

Nos. 17-1118, -1202

IN THE
United States Court of Appeals for the Federal Circuit

ORACLE AMERICA, INC.,
Plaintiff-Appellant,

v.

GOOGLE LLC,
Defendant-Cross-Appellant.

On Appeal from the United States District Court
for the Northern District of California
No. 3:10-cv-03561-WHA Hon. William H. Alsup

**RESPONSE TO COMBINED PETITION FOR
REHEARING AND REHEARING EN BANC**

Dorian E. Daley
Deborah K. Miller
Matthew M. Sarboraria
Ruchika Agrawal
ORACLE AMERICA, INC.
500 Oracle Parkway
Redwood Shores, CA 94065

Dale M. Cendali
Joshua L. Simmons
KIRKLAND & ELLIS LLP
601 Lexington Avenue
New York, NY 10022

E. Joshua Rosenkranz
Annette L. Hurst
Andrew D. Silverman
ORRICK, HERRINGTON &
SUTCLIFFE LLP
51 West 52nd Street
New York, NY 10019
(212) 506-5000

Kelsi Brown Corkran
Melanie L. Bostwick
Jeremy Peterman
ORRICK, HERRINGTON &
SUTCLIFFE LLP
1152 15th Street NW
Washington, DC 20005

Counsel for Plaintiff-Appellant

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Oracle America, Inc.

v.

Google LLC

Case No. 17-1118, -1202

CERTIFICATE OF INTEREST

Counsel for the:

(petitioner) (appellant) (respondent) (appellee) (amicus) (name of party)

Oracle America, Inc.

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10 % or more of stock in the party
Oracle America, Inc.	None	Oracle Corporation

4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court (**and who have not or will not enter an appearance in this case**) are:

See Attachment A.

July 27, 2018

Date

/s/ E. Joshua Rosenkranz

Signature of counsel

Please Note: All questions must be answered

E. Joshua Rosenkranz

Printed name of counsel

cc: Counsel of Record

Reset Fields

ATTACHMENT A

4. The following law firms and partners or associates appeared for Oracle America, Inc. in the Northern District of California or are expected to appear in this Court (and have not or will not enter an appearance in this case):

ORRICK, HERRINGTON & SUTCLIFFE LLP

Alyssa M. Caridis
Jeffrey L. Cox
Michelle O'Meara Cousineau
Kelly M. Daley
Vickie Feeman
Melinda Haag
Karen G. Johnson-McKewan
Ayanna Lewis-Gruss
Randall S. Luskey
Elizabeth C. McBride (no longer with firm)
Denise M. Mingrone
Geoffrey G. Moss
Gabriel M. Ramsey
Nathan D. Shaffer
Robert P. Varian
Christina M. Von Der Ahe

KIRKLAND & ELLIS LLP

Susan Davies
Sean Fernandes (no longer with the firm)
Diana M. Torres

MORRISON & FOERSTER LLP

Richard S. Ballinger (no longer with firm)

Michael A. Jacobs

Rudolph Kim

Kenneth A. Kuwayti

Daniel P. Muino

Marc David Peters

Roman A. Swoopes

Yuka Teraguchi

Mark E. Ungerman (no longer with firm)

BOIES, SCHILLER & FLEXNER LLP

David Boies

Meredith R. Dearborn

Steven C. Holtzman

William F. Norton, Jr. (no longer with the firm)

Beko Osiris Ra Reblitz-Richardson

Alanna Rutherford

TABLE OF CONTENTS

	Page
CERTIFICATE OF INTEREST.....	i
TABLE OF AUTHORITIES.....	v
INTRODUCTION.....	1
FACTUAL BACKGROUND.....	3
ARGUMENT.....	7
I. The Panel’s Application Of Ninth Circuit Law Does Not Warrant Rehearing.	7
II. The Panel’s 2014 Copyrightability Decision Does Not Warrant Rehearing.	9
A. This Court should not review an opinion that Google declined to present for rehearing when it issued four years ago.	9
B. Applying Ninth Circuit law, the panel correctly held Oracle’s original work copyrightable.	10
III. The Panel’s Fair-Use Decision Does Not Warrant Rehearing.	14
A. The standard of review in the Ninth Circuit does not warrant rehearing.	14
B. The panel’s sound application of Ninth Circuit transformative-use law does not warrant rehearing.	15
C. The panel did not overlook arguments.	18
IV. There Is No Urgency To Rehear This Case.	19
CONCLUSION.....	21
CERTIFICATE OF SERVICE	1
CERTIFICATE OF COMPLIANCE	1

