

Why 65 Intellectual Property Scholars Filed an Amicus Curiae Brief in Support of Google’s Petition for Cert in the Oracle Case

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Pamela Samuelson (Berkeley Law School)

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In January 2018, Google filed a petition to ask the U.S. Supreme Court to review two adverse rulings by the Court of Appeals for the Federal Circuit in the *Oracle Am. Inc. v. Google Inc.* case. The first was the Federal Circuit’s 2014 decision overturning a district court ruling that several thousand declarations that Google used for its Android platform, which it derived from 37 of 166 Java application program interface (API) packages, were unprotectable by copyright law. Although disagreeing with the lower court’s copyrightability analysis, the Federal Circuit remanded the case, saying that there was a triable issue of fact on Google’s fair use defense. In the spring of 2016, Google’s fair use defense prevailed before a jury. The second adverse ruling was the Federal Circuit’s decision that no reasonable jury could have found fair use. Google’s petition asks the Court to review both the copyrightability and fair use rulings. Oracle will be filing its brief opposing Supreme Court review later this spring. Amicus curiae (friend of the court) briefs, whether in support of Google’s petition or in support of neither party, were recently filed.

One of the amicus curiae briefs supporting Google’s petition on the copyrightability issue was co-authored by me and my Berkeley colleague Catherine Crump, who is the Director of the Samuelson Law, Technology and Public Policy clinic at Berkeley Law School. Although the Supreme Court denied Google’s previous petition seeking review of the Federal Circuit’s copyrightability ruling, our amicus brief on behalf of 65 scholars of intellectual property law has asked the Court to grant the petition because, as the brief explains, we

are alarmed that the Federal Circuit’s copyrightability ruling has deepened splits in circuit court interpretations of several major copyright doctrines as applied to computer programs. That ruling disrupted the relative equilibrium of more than two decades of software copyright precedents and upset settled expectations within the software industry. Th[e] Court’s guidance is urgently needed to address and resolve circuit conflicts affecting this \$564 billion industry. [Our] sole interest in the case lies in [our] concern for the proper application of traditional principles of copyright law to computer programs. Because amici have devoted [our] careers to understanding the balancing principles built into copyright and other intellectual property laws, [our] views can aid the Court in resolving the important issues presented by the Petition.

While there is much that IP scholars will have to say on the merits if the Court grants the petition, our brief concentrates on numerous respects in which the Federal Circuit’s ruling is in conflict with Supreme Court and other appellate court rulings.

Before presenting the brief’s summary of our argument, it is worth noting that the lower court gave three reasons for holding that the Java API declarations were unprotectable by copyright law: first, because they constituted an unprotectable method or system under 17 U.S.C. § 102(b), second, because the merger doctrine precluded copyright protection for the declarations as there was, in effect, no other way to say them, and third, because the declarations were unprotectable under the words and short phrases doctrine. The Federal Circuit rejected all three rationales in its copyrightability ruling.

While our brief focuses primarily on the merger issue because the Federal Circuit’s interpretation of that doctrine is so clearly contrary to Supreme Court as well as other appellate court precedents, it also identifies the proper application of § 102(b) method/system exclusion in software copyright cases as another cert-worthy question. In addition, the brief touches on the words and short phrases issue, albeit less extensively.

We reprint the Summary of Argument below, and the entire brief is available from the Supreme Court’s website ([here](#)).

SUMMARY OF ARGUMENT

The Federal Circuit’s copyrightability ruling in *Oracle* has deepened splits in circuit court interpretations of several major copyright doctrines as applied to computer programs.

This brief makes three principal points. First, the Federal Circuit’s merger analysis is in conflict with this Court’s ruling in *Baker v. Selden*, 101 U.S. 99 (1880), and decisions by the First, Second, Fifth, Sixth, and Eleventh Circuits. Second, the Federal Circuit’s interpretation of the scope of copyright protection available to computer programs is at odds with *Baker* and decisions of the First, Second, Tenth, and Eleventh Circuits. Third, the Federal Circuit’s interpretation of the words and short phrases doctrine cannot be reconciled with holdings of the Third and Sixth Circuits.

The merger doctrine holds that expressions in works of authorship are unprotectable by copyright law when, as a practical matter, there is only a limited number of ways to express an idea, fact, or function. When ideas, facts, or functions, in effect, “merge” with expression, copyright protection will be withheld from the merged elements. The merger doctrine fosters socially beneficial competition and ongoing innovation as well as promoting the ongoing progress of science and useful arts, as the Constitution commands. U.S. Const. art. I, § 8, cl. 8.

The Federal Circuit’s copyrightability ruling conflicts with *Baker* in three respects: first, because the Federal Circuit concluded that merger can only be found if a first author had no alternative ways to express an idea when creating the work; second, because it held that constraints on a second comer’s design choices are never relevant to merger; and third, because it ruled that merger is only a defense to infringement, and never raises a copyrightability issue.

Post-*Baker* cases from the First, Second, Fifth, Sixth, and Eleventh Circuits have conceptualized and applied the merger doctrine more broadly than the Federal Circuit. These idea/expression, fact/expression, and function/expression merger cases have resulted in uncopyrightability rulings, which contradict the Federal Circuit’s holding on merger.

Beyond merger, the Federal Circuit’s interpretation of the scope of copyright protection available to software innovations conflicts with the rulings of other circuits in four respects. First, the Federal Circuit’s interpretation of the exclusion of methods and systems from copyright’s scope under 17 U.S.C. § 102(b) is contrary to the First Circuit’s interpretation in *Lotus Development Corp. v. Borland International, Inc.*, 49 F.3d 807 (1st Cir. 1995), *aff’d by an equally divided Court*, 516 U.S. 233 (1996). Second, several circuit courts have ruled in favor of compatibility defenses in software copyright cases. Only the Third and Federal Circuits have rejected them. Third, the Federal Circuit’s conception of “structure, sequence, and organization” (SSO) of programs as protectable expression as long as it embodies a modicum of creativity conflicts with the Second Circuit’s landmark decision, *Computer Associates International, Inc. v. Altai, Inc.*, 982 F.2d 693 (2d Cir. 1992). *Altai* rejected the conception of SSO as determinative of protectable expression. *Id.* at 706. Fourth, the Federal Circuit’s assertion that copyright and utility patents can provide overlapping protection to program SSO is in conflict with *Baker* as well as Tenth and Eleventh Circuit decisions.

There is, moreover, conflict among the circuits concerning the protectability of “words and short phrases.” The District Court denied Oracle’s claim in part based on its view that names and short phrases are not copyrightable, but the Federal Circuit held that words and short phrases, such as the names of individual Java declarations, could, if original, be eligible for copyright protection. However, the Third and Sixth Circuits have denied similar claims in cases involving identifiers such as names and numbers. Granting the Petition would enable this Court to resolve this split as well.

This post was previously published on the Patently-O blog.