

No. 18-956

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 OF 65 INTELLECTUAL
PROPERTY SCHOLARS AS *AMICI CURIAE*
IN SUPPORT OF PETITIONER**

—◆—
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INTEREST OF *AMICI CURIAE*¹

Amici curiae are intellectual property scholars (listed in Appendix A) who 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. This Court’s guidance is urgently needed to address and resolve circuit conflicts affecting this \$564 billion industry.² *Amici*’s sole interest in this case lies in their concern for the proper application of traditional principles of copyright law to computer programs. Because *amici* have devoted their careers to understanding the balancing principles built into copyright and other intellectual property laws, their

¹ Pursuant to Supreme Court Rule 37, counsel for *amici* represent that they authored this brief in its entirety and that none of the parties or their counsel, nor any other person or entity other than *amici* or their counsel, made a monetary contribution intended to fund the preparation or submission of this brief. Counsel for petitioner gave blanket consent to the filing of *amicus* briefs, counsel for respondent has consented in writing to the filing of this brief, and both parties received timely notice of *amici*’s intent to file this brief.

² See BSA | The Software Alliance, *The Growing \$1 Trillion Economic Impact of Software* (Sep. 2017), <https://software.org/reports/2017-us-software-impact/> (based on 2016 figures). The 2017 study estimated total contributions by the software industry, including indirect and induced aspects, of more than a trillion dollars a year. *Id.*

views can aid the Court in resolving the important issues presented by the Petition.



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.



ARGUMENT

I. The Federal Circuit’s Merger Analysis Conflicts With This Court’s Ruling In *Baker v. Selden* As Well As With Decisions From Five Circuit Courts.

The Federal Circuit’s analysis of the merger doctrine is contrary to this Court’s decision in *Baker* and decisions of numerous circuit courts. These decisions make clear that merger can be a reason to withhold copyright from expression when a first author’s design choices constrain a second comer’s options in a wide range of contexts beyond software copyrights.

A. The Federal Circuit’s Merger Analysis Is Contrary To *Baker v. Selden*.

The merger doctrine is often traced to this Court’s decision in *Baker v. Selden*, 101 U.S. 99 (1880). *See, e.g., Arica Institute, Inc. v. Palmer*, 970 F.2d 1067, 1076 (2d Cir. 1992). Selden devised a novel bookkeeping system, and he could have designed the system in a number of ways. Selden thereafter claimed that Baker infringed by copying the selection and arrangement of columns and headings from forms in Selden’s book setting forth that system. Baker’s forms were not identical to Selden’s, but were substantially similar. *Baker*, 101 U.S. at 101. The Court recognized, though, that anyone who wanted to implement the Selden system would have to select and arrange columns and headings in a substantially similar way. *Id.* Since copyright does not protect useful arts such as bookkeeping systems, but only

authorial expression, *id.* at 101-02, Baker was free to publish similar forms to instantiate the Selden system. The Court ruled that the forms were uncopyrightable. *Id.* at 105. *Baker* importantly distinguished between authorship (the original expression that copyright protects) and invention (the functional creativity, which only utility patent law can protect). *Id.*

The Federal Circuit diverges from *Baker* in taking an excessively narrow view of when the merger doctrine applies. The opinion also contains internal contradictions. Although the Federal Circuit sometimes correctly describes the merger doctrine as applying “when there are a limited number of ways to express an idea,” App. 147a, on other occasions it incorrectly characterizes the doctrine as applying only when an idea “can be expressed in only one way,” App. 148a. Regardless, its application of the doctrine reveals it views the doctrine too narrowly. For example, it pointed to the existence of alternative names for Java functions, such as “Arith.Larger” instead of “Math.Max,” in finding that the merger doctrine did not apply to the Java API. App. 150a. This reasoning, however, does not comport with *Baker*, in which it did not matter whether column headers such as “Brought forw’d.” or “Aggregates of Accounts” could have been worded differently when implementing Selden’s accounting system.

