

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

SUPPLEMENTAL BRIEF FOR PETITIONER

Lisa S. Blatt
Sarah M. Harris
Meng Jia Yang
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005

Robert A. Van Nest
Christa M. Anderson
Eugene M. Paige
Reid P. Mullen
KEKER, VAN NEST
& PETERS LLP
633 Battery Street
San Francisco, CA 94111

Bruce W. Baber
Marisa C. Maleck
KING & SPALDING LLP
1180 Peachtree Street, N.E.
Atlanta, GA 30309

Thomas C. Goldstein
Counsel of Record
Sarah E. Harrington
Erica Oleszczuk Evans
GOLDSTEIN & RUSSELL, P.C.
7475 Wisconsin Avenue
Suite 850
Bethesda, MD 20814
(202) 362-0636
tg@goldsteinrussell.com

Michael S. Kwun
KWUN BHANSALI LAZARUS LLP
555 Montgomery Street
Suite 750
San Francisco, CA 94111

TABLE OF CONTENTS

TABLE OF AUTHORITIES ii

SUPPLEMENTAL BRIEF FOR PETITIONER 1

I. Certiorari Should Be Granted Based On The
Overriding Importance Of The Questions
Presented 2

II. Certiorari Should Be Granted To Determine
The Copyrightability Of Software Interfaces 5

III. Certiorari Should Be Granted To Determine
Whether The Reimplementation Of Software
Interfaces May Be Fair Use 9

CONCLUSION 12

TABLE OF AUTHORITIES**Cases**

<i>Computer Assocs. Int’l v. Altai, Inc.</i> , 982 F.2d 693 (2d Cir. 1992)	2
<i>Harper & Row, Publishers, Inc. v. Nation Enters.</i> , 471 U.S. 539 (1985)	9
<i>Lexmark Int’l, Inc. v. Static Control Components, Inc.</i> , 387 F.3d 522 (6th Cir. 2004)	2
<i>Lotus Dev. Corp. v. Borland Int’l, Inc.</i> , 49 F.3d 802 (1st Cir. 1995)	2, 7, 8, 9
<i>Lotus Dev. Corp. v. Borland Int’l, Inc.</i> , 516 U.S. 233 (1996)	2, 8
<i>Zalewski v. Cicero Builder Dev., Inc.</i> , 754 F.3d 95 (2d Cir. 2014)	6

Constitutional Provisions

U.S. Const. art. I, § 8, cl. 8	3
--------------------------------------	---

Statutes

17 U.S.C. § 102(b)	8
--------------------------	---

SUPPLEMENTAL BRIEF FOR PETITIONER

The Solicitor General has indicated that he now agrees with the Federal Circuit's judgment, albeit with some "doubt." Br. of U.S. (New SG Br.) 10. But the new invitation brief (a) notably is not signed by either of the two specialist departments of the federal government,¹ (b) does not engage the opposite position of 73 scholars (including the author of the seminal copyright treatise),² and (c) contradicts the prior invitation brief in this case.³

The Solicitor General's further effort to cabin the Federal Circuit's fair use ruling as factbound is refuted by the 175 individuals, companies, and organizations that filed 15 amicus briefs in support of the petition to explain that it is imperative that this Court grant certiorari. Those submissions recognize that the Federal Circuit has effectively prohibited the widely accepted industry practice of reimplementing software interfaces, inevitably causing serious harm to current practices and future innovation in the software industry.

The Solicitor General also affords too little weight to the fact that this case directly presents an avowed circuit conflict on an issue that this Court granted

¹ Compare, e.g., Br. of U.S., No. 18-1150, *Georgia v. Public.Resource.Org, Inc.* (signed by Copyright Office and Patent & Trademark Office).

² See 65 IP Scholars Br. (copyrightability); 8 IP Scholars Br. (fair use).

