

IN THE
Supreme Court of the United States

GOOGLE, LLC,
Petitioner,

v.

ORACLE AMERICA, INC.,
Respondent.

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

**BRIEF FOR AMICI CURIAE
PYTHON SOFTWARE FOUNDATION AND TIDELIFT
IN SUPPORT OF PETITIONER**

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BRIEF OF *AMICI CURIAE* IN SUPPORT OF PETITIONER

INTEREST OF THE *AMICI CURIAE*¹

Amicus Python Software Foundation is a 501(c)(3) non-profit corporation that holds the intellectual property rights behind the open source Python programming language. We manage the open source licensing for Python version 2.1 and later and own and protect the trademarks associated with Python.

Amicus Tidelift, Inc. is a venture-backed corporation that works directly with open source maintainers to support open source components and the enterprises that use them.

Amici file this brief because all the software at issue in this case is subject to open source licenses. The resolution of the questions presented in the petition will directly affect the scope and enforceability of open source licenses crucial to *amici's* ongoing operations.

¹ No counsel for any party has authored this brief in whole or in part, and no person other than *amici* or their counsel have made any monetary contribution intended to fund the preparation or submission of this brief. Both parties were provided notice of intention to file ten days before the filing of this brief. In an email dated February 14, 2019, Respondent granted consent for the filing of this brief. Petitioner has given blanket consent to the filing of timely briefs for *amici curiae*.

SUMMARY OF ARGUMENT

A fundamental principle of copyright is that it only protects expression, not functionality. As the Court explained in *Harper & Row*: “[C]opyright is limited to those aspects of the work—termed ‘expression’—that display the stamp of the author’s originality.”² But not all aspects of a work are protected. The Copyright Act provides: “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.”³

So how should courts evaluate software, which includes both expressive and functional elements? That is the question posed by this case—which this Court should answer.

The works at issue in this case are the Java language “APIs,” shorthand for “Application Programming Interfaces,” as well as their structure, sequence, and organization (“SSO”). Some APIs can be clever, creative, and even expressive. But every API is *primarily* functional.

² 471 U.S. at 547-548.

³ 17 U.S.C. § 102 (b).

The Federal Circuit’s decisions, either with regard to copyrightability (“*Oracle I*,” App. at 121a) or fair use (“*Oracle II*,” App. at 1a), share the same fundamental error: they fail to deal appropriately with software as a mixed work consisting of both copyrightable expression and uncopyrightable functionality. Absent this Court’s intervention, a copyright holder will be able to use copyright to gain patent-like control over functionality for a copyright-length term.

The Federal Circuit compounded its error by failing to evaluate Google’s fair use arguments in light of Oracle’s actions in the marketplace. Before Google released Android, Oracle made a calculated decision to provide its software to the public under a widely-used open source license called the GNU General Public License (the “GPL”). Oracle was aware of the tradeoffs involved when it chose to release its software under the GPL. In blog posts celebrating the open source release, vice president James Gosling described Oracle’s hope that releasing the software as open source would increase its use and distribution.⁴ More significantly, Gosling anticipated that other open source Java implementations would “mine

⁴ James Gosling was vice president for Sun Microsystems, which was purchased by Oracle in 2010. For clarity, both entities are referred to in this brief as “Oracle.”

[Oracle’s] source for stuff to incorporate into their projects.”⁵ This is exactly what Google did.

The Federal Circuit’s decisions threaten to destabilize the software industry and upset more than thirty years of established practice within the software trade. Both open source and proprietary software development depend on the understanding that independent reimplementations are a common, pro-competitive and legally permissible activity.

REASONS FOR GRANTING THE PETITION

I. **The Federal Circuit failed to exclude uncopyrightable functionality from its copyrightability and fair use analyses.**

Computer software provides unique challenges in the context of copyright, because it incorporates both functional and expressive elements.⁶ It is well understood that the expressive elements of computer software are protectable as a

⁵ Robert Eckstein, James Gosling on Open Sourcing Sun’s Java Platform Implementations, Part 2, (Nov. 2006) <www.oracle.com/technetwork/articles/javase/gosling-os2-qa-136546.html>.