Thus, merger is a viable argument against copyrightability when the range of available alternatives for this function is very limited, as the District Court concluded, App. 261a, and as was true in *Baker*. Moreover, the District Court made a finding that there *was*,

in fact, only one way to write the name of each function: “Under the rules of Java, [declarations] *must be identical* to declare a method specifying the *same* functionality—even when the implementation is different.” App. 215a. Thus, any programmer wishing to invoke the functionality of “Math.Max” would have to use the exact phrase “Math.Max.”

Even more difficult to reconcile with *Baker* is the Federal Circuit’s holding that courts in merger cases can consider only constraints on the plaintiff’s creation and never constraints on the defendant’s expressive choices. App. 151a. The Court in *Baker* did not consider whether Selden’s own choices in designing a bookkeeping system were constrained. Nor is there anything in *Baker* suggesting that the Court rejected Selden’s copyright claim because Selden had no choice about how to select and arrange columns and headings for his bookkeeping forms. Indeed, Baker’s forms were somewhat different. *See Baker*, 101 U.S. at 101. Instead, the Court decided that once Selden designed his bookkeeping system, Baker’s design choices for arranging columns and headings to implement the same system were constrained by the choices that Selden had made. *Id.*

Finally, the Federal Circuit’s decision conflicts with *Baker* in holding that merger can be a defense to infringement claims, but not a basis for denying copyrightability. App. 144a-145a. However, the Court in *Baker* held that Selden’s forms were uncopyrightable because the selection and arrangement of columns and

headings were embodiments of the bookkeeping system. *Baker*, 101 U.S. at 107.

B. The Federal Circuit’s Merger Analysis Conflicts With Many Post-*Baker* Precedents.

In addition to being irreconcilable with *Baker*, the Federal Circuit’s merger analysis also conflicts with decisions of the First, Fifth, Sixth, and Eleventh Circuits. In these cases, the plaintiffs had more than one choice about how to express ideas, facts, or functions, but the range of choices was limited. In most, courts recognized that the defendant’s choices of alternative expressions were constrained by the plaintiff’s choices, and some ruled against copyrightability because of those constraints. These precedents go far beyond the computer software context; yet, they apply the exact same legal rule. These cases thus illustrate how far the Federal Circuit’s misconstruction of the merger doctrine diverges from how courts generally apply the merger doctrine to many different types of works.

The Federal Circuit’s conception of merger is, for example, at odds with the First Circuit’s ruling in *Morrissey v. Procter & Gamble Co.*, 379 F.2d 675 (1st Cir. 1967). *Morrissey* authored a set of sweepstakes contest rules. *Id.* at 676. The First Circuit agreed with *Morrissey* that his rules were original because of evidence that there were different ways to express such rules. *Id.* at 678. However, the court characterized the way that *Morrissey* chose as straightforward and simple

and observed that the range of possible expressions of sweepstakes rules admitted of little variation,

so that “the topic necessarily requires,” [citations omitted] if not only one form of expression, at best only a limited number, [so] to permit copyrighting would mean that a party or parties, by copyrighting a mere handful of forms, could exhaust all possibilities of future use of the substance. In such circumstances it does not seem accurate to say that any particular form of expression comes from the subject matter. However, it is necessary to say that the subject matter would be appropriated by permitting the copyrighting of its expression. We cannot recognize copyright as a game of chess in which the public can be checkmated. Cf. *Baker v. Selden* [citation omitted].

Id. at 678-79. Even if Procter & Gamble had deliberately copied Morrissey’s rules, no infringement would be found because the rules were uncopyrightable because of the limited choices available to anyone seeking to draft such rules. *Id.* at 679. Had the Federal Circuit approached applying the merger doctrine with the same principles as *Morrissey*, Google’s merger defense would likely have succeeded because the declarations had to be replicated exactly to invoke the appropriate functionality. App. 215a.

