the development of copyright law in this area because the reasoning in both decisions dramatically departs from that of other circuits. *Oracle I* conflicts with many other circuits on the proper test for evaluating the copyrightability of the functional aspects of computer programs under 17 U.S.C. § 102(b). *Oracle II* conflicts with decisions by both this Court and regional circuits on the overall purpose of the fair use doctrine, and improperly analyzes at least the second and third fair use factors.

We urge the Court to grant certiorari and put copyright law in this crucial area back on track.

ARGUMENT

I. The Increasing Use of *Oracle I* as Binding or Persuasive Copyright Authority Warrants Supreme Court Review

Both *Oracle I* and *Oracle II* acknowledge that the Federal Circuit was supposed to apply Ninth Circuit copyright law in this case. *Oracle I*, 750 F.3d at 1353; *Oracle II*, 886 F.3d at 1190. However, that's not what happened. Instead, the Federal Circuit created its own precedential law, in effect exercising de facto authority over copyright contrary to precedent from the Ninth and other circuits.

Nonetheless, amicus expects that Oracle and possibly the Solicitor General will contend, as they have before, that this case is unworthy of Supreme Court review on the theory that *Oracle I* is not binding on future Circuit panels and is unable to create a circuit split. *See* Br. of United

States, *Google, Inc. v. Oracle Am., Inc.*, No. 14-410, 2015 WL 2457656, at *22 (May 2015)[2] ("[T]he decision below has limited precedential value. The Federal Circuit's decision applying Ninth Circuit law would not bind a future Ninth Circuit panel . . . ."); Oracle's Response to Combined Petition for Rehearing and Rehearing En Banc, Federal Circuit Nos. 17-1118, -1202, at 7-8 (Jul. 27, 2018)[3] (other cases involving issues similar to this case "will *always* be governed by the law of the various regional circuits. . . . Future panels will be required to reach the results dictated by the relevant regional circuit regardless of what this Court holds en banc") (emphasis in original).

Experience has already proven that argument wrong. While a Federal Circuit opinion on copyright law may not be *de jure* binding in other circuits, *Oracle I* has acquired *de facto* precedential value.

A. Courts in Multiple Circuits Treat *Oracle I* as Binding or Persuasive Authority for Copyright Disputes

Rather than rely on the law of their regional circuits, district courts regularly treat *Oracle I* as the primary copyright authority they should follow—even where those cases do not include any patent claims and will therefore never end up before the Federal Circuit.

Most significantly, a district court in the Ninth Circuit

2. Available at: https://www.eff.org/document/amicus-brief-solicitor-general

3. Available at: https://www.eff.org/document/oracle-response-google-petition-rehearing-en-banc

relied on *Oracle I* in a copyright dispute because it viewed the Federal Circuit's opinion as least as binding as Ninth Circuit authority. In *SellPoolSuppliesOnline.com LLC v. Ugly Pools Arizona, Inc.*, 2017 WL 6420464, at *18–19 (D. Ariz. 2017), the court used *Oracle I* rather than any Ninth Circuit case to explain that Ninth Circuit law supposedly rejects "the 'method of operation' reasoning" described in *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807 (1st Cir. 1995) (*"Lotus"*), *aff'd by an equally divided court*, 516 U.S. 233 (1996). 2017 WL 6420464 at *18. It did so even though a 2015 Ninth Circuit decision issued *after Oracle I* used reasoning substantially similar to *Lotus* rather than follow *Oracle I* (*see* section II.A below).

Additionally, *SellPool* almost exclusively cited *Oracle I* to say that particular elements of computer code and "the structure, sequence, and organization" of computer programming interfaces are entitled to copyright protection. *Id.* at *19. By recognizing *Oracle I's* indications that "coding is copyrightable" and copyright protection for computer programs "varies based on the facts," *SellPool* confirms *Oracle I's de facto* precedential value within copyright jurisprudence. *Id.*

District courts in the First Circuit have done the same. For example, a Massachusetts district court copyright case looked to both *Lotus* and *Oracle I* in determining the scope of copyright protection for a software program. *McEnroe v. Mantissa Corp.*, 2016 WL 7799636, at *6–7 (D. Mass. 2016). And even though *Lotus* remains binding authority in the First Circuit, the court adopted a conflicting principle from *Oracle I:* that a program's copyrightability is contingent "on the choices made by" the plaintiff upon the program's creation. *Id.* at

*8; *compare Lotus*, 49 F.3d at 816 ("expressive choices" do not "magically" change uncopyrightable commands into copyrightable subject matter).