³ See Br. of U.S., No. 14-410, *Google, Inc. v. Oracle Am., Inc.* (Prior SG Br.); *infra* at 4, 6, 8, 10.

certiorari to resolve, but divided four-to-four. *Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 802 (1st Cir. 1995), *aff'd by an equally divided Court*, 516 U.S. 233 (1996) (per curiam). For decades, the lower courts have described these questions as “vexing”⁴ and “elusive,”⁵ because “[a]pplying copyright law to computer programs is like assembling a jigsaw puzzle whose pieces do not quite fit.”⁶

Certiorari should be granted.

I. Certiorari Should Be Granted Based On The Overriding Importance Of The Questions Presented.

Start with the petition’s breathtaking importance, given that the rulings below will seriously impede software innovation. Contrary to the Solicitor General’s assumption, at 3, this case is not about the copyrightability of computer code generally. The issue is whether copyright law prohibits reimplementing—*i.e.*, reusing—the software interfaces that are necessary to connect dozens of platforms to millions of applications on billions of devices. Without interfaces, your contact list cannot access your email program, which cannot send a message using the operating system, which cannot access your phone in the first place. Each is an island.

Countless other examples abound. The information age depends on the reuse of interfaces. Once

⁴ *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 535 (6th Cir. 2004) (Sutton, J.).

⁵ *Computer Assocs. Int'l v. Altai, Inc.*, 982 F.2d 693, 704 (2d Cir. 1992).

⁶ *Lotus*, 49 F.3d at 820 (Boudin, J., concurring).

an interface is written and used, no substitute works, because information must be passed precisely. Unless new software reimplements the old interface exactly, that software cannot connect to existing applications or platforms—making it functionally impossible for a new entrant to develop software that improves on or extends legacy products. Banning the reuse of interfaces is equivalent to mandating that car companies “invent a substitute for the steering wheel,” 78 Computer Scientists Br. 23, or that manufacturers replace the “plug and electrical outlet combination,” Red Hat Br. 10 n.2.

Google reimplemented interfaces called “declarations.” The declarations do only one thing. They are the essential bridge between (a) software applications written by independent developers (such as Microsoft’s Outlook email program or a game created by a start-up developer), and (b) “implementing code”—here, Google’s code that lets those applications work with the Android operating system.

Oracle argues that it owns—and therefore can close off—that bridge, even though it has *no rights at all* to either the applications or the implementing code on either side of the divide. Oracle believes it can use copyright to “lock in” the developers that used the open and uncopyrighted Java programming language, making it much more difficult for them to write their own programs for a new and innovative platform like Android. That turns on its head the purpose of copyright to “promote the Progress of Science and useful Arts.” U.S. Const. art. I, § 8, cl. 8; *see also infra* at 8-10.

The Federal Circuit agreed with Oracle, notwithstanding that extending the sweeping monopoly of copyright would choke off the interoperability that has

been an essential driver of software innovation. It held that Google committed copyright infringement, because (a) interfaces are copyrightable, and (b) reimplementing them is not fair use. The multi-trillion-dollar software industry has always operated in reliance on the exact opposite “competition-enhancing consensus,” CCIA Br. 3, created by “nearly three decades of sound, well-settled, and critically important decisions of multiple regional circuits,” Menell & Nimmer Br. 3. Leading companies do not lightly use phrases like “disastrous consequences.” Microsoft Br. 4; *see also* Cert. Reply 1-3 (collecting citations).

When this case was previously here, the Solicitor General repeatedly represented to this Court that there were “important concerns about the effects that enforcing respondent’s copyright could have on software development.” Prior SG Br. 10; *see also id.* at 17, 22. But that brief advised the Court to wait until now, because those issues “are better addressed through petitioner’s fair use defense” after remand. *Id.* at 10. “At a minimum,” the Solicitor General said then, “this Court could better assess and clarify the relevance of those concerns to copyright-law analysis if the Court had before it all potentially relevant statutory arguments.” *Id.* at 22. That was exactly right.