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Apple Comput., Inc. v. Formula Int’l, Inc.</i> , 725 F.2d 521 (9th Cir. 1984).....	13
<i>Bikram’s Yoga College of India, L.P. v. Evolation Yoga</i> , 803 F.3d 1032 (9th Cir. 2015).....	9, 12
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994).....	15, 18
<i>Dow Chem. Co. v. Nova Chems. Corp. (Canada)</i> , 803 F.3d 620 (Fed. Cir. 2015).....	9
<i>Dr. Seuss, Enters. L.P. v. Penguin Books USA, Inc.</i> , 109 F.3d 1394 (9th Cir. 1997).....	18
<i>Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.</i> , 499 U.S. 340 (1991).....	11
<i>Fisher v. Dees</i> , 794 F.2d 432 (9th Cir. 1986).....	14
<i>George E. Warren Corp. v. United States</i> , 341 F.3d 1348 (Fed. Cir. 2003).....	8
<i>Harper & Row Publ’rs, Inc. v. Nation Enters.</i> , 471 U.S. 539 (1985).....	14, 18
<i>Johnson Controls, Inc. v. Phoenix Control Sys., Inc.</i> , 886 F.2d 1173 (9th Cir. 1989).....	11, 13
<i>Lotus Dev. Corp. v. Borland Int’l</i> 750 F.3d 1339 (Fed. Cir. 2014).....	13
<i>Oracle Am., Inc. v. Google Inc.</i> , 750 F.3d 1339 (Fed. Cir. 2014) (“ <i>Oracle P</i> ”).	3, 4, 6, 9, 10, 11, 12, 13, 21

Pentax Corp. v. Robison,
 135 F.3d 760 (Fed. Cir. 1998) 10

Sega Enters. Ltd. v. Accolade, Inc.,
 977 F.2d 1510 (9th Cir. 1992) 12, 18

Sony Corp. of Am. v. Universal City Studios, Inc.,
 464 U.S. 417 (1984) 12, 16, 18

Stewart v. Abend,
 495 U.S. 207 (1990) 2

TCA Television Corp. v. McCollum,
 839 F.3d 168 (2d Cir. 2016) 18

U.S. Bank Nat’l Ass’n ex rel. CWC Capital Asset Mgmt. v. Vill. at Lakeridge, LLC
 138 S. Ct. 960 (2018) 14

Worldwide Church of God v. Phila. Church of God, Inc.,
 227 F.3d 1110 (9th Cir. 2000) 16

Statutes & Rules

17 U.S.C. § 101 11

17 U.S.C. § 102(a) 10, 11

17 U.S.C. § 102(b) 10, 11

17 U.S.C. § 103(a) 13

17 U.S.C. § 107 17

Fed. Cir. R. 35 (b)(2) 7

Fed. R. App. P. 35(a)(1) 7

Other Authorities

Brief of United States, *Google Inc. v. Oracle Am., Inc.*,
 No. 14-410, 2015 WL 2457656 1

BSA Foundation, *The Growing \$1 Trillion Economic Impact of Software* (Sept. 2017), <https://tinyurl.com/y77xjgke> 20

Petition for Writ of Certiorari, *Google Inc. v. Oracle Am., Inc.*, No. 14-410, 2014 WL 5319724..... 20

INTRODUCTION

There is nothing “extraordinary” or “unusual,” Pet. 4, about the panel opinions in this case.

What is extraordinary is seeking en banc review of decisions that turn entirely on Ninth Circuit law. This Court has never granted rehearing en banc to consider a regional circuit’s law. It simply does not satisfy the criteria for en banc review.

Equally unusual is Google’s effort to seek review of a four-year-old decision in an earlier appeal that held Oracle’s work copyrightable. Google skipped the rehearing petition when that appeal was decided and failed to convince the Supreme Court to grant certiorari. As the United States explained to the Court, the decision was “correct[],” and Google “identified no sound basis for further review.” Brief of United States, *Google Inc. v. Oracle Am., Inc.*, No. 14-410, 2015 WL 2457656, at *19. Google recycles the same arguments here, which warrant the same result.

