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 PROFESSORS PETER S. MENELL AND DAVID NIMMER AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

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INTEREST OF *AMICI CURIAE*[1]

The authors of this brief are professors of law at the University of California who study and teach intellectual property law. Their interest in filing this brief is to promote faithful interpretation of U.S. copyright law. Both authors have written extensively about copyright law in general and copyright protection for computer software in particular since the mid 1980s. Their work has been cited extensively in the leading cases on copyright protection for computer software.

Professor Peter S. Menell is the Koret Professor of Law at the University of California at Berkeley. He holds a law degree and a doctorate degree in economics. Beginning in graduate school, he has focused a significant portion of his research on intellectual property law. Soon after joining the University of California at Berkeley School of Law faculty in 1990, he laid the groundwork to establish the Berkeley Center for Law & Technology (BCLT). Since its founding in 1995, BCLT has sought to foster the beneficial and ethical understanding of intellectual property law and related fields as they affect public policy, business, science and technology. Professor Menell has authored or co-authored more than 100 articles and authored,

[1] Pursuant to Sup. Ct. R. 37.6, *amici* represent that no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amici* made a monetary contribution to its preparation or submission. Petitioner and Respondent have consented in writing to the filing of this brief and were given 10 days notice of *Amici*'s intent to file.

co-authored, or edited 15 books, including leading casebooks, intellectual property treatises, and research handbooks. Professor Menell has also organized more than 60 intellectual property education programs for federal judges in conjunction with the Federal Judicial Center since 1998, including an annual four-day intensive course on "Intellectual Property in the Digital Age." He has also collaborated with government agencies (U.S. Patent & Trademark Office, U.S. Copyright Office, Federal Trade Commission, Office of Technology Assessment) on a wide range of public policy, research, and education projects. He served as Vice-Chair of the National Academies of Sciences project on copyright and innovation.

Professor David Nimmer has taught courses in copyright law and lectured on the subject at his home institution of UCLA and at other universities across the country and around the world. Since 1985, he has authored Releases 18 through 106 of NIMMER ON COPYRIGHT, maintaining up-to-date the treatise originally published in 1963 by his late father, Melville B. Nimmer. He has also written more than 50 articles about domestic and international copyright law as well as its historical development, some of which are gathered in two anthologies: COPYRIGHT: SACRED TEXT, TECHNOLOGY AND THE DMCA (2003) and COPYRIGHT ILLUMINATED (2008).

In Spring 2018, the HARVARD JOURNAL OF LAW & TECHNOLOGY published a Special Issue on copyright protection for computer software focusing on the

Oracle v. Google litigation. The issue is framed by Professor Menell's monograph-length lead article, which explores the rich history, technology, and legal issues surrounding this case. The Special Issue includes commentaries prepared by counsel from both sides of the *Oracle v. Google* litigation as well as leading academics, and a response by Professor Menell. In addition, the BERKELEY TECHNOLOGY LAW JOURNAL published a 2016 article by Professor Menell addressing the distinctive jurisdictional issue at the heart of this brief. Professor Nimmer's treatise, NIMMER ON COPYRIGHT, has been cited extensively in the decisions below as well as throughout copyright jurisprudence.

SUMMARY OF ARGUMENT

The Supreme Court should grant review of the Federal Circuit's decisions in *Oracle v. Google* for two compelling sets of reasons. First, the Federal Circuit's decisions conflict with this Court's seminal decision in *Baker v. Selden*, 101 U.S. 99 (1879), misinterpret Congress's codification of this Court's fundamental channeling principle and related limiting doctrines, and upend nearly three decades of sound, well-settled, and critically important decisions of multiple regional circuits on the scope of copyright protection for computer software. By various measures—economic output and growth, employment, international competitiveness, strategic national defense—the computer software industry is among the most significant in the United

States. As the digital revolution continues to unfold, the software industry's importance will only grow. The balance of intellectual property protection for the software industry drives innovation and competition in this critical economic sector. The Federal Circuit's decisions revive and exacerbate circuit splits that had largely been resolved through the evolution of well-reasoned regional circuit authority.