The Solicitor General’s new attempt to insulate the fair use ruling from further review by characterizing it as factbound depends on misreading isolated words and phrases. The Federal Circuit did not “emphasize[], however, that its decision rested on the specific ‘facts relating to the copying at issue here’ and ‘this particular code.’” New SG Br. 10 (quoting Pet. App. 54a). It summarized its discussion of how interfaces are purportedly distinguishable from the

computer code that was at issue in two prior Ninth Circuit cases: “We hold that, given the facts relating to the copying at issue here—which differ materially from those at issue in *Sony* and *Sega*—Google’s copying and use of this particular code was not fair as a matter of law.” Pet. App. 54a.

Nor did the Federal Circuit “limit[] its fair-use holding to the facts of this case and disclaim[] any broader fair-use rule governing other ‘action[s] involving the copying of computer code.’” New SG Br. 21 (quoting Pet. App. 53a). It stated that it was not “conclud[ing] that a fair use defense could *never* be sustained in an action involving the copying of computer code.” Pet. App. 53a-54a (emphasis added).⁷

II. Certiorari Should Be Granted To Determine The Copyrightability Of Software Interfaces.

The Solicitor General’s view that “[p]etitioner’s first question presented is essentially identical to the question on which this Court previously denied certiorari,” New SG Br. 10, is at odds with his acknowledgment that “[p]etitioner’s earlier petition did not seek review of the court of appeals’ merger holding,” *id.* at

⁷ The Solicitor General’s recognition that the Federal Circuit applied Ninth Circuit case law acknowledges that the rulings below are binding whenever a plaintiff sues a software company in California and also asserts a nominal software patent claim. New SG Br. 22. The better question is what future plaintiff *won’t* satisfy those elementary forum-shopping criteria. The Federal Circuit’s decisions have effectively made it “the de facto national appellate software copyright tribunal,” Menell & Nimmer Br. 4, accessible by any plaintiff that attaches a throw-away software patent claim. In the best case, some suits will be controlled by the rulings below, while others will be subject to the traditional rule, creating inconsistency and uncertainty.

13 n.1. Merger is the principle that “if an idea ‘can only be expressed in a limited number of ways,’ those means of expression ‘cannot be protected, lest one author own the idea itself.’” *Id.* at 2 (quoting *Zalewski v. Cicero Builder Dev., Inc.*, 754 F.3d 95, 102-03 (2d Cir. 2014)).

The Solicitor General argues that Oracle should prevail because merger is inapplicable if the declarations’ author “had ‘unlimited options as to [their] selection and arrangement.’” New SG Br. 13 (quoting Pet. App. 150a). But here, the author did not. In the very next sentence, the Solicitor General has no answer to the point “that the declaring code could be written ‘only in one way’ after respondent’s predecessor-in-interest made certain conceptual decisions.” *Ibid.* Take his own example: *public static int max (int x, int y)*. *Id.* at 5. The author made the choice to create a method that determines the larger of two integers. The *only* expressive choices in writing that code were “uncopyrightable names,” *id.* at 15—*viz.*, *max*, *x*, and *y*. As the district court found, the programming language itself dictates all the other expression—the commands and the precise order in which they are expressed. Pet. App. 225a-26a.

That is why it was necessary for Google to reimplement the declarations. Google invested substantial effort and time in creating the creative “implementing code” that actually performs the programming functions. *See* New SG Br. 13 (“Without infringing any copyright, petitioner could and did write its own code to implement the same processes or methods.”). By contrast, “the rules of Java dictate the precise form” of the declarations—for either the original author or anyone else—such that “everyone using that function must

write that specific line of code in the same way.” Pet. App. 221a. Under principles of merger, the declarations were not copyrightable. As the Solicitor General explained last time: “If within a given technological environment, code must be drafted in a specific way in order to induce the computer to carry out a particular function, then the expression would ‘merge’ with the function, and the code would be uncopyrightable.” Prior SG Br. 14.