Another software copyright case within the First Circuit expressed similar opinions about *Oracle I's* authority. *Commonwealth of Puerto Rico v. OPG Tech., Inc.*, 2016 WL 5724807 (D.P.R. 2016). While acknowledging that *Lotus* "remains the law of [the First] Circuit," the court used *Oracle I* to underscore that the First Circuit's method of operation analysis "is in tension with the law of other circuits." *Id.* at *12. But rather than immediately applying *Lotus*, the court felt it necessary to discuss *Oracle I* as a key participant in the copyright circuit split.

Thus, these district courts in the First Circuit view *Oracle I* as a significant and influential copyright case—so significant in *McEnroe* that the court rejected the *Lotus* precedent at least in part. The purposeful juxtaposition of *Lotus* and *Oracle I* in these cases shows an unambiguous belief that the Federal Circuit has equal, if not greater, precedential value than the First Circuit counterpart on a question of copyright law.

Other cases across the circuits have cited *Oracle I* as a general authority for describing components of copyright protection—in many cases, the first and/or primary authority cited. *Motion Med. Techs., LLC v. Thermotek, Inc.*, 875 F.3d 765, 775-76 (5th Cir. 2017) (using *Oracle I* to assert that infringement of both literal and non-literal elements may be actionable under copyright law); *Dynamic Concepts, Inc. v. Tri-State Surgical Supply and Equip., Ltd.*, 716 Fed. Appx. 5, *8 n.2 (2d Cir. 2017) (nonprecedential) (explaining that copyright protection

can extend to literal elements, non-literal elements, and the actual experience a user has running a software program); *StorageCaft Tech. Corp. v. Persistent Telecom Sols., Inc.*, 2016 WL 3435189, at *3–4 (D. Utah 2016) (delineating the fair use doctrine with frequent support from *Oracle I*); *Data Trace Info. Services LLC v. Axis Tech. Grp., LLC*, 2016 WL 7486285, at *5 (C.D. Cal. 2016) (citing *Oracle I*, and no other case, to say that "copyright protection extends only to the expression of an idea, not the underlying idea itself"); *Page v. Microsoft Corp.*, 2014 WL 6460019, at *5 (N.D. Tex. 2014) (reiterating that ideas are not protected by copyright law).

B. Cases With Patent and Copyright Claims Especially Rely on *Oracle I* as Binding Authority

Appeals from cases with both patent and copyright claims go to the Federal Circuit. In recent cases, plaintiffs have added patent claims to their copyright claims to invoke *Oracle I* as not only binding, but as virtually exclusive authority.

1. *Cisco v. Arista*

In 2014, Cisco Systems filed a lawsuit to prevent its competitor, Arista Networks, from building competing Ethernet switches that rely in part on commands Cisco argues it initially developed. *Cisco Sys., Inc. v. Arista Networks, Inc.*, N.D. Cal. No. 5:14-cv-5344. While the gravamen of Cisco's claims turned on allegations that Arista infringed Cisco's copyright in 500 command line interface commands that operate the switches, Cisco followed Oracle's strategy of tacking on a few patent

claims, ensuring that any appeal would go to the Federal Circuit. In 2016, a jury found that Arista was not liable on either set of claims.

On appeal, Cisco abandoned its patent claims altogether—but its appeal was still before the Federal Circuit. On the copyright claim, Cisco relied heavily on *Oracle I*, in particular for *Oracle I's* key holding that "under Ninth Circuit law, an original work—even one that serves a function—is entitled to copyright protection as long as the author had multiple ways to express the underlying idea." Br. for Plaintiff-Appellant, *Cisco Sys., Inc. v. Arista Networks, Inc.*, Fed. Cir. No. 17-2145, at 38, 40 (Sept. 13, 2017).[4] Cisco's reply brief even more stridently relied on *Oracle I*, criticizing Arista for mounting a "collateral attack" on the Federal Circuit's holding. Reply Br. for Plaintiff-Appellant, *Cisco Sys., Inc. v. Arista Networks, Inc.*, Fed. Cir. No. 17-2145, at 11 (Feb. 5, 2018).[5]