While *Morrissey* dealt with constraints derived from the choice of subject matter, other circuit court cases have applied merger where a second comer’s choices were limited by decisions a first author made. In *Veeck v. Southern Building Code Congress Int’l, Inc.*,

293 F.3d 791 (5th Cir. 2002) (en banc), cert. denied, 539 U.S. 969 (2003), merger precluded enforcement of SBCCI's claim against Veeck for his online posting of a privately written code that had been adopted as law in Anna and Savoy, Texas. *Id.* at 800-02. It did not matter how many possible alternative expressions existed when the codes were initially created. What mattered was that once enacted, there was no other way to express what the law was. *Id.* at 802. *See also Code Revision Commission v. PublicResource.Org, Inc.*, 906 F.3d 1229, 1243 (11th Cir. 2018) (annotations on Georgia laws that merged with the texts of the statutes held uncopyrightable).

The most striking contrast with the Federal Circuit's narrow conception of merger is the Sixth Circuit's ruling against a claim of copyright infringement involving printer cartridge software in *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522 (6th Cir. 2004). Static persuaded the court that installing a copy of the Lexmark code was necessary to enable competing cartridges to interoperate with Lexmark printers. *Id.* at 542. Although Lexmark argued that there were alternative ways to write code that would achieve the same functions, *id.* at 539, the Sixth Circuit concluded that the alternatives were inefficient and functionality constrained Static's design choices. *Id.* at 540. Static was therefore free to use the Lexmark code because "if any single byte of the Toner Loading Program is altered, the printer will not function." *Id.* at 542. *See also MiTek Holdings, Inc. v. Arce Engineering Co.*, 89 F.3d 1548, 1556 n.19 (11th Cir.

1996) (recognizing method/expression merger); *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1541 n.21 (11th Cir. 1996) (accord). The Federal Circuit ignored these decisions.

C. The Second Circuit Has Rejected The Third And Federal Circuits' Narrow Conception Of Merger.

The Third Circuit is the only circuit court to have adopted as narrow a conception of merger as the Federal Circuit. In *Whelan Associates, Inc. v. Jaslow Dental Laboratory, Inc.*, 797 F.2d 1222 (3d Cir. 1986), the court adopted a broad conception of the scope of copyright in software and a narrow conception of merger. Whelan claimed that Jaslow copied the “structure, sequence, and organization” (SSO) of its software to automate common business functions of dental laboratories. The Third Circuit upheld an infringement ruling based on SSO similarities, *id.* at 1233-34, 1242-48, and announced this test for software copyright infringement:

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.

Id. at 1236 (emphasis in the original). The court purported to derive this test from *Baker. Id.* Like the Federal Circuit in *Oracle*, the court in *Whelan* confined merger to situations in which there was only one way to express an idea or function. *Id.* at 1236-37. Like *Oracle*, *Whelan* focused on expressive choices (or lack

thereof) available to the plaintiff at the time of creation. *Id.*

Whelan's narrow conception of merger and broad conception of software copyright scope has been much criticized, most notably by the Second Circuit in its landmark *Altai* decision, 982 F.2d at 705-06. The court in *Altai* invoked the merger doctrine as a basis for filtering out efficient program structures during infringement analysis. *Id.* at 707. Even if other alternatives might be available, the range of efficient design choices would be limited. The court noted that “[i]n the context of computer program design, the concept of efficiency is akin to deriving the most concise logical proof or formulating the most succinct mathematical computation.” *Id.* at 708. Copyright law should not force second comers to adopt less efficient structures to accomplish program functions. The Federal Circuit’s conception of merger is inconsistent with *Altai*.

This case presents an opportunity to resolve the serious and longstanding conflict among the circuits and with *Baker* about copyright’s merger doctrine.

II. Circuit Courts Are Split On The Scope Of Copyright Protections For Software.

The Federal Circuit’s copyrightability ruling conflicts with circuit court decisions on four other scope of protection issues that often arise in software copyright cases: (1) the role of § 102(b) method exclusions in software copyright cases, (2) the viability of compatibility

defenses, (3) whether “structure, sequence, and organization” of computer programs is copyrightable expression, and (4) whether copyright and utility patents can provide overlapping protections.

A. A Circuit Split Exists About Applications Of § 102(b) System And Method Exclusions In Software Copyright Cases.

Amici agree with Google’s Petition that for the past 24 years there has been a well-recognized circuit split about the proper interpretation of § 102(b)’s exclusions of methods and processes from the scope of copyright as applied to computer programs. *See* 17 U.S.C. § 102(b) (“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.”).