This time, the Solicitor General argues that copyright actually protects the unwritten structure, sequence, and organization (SSO) of the Java API packages, New SG Br. 14, a theory that was notably absent from the last invitation brief. This new position leaves aside the bulk of the Federal Circuit’s rulings, which devote little attention to the distinct copyright status of the SSO.

Further, because Google has the right to copy the declarations, it cannot reasonably be held liable for copying the SSO—because the SSO is embodied *only* in the declarations. When Google lawfully reimplemented the declarations, it inherently and unavoidably duplicated the SSO without any particular intention to do so. New SG Br. 7 (“[T]he declaring code establishes and reflects” the “SSO[] of the Java Standard Library.”). The Solicitor General’s position is the same as saying that someone who is licensed to copy a novel word for word—including the *chapter names*—nonetheless commits copyright infringement by thereby unavoidably and unintentionally replicating the *table of contents*.

The Solicitor General also gives insufficient weight to the conflict with the holding of *Lotus*. The First Circuit held in that case that the menu

commands and structure of the Lotus computer spreadsheet program were not copyrightable. In stark conflict with the Federal Circuit here, the First Circuit expressly rejected as “immaterial” the fact that the original “developers could have designed the Lotus menu command hierarchy differently.” 49 F.3d at 816. Instead, the First Circuit deemed it dispositive that (a) the menus operated the program (and hence were an uncopyrightable “method of operation” under 17 U.S.C. § 102(b)), and (b) a later competitor had to re-use the original menus to allow users of the Lotus software to use the new competitor. 49 F.3d at 815-19.

This Court granted certiorari in *Lotus*, but divided four-to-four. 516 U.S. 233. The Federal Circuit in this case expressly rejected the First Circuit’s decision, recognizing that it was taking sides on an existing circuit conflict. Pet. App. 142a, 158a-66a. *Lotus* demonstrates that this issue has deserved the Court’s attention for more than 20 years; the Federal Circuit’s rejection of *Lotus* only serves to highlight and heighten the need for this Court’s definitive guidance.

Because the split is tailor-made for certiorari, Google previously sought review based on the acknowledged conflict over the meaning of “method of operation.” 14-410 Pet. i. The Solicitor General waved the split away by characterizing *Lotus* as relying at least in part on “a principle analogous to the merger doctrine, to the effect that, because there was only one menu hierarchy that would allow users to operate the spreadsheet program in substantially the same way, the menu hierarchy (unlike the underlying code) could not acquire copyright protection.” Prior SG Br. 20. That is of course precisely the conflict over the merger doctrine now presented by this petition. Pet. 2, 12. No

matter whether *Lotus* is regarded as resting on the meaning of “method of operation” or on principles of merger, or both, the decisions squarely conflict, and that conflict is now squarely presented.

III. Certiorari Should Be Granted To Determine Whether The Reimplementation Of Software Interfaces May Be Fair Use.

The Solicitor General tepidly endorses the Federal Circuit’s fair use ruling as “not free from doubt.” New SG Br. 10. Last time, the Solicitor General correctly advised the Court that fair use

is an “equitable rule of reason” that “permits courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.” Interoperability and lock-in concerns like those raised by petitioner can appropriately be considered as part of fair-use analysis.

Prior SG Br. 17 (quoting *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 550 n.3 (1985)). Under that approach, the Federal Circuit unquestionably erred. The Solicitor General does not dispute that (a) interfaces involve little if any creative expression, while by contrast (b) prohibiting the reimplementation of interfaces seriously inhibits the development of new applications and platforms. Cert. Reply 3 (collecting citations).

Having previously embraced a flexible test for fair use, the Solicitor General now reverses course and says that the Federal Circuit is correct because “[t]he first and fourth factors are particularly relevant here.” New SG Br. 17. But the Court is left to wonder why

the Solicitor General provides neither a citation nor an explanation for why those factors should get such dispositive weight, notwithstanding the jury's contrary finding and the harm to software innovation that results from ruling out fair use as a matter of law.