At oral argument, Cisco abandoned any pretense that cases other than *Oracle I* mattered. In support of her main argument during 42 total minutes of argument, Cisco's counsel cited only one case: *Oracle I*. Audio recording of oral argument, *Cisco Sys., Inc. v. Arista Networks, Inc.*, Fed. Cir. No. 17-2145 (Jun. 6, 2018).[6] For example, Cisco

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4. Available at: https://www.eff.org/document/cisco-v-arista-cisco-opening-brief

5. Available at: https://www.eff.org/document/cisco-v-arista-cisco-reply-brief

6. Available at: http://oralarguments.cafc.uscourts.gov/default.aspx?fl=2017-2145.mp3. In the very last minute of a 31-minute opening argument, Cisco's counsel cited for the first time a case other than *Oracle I*, and that case (from the Ninth Circuit) only as

argued that its case was "straight out of *Oracle v. Google*" (*id.* at 4:26-35) and that the Federal Circuit had "crossed this bridge in the SSO portion of the *Oracle* decision" by holding APIs copyrightable (*id.* at 30:43-31:07).

Despite having won the case in the district court, the specter of a Federal Circuit reversal based on the *Oracle I* precedent forced Arista to pay $400 million to settle its litigation with Cisco. This was before the court could rule on Cisco's appeal. Jan Wolfe, *Arista to pay $400 million to Cisco to resolve court fight*, Reuters Business News (Aug. 6, 2018).[7]

2. *SAS Institute v. World Programming*

In *SAS Institute Inc. v. World Programming Ltd.*, 64 F. Supp. 3d 755 (E.D.N.C. 2014), SAS sued WPL for breach of contract and for copyright infringement of SAS's programming language. SAS argued that its copyright claim was "on all fours" with *Oracle I*. *Id.* at 777. The district court extensively analyzed *Oracle I*, concluded that the case was distinguishable, and found no copyright infringement. *Id.* at 778. On appeal, the Fourth Circuit affirmed a judgment against WPL on the contract claim, but found the copyright claim moot and vacated the district court's judgment in favor of WPL. *SAS Institute, Inc. v. World Programming Ltd.*, 874 F.3d 370, 389-90 (4th Cir. 2017).

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an "alternative argument" for reversal. *Oracle I* was the sole case Cisco's counsel cited in her 11-minute rebuttal argument.

7. Available at: https://www.reuters.com/article/us-cisco-arista-settlement/arista-to-pay-400-million-to-cisco-to-resolve-court-fight-idUSKBN1KR1PI

Since the adverse district court copyright decision was vacated and dismissed without prejudice, SAS tried again elsewhere, refiling its copyright claims in the Eastern District of Texas. This time, SAS included patent claims, ensuring that any appeal would go to the Federal Circuit. *See* Complaint in *SAS Institute Inc. v. World Programming Ltd.*, E.D. Tex. No. 18-cv-295 (Jul. 18, 2018).[8] SAS's complaint is full of language that evokes *Oracle I*, such as using the phrase "creative choice" to describe its program over 25 times, or stating that program elements could be "expressed in more than one way." That case remains pending.

C. Legal Scholars Have Treated *Oracle I* as Important and Persuasive Authority, Including a Special Issue of the Harvard Journal of Law and Technology

Legal scholars have treated this case as important and persuasive authority, as shown by many law review articles discussing this case. A Westlaw search of law review articles published since the 2014 *Oracle I* decision shows at least 23 articles that discuss the case in depth. Eight of them actually include *Oracle v. Google* in the title. Nine of the 23 were included in a Spring 2018 Special Issue by the Harvard Journal of Law and Technology exclusively devoted to *Oracle I*. 31 Harv. J.L. & Tech. (Special Issue) ___ (2018).[9] The introduction to the Special

8. Available at: https://www.eff.org/document/complaint-filed-sas-institute-inc-vs-world-programming-limited-et-al

9. The table of contents for this Special Issue is available at: https://jolt.law.harvard.edu/assets/articlePDFs/v31/31HarvJLTechIntro2.pdf

Issue[10] described this case as a "crucial battle" and "landmark legal dispute" over software copyright. *Id.* at 303. The introduction summarized the Issues' contents as follows (footnotes omitted):