Second, the Federal Circuit's handling of the *Oracle v. Google* cases flies in the face of Congress's clear intent in creating a specialized national appellate *patent* tribunal. Unlike regional courts of appeals, the Federal Circuit does not have general authority to interpret non-patent intellectual property law. Rather, Congress mandated that the Federal Circuit must apply the copyright law of the regional circuit court in which resides the district court that heard a case involving a patent infringement claim. By failing to apply Ninth Circuit copyright law faithfully in the *Oracle v. Google* decisions, the Federal Circuit has established itself as the de facto *national appellate software copyright tribunal* in direct contravention of legislative directive and intent. By the readily available option of bringing software copyright and patent claims in the same complaint, any software company can secure exclusive Federal Circuit appellate jurisdiction over all issues and thereby circumvent regional copyright law and insulate its decisions from regional circuit copyright authority. As a result, it is essential that the Supreme Court grant review to address the clear

circuit splits created by the decisions below and restore Congress's division of appellate authority.

ARGUMENT

I. THE FEDERAL CIRCUIT DECISIONS CONFLICT WITH THIS COURT'S SEMINAL RULING IN *BAKER V. SELDEN*, MISINTERPRET CONGRESS'S CODIFICATION OF INTELLECTUAL PROPERTY LAW'S FUNDAMENTAL CHANNELING PRINCIPLE AND COPYRIGHT'S LIMITING DOCTRINES, AND EXACERBATE CIRCUIT SPLITS ON COPYRIGHTABILITY, MERGER, AND FAIR USE

A. The Federal Circuit's Decisions Conflict with *Baker v. Selden*

This Court's decision in *Baker v. Selden*, 101 U.S. 99 (1879), established the structural foundation for the U.S. intellectual property system. Accountant Charles Selden devised a condensed ledger bookkeeping system for government accounting. See CHARLES SELDEN, SELDEN'S CONDENSED LEDGER, OR BOOK-KEEPING SIMPLIFIED (1859). His new system consolidated the broad range of county transactions into a single ledger. The preface to Selden's book proclaimed that this new system would "greatly simplify the accounts of extensive establishments doing credit business" and handle "an almost infinite variety of transactions," qualifying it

"to be classed among the greatest benefactions of the age." *Id*. It noted that "[i]n addition to the copyrights of this little book, [Selden] has applied for a patent right to cover the forms of the publication, and prevent their indiscriminate use by the public." *Id*.

After some initial success, Selden's enterprise foundered. In 1867, another accountant released BAKER'S REGISTER OF RECEIPTS AND DISBURSEMENTS WITH BALANCE SHEETS AND REPORTS FOR COUNTY AUDITORS AND TREASURERS, offering a similar accounting system with some advantages that made it easier to use. By 1871, Baker's system was in wide use while Selden's languished.

Selden's widow sued Baker for copyright infringement. On appeal, this Court recognized that Selden sought to monopolize use of the accounting system or method explained in the book through copyright law, thereby gaining an exclusive right in the use of similar ruled lines and headings. *Baker v. Selden*, 101 U.S. at 101. While acknowledging that copyright law protected an author's expression in conveying information on the subject of bookkeeping, the Court ruled that copyright protection could not extend to the "art" or methods thus described:

> To give to the author of the book an exclusive property in the art described therein, when no examination of its novelty has ever been officially made, would be a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright. The claim to an invention or discovery of an art or

> manufacture must be subjected to the examination of the Patent Office before an exclusive right therein can be obtained; and it can only be secured by a patent from the government.

Id. at 102. Justice Bradley illustrated the proposition by noting that although a physician could gain a copyright in a book about his medical discoveries and treatments, such protection could not extend to the new art, manufacture, or composition of matter without obtaining a utility patent. *Id*. at 103-04. *Baker v. Selden* thereby established a fundamental principle for channeling protection among the intellectual property regimes.