Google also seeks review of the panel’s current ruling that Google’s unlicensed commercial use of Oracle’s copyrighted work was not fair use. Google labels this decision “extraordinary” based on a

tweet claiming that “of the more than 300 decisions on fair use ... only one other decision overturn[ed] a jury verdict on fair use.” Pet. 4. But Google fails to mention that hardly any of those cases went to a jury. By our count, there have been exactly *five* JMOL appeals from fair use jury verdicts in the last 24 years. Resolving fair use as a matter of law is the norm.

It is certainly proper on such extreme facts: Oracle spent years writing packages of elegant software for the Java platform that appealed to a fan base of millions of app developers. Google then copied 11,500 lines of that expressive code into a competing platform for the express purpose of capturing Oracle’s fan base and competing against Oracle in the market. Google’s copying was the equivalent of taking the most recognizable parts of a popular short story and turning them into a blockbuster movie without the author’s permission—something the Supreme Court deemed a “classic” unfair use. *Stewart v. Abend*, 495 U.S. 207, 238 (1990). No court has ever held that it could be fair to copy this much original material and incorporate it into a competing product that displaces the original.

That is why Google and its amici are wrong in predicting that the panel opinion will undermine software innovation. The panel followed existing law. Google’s premise has always been that it may copy Oracle’s original code precisely because it has become wildly popular. *Oracle I*, 750 F.3d 1339, 1372 (Fed. Cir. 2014). That principle is foreign to copyright law—and anathema to innovation. No software company will ever invest the millions of dollars necessary to create such an innovative platform if competitors are free to plagiarize when it becomes popular.

This Court should deny Google’s petition.

FACTUAL BACKGROUND

Oracle and its predecessor, Sun Microsystems, created and continuously improved the Java platform to appeal to a community of developers who write their own apps. Relevant here are the Java platform’s thousands of prewritten programs known as application programming interfaces or “APIs” that “programmers ... use ... to build certain functions into their own programs.” Op. 8.

The Java APIs contain both “declaring code” and “implementing code.” “Declaring code” (what Google copied verbatim) is like the

chapter headings and topic sentences of an elaborate literary work: It introduces, names, and describes each pre-written program to help app developers learn and remember what those pre-written programs do, and how they interrelate, while writing their own code. App developers invoke the declaring code to incorporate a desired prewritten program into an app. Each portion of declaring code is associated with particular “implementing code,” which tells the computer how to perform the pre-written function. *Id.*

“[D]esigning the Java API packages was a creative process.”

Oracle I, 750 F.3d at 1356. Oracle painstakingly wrote expressive declaring code and organized the programs into an intricate structure and organization—all with a view toward making the platform attractive and intuitive to a vast fan base of millions of app developers. None of these creative choices were dictated by function. *Id.*

Google likes to say that Oracle’s code was “free and open” for all to use. Pet. 6. But Oracle made its code available only by license. Op. 9. App developers who used the platform to write *apps* could take a non-royalty-bearing license. But critically, Oracle never let competitors or device manufacturers freely copy its code to build competing *platforms*.

Id. Before Google began marketing Android using Oracle’s work, Oracle successfully licensed the Java platform for desktop and laptop computers, as well as for smartphones (like Danger), for tablets (like Amazon Kindle), and for development of a smartphone platform (SavaJe). Op. 51-52.

The panel’s opinion lays out Google’s brazen copying in full color. Op. 10-11. To summarize: In 2005, Google wanted to quickly develop a programming platform for mobile devices to protect its revenue from search-engine advertising. Google needed to attract Java developers to build apps for it. Op. 10. To speed the development and adoption of its platform—Android—Google copied 11,500 lines of Oracle’s declaring code and the exact structure and organization of the 37 API packages most relevant to attract Java mobile-app developers. *Id.* Google also made Android incompatible with Java so that apps written for Android would not run on the Java platform. Op. 47 n.11. Android generated over \$42 billion for Google as of 2016. It cost Oracle existing customers and blocked its entry into developing markets. Op. 10-11, 51-53.

Oracle sued Google for copyright infringement. The original jury found Google infringed Oracle’s copyright but hung on fair use.

Oracle I, 750 F.3d at 1347-48. After trial, the district court held the code Google copied devoid of copyright protection. *Id.* In 2014, this Court reversed, holding both Oracle’s declaring code and its structure and organization subject to copyright protection. *Id.* Google did not seek rehearing but petitioned for certiorari. The United States, as amicus, opposed Google’s petition. The Supreme Court denied it.