> Professor Peter Menell's anchoring article describes the history and scope of the case in incredible detail, putting the entire dispute into perspective and framing the conversation that follows. Included is commentary from the lawyers who have represented Oracle and Google in the already-litigated cases, Ms. Annette Hurst and Mr. Fred von Lohmann respectively, as well as contributions from leading scholars in the field. The topics of the contributions include direct commentary on the litigation and its impact from Professor Oman, a discussion of the importance of interoperability by Mr. Gratz and Professor Lemley, in-depth examinations of aspects of the fair use defense from Professor Nimmer as well as from Professors Samuelson and Asay, and a look at the international software copyright landscape from Professor Band.

Professor Menell's "anchoring" article describes at length how *Oracle I* created its own law of computer copyright. Peter S. Menell, *Rise of the API Copyright Dead?: An Updated Epitaph for Copyright Protection of*

Links to the nine articles are available at: https://jolt.law.harvard.edu/volumes/volume-31-special-issue

10. Available at: http://jolt.law.harvard.edu/assets/articlePDFs/v31/31HarvJLTech303.pdf

Network and Functional Features of Computer Software, 31 Harv. J.L. & Tech. 305, 417 (2018)[11] (this case "revived flawed and widely rejected arguments from the first wave of API copyright litigation"), 421-52 (explaining how *Oracle I* misinterpreted 17 U.S.C. § 102(b); contradicted Ninth Circuit authority; ignored the difference between technologically functional and traditional works such as novels; and otherwise engaged in flawed analysis).

D. Stakeholders and the Copyright Office Have Relied on *Oracle I* in Rulemaking Proceedings

The Digital Millennium Copyright Act (DMCA) prohibits someone from circumventing a "technological measure that effectively controls access" to copyrighted works. 17 U.S.C. § 1201(a)(1)(A). Every three years, the U.S. Copyright Office conducts rulemaking to consider granting exemptions to this rule. 17 U.S.C. § 1201(a)(1)(C). After the 2014 *Oracle I* decision, the Copyright Office has conducted that rulemaking twice, in 2015 and 2018.

During both cycles, both the Office itself and the parties supporting or opposing proposed exemptions looked to *Oracle I* as legal authority on copyrightability and fair use. For example, in 2015, the Office considered an exemption for "jailbreaking" smart TVs, known as class 20. Library of Congress, Copyright Office, *Exemption to Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies*, Docket No. 2014-07, 79 Fed. Reg. 73856, 73868 (Dec. 12, 2014).[12] A group

11. Available at: https://jolt.law.harvard.edu/assets/articlePDFs/v31/31HarvJLTech305.pdf

12. Available at: https://www.copyright.gov/fedreg/2014/79fr73856.pdf

called the "Joint Creators and Copyright Owners" opposed that exemption. Joint Creators and Copyright Owners, *Long Comment Regarding a Proposed Exemption Under 17 U.S.C. 1201* (Proposed Class #20) (*"Long Comment"*).[13] The Joint Creators relied on *Oracle I* as their sole authority against the exemption (*id.* at 3-4):

> Second, since the last proceeding, the Federal Circuit decided *Oracle Am., Inc. v. Google, Inc.*, 750 F.3d 1339 (Fed Cir. 2014), which the Joint Creators and Copyright Owners submit should cause the Register to reevaluate her previous analysis.

The Joint Creators essentially argued that the Federal Circuit's reasoning in *Oracle I* compelled denial of the exemption as a fair use since it was preferable to that of previous Ninth Circuit decisions, *Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9th Cir. 1992) and *Sony Computer Entertainment, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000), *see Long Comment* at 4. The Office concluded that *Oracle I* did not compel denial of the exemption, since *Oracle I* "acknowledged that [the] interoperability concerns" of *Sega* and *Sony* were relevant to fair use. U.S. Copyright Office, Section 1201 Rulemaking: *Sixth Triennial Proceeding to Determine Exemptions to the Prohibition on Circumvention, Recommendation of the Register of Copyrights*, at 214 (Oct. 2015).[14]

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13. Available at: https://cdn.loc.gov/copyright/1201/2015/comments-032715/class%2020/Joint_Creators_and_Copyright_Owners_Class20_1201_2014.pdf