The Federal Circuit's decisions directly conflict with *Baker v. Selden*. By affording Oracle exclusive rights to not just the implementing code for Java application programming interface (API) elements but also the declarations that are necessary to call those methods, the Federal Circuit has protected the computer system's functionality through copyright law. Sun's/Oracle's devising of a package (java.security) using a particular class name (ProtectionDomain) and method name (ClassLoader) to effectuate a machine that responds to particular inputs and produces particular outputs moves the creative names and essential structure outside of copyrightability, thereby enabling others (in the absence of a utility patent covering this process or machine) to emulate (and interoperate with) this machine so long as they write their

own implementation. As this Court explained in *Baker v. Selden*,

> [t]he copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires. The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book. And where the art it teaches cannot be used without employing the methods and diagrams used to illustrate the book, or such as are similar to them, such methods and diagrams are to be considered as necessary incidents to the art, and given therewith to the public; not given for the purpose of publication in other works explanatory of the art, but for the purpose of practical application.

Id. at 103-04.

B. The Federal Circuit's Decisions Misconstrue the Copyright Act

1. 17 U.S.C. § 102(b)

Congress codified *Baker v. Selden*'s fundamental channeling principle in the text of the Copyright Act of 1976:

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

17 U.S.C. § 102(b). A plain reading of the statute indicates that these exclusions apply at the copyrightability stage of analysis. It is also pertinent to infringement analysis and the fair use defense. Beyond the statutory text, the legislative history concurs:

> Some concern has been expressed lest copyright in computer programs should extend protection to the methodology or processes adopted by the programmer, rather than merely to the "writing" expressing his ideas. Section 102(b) is intended, among other things, to make clear that the expression adopted by the programmer is the copyrightable element in a computer program, and that the actual processes or methods embodied in the program are not within the scope of the copyright law.

H.R. REP. NO. 94-1476, at 57 (1976).

> [O]ne is always free to make a machine perform *any* conceivable process (in the absence of a patent) [so long as one does not] take another's program.

See NAT'L COMM'N ON NEW TECHNOLOGICAL USES OF COPYRIGHTED WORKS, FINAL REPORT 1 (1979) ("CONTU FINAL REPORT"), at 20 (emphasis added).[2]

Google argued that the particular compilations of functions in Java API packages were uncopyrightable "method[s] of operation." The Federal Circuit rejected this:

> Section 102(b) does not, as Google seems to suggest, automatically deny copyright protection to elements of a computer program that are functional. Instead, as noted, Section 102(b) codifies the idea/expression dichotomy and the legislative history confirms that, among other things, Section 102(b) was 'intended to make clear that the expression adopted by the programmer is the copyrightable element in a computer program.' H.R. REP. NO. 1476, 94th Cong., 2d Sess. 54 [sic; the correct page reference is 57], reprinted in 1976 U.S.C.C.A.N. 5659, 5670.

Oracle America, Inc. v. Google Inc., 750 F.3d 1339, 1367 (Fed. Cir. 2014). As reflected above, however, the Federal Circuit omitted the critical completion to the quoted sentence: "*and that the actual processes and methods embodied in the program are not within the*

[2] Courts have treated the CONTU FINAL REPORT as legislative history for the Computer Software Act of 1980, amending the 1976 Act in accordance with CONTU's recommendations. See *Vault Corp. v. Quaid Software Ltd.*, 847 F.2d 255, 260-61 (5th Cir. 1988); *Apple Comput., Inc. v. Franklin Comput. Corp.*, 714 F.2d 1240, 1252 (3d Cir. 1983).

scope of the copyright law." H.R. REP. NO. 1476, 94th Cong., 2d Sess. at 57 (emphasis added).