The case returned to district court for a retrial on Google’s fair-use defense. The second jury concluded that Google’s use was fair, and the district court denied Oracle’s JMOL motion. Op. 7. Oracle appealed, and the panel reversed. The panel “assume[d] that the jury resolved all factual issues relating to the historical facts in favor of the verdict” and, following Ninth Circuit law, carefully analyzed each of the fair-use factors in light of those historical facts. Op. 25.

Based upon undisputed facts, the panel concluded that factor one (the purpose and character of the copied use) weighed against fair use. Google’s use was “overwhelmingly commercial.” Op. 28-30. And it was not “transformative” because Google “made no alteration to the expressive content or message of the copyrighted material” and used it for the “same ... purpose” in the same “smartphone[] ... context.” Op.

30-39. The second factor (the nature of the copied work) weighed in Google’s favor, Op. 44, and the third (the amount taken) was neutral or favored Oracle, given the code’s conceded importance, Op. 44-48. The fourth factor (harm to existing and potential markets) “weigh[ed] heavily in favor of Oracle” in light of the unrebutted evidence that Android caused Oracle to lose customers and impaired Oracle’s ability to “license its work for mobile devices.” Op. 48-53.

“Weighing these factors together, [the panel] conclude[d] that Google’s use of the declaring code and [structure and organization] of the 37 API packages was not fair as a matter of law.” Op. 54.

ARGUMENT

I. The Panel’s Application Of Ninth Circuit Law Does Not Warrant Rehearing.

Last time, Google did not seek rehearing. And for good reason: The question whether a panel of this Court correctly applied Ninth Circuit law is not worthy of en banc review. This Court reserves its en banc power for exceptional cases—those that present a need to “secure or maintain uniformity of *the court’s* decisions” or “*precedent-setting* questions of exceptional importance.” Fed. R. App. P. 35(a)(1), Fed. Cir. R. 35 (b)(2) (emphases added). Where the answer to a question will not

“create a precedent,” en banc review is unwarranted. *George E. Warren Corp. v. United States*, 341 F.3d 1348, 1352 n.1 (Fed. Cir. 2003). A case involving purely regional circuit law does not meet these criteria, and Google does not seriously argue otherwise. Indeed, we have found no instance of this Court ever reviewing en banc a question controlled by regional circuit law.

Google proclaims the panel’s application of Ninth Circuit law “is now a Federal Circuit problem,” because plaintiffs might increasingly append patent claims to their copyright cases. Pet. 21. Google musters only two examples in five years of this supposed problem. *Id.* It also misses the point. Those cases will *always* be governed by the law of the various regional circuits. They will never involve questions of Federal Circuit law. Future panels will be required to reach the results dictated by the relevant regional circuit regardless of what this Court holds en banc.

II. The Panel’s 2014 Copyrightability Decision Does Not Warrant Rehearing.

A. This Court should not review an opinion that Google declined to present for rehearing when it issued four years ago.

Google’s lead argument challenges a 2014 decision resolving a prior appeal in this litigation. “[L]aw of the case posits that when a court decides upon a rule of law, that decision should continue to govern the same issues in *subsequent stages in the same case.*” *Dow Chem. Co. v. Nova Chems. Corp. (Canada)*, 803 F.3d 620, 627 (Fed. Cir. 2015) (quotation marks omitted). Copyrightability became such a “decide[d]” issue when Google declined to seek rehearing, the Supreme Court denied certiorari, and the parties pursued three years of fair-use litigation premised on the correctness of that ruling. Google offers no justification for skipping en banc review the first time and no reason why this Court should revisit a now-final ruling.

Worse, Google presents to the en banc Court an argument that it waived before the panel. Google argues that intervening Ninth Circuit law undermines *Oracle I*. Pet. 10 (citing *Bikram’s Yoga College of India, L.P. v. Evolation Yoga*, 803 F.3d 1032 (9th Cir. 2015)). In the latest appeal, Google included *Bikram’s* in a string cite before the panel,

but chose neither to “ask[] the panel for relief on the copyrightability issue nor offer[] any arguments on that issue.” Op. 55. This Court should follow its usual practice and “decline to address the ... new theory raised for the first time in [Google’s] petition for rehearing.” *Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998).