⁶ See, e.g., “[C]omputer 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 external factors such as compatibility requirements and industry demands...” *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1525 (9th Cir. 1992)

literary work under the Copyright Act.⁷ But software is also a “useful article ... having an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information.”⁸ This Court should clarify whether a copyright on expressive elements of software can be used to prevent the use of the functional elements of that same code.

The Federal Circuit’s two decisions are not consistent with each other. In *Oracle I*, the Federal Circuit held that functional interoperability is “irrelevant to copyrightability.”⁹ But in *Oracle II*, the Federal Circuit held that the fact that Google’s software “*perform[ed] the same functions*” as Oracle’s software was evidence that Google’s software infringed Oracle’s copyrights.¹⁰ Functionality cannot be both “irrelevant” to copyrightability and evidence of infringement.

Further, the Federal Circuit’s stance is contrary to the clear language of the statute. Saying that functionality is irrelevant to

⁷ 17 U.S.C. § 102 (b).

⁸ 17 U.S.C. § 101, definition of “useful article.”

⁹ *Oracle I* at 148a, 166a.

¹⁰ “Google argues that, although the declarations and SSO may *perform the same functions* in Android and Java, the jury could reasonably find that they have different purposes because the ‘point of Android was to create a groundbreaking platform for smartphones.’ Google’s arguments are without merit.” *Id.* at 31a, *emphasis* added, internal citations removed.

copyrightability is clearly at odds with the statutory text, which states that “In no case does copyright protection for an original work of authorship extend to any... procedure, process, system, [or] method of operation.”¹¹ The Federal Circuit’s analysis of fair use is similarly flawed. Following the statutory command to consider “the nature of the copyrighted work” (fair use factor two)¹² does not, as the Federal Circuit contends, “effectively negate Congress’s express declaration... that software is copyrightable.”¹³

II. The Federal Circuit’s reasoning is contrary to this Court’s decision in *Star Athletica*.

This Court recently addressed copyright protection for works that are both functional and expressive. Although this case concerns computer code, not clothing, the issues in this case are conceptually similar to those discussed in *Star Athletica, L.L.C. v. Varsity Brands, Inc.*¹⁴ In *Star Athletica*, there was concern that the failure to separate copyrightable and functional elements would lead to the “copyrighting of shovels.”¹⁵ But, contrary to this Court’s express concern, that is

¹¹ 17 U.S.C. § 102 (b).

¹² 17 U.S.C. § 107, factor (2).

¹³ *Oracle II* at 43a.

¹⁴ 137 S. Ct. 1002 (2017)

¹⁵ *Id.* at Fn. 2.

effectively what the Federal Circuit has allowed Oracle to do here.

In *Star Athletica*, this Court held that designs on a cheerleading uniform could be considered separately from the uniform's function as clothing and were copyrightable under the Copyright Act.¹⁶ In discussing how copyright applies to useful articles, this Court described what copyright does, and does not, protect: "To be clear, the only feature of the cheerleading uniform eligible for copyright in this case is the two-dimensional work of art.... respondents have no right to prohibit any person from manufacturing a cheerleading uniform of identical shape, cut, and dimensions to the one on which the decorations ... appear."¹⁷ As this Court expressed, the functional, utilitarian elements of a mixed work are not protectable under copyright, and the existence of a copyright in one part of a mixed work must not prohibit others' use of the utilitarian, functional aspects of the mixed work.

The Federal Circuit got this principle backwards. Just like a shovel may incorporate copyrightable designs, the works at issue here—the API and SSO—may indeed be copyrightable as a whole. But, like a shovel, software is primarily functional in nature. The Federal Circuit's decisions did not identify those functional elements that are excluded from copyrightability and

¹⁶ *Id.* at 1016.