In accordance with clear text (and the full legislative history) of the Copyright Act, Google was entitled to make a mobile device ("a machine") perform the same functions as a Java API package (a "conceivable process") with independently developed implementation code (i.e., not "another's program"). Each Java API package constituted a particular subsystem within a larger particular computing environment. Hence, Google was justified in selecting a set of Java API packages and implementing them with original code to create a new machine. See Peter S. Menell, Rise of the API Copyright Dead?: An Updated Epitaph for Copyright Protection of Network and Functional Features of Computer Software, 31 HARV. J.L. & TECH. 305, 433-52 (2018) (hereinafter cited as "Rise of the API Copyright Dead").

2. 17 U.S.C. § 107

Section 107 of the Copyright Act provides:

> Notwithstanding the provisions of sections 106 and 106A, 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
> >
> > (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.

17 U.S.C. § 107.

The Federal Circuit's 2018 decision gives no weight to the second fair use factor, explaining that

> [t]he Ninth Circuit has recognized . . . that this second factor 'typically has not been terribly significant in the overall fair use balancing.' *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1402 (9th Cir. 1997) (finding that the 'creativity, imagination and originality embodied in The Cat in the Hat and its central character tilts the scale against fair use'); *Mattel*[, *Inc. v. Walking*

> *Mountain Prods.*, 353 F.3d 792, 803 (9th Cir. 2003)] (similar).

Oracle America, Inc. v. Google LLC, 886 F.3d 1179, 1205 (Fed. Cir. 2018). The Federal Circuit's reliance on *Dr. Seuss Enters.* and *Mattel* makes no sense. Those cases addressed familiar children's stories and dolls; neither involved functional works, let alone computer software. By contrast, the Ninth Circuit's decisions in *Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1524-27 (9th Cir. 1993) (extensive discussion of the second factor connecting fair use to *Baker v. Selden* and § 102(b)) and *Sony Comput. Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596, 602-05 (9th Cir. 2000) (leading its discussion of fair use with the second fair use factor and affording it great significance), bear directly on the Ninth Circuit's treatment of the second fair use factor in a *software case*, yet get no mention in the Federal Circuit's discussion of the second fair use factor.

C. The Federal Circuit's Decisions Revive and Exacerbate Circuit Splits on Copyrightability, Merger, and Fair Use

As chronicled in Rise of the API Copyright Dead, 31 HARV. J.L. & TECH. at 322-26, copyright protection for computer software got off to an unfortunate start. In a case involving blatant and cavalier piracy of entire computer programs, the Third Circuit went overboard in addressing the defendant's interoperability argument, stating in dicta that "total compatibility with independently developed application programs . . . is a commercial and competitive objective which does not

enter into the somewhat metaphysical issue of whether particular ideas and expressions have merged." *Apple Comput., Inc. v. Franklin Comput. Corp.*, 714 F.2d 1240 (3d Cir. 1983). Building on that decision, the Third Circuit ruled that, in distinguishing protectable expression from unprotectable ideas,

> *the purpose or function of a utilitarian work would be the work's idea, and everything that is not necessary to that purpose or function would be part of the expression of the idea.* Where there are many means of achieving the desired purpose, then the particular means chosen is not necessary to the purpose; hence, there is expression, not idea.

Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc., 797 F.2d 1222, 1236 (3d Cir. 1986) (emphasis in original; citations omitted). In applying this rule, the court defined the idea as "the efficient management of a dental laboratory," for which countless ways of expressing the idea would be possible. *Id*.

These decisions were roundly criticized by commentators. See, e.g., 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.03[F], at 13-62.34, at 13-4 (1991) (explaining that "[t]he crucial flaw in [*Whelan*'s] reasoning is that it assumes that only one 'idea,' in copyright law terms, underlies any computer program, and that once a separable idea can be identified, everything else must be expression"); Donald S. Chisum, Rochelle Cooper Dreyfuss, Paul Goldstein, Robert A. Gorman, Dennis S. Karjala, Edmund W. Kitch, Peter S. Menell, Leo J. Raskind, Jerome H.