14. Available at: https://www.copyright.gov/1201/2015/registers-recommendation.pdf

By the time of the 2018 rulemaking, however, *Oracle II* had been decided, virtually eviscerating fair use for the functional aspects of computer programs. The Joint Creators jumped on this, arguing that *Oracle II* "impacts some of the prior reasoning." Transcript of Proceedings, Copyright Office Section 1201 Roundtable, at 157-59 (Apr. 12, 2018).[15] While the Office didn't use *Oracle II* to change its previous exemptions, it repeatedly had to deal with the case. U.S. Copyright Office, Section 1201 Rulemaking: *Seventh Triennial Proceeding to Determine Exemptions to the Prohibition on Circumvention, Recommendation of the Register of Copyrights*, at 169-70, 207 (Oct. 2018).[16] There is a real risk that the Copyright Office or other governmental agencies will treat the Oracle decisions as binding authority in the future, or at the very least be forced to determine which law to follow in light of the circuit split.

E. Numerous Articles in the Legal and Technical Press Show the Importance of This Case

For a supposedly non-precedential case, this litigation has generated an enormous number of articles in the legal and technical press.

First, the press commentators agree that this case is crucial to the future of innovation. The Federal Circuit's two opinions have appeared twice on "top ten" lists of the most important copyright cases of the year—in both

15. Available at: https://www.copyright.gov/1201/2018/hearing-transcripts/1201-Rulemaking-Public-Roundtable-04-12-2018.pdf

16. Available at: https://www.copyright.gov/1201/2018/2018_Section_1201_Acting_Registers_Recommendation.pdf

lists, as the #1 most important case of the entire year. For 2014, *see* Stephen McJohn, *Top Tens in 2014: Patent, Trademark, Copyright and Trade-Secret Cases*, 13 Nw. J. Tech. & Intell. Prop. 317, 320, 340 (2015)[17] (calling *Oracle I* the year's "most notable case in copyright"). In 2018, the LexisNexis Company's Law360 newsletter made *Oracle II* the #1 case on its list by saying "[i]t's hard to overstate this March ruling from the Federal Circuit." Bill Donahue, *Top 10 Copyright Rulings Of 2018*, Law360 (Dec. 14, 2018).[18]

Others have described *Oracle I* as having "long-term repercussions—not just for Google, but the entire software industry." Chris Preimesberger, *Why Oracle vs. Google API Litigation Remains a Pivotal Case*, eWeek (Jun. 29, 2015).[19] One commentator described *Oracle II* as "a blockbuster ruling" and the case overall as "The World Series of IP cases." Jeffrey Neuburger, *Federal Circuit Again Reverses California Court in Oracle-Google Copyright Dispute over Java APIs – Releases a Major Ruling on Fair Use in the Software Context*, Proskauer New Media and Technology Law Blog (Mar. 30, 2018).[20]

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17. Available at: https://scholarlycommons.law.northwestern.edu/cgi/viewcontent.cgi?referer=&httpsredir=1&article=1243&context=njtip

18. Available at: https://www.law360.com/ip/articles/1106485/top-10-copyright-rulings-of-2018 (subscription required)

19. Available at: https://www.eweek.com/mobile/why-oracle-vs.-google-api-litigation-remains-a-pivotal-case

20. Available at: https://newmedialaw.proskauer.com/2018/03/30/federal-circuit-again-reverses-california-court-in-oracle-google-copyright-dispute-over-java-apis-releases-a-major-ruling-on-fair-use-in-the-software-context/

A large law firm partner called *Oracle II* "a "hugely important" development in the law of copyright and fair use. Jocelyn Aspa, *Google vs. Oracle Lawsuit Resurrected by Federal Court*, Mobile Web Investing News (Mar. 27, 2018).[21] *Oracle II* has been described as "momentous" and "very, very important for the software industry." Jason Tashea, *Federal Circuit rules Google infringed copyright, may owe billions*, ABA Journal (Mar. 30, 2018).[22]

Second, the litigation is widely viewed as precedential. Rachel Kraus, *Everything you need to know about the Oracle lawsuit against Google*, Mashable (Mar. 30, 2018, updated Aug. 28, 2018)[23] (*Oracle II* "overturns decades of precedent"); Chris Mills, *Google has lost its billion-dollar legal fight with Oracle, but everybody will pay the price*, BGR (Mar. 27, 2018)[24] ("More worryingly, however, the lawsuit sets a strict precedent on the use of application program interfaces (APIs) in coding"); Michael Risch, *Oracle v. Google Again: The Unicorn of a Fair Use Jury Reversal*, Written Description blog (Mar. 28, 2018)[25] (*Oracle II* is "as worrisome and far-reaching" as people think).