¹⁷ *Id.* at 1013.

available for anyone to use. Rather, the Federal Circuit used the existence of elements “perform[ing] the same functions” as the linchpin establishing copyright infringement.¹⁸

III. The Federal Circuit failed to consider Oracle’s actions and the open source context in its fair use analysis.

The dispute in *Oracle II* focused on the scope of the fair use doctrine as applied to Oracle’s software. As part of that analysis, the Federal Circuit gave heavy weight under fair use factors one (“the nature and character of the use”) and four (“the effect of the use on the market”) to Oracle’s failures to secure commercial, royalty-bearing licenses for Java.¹⁹ However, the Federal Circuit’s analysis noted, but disregarded, a key fact: all the software in this case is provided under “open source” licenses granting broad permissions, including the permission to reimplement functionality.²⁰

“Open source” is a method of licensing intellectual property designed to encourage cooperation between parties. Open source licenses encourage cooperation by licensing copyrighted

¹⁸ *Oracle II* at 31a, internal citations removed.

¹⁹ “The jury also heard evidence that Amazon later used the fact that Android was free to negotiate a steep discount to use Java SE in its newer e-reader.” *Oracle II* at 51a.

²⁰ *Id.* at 6a.

material according to a set of rules—rules that grant broad latitude to licensees.²¹ This latitude even includes permission to act in ways contrary to the wishes of the copyright holder. Placing software under an open source license is a deliberate, strategic decision to forgo the tight control allowed by copyright to try to gain an alternative benefit like broader distribution or use. In return, licensees are able to rely on the permissions granted in the license to provide a stable legal foundation for independent development. Official commentary exists for various licenses, helping licensors and licensees come to a common understanding of what permissions are granted to open source licensees.

In this case, Oracle made the decision to provide its software under the GPL. The GPL is one of the licenses that has official commentary—specifically including statements explaining that one of the purposes of the license is to ensure that any licensee is able to “study how the program works” for any purpose whatsoever, including reimplementing the software.²²

Oracle was aware of and counted on these established interpretations when it chose to release its software under the GPL. Software developers were unwilling to invest heavily in software that didn’t provide the full range of permissions granted

²¹ For a listing of these rules, see the “Open Source Definition” at <opensource.org/osd-annotated>.

²² Richard Stallman, “What is free software?” <www.gnu.org/philosophy/free-sw.en.html>.

under open source licenses. As then-vice president James Gosling explained in an interview:

Q: What does [Oracle] hope to accomplish by open sourcing the JDK?

A: We want better conversations with the developer community, a more collaborative relationship. We want to have better relationships with many of the Linux distributions, and a lot of the Linux distributions are very sensitive about precisely which license one uses. We want to have better relationships with the open-source community, which leads to better distribution and makes it easy for people to collaborate with us to evolve the platform, to use it in even more interesting ways and in more interesting areas.²³

Even more significantly, Oracle publicly acknowledged its belief—also shared by others in the broader open source community—that releasing its work under the GPL would allow other open source implementations to learn from, take, and reimplement portions of its code. Again quoting Gosling:

²³ Robert Eckstein, James Gosling on Open Sourcing Sun's Java Platform Implementations, Part 1, (Oct. 2006) <www.oracle.com/technetwork/articles/javase/gosling-os1-qa-142025.html>.

Q: What kinds of things can a developer do with the open-source Java SE platform pieces right away?

A: Probably the most useful thing you can do with it is look at it and learn from it. It is somewhat traditional, but I always say that the source [code] is the documentation of last resort....

Q: How do you think this move will affect other open-source implementations of the Java programming language—for example, Apache Harmony or GNU Classpath?

A: It's hard to know. They'll certainly be able to mine our source for stuff to incorporate into their projects.²⁴

Google did nothing more than take Oracle at its word: it based Android on the Apache Harmony implementation of Java, and incorporated “stuff... into [it's] project” to help programmers already familiar with Oracle's Java platform. Google's actions were consistent with both Oracle's statements, its course of dealing in Java, and the

²⁴ Robert Eckstein, James Gosling on Open Sourcing Sun's Java Platform Implementations, Part 2, (Nov. 2006) <www.oracle.com/technetwork/articles/javase/gosling-os2-qa-136546.html>.

usage of trade concerning open source licenses and the GPL in particular.