Reichman & Pamela Samuelson, LaST Frontier Conference on Copyright Protection of Computer Software, 30 JURIMETRICS J. 15, 20-21 (1989); Peter S. Menell, An Analysis of the Scope of Copyright Protection for Application Programs, 41 STAN. L. REV. 1045, 1074 (1989); Peter S. Menell, Tailoring Legal Protection for Computer Software, 39 STAN. L. REV. 1329 (1987). As this scholarship emphasized, viewing the idea-expression dichotomy at such a high level of abstraction produces an overbroad scope of copyright because it results in all implementations of the idea garnering protection. Furthermore, the Third Circuit's conflation of merger analysis and the idea-expression dichotomy implicitly allows copyright protection of procedures, processes, systems, and methods of operation that are expressly excluded under § 102(b).

Drawing on this scholarship, other circuits developed alternative approaches to the scope of copyright protection that better comport with *Baker v. Selden* and related fundamental limiting doctrines. See, e.g., *Plains Cotton Coop. Assoc. v. Goodpasture Comput. Serv., Inc.*, 807 F.2d 1256, 1262 (5th Cir. 1987) (declining to follow *Whelan*); *Comput. Assocs. Int'l v. Altai, Inc.*, 982 F.2d 693, 705-06 (2d Cir. 1992) (rejecting dictum in *Apple v. Franklin* and the *Whelan Associates* analytical framework); *Sega Enterprises Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1525 (9th Cir. 1993) (rejecting *Whelan*); *Gates Rubber v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834, 841 (10th Cir. 1993) (endorsing *Altai*); *Apple Computer, Inc. v. Microsoft Corp.*, 799 F. Supp. 1006 (N.D. Cal. 1992), *aff'd in part, rev'd in part*, 35

F.3d 1435, 1445 (9th Cir. 1994) (endorsing *Altai*); *Eng'g Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1341-43 (5th Cir. 1994) (endorsing *Altai*); *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 813 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1996); *MiTek Holdings, Inc. v. ARCE Engineering Co.*, 89 F.3d 1548, 1559 (11th Cir. 1996) (endorsing *Altai*); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1375 (10th Cir. 1997) (endorsing *Altai*).

Thus, after an inauspicious start, the regional circuit courts of appeals implemented a balanced framework for both protecting computer software against piracy and interpreting the idea-expression doctrine to ensure that copyright law excludes functional features of computer technology. Although the early overbroad Third Circuit cases remained on the books, software copyright law achieved stability, clarity, and sound reasoning. See Peter S. Menell, An Epitaph for Traditional Copyright Protection of Network Features of Computer Software, 43 ANTITRUST BULL. 651, 707-08 (1998); see also *Sony Comput. Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000) (reinforcing and extending *Sega*); *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 534-37 (6th Cir. 2004) (reinforcing this evolution).

The Federal Circuit's decisions revive and exacerbate the long dormant circuit splits relating to copyrightability of particular elements of computer software, copyright infringement analysis, and the application of the Copyright Act's fair use doctrine.

II. THE FEDERAL CIRCUIT'S DECISIONS USURP REGIONAL CIRCUIT COURT AUTHORITY, PROMOTE FORUM SHOPPING, AND SPAWN A MUTANT BRANCH OF REGIONAL CIRCUIT LAW

Not all circuit courts are created equal. Congress granted the Federal Circuit exclusive authority to interpret *patent* law, but specifically required that it faithfully apply the law of regional circuits in addressing non-patent questions. By not faithfully applying Ninth Circuit precedent, the Federal Circuit has improperly usurped the role that Congress reserved for regional courts of appeals. See Peter S. Menell, API Copyrightability Bleak House: Unraveling and Repairing the *Oracle v. Google* Jurisdictional Mess, 31 BERKELEY TECH. L.J. 1515 (2016) (hereinafter cited as "API Copyrightability Bleak House").