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21. Available at: https://investingnews.com/daily/tech-investing/mobile-web-investing/google-vs-oracle-lawsuit-resurrected-federal-court/

22. Available at: http://www.abajournal.com/news/article/appeals_court_rules_google_infringed_copyright_may_owe_billions

23. Available at: https://mashable.com/2018/03/30/google-vs-oracle-explainer/#CX0jpdfKbPqd

24. Available at: https://bgr.com/2018/03/27/google-oracle-appeals-ruling-2018/

25. Available at: https://writtendescription.blogspot.com/2018/03/oracle-v-google-again-unicorn-of-fair.html

But there is a third theme in the coverage: that the Federal Circuit got it wrong—twice. Regarding *Oracle I*, one commentator pointed out basic flaws in the Federal Circuit's reasoning, suggesting it reflected a "fundamental lack of understanding of how software works." Timothy B. Lee, *The court that created the patent troll mess is screwing up copyright too*, Vox (May 9, 2014).[26] *See also* Jonathan Band, *The Federal Circuit's Poorly Reasoned Decision in Oracle v. Google*, Disco (May 9, 2014)[27] (*Oracle I* places "U.S. programmers at a competitive disadvantage to developers in other jurisdictions that recognized that copyright does not protect program elements necessary for interoperability"); Kin Lane, *Where Will Your API Stand In The Oracle v Google API Copyright Debate?*, API Evangelist (May 10, 2014)[28] (analogizing the computer industry's API economy to an engine, and stating that "Oracle is replacing the engine oil with glue").

Oracle II has also been harshly criticized. *See, e.g.*, Krista L. Cox, *Oracle v. Google Is More Evidence That The Federal Circuit Has No Business Deciding Copyright Cases*, Above The Law (Mar. 29, 2018)[29] ("the Federal

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26. Available at: http://www.vox.com/2014/5/9/5699960/this-court-decision-is-a-disaster-for-the-software-industry

27. Available at: http://www.project-disco.org/intellectual-property/050914-the-federal-circuits-poorly-reasoned-decision-in-oracle-v-google

28. Available at: http://apievangelist.com/2014/05/10/where-will-your-api-stand-in-the-oracle-v-google-api-copyright-debate/

29. Available at: https://abovethelaw.com/2018/03/oracle-v-google-is-more-evidence-that-the-federal-circuit-has-no-business-deciding-copyright-cases/

Circuit predetermined what it wanted the outcome of the case to be and expected the jury to find against Google"); Mike Masnick, *Insanity Wins As Appeals Court Overturns Google's Fair Use Victory For Java APIs*, Techdirt blog (Mar. 27, 2018)[30] ("while we normally expect bad reasoning from CAFC decisions, this one is particularly stupid"); Urmika Devi Shah, *Decision in Oracle v. Google Fair Use Case Could Hinder Innovation in Software Development*, Mozilla blog (Apr. 17, 2018)[31] ("[t]he Federal Circuit's decision is a big step in the wrong direction").

Thus, the Federal Circuit has created its own law of copyrightability and fair use. The Court should grant certiorari to correct the Federal Circuit's precedent.

II. The Federal Circuit's Copyright Decisions in This Case Conflict With Decisions From Other Circuits

The importance of this case, along with the Federal Circuit's improper creation of its own copyright law, are sufficient for a grant of certiorari. But to eliminate any doubt that certiorari should be granted, the following briefly shows why the court's decisions conflict with the opinions of other circuits, recognizing that other amici will discuss this issue in more detail.