By granting certiorari to review the First Circuit’s ruling in *Lotus Development Corp. v. Borland International, Inc.*, 49 F.3d 807 (1st Cir. 1995), this Court recognized that split, but was unable to resolve it, affirming the First Circuit’s decision by an evenly divided court, 516 U.S. 233 (1996).

The Petition is correct that since then, the circuit split has deepened. Pet. 11-14. The Federal Circuit’s *Oracle* decision is only its latest manifestation. This longstanding split on its own would be a worthy reason to grant certiorari in this case.

B. A Circuit Split Exists On The Viability Of Compatibility Defenses.

The Federal Circuit characterized Google’s interoperability defense as “irrelevant to copyrightability.” App. 166a. It relied on *Dun & Bradstreet Software Services, Inc. v. Grace Consulting, Inc.*, 307 F.3d 197 (3d Cir. 2002), which held that the only compatibility considerations that mattered for copyrightability purposes were those faced by the first author when creating its software, not the effect of the first author’s choices on a second author’s options. App. 169a-171a. The Federal Circuit opined that “a defendant’s desire ‘to achieve total compatibility . . . is a commercial and competitive objective which does not enter into the . . . issue of whether particular ideas and expressions have merged.’” App. 171a (quoting *Apple Computer, Inc. v. Franklin Computer, Inc.*, 714 F.2d 1240, 1253 (3d Cir. 1983)). Four circuits have ruled otherwise.

The Second Circuit in *Altai* was the first to recognize compatibility as a meaningful constraint on programmers’ design decisions. *Altai*, 986 F.2d at 709-10. Similarities due to compatibility constraints must be filtered out of infringement analysis. *Id.* The Second Circuit made no distinction between compatibility as a constraint on plaintiffs or on defendants. *Id.* at 715. Because *Altai* needed to use the same parameters as *Computer Associates* to attain interoperability, its compatibility defense succeeded. *Id.*

Following *Altai*, other courts have ruled in favor of compatibility defenses when defendants claimed their

program needed to be compatible with another firm's program. In *Lexmark*, for instance, the Sixth Circuit was persuaded that Static had no choice but to use copies of Lexmark's code for printer cartridges loaded with Static chips to interoperate with Lexmark printers. *Lexmark*, 387 F.3d at 530-31. Lexmark's printer cartridge code was held uncopyrightable. *Id.* at 544. See also *Bateman*, 79 F.3d at 1546-48 (recognizing viability of compatibility defense); *Sega Enterprises, Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1522 (9th Cir. 1992) (accord).

C. A Circuit Split Exists On Whether The “Structure, Sequence, And Organization” (SSO) Of Computer Programs Is Protectable Expression As Long As It Exhibits Some Creativity.

Whelan introduced the SSO concept to software copyright law. *Whelan*, 797 F.2d at 1224. In the Third Circuit's view, all program SSO was copyright-protectable expression unless one or more elements were incapable of being expressed in a different way. *Id.* at 1236-37. *Whelan* spoke of computer programs as literary works and reasoned that just as the structure of a novel or play could be protectable expression, so could the SSO of programs. *Id.* at 1234.

Relying on *Whelan*, Computer Associates alleged that Altai had copied protectable SSO from CA's scheduling program. *Altai*, 982 F.2d at 701-02. The Second Circuit was highly critical of the *Whelan* decision, the

SSO concept, and its test for software copyright infringement. *Id.* at 705-06. While it agreed with *Whelan* that some nonliteral elements of programs may be copyright-protectable, *id.* at 702, the court did not find the SSO concept to be helpful in distinguishing between those nonliteral elements of programs that are copyright-protectable and those that are not. *Id.* at 705-06. Moreover, the SSO conception “demonstrated a flawed understanding of a computer program’s method of operation” and rested on a “somewhat outdated appreciation of computer science.” *Id.* at 706. It characterized the *Whelan* test for software copyright infringement as “conceptually overbroad” and “descriptively inadequate,” relying “too heavily on metaphysical distinctions” instead of on “practical considerations.” *Id.* at 705-06.