A. The Federal Circuit's Subject Matter Jurisdiction

Congress established the U.S. Court of Appeals for the Federal Circuit in 1982 for the express purpose of "ending the current legal confusion created by eleven different appellate forums, all generating different interpretations of the patent law." See H.R. REP. NO. 96-1307 (1980) (commenting on the legislation that would become the Federal Courts Improvement Act of 1981, Pub. L. No. 97-164, 96 Stat. 25); see also COMM'N ON REVISION OF THE FEDERAL COURT APPELLATE SYS., STRUCTURE AND INTERNAL PROCEDURES: RECOMMENDATIONS FOR CHANGE 15, as reprinted in 67 F.R.D. 195,

220-21 (1975) (quoting Judge Henry Friendly describing "mad and undignified races between a patentee who wishes to sue for infringement in one circuit believed to be benign toward patents, and a user who wants to obtain a declaration of invalidity or noninfringement in one believed to be hostile to them") (citing HENRY J. FRIENDLY, FEDERAL JURISDICTION: A GENERAL VIEW (1973)); see generally *API Copyrightability Bleak House*, 31 BERKELEY TECH. L.J. at 1578-81.

In crafting the Federal Circuit's subject matter jurisdiction, Congress was clear that the Federal Circuit's exclusive patent jurisdiction did not apply to other areas of federal law, such as copyright law. See 28 U.S.C. § 1295. As the Senate Report explains, the establishment of the Federal Circuit

> is intended to alleviate the serious problems of forum shopping among the regional courts of appeals on patent claims by investing exclusive jurisdiction in one court of appeals. It is not intended to create forum shopping opportunities between the Federal Circuit and the regional courts of appeals on other claims.

See S. REP. 97-275 (1981), as reprinted in 1982 U.S.C.C.A.N. 11; see also H.R. REP. No. 96-1307, at 23 (1980) ("[J]urisdiction of an appeal in a case involving a claim arising under any Act of Congress relating to copy rights or trademarks . . . will continue to go to the regional appellate courts, pursuant to section 1294 of title 28.").

Yet the Federal Circuit's exclusive appellate jurisdiction over cases involving patent infringement allegations has created a new species of interpretive confusion. In patent cases that contain copyright (or other non-patent) causes of action, the Federal Circuit will hear the appeals of such non-patent issues even if, as was the circumstance in *Oracle v. Google*, neither party challenged the district court's patent rulings. Congress did not provide a mechanism short of Supreme Court review for ensuring that the Federal Circuit properly interpreted regional circuit law. This creates the potential for a mutant body of regional circuit software copyright law that is beyond the reach of the very regional circuit court in charge, which is precisely what the Federal Circuit has wrought.[3]

B. Software Copyright Forum Shopping at the Federal Circuit

The Federal Circuit's lack of fidelity to regional circuit law has created the very problem that legislators warned against. By the readily available option of combining software copyright and patent claims in the same complaint, any software company can secure Federal Circuit appellate jurisdiction over all issues

[3] This Court has unanimously rebuffed a plaintiff's efforts to invoke trademark laws to "create a species of mutant copyright law that limits the public's 'federal right to "copy and to use"'" works not validly within copyright protection. *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 34 (2003). The Federal Circuit's vindication of plaintiff Oracle's position here gives rise to parallel dangers.

and thereby circumvent regional copyright law and insulate its decisions from regional circuit copyright authority. As a result, it is essential that the Supreme Court grant review to address the clear circuit splits created by the decisions below and restore the division of appellate authority that Congress intended.