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30. Available at: https://www.techdirt.com/articles/20180327/10431439512/insanity-wins-as-appeals-court-overturns-googles-fair-use-victory-java-apis.shtml

31. Available at: https://blog.mozilla.org/netpolicy/2018/04/17/decision-in-oracle-v-google-fair-use-case-could-hinder-innovation-in-software-development/

A. The *Oracle I* Copyrightability Decision Conflicts With Decisions From the Ninth, First, Second, and Sixth Circuits

One of the Federal Circuit's key mistakes concerned the copyrightability of the words used to describe functions in the Java APIs, such as the word "max" to describe the Java function that finds the larger of two numbers. *Oracle I*, 750 F.3d at 1349-50. Oracle argued that its choice of "max" was copyrightable as long as that choice was not preordained, and alternate words were available for the same function, such as "Math.maximum" or "Arith.larger." *Id.* at 1361, 1367-68. The Federal Circuit agreed, despite the mandate of § 102(b) that copyright protection does not "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*" (emphasis added). 750 F.3d at 1361-67.

In any event, as the following table shows, other circuit courts have expressly disagreed with the Federal Circuit's analysis, both before and after the 2014 *Oracle I* decision.

Case	Holding
Oracle I, 750 F.3d at 1367 (2014)	We agree with Oracle that, under Ninth Circuit law, an original work—even one that serves a function—is entitled to copyright protection as long as the author had multiple ways to express the underlying idea.
Bikram's Yoga College of India, L.P. v. Evolation Yoga, LLC, 803 F.3d 1032, 1042 (9th Cir. 2015) (citations, quotations, and footnote omitted)	It makes no difference that similar results could be achieved through a different organization of yoga poses and breathing exercises. . . . the possibility of attaining a particular end through multiple different methods does not render the uncopyrightable a proper subject of copyright. Though it may be one of many possible yoga sequences capable of attaining similar results, the Sequence is nevertheless a process and is therefore ineligible for copyright protection.
Lotus Dev. Corp. v. Borland Int'l, Inc., 49 F.3d 807, 816 (1st Cir. 1995)	The fact that Lotus developers could have designed the Lotus menu command hierarchy differently is immaterial to the question of whether it is a "method of operation." . . . The "expressive" choices of what to name the command terms and how to arrange them do not magically change the uncopyrightable menu command hierarchy into copyrightable subject matter.

See also Sega, 977 F.2d at 1527 (granting copyright protection to functional concepts in computer programs "confers on the copyright owner a *de facto* monopoly over those ideas and functional concepts" and "defeats the fundamental purpose of the Copyright Act") (italics in original); *Comput. Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 708 (2d Cir. 1992) (while "there might be a myriad of ways in which a programmer may effectuate certain functions within a program,—i.e., express the idea embodied in a given subroutine—efficiency concerns may so narrow the practical range of choice as to make only one or two forms of expression workable options"); *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 536 (6th Cir. 2004) ("The question, however, is not whether *any* alternatives theoretically exist; it is whether other options practically exist under the circumstances . . . In order to characterize a choice between alleged programming alternatives as expressive, in short, the alternatives must be feasible within real-world constraints") (emphasis in original).

The Federal Circuit's holding in *Oracle I* is incompatible with that of the other circuits cited above; this Court should resolve that conflict.

B. *Oracle II*'s Cramped Fair Use Analysis Conflicts With the Holdings of This Court as Well as the Ninth and First Circuits

The court's *Oracle II* decision also conflicts with guidance from this Court and several circuit courts.

1. Liberal and Flexible Fair Use Analysis Is Especially Crucial When Dealing With New, Functional Technologies

Fair use was designed to ensure that copyright law could accommodate technological change. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 448 n.31 (1984) (quoting H.R. Rep. No. 94-1476, at 65-66 (1976)) (noting that Congress rejected "a rigid, bright line approach" to fair use and that such flexibility was key to the continuing achievement of copyright's aims "during a period of rapid technological change").

To ensure that breathing space for new technologies, this Court has cautioned that courts confronted with such technologies should err on the side of fair use. In *Sony*, the Court observed that where "Congress has not plainly marked our course, we must be circumspect in construing the scope of rights created by a legislative enactment which never contemplated such a calculus of interests." *Id.* at 431. Thus, the Court held that time-shifting of television programs was fair use, and left it to Congress to decide otherwise: "It may well be that Congress will take a fresh look at this new technology, just as it so often has examined other innovations in the past. But it is not our job to apply laws that have not yet been written." *Id.* at 456.

Similarly, the Ninth Circuit teaches that where, as here, technological change "has rendered an aspect or application of the Copyright Act ambiguous," then that ambiguity should be resolved in favor of the public good. *Sega*, 977 F.2d at 1527.