The Federal Circuit’s decision on fair use failed to take into account this open source context, already established by the lower court.²⁵ Even disregarding Google’s reasonable reliance on Oracle’s public statements, the Federal Circuit’s fair use analysis missed the significance of Oracle’s actions. Specifically, under fair use factor one, “the purpose and character of the use,”²⁶ Google’s use was explicitly contemplated and anticipated by Oracle, and was consistent with Oracle’s goals in making the work available under the GPL. Under fair use factor four, “the effect of the use upon the potential market,”²⁷ Google’s use of Java in

²⁵ “Also, before Android was released, [Oracle] made all of the Java API available as free and open source under the name OpenJDK, subject only to the lax terms of the General Public License Version 2 with Classpath Exception. This invited anyone to subset the API. Anyone could have duplicated, for commercial purposes, the very same 37 packages as wound up in Android with the very same SSO and done so without any fee, subject only to lenient “give-back” conditions of the GPLv2+CE. Although Google didn’t acquire the 37 packages via OpenJDK, our jury could reasonably have found that Android’s impact on the market for the copyrighted works paralleled what [Oracle] already expected via its OpenJDK.” Order Denying Renewed Motion for Judgment as a Matter of Law and Motion for a New Trial of the United States District Court for the Northern District of California, (September 27, 2016), App. at 115a.

²⁶ 17 U.S.C. § 107, factor (1).

²⁷ *Id.*, factor (4).

Android delivered to Oracle exactly the business benefit it hoped for: a massive increase in the number of programmers familiar with and using Java.

IV. This case’s implications go beyond the case at issue, and affect the software industry generally and open source software in particular.

Google’s petition highlights the stakes for the two companies at issue. But *amici* want to emphasize that the effects of this decision go far beyond the two parties.

The Federal Circuit’s decisions are so destabilizing because they upset the settled expectations of thousands of software developers—and particularly open source software licensees—across all aspects of the economy. If these Federal Circuit decisions are allowed to stand, an immediate result will be the adoption of copyright enforcement for certain types of functional software elements. As intellectual property Professor Michael Risch expressed it:

I say that without commenting on the merits; right or wrong, this opinion will have real repercussions. The upshot is: no more compatible compiler/interpreters/APIs. If you create an API language, then nobody else can make a competing one, because to do so would necessarily entail copying the same structure of

the input commands and parameters in your specification. If you make a language, you own the language. That's what Oracle argued for, and it won. No Quattro Pro interpreting old Lotus 1-2-3 macros, no competitive C compilers, no debugger emulators for operating systems, and potentially no competitive audio/visual playback software. This is, in short, a big deal.²⁸

The open source licensing context is important because open source usage has become ubiquitous in software development. Recent estimates indicate that 98% of all software includes one or more open source-licensed components.²⁹ Changes to established interpretations of open source licenses and the permissions they grant to licensees will have effects far beyond this case.

Open source licensees depend on stable interpretations of what is “functional” and what is “expressive.” The ability to reimplement APIs, including in commercial contexts, has long been considered “fair game”—and fair use—if not excluded from copyrightability completely under the merger doctrine or as a “useful article.” Millions

²⁸ Michael Risch, *Oracle v. Google Again: The Unicorn of a Fair Use Jury Reversal*, (Mar. 28, 2018) <bit.ly/oracle-google-effect>.

²⁹ See “Open Source Adoption” at <bit.ly/open-source-adoption>.

of lines of open source code, with commercial value in the hundreds of billions of dollars, have been written with these settled expectations in mind. Absent this Court's review, all those investments are at risk.

Conclusion

Amici therefore join the Petitioner in asking that this Court grant the petition for a writ of certiorari.

Respectfully submitted,

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