But in any event, certiorari is warranted to review the Federal Circuit's categorical ruling. With respect to the first factor—transformation—the Federal Circuit undoubtedly ruled as a matter of law. It did not doubt that Google reimplemented the interfaces in the new context of the innovative Android platform and thus put them to a new use. Instead, it found dispositive that the declaring code as a technical matter was used to “perform the same functions in Android and Java,” and petitioner had not changed the copied code's expressive content or message.” New SG Br. 9 (quoting and citing Pet. App. 31a, 33a-35a). But it is undisputed that the same will *invariably* be true, because computer code performs only one function. If interfaces can only lawfully be reused “in a textbook to illustrate a coding technique,” *id.* at 19, then they *cannot* be reimplemented to facilitate communication between applications and platforms—as a matter of law.

The Solicitor General also now maintains that it is not appropriate to consider the widespread use of code at the time it is reimplemented. New SG Br. 20. But last time, the Solicitor General said the opposite in arguing that the issues raised by the case would be ripe after remand. That brief explained that although “[t]he fact that a particular computer program or line of computer code has become well known and popular among programmers cannot change its fundamental character from an ‘original work of authorship,’” “a focus on the circumstances that exist at the time of

copying is typical of fair-use analysis.” Prior SG Br. 18 n.2.

With respect to the fourth factor—the effect on the market—the Federal Circuit ruled as a matter of law as well. It manifestly did not find that “the trial record contained ‘overwhelming’ evidence that petitioner’s copying harmed the market for Java.” New SG Br. 20. Instead, it agreed there was “overwhelming” evidence of “actual *and potential* harm.” Pet. App. 50a (emphasis added). With respect to “actual market harm,” the court merely held that “no reasonable jury could have concluded there was *no* market harm to Oracle from Google’s copying,” *id.* at 51a (emphasis added), because “Android was used as a substitute for Java SE” in a total of two devices made by one manufacturer that had no demonstrable impact on the market, *ibid.*

The Federal Circuit instead actually “focuse[d] on *potential ... harm,*” and found it sufficient that “Oracle was attempting to license its work for mobile devices,” Pet. App. 51a (citation omitted), based on the court of appeals’ legal rule that “a market is a potential market even where the copyright owner has no immediate plans to enter it or is unsuccessful in doing so,” *id.* at 52a. “Because the law recognizes and protects a copyright owner’s *right* to enter a ‘potential market,’ this fact alone is sufficient to establish market impact.” *Ibid.* (emphasis added). The move from actual to merely “potential” market impact is critical. The copyright owner will always be able to assert a *desire* to enter into a market. Thus, by requiring a defendant to prove that a plaintiff had no desire to compete, the Federal Circuit’s ruling erects a categorical rule precluding a finding of fair use.

CONCLUSION

For the foregoing reasons, as well as those set forth in the petition, reply, and 15 amicus briefs, certiorari should be granted.

Respectfully submitted,

Lisa S. Blatt
Sarah M. Harris
Meng Jia Yang
WILLIAMS & CONNOLLY LLP
725 Twelfth Street, N.W.
Washington, DC 20005

Robert A. Van Nest
Christa M. Anderson
Eugene M. Paige
Reid P. Mullen
KEKER, VAN NEST
& PETERS LLP
633 Battery Street
San Francisco, CA 94111

Bruce W. Baber
Marisa C. Maleck
KING & SPALDING LLP
1180 Peachtree Street, N.E.
Atlanta, GA 30309

Thomas C. Goldstein
Counsel of Record
Sarah E. Harrington
Erica Oleszczuk Evans
GOLDSTEIN & RUSSELL, P.C.
7475 Wisconsin Avenue
Suite 850
Bethesda, MD 20814
(202) 362-0636
tg@goldsteinrussell.com
Michael S. Kwun
KWUN BHANSALI LAZARUS LLP
555 Montgomery Street
Suite 750
San Francisco, CA 94111

October 16, 2019