The Federal Circuit's misinterpretation of Ninth Circuit copyright law now motivates software intellectual property owners to bundle patent and copyright claims in order to take advantage of the Federal Circuit's expansive interpretation of software copyright protection. It is no coincidence that Cisco filed its complaint alleging software patent and copyright causes of action against Arista Networks after the Federal Circuit's 2014 *Oracle v. Google* decision. See Quentin Hardy, In Suit, Cisco Accuses Arista of Copying Work, N.Y. TIMES: BITS (Dec. 5, 2014), http://bits.blogs.nytimes.com/2014/12/05/in-suit-cisco-accuses-arista-of-copying-work/; Scott Graham, *Cisco v. Arista* IP Battle Starts to Look a Lot Like *Oracle v. Google*, RECORDER (Sept. 14, 2017), http://www.therecorder.com/id=1202766017854/Cisco-v-Arista-IP-Battle-Starts-to-Look-a-Lot-Like-Oracle-v-Google. The district judge in that case faced the dilemma of whether to follow actual Ninth Circuit decisions or the Federal Circuit's distorted version of Ninth Circuit law. See Rise of the API Copyright Dead, 31, HARV. J.L. & TECH. at 429-52.

The forum shopping problem is especially pronounced because of the ease with which the software copyright owners can manufacture Federal Circuit jurisdiction. Software patents have proliferated over the

past two decades, see U.S. Patent and Trademark Office, Patent Counts By Class By Year (January 1977-December 2015) (showing tremendous growth in the number of patents issued in classes 700-26, those most associated with computer software; and the issuance of approximately 450,000 patents in software-related classes since the year 2000), https://www.uspto.gov/web/offices/ac/ido/oeip/taf/cbcby.htm, and a robust market for software patents exists. See Chris Dongan & Matthew Vella, The Secondary Market in Patents: What Went Right, What Went Wrong and How to Fix It, IAM (Oct. 12, 2017) (describing evolution of the market for patents), https://www.iam-media.com/finance/secondary-market-patents-what-went-right-what-went-wrong-and-how-fix-it. Thus, even if software companies have not patented their software, they can find a broad assortment of software patents in the secondary market. The mere filing of a complaint alleging both patent and copyright causes of action locks in Federal Circuit appellate jurisdiction over all issues in the case. Even if the patent issues later drop out of the case, as occurred in *Oracle v. Google* and *Cisco v. Arista*, the Federal Circuit retains appellate jurisdiction over whatever remains.

C. The Federal Circuit's Lack of Fidelity to Ninth Circuit Precedent Creates an Unworkable Legal Regime in Direct Conflict with Congress's Crafting of Federal Jurisdiction

Absent Supreme Court intervention, the Federal Circuit's *Oracle v. Google* decisions validate legislators'

fears that the national appellate *patent* tribunal will establish itself as the de facto *national appellate software copyright tribunal*.

The Federal Circuit's misreading of regional circuit law creates an anomalous intra-circuit split that only the Supreme Court can resolve.[4] Ninth Circuit jurisprudence holds that the "functional requirements for compatibility with the Genesis [video game console constitute] aspects of Sega's programs that are not protected by copyright. 17 U.S.C. § 102(b)." *Sega Enterprises Ltd. v. Accolade*, 977 F.2d 1510; see also *Sony Comput. Entm't, Inc. v. Connectix Corp.*, 203 F.3d 596, 603 (9th Cir. 2000) ("There is no question that the Sony BIOS [Basic Input Output System] contains unprotected functional elements.").

To make this point concrete, suppose that Sega had written its lockout code not as 20-25 bytes of data, see *Sega*, 955 F.2d at 1516, but rather as an original haiku or, better yet, an entire novel about young wizards. See Peter S. Menell, Against Defibrillating the API Copyright Dead: A Response to Advocates of Copyrightability of Software Functional Specifications, 31 HARV. J.L. & TECH. 653, 660-61 (2018). Even though that haiku or novel could well be protected if distributed as poetry or a book, it would be barred from copyright protection as lockout code. That is the reason for the Ninth Circuit's unmistakable statement in *Sega*

[4] In every other instance, a circuit court itself can solve an intra-circuit split. But when the Federal Circuit applies standards that it has created in the guise of following "Ninth Circuit law," the Ninth Circuit itself is powerless to redress the matter.

that the "functional requirements for compatibility with the Genesis [video game console constitute] aspects of Sega's programs that are not protected by copyright. 17 U.S.C. § 102(b)." As essential gears and levers for particular digital machines, the Java API declarations are not protectable under copyright law due to the overarching channeling principle established in *Baker v. Selden* and reflected in Section 102(b) and other limiting doctrines.