The *Altai* decision recognized that the highly functional nature of computer programs meant that copyright could provide only a narrow scope of protection. *Id.* at 712. It directed courts to “filter out” three categories of unprotectable elements—efficient program structures, constraints on programmer design choices due to external factors (such as compatibility considerations), and public domain elements—before proceeding to compare protectable elements of programs to determine if the defendant infringed the plaintiff’s work. *Id.* at 706-08. Numerous courts have followed *Altai* and used its filtration analysis. *See, e.g., Bate-man*, 79 F.3d at 1541 n.21, 1545 (directing filtration also of program processes and methods, and further holding that regardless whether the *Altai* test applies

to literal copying, “a parallel type of analysis must be undertaken in examining alleged instances of literal copying of computer code or screen displays”); *Gates Rubber Co. v. Bando Chemical Industries, Ltd.*, 9 F.3d 823, 836-37 (10th Cir. 1993) (following *Altai*).

The District Court in *Oracle*, like the Second Circuit in *Altai*, was not persuaded that the SSO concept provided a sound basis for distinguishing between structural elements of programs that copyright can protect and those that it cannot. App. 259a. The Federal Circuit has revived the discredited *Whelan* conception of program SSO as protectable expression. App. 191a. The circuit split over the protectability of program SSO is deep and longstanding. This Court should grant the Petition to resolve this issue.

D. A Circuit Split Exists Over Whether Copyright and Utility Patents Can Provide Overlapping Protections To Program Innovations.

In support of its ruling that the parts of the Java API Google used in Android were uncopyrightable, the District Court noted some patents that Sun and Oracle had obtained on APIs. App. 260a. These patents suggested that APIs were more utility patent than copyright subject matters. After all, *Baker* had conceptualized copyright and patent subject matters as distinct and mutually exclusive. Patent protection might be available to inventions in the useful arts, but copyright could protect only authorial expression. *Baker*, 101

U.S. at 102. The Court in *Baker* asserted that it would be “a surprise and a fraud upon the public” to give patent-like protection through copyright law. *Id.*

The Federal Circuit’s response to Google’s *Baker*-inspired patent-copyright exclusivity argument was to quote dictum from *Mazer v. Stein*, 347 U.S. 201, 217 (1954): “[n]either the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.” App. 191a. The Balinese dancer statuette in *Mazer* did qualify for both design patenting as an ornamental design for an article of manufacture (a lamp base) and copyright as a work of art. But *Mazer* actually reaffirmed *Baker*’s holding that “the Mechanical Patent Law and Copyright Laws are *mutually exclusive*.” *Mazer*, 347 U.S. at 215 n.33 (emphasis added). The Federal Circuit ignored this Court’s reaffirmation of the exclusivity of copyright and utility patent protections based on the inherent difference between copyrightable expressions and potentially patentable functions.

Mazer also cited approvingly to another patent-copyright exclusivity decision, *Taylor Instrument Cos. v. Fawley-Brost Co.*, 139 F.2d 98 (7th Cir. 1943), cited in *Mazer*, 347 U.S. at 215 n.33. Taylor sued Fawley-Brost for copying its temperature recording charts. Fawley-Brost defended by challenging the validity of Taylor’s copyrights. Among other things, it pointed to expired utility patents on such charts as evidence that these charts were patent, not copyright, subject matters. *Taylor*, 139 F.2d at 100-01. Invoking *Baker*, the Seventh Circuit agreed:

While it may be difficult to determine in which field protection must be sought, it is plain . . . that it must be in one [copyright] or the other [patent]; it cannot be found in both. In other words, there is no overlapping territory, even though the line of separation may in some instances be difficult of exact ascertainment.

Id. at 99. The court regarded as “intolerable” that Taylor could extend its monopoly over the charts by claiming copyright in them. *Id.* at 101.

In the context of computer program innovations, the Tenth Circuit reversed a trial court ruling that copyright and patent could provide overlapping protections for program innovations. *Gates Rubber*, 9 F.3d at 836-37. *See also MiTek*, 89 F.3d at 1556 n.19 (construing the scope of copyright protection in programs narrowly to avoid allowing copyright to confer patent-like protection to program processes). Thus, the Federal Circuit’s endorsement of overlapping patent and copyright protections for program innovations presents yet another circuit conflict that this Court should resolve.