B. Applying Ninth Circuit law, the panel correctly held Oracle’s original work copyrightable.

As the United States explained to the Supreme Court, the panel’s 2014 copyrightability decision was “correct.” *Supra* 1.

“The Copyright Act provides protection to ‘original works of authorship’—which all agree include computer programs. *Oracle I*, 750 F.3d at 1354-55 (quoting § 102(a)). The panel held Oracle’s declaring code, and the code’s structure and organization, copyright-protected because they are creative expression that all agreed qualified as original works under § 102(a). *Id.* at 1355-56.

Google contends that Oracle’s work is a “system” or “method of operation” under § 102(b) and that the panel erred in holding that § “102(b) does *not* exclude systems or methods of operation from copyright protection.” Pet. 8-9. That is not what the panel held. Rather, following Ninth Circuit and Supreme Court precedent, the

panel recognized that § 102(b) does not extinguish the copyright protection that § 102(a) grants. 750 F.3d at 1354-55; *see Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 356 (1991) (§ 102(b) “in no way ... contracts the scope of copyright protection”; its “purpose is to restate ... the basic dichotomy between expression and idea”); *Johnson Controls, Inc. v. Phoenix Control Sys., Inc.*, 886 F.2d 1173, 1175-76 (9th Cir. 1989) (software’s “structure, sequence, and organization” is copyrightable if “the component in question qualifies as an expression of an idea”). Section 102(b) means that just because a work has copyright protection (under § 102(a)) does not mean the protection “*extend[s]*” to the underlying “ideas,” “systems,” and “methods of operation” that the author describes in the work. *Oracle I*, 750 F.3d at 1355-57 (quoting § 102(b)). Because the declaring code and its structure and organization were protected expression—not an idea, system, or method of operation—the panel correctly held them copyrightable. *Id.*

Google is wrong that Oracle’s code is an uncopyrightable “method of operat[ion]” because the code “instruct[s] a computer to carry out desired operations.” Pet. 10. That would be true of all computer programs. 17 U.S.C. § 101 (defining “computer program[s],” as “a set of

statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result”). So that rule would nullify Congress’s decision to make computer programs copyrightable. *Oracle I*, 750 F.3d at 1367.

The Ninth Circuit cases Google and its amici cite are not to the contrary. Pet. 10. The panel thoroughly considered *Sega* and *Sony* and rejected Google’s argument for several reasons. Most notably—they are not copyrightability decisions. *Oracle I*, 750 F.3d at 1369.

Even if Google had preserved its argument about *Bikram’s Yoga*, *but see supra* 9-10, it changes nothing. *Bikram’s* held that a “healing methodology” comprised of a series of yoga poses was not copyrightable because “medical and functional considerations” “compel[led]” arranging the poses in a “strict order.” 803 F.3d at 1039-40, 1042. Here, however, it was undisputed that Oracle had an unlimited number of ways to write and organize the ideas in its code, such that functional considerations did not dictate the specific expression Oracle chose. *Supra* 4. *Bikram’s* did not call into question the Ninth Circuit’s *Johnson Controls* decision—ignored by Google and its amici—that software code is copyrightable whenever it “qualifies as an *expression of*

an idea.” 886 F.2d at 1175-76 (emphasis added). Google instead relies on a portion of *Birkam’s* that holds the yoga sequence could not qualify for copyright protection *as a compilation* under § 103(a), when this case is not about compilations.¹

Lastly, Google argues that the panel misapplied the merger doctrine, which precludes copyright protection where the idea and expression “merge[].” Pet. 11. It reasons that “[i]f Google did not use the API’s declarations ... programmers could not have used the familiar shorthand commands” that Oracle made so popular. *Id.* But the panel followed Ninth Circuit law holding that the merger analysis applies “at the time of creation [by Oracle], not at the time of infringement [by Google].” *Oracle I*, 750 F.3d at 1361 (citing *Apple Comput., Inc. v. Formula Int’l, Inc.*, 725 F.2d 521, 524 (9th Cir. 1984)).

¹ The panel explained why the First Circuit’s *Lotus* decision is consistent with its copyrightability holding. *Oracle I*, 750 F.3d at 1365. Moreover, any conflict would be irrelevant because Ninth Circuit law governs here.