Oracle II, by contrast, took a constrained and rigid approach. The lower court focused on Oracle's private commercial interests, particularly in its discussion of fair use factors one and four. *Oracle II* thus narrowly construes fair use for a new technology, instead of resolving any ambiguity broadly. Indeed, *the jury* had no trouble applying the teachings of this Court and other circuits—yet another reason the Federal Circuit should have left the jury's conclusion undisturbed.

2. *Oracle II*'s Analysis of the Second and Third Fair Use Factors Conflicts With the Ninth Circuit

Oracle II's analysis of fair use factor two is especially problematic. The second factor looks to "the nature of the copyrighted work." 17 U.S.C. § 107(2). In weighing factor two, *Oracle II* called it not "terribly significant" and having "less significance" than the other factors. 886 F.3d at 1205.

Not coincidentally, *none* of the cases the lower court cited for that proposition involved functional aspects of computer programs. In particular, *Oracle II* ignored *Sega*, 977 F.2d 1510, a leading Ninth Circuit case on fair use of functional aspects of computer programs. In its fair use analysis, *Sega* observed:

> The second statutory factor, the nature of the copyrighted work, reflects the fact that not all copyrighted works are entitled to the same level of protection.
>
> . . .

> [T]he programmer's choice of program structure and design may be highly creative and idiosyncratic. However, computer programs are, in essence, utilitarian articles—articles that accomplish tasks. As such, they contain many logical, structural, and visual display elements that are dictated by the function to be performed, by considerations of efficiency, or by external factors such as compatibility requirements and industry demands.

977 F.2d at 1524 (citations omitted). The court concluded that "[u]nder the Copyright Act, if a work is largely functional, it receives only weak protection. 'This result is neither unfair nor unfortunate. It is the means by which copyright advances the progress of science and art.'" *Id.* at 1527 (quoting *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 350 (1991)).

Thus, the Ninth Circuit does not share *Oracle II's* view that the second fair use factor is not "terribly significant." To the contrary, in cases concerning functional works such as those here and in *Sega*, the Ninth Circuit views factor two as *highly* significant. In *Sega*, Accolade used the functional elements of Sega's software for commercial purposes—just as Oracle accuses Google of doing here. Nevertheless, taking due account of the second fair use factor, the Ninth Circuit found that Accolade's copying of Sega's functional requirements for compatibility was fair use as a matter of law, and reversed the district court's preliminary injunction. *Sega*, 977 F.2d at 1524-28. Here, the jury was entitled to give factor two great weight in its fair use analysis. *Oracle II's* rejection of the jury's conclusions squarely conflicts with the Ninth Circuit.

Oracle II also conflicts with Judge Michael Boudin's influential concurring opinion in *Lotus*. In that case, Lotus was attempting to claim copyright protection over the functional aspects of its spreadsheet computer menus. Judge Boudin asked "why customers who have learned the Lotus menu and devised macros for it should remain captives of Lotus because of an investment in learning made by the users and not by Lotus." 49 F.3d at 821. Thus, Judge Boudin concluded that Borland's use of the Lotus menus could be called a fair or "privileged" use. *Id.* The same was true here.

As to the third factor, there was no dispute that the amount of the copyrighted work that Google used was quantitatively minimal. Pet. App. at 114a. *Oracle II* nevertheless concluded that factor three "arguably weighs against" fair use as a matter of law because, in the lower court's view, the Java APIs used were qualitatively significant. *Oracle II*, 886 F.3d at 1207.

But the Federal Circuit also acknowledged that Google used that small portion of Java for functional reasons, such as allowing third-party developers to continue using their training and experience in the Java APIs to create new software for mobile devices. *Id.* at 1206–07. Under Ninth Circuit precedent, that functional purpose should have tilted the factor three analysis in favor of fair use. *SOFA Entm't, Inc. v. Dodger Prods., Inc.*, 709 F.3d 1273, 1279 (9th Cir. 2013).

In sum, the Federal Circuit analyzed the highly functional Java APIs the same way one would analyze copyrightability or fair use for a work of entertainment such as a book or screenplay. As the other circuits have recognized, under Sections 102(b) and 107 that approach was both simplistic and erroneous.

CONCLUSION

The Court should grant the petition for a writ of certiorari.

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