It is for that reason that it is irrelevant that the Java APIs might be highly creative. So are haikus—but, if used as lockout code, those haikus garner no protection under copyright law against their being reproduced for the purpose of unlocking. Technological creativity is among the most difficult and praiseworthy forms of creativity. Yet the overarching intellectual property system would be undermined if the inventor of a better digital water pump or arrangement of typewriter keys could bar competition for life of the inventor plus 70 years by copyrighting the declarations (or functional specifications) for these devices. And therein lies the key to understanding intellectual property law as a cohesive system. Copyright does not stand alone as the sole means of promoting progress in computer software. It is part of a larger intellectual property *system* that channels protection for functional features of machines and other useful articles into the utility patent regime.

The Federal Circuit mistakenly holds that *Sega*'s unequivocal statement applies only to fair use analysis (and not to the threshold question of copyrightability),

and that "copyrightability is focused on the choices available to the plaintiff at the time the computer program was created," not the defendant's desire to achieve interoperability, see *Oracle America, Inc. v. Google Inc.*, 750 F.3d at 1369-70 (reviving the Third Circuit's flawed analysis in *Apple v. Franklin* and *Whelan*), views that are clearly rejected by Ninth Circuit authority. See *Sega*, 977 F.2d at 1525 (rejecting *Whelan*).

After the Federal Circuit's decision, the Ninth Circuit ruled that even if there are multiple methods to reach a particular end, a choice made among those methods is not expression to which copyright protection extends. See *Bikram's Yoga College of Indiana, L.P. v. Evolation Yoga, LLC*, 803 F.3d 1032, 1042 (9th Cir. 2015) (citing *Baker v. Selden* and *Sega*). The Ninth Circuit makes no mention of the Federal Circuit's 2014 *Oracle v. Google* decision in *Bikram's Yoga* or any other decision. As further evidence that the Federal Circuit seeks to develop its own branch of Ninth Circuit software copyright law, the supposedly "Ninth Circuit" decision on which it places greatest reliance is its own prior interpretation of Ninth Circuit law in *Atari Games Corp. v. Nintendo of Am., Inc.*, 975 F.2d 832 (Fed. Cir. 1992). See *Oracle v. Google*, 750 F.3d at 1354, 1357, 1360, 1361, 1363, 1366, 1370 (basing analysis on *Atari Games*).

As actual Ninth Circuit law makes clear, copyright's limiting doctrines operate as threshold copyrightability determinations, part of the filtration step

of infringement analysis, and as factors in fair use analysis. See *Ets–Hokin v. Skyy Spirits, Inc.*, 225 F.3d 1068, 1080 (9th Cir. 2000) (treating the object of the photograph as uncopyrightable under the useful-article doctrine, i.e., at a threshold copyrightability level); *Sega*, 977 F.2d at 1517-27; *Sony*, 203 F.3d at 602-05. Copyright law, like patent law's nonobviousness doctrine, does not fit a rigid mold. Cf. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398 (2007) (reversing the Federal Circuit for an overly rigid test). Yet the Federal Circuit's mutant version dictates otherwise.

CONCLUSION

For the reasons set forth above, the Court should grant the Petition for writ of certiorari. Beyond the clear circuit splits and salience of legal protection for computer software in the digital age, this petition presents a novel, unique, and critically important jurisdictional reason for Supreme Court review.

In closing, we emphasize that although both the Federal Circuit's 2014 copyrightability ruling and its 2018 fair use ruling are worthy of Supreme Court review, correcting the 2014 copyrightability ruling is of utmost importance to the integrity of copyright law

and competition and innovation in the computer software industry.

Respectfully submitted,

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