III. The Panel’s Fair-Use Decision Does Not Warrant Rehearing.

A. The standard of review in the Ninth Circuit does not warrant rehearing.

The panel correctly reviewed “the ultimate determination of fair use” “*de novo*.” Pet. 12. The controlling law is clear: “the ultimate conclusions to be drawn from the admitted facts [in a fair use case] ... are legal in nature.” *Fisher v. Dees*, 794 F.2d 432, 436 (9th Cir. 1986); accord *Harper & Row Publ’rs, Inc. v. Nation Enters.*, 471 U.S. 539, 560 (1985) (“Where the district court has found facts sufficient to evaluate each of the statutory factors, an appellate court ... may conclude as a matter of law that the challenged use does not qualify as a fair use”). The panel thoroughly explained how the recent Supreme Court bankruptcy decision *U.S. Bank* further supports *de novo* review. Op. 19-20. This Court should not sit en banc to predict how the Ninth Circuit would apply *U.S. Bank*.

Google mischaracterizes the panel decision when it asserts that the panel “adopted as fact a large number of disputed Oracle assertions.” Pet. 13. The panel explicitly “resolved all factual issues relating to the historical facts in favor of the verdict.” Op. 25. Google’s

fact-specific contention to the contrary is not worthy of en banc review. Regardless, it fails because most of Google's examples are unsupported by the record citations this Court needs to assess its argument. *See* Pet. 14 n.2. Where Google does offer citations, there is no material dispute. Taking Google's three examples (at 13-14) in order: *Google's* witnesses testified that Java SE was in a modern smartphone, Oracle Reply 13; caselaw establishes that unauthorized use weighs against fair use even if the work is free, *id.* at 44; and Google conceded that "only" 170 lines of code were "technically necessary" to use the Java language, Oral Arg. at 24:45-25:30.

B. The panel's sound application of Ninth Circuit transformative-use law does not warrant rehearing.

The panel correctly held that Google's copying is non-transformative under Ninth Circuit law. Op. 30-39. The panel applied the established test: "[a] use is 'transformative' if it 'adds something new, with a further purpose or different character, *altering the first with new expression, meaning or message.*'" Op. 30 (emphasis added) (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994)). The panel correctly found that Google's use failed that test. Every line of code Google copied into Android serves the same purpose and

communicates the same message as the original code. “Google made no alteration to the expressive content or message of the copyrighted material.” Op. 33.

Google contends the panel erred in concluding “Google’s use was not transformative primarily because ... the copied declarations ... serve ‘an identical function and purpose’ in Android.” Pet. 15. But copying a work and using it for the same purpose as the original “seriously weakens [the] claimed fair use.” Op. 31 (quoting *Worldwide Church of God v. Phila. Church of God, Inc.*, 227 F.3d 1110, 1117 (9th Cir. 2000)). Moreover, the panel’s holding rests on Google’s failure to alter the work’s *expression or meaning*, not on an absolute rule that “similarity of uses and functions” can never be transformative. Pet. 15. Citing *Sony*, the panel recognized that copying code for a similar purpose can be “modestly transformative” when done to *learn* about the “unprotected” ideas in a computer program in order to create “a wholly new product” with “entirely new ... code.” Op. 34 (citing *Sony*). But, unlike *Sony*, Google copied *protected* expression, not to reverse engineer, but to put the copied code *directly into* a competing commercial product. *Id.*

Google's inability to explain how it changed the meaning or message communicated by Oracle's code is also why the panel correctly concluded that it was "irrelevant" that Google wrote its own implementing code. Pet. 16. Google made "no suggestion that the new implementing code somehow changed the expression or message of the declaring code." Op. 36.

Google argues the panel "erred by focusing on transformation of the declarations, as opposed to" Java and Android "as a whole." Pet. 16. But the panel thoroughly compared Oracle's and Google's works and rejected Google's argument. Op. 36-37. It found *undisputed* evidence established that Java and Android shared the same purpose. *Id.* ("the record showed that Java SE APIs were in smartphones before Android entered the market").

In any event, Google is wrong about the proper focus. Oracle Reply 16-17. Congress directed courts to determine "the purpose and character of the *use*," meaning the *infringing use* of the copyrighted material that the defendant seeks to establish as fair. 17 U.S.C. § 107 (emphasis added). Thus, in *Campbell*, the Supreme Court focused on how the new work changed the meaning of the copied verses by using

them as part of a “play on words” with “juxtapos[ition]” to “comment on the naiveté of the original.” 510 U.S. at 582-83 (citation omitted). That is also how the Ninth Circuit analyzes transformative use. *See Dr. Seuss, Enters. L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1401 (9th Cir. 1997) (analyzing use of the expropriated elements of the original in the new work: “the Cat’s stove-pipe hat, the narrator, and the title.”); *accord TCA Television Corp. v. McCollum*, 839 F.3d 168, 180 (2d Cir. 2016).