III. The Federal Circuit’s Decision Opens A Circuit Split On The Copyrightability Of Words And Short Phrases.

The Federal Circuit’s decision opens a circuit split concerning the copyrightability of names under the “words and short phrases” doctrine. The District Court invoked the words and short phrases exclusion as a third basis for rejecting Oracle’s claim. App 261a. The

Federal Circuit rejected that argument, holding that declarations, which are names for pre-written functions, can be eligible for copyright protection if they are creative.³ App. 153a.

By contrast, the Third and Sixth Circuits have held that similar identifiers of functional items are not copyrightable. In *Southco, Inc. v. Kanebridge Corp.*, 390 F.3d 276 (3d Cir. 2004) (en banc) (Alito, J.), the Third Circuit considered whether the serial numbers used to uniquely identify hardware parts were copyrightable, and concluded that they were not. *Id.* at 277-78. The court explained that part numbers are “excluded from copyright protection because they are analogous to short phrases or the titles of works.”⁴ *Id.* at 285. Just as a title is used to refer to a literary work, a serial number is used to refer to a hardware part.

The Sixth Circuit has twice denied claims of copyright protection in cases involving names. In *ATC Distribution Group v. Whatever It Takes Transmissions & Parts, Inc.*, 402 F.3d 700 (6th Cir. 2005), the Sixth Circuit held that a taxonomy for assigning unique identifiers to auto transmission parts by sorting them into categories and sub-categories was not copyrightable. *Id.* at 706. It held that the taxonomy for assigning

³ A compilation of names might, if original, be protectable by copyright, but *amici* do not understand Oracle to be claiming that Google literally infringed its original compilation of names. Rather, *amici* understand its claim to be that the names themselves are original and copyrightable.

⁴ The court also held that the serial numbers were not original expressions. *Id.* at 282.

numbers was itself an uncopyrightable idea. *Id.* at 707. It further held that the numbers generated through application of the taxonomy were unprotected because they were unoriginal or else merger had occurred. *Id.* Beyond this, the court concluded that there were additional reasons not to grant copyright protection “to short ‘works,’ such as part numbers.” *Id.* at 709. It recognized that allowing copyright in such short works would substantially raise the risk of litigation for those who use such works legitimately and would not meaningfully advance the progress of science and useful arts. *Id.* at 710. To support this point, it cited to the Copyright Office’s policy of not granting copyright protection to short phrases such as names. *Id.* at 709-10 (citing 37 C.F.R. § 202.1 and Copyright Office Circular 34 (now 33)⁵). *See also Lexmark*, 387 F.3d at 542 (invoking words and short phrases doctrine to reject Lexmark’s claim that inserting stock ticker symbols into code was creative expression).

Java declarations that serve as interfaces to pre-written programs, like serial numbers for hardware parts, are names. The Federal Circuit says that names can be protected if creative, whereas the Third and Sixth Circuits have denied copyrightability in similar circumstances. The Third and Sixth Circuits’ position is also the one held by the Copyright Office. 37 C.F.R.

⁵ Circular 34, *Copyright Protection Not Available for Names, Titles, or Short Phrases*, was updated to become Circular 33, *Works Not Protected by Copyright*, available at <https://www.copyright.gov/circs/circ33.pdf>. The update is noted in the Office’s Circular Update Guide, <https://www.copyright.gov/circs/circular-update-guide.pdf>.

§ 202.1 (“[w]ords and short phrases such as *names*, titles, and slogans” not subject to copyright) (emphasis added). Still other circuits have denied copyright protection to names, but have done so grounded in doctrines other than words and short phrases. *See, e.g., Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1373 (10th Cir. 1997) (four-digit numeric codes used to access features of telecommunications hardware not copyrightable due to unoriginality and scenes a faire).

Granting certiorari would give this Court an opportunity to clarify the scope of the words and short phrases doctrine.

◆

CONCLUSION

The petition for writ of certiorari should be granted.

Respectfully submitted,

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