At bottom, Google’s argument rests on the assertion that under the panel’s approach “virtually no use of any element of a computer program could ever be transformative.” Pet. 15. But the panel said it did “not conclude that a fair use defense could never be sustained in an action involving the copying of computer code.” Op. 54 (citing *Sega* and *Sony*). More importantly, it has never been fair to copy a work and put it to the exact same use at the expense of the original. *Harper & Row*, 471 U.S. at 550.

C. The panel did not overlook arguments.

Google complains that the panel overlooked its argument that its use was fair because “a ‘reasonable copyright owner’ would have

consented to the use.” Pet. 18 (citation omitted). The panel quoted this very argument, Op. 17, and properly rejected it, Op. 41.

Amici also complain about ignored arguments. But Google “abandoned the arguments” about “interoperability” that amici press. Op. 47 n.11. Google likewise disclaimed its amici’s arguments about factor 2’s importance, telling the panel “market harm is the most important factor.” Google Br. 68. The panel nonetheless acknowledged that “functional considerations were both substantial and important” and gave that consideration due weight, resolving factor 2 in Google’s favor. Op. 44.

IV. There Is No Urgency To Rehear This Case.

Google and its amici raise alarms about dire consequences. They concede that “software can generally be protected by copyright.” Pet. 5. Yet they insist that the panel upset settled “law ... recogniz[ing] ... that [software developers] are free to use existing computer software interfaces.” Pet. 3. But they cite no case that has ever held it is permissible to copy thousands of lines of code into a competing product that supersedes the original in the marketplace.

Nor did the panel make grand pronouncements about the copyrightability of interfaces or “the basic building blocks of computer design and programming.” Pet. 20-21. Some interfaces may be devoid of expression and thus not copyrightable. The panel painstakingly assessed the unique work here on the specific record before it, according to basic copyright principles.

The panel’s adherence to settled law also refutes Google’s assertion that the decision will cause “crippling liability and ... new barriers to innovation” for the software industry. Pet. 19-20. Google made the same dire warning to the Supreme Court four years ago, *see* Petition for Writ of Certiorari, *Google Inc. v. Oracle Am., Inc.*, No. 14-410, 2014 WL 5319724 at *36, yet offers not a shred of proof that its doomsday scenario has transpired. To the contrary, software innovation has thrived since then. *See* BSA Foundation, *The Growing \$1 Trillion Economic Impact of Software* (Sept. 2017), <https://tinyurl.com/y77xjgke>.

Google’s doomsday scenario is unfounded. Under the panel decision, app developers may continue to use the Java APIs for free. The decision merely prohibits what only Google has done: copying

Oracle’s work into a competing commercial platform without abiding by Oracle’s licensing scheme. *Oracle I*, 750 F.3d at 1360 n.5. Allowing such plagiarism is what would constitute a “devastating” blow to “the computer software industry.” Pet. 3.

CONCLUSION

This Court should deny Google’s petition.

July 27, 2018

Respectfully submitted,

/s/ E. Joshua Rosenkranz

E. Joshua Rosenkranz
ORRICK, HERRINGTON &
SUTCLIFFE LLP
51 West 52nd Street
New York, NY 10019
(212) 506-5000

Counsel for Plaintiff-Appellant

CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States Court of Appeals for the Federal Circuit by using the appellate CM/ECF system on July 27, 2018.

ORRICK, HERRINGTON & SUTCLIFFE LLP

/s/ E. Joshua Rosenkranz

E. Joshua Rosenkranz

Counsel for Plaintiff-Appellant

CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limitation of Fed. R. App. P. 32(a)(7)(B)(i) because this brief contains 3891 words, excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally spaced typeface using Microsoft Word 2013 in Century Schoolbook 14-point font.

Orrick, Herrington & Sutcliffe LLP

/s/ E. Joshua Rosenkranz
E. Joshua Rosenkranz
Counsel for Plaintiff-Appellant