No. 14-410

In the

Supreme Court of the United States

GOOGLE INC.,

PETITIONER,

v.

ORACLE AMERICA, INC.,

RESPONDENT.

On Petition for a Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

REPLY BRIEF OF PETITIONER

BRUCE W. BABER
KING & SPALDING LLP
1180 Peachtree Street, NE
Atlanta, GA 30309

ROBERT A. VAN NEST
STEVEN A. HIRSCH
CHRISTA M. ANDERSON
MICHAEL S. KWUN
DAN JACKSON
KEKER & VAN NEST LLP
633 Battery Street
San Francisco, CA 94111

DARYL L. JOSEFFER
  Counsel of Record
ASHLEY C. PARRISH
ADAM M. CONRAD
ETHAN P. DAVIS
KING & SPALDING LLP
1700 Pennsylvania Ave., NW
Washington, DC 20006
(202) 737-0500
djoseffer@kslaw.com

RENNY HWANG
GOOGLE INC.
1600 Amphitheatre Parkway
Mountain View, CA 94043

Counsel for Petitioner

December 23, 2014

TABLE OF CONTENTS

TABLE OF AUTHORITIES

iii

REPLY BRIEF

Oracle does not dispute the exceptional importance of the question presented. Nor could it. Since this Court granted review of the same question in *Lotus Development Corp. v. Borland International, Inc.*, 516 U.S. 233 (1996) (per curiam), the question's importance has only grown—as confirmed by the seven *amicus* briefs representing the views of more than two dozen industry leaders, 77 pioneering computer scientists, numerous industry and public-interest groups, and 41 law professors.

The circuit split has also deepened, as more courts have considered the question and acknowledged their disagreement. Although the brief in opposition purports to identify factual differences between this case and *Lotus*, none bears on the question presented. That question is not, as Oracle contends, whether software is ever entitled to copyright protection; it is. But like any original work, software is subject to 17 U.S.C. § 102(b)'s exclusion of systems and methods of operation. That means that the Java libraries of pre-written programs are generally eligible for copyright protection, but the method headers (also known as declarations) used to operate those programs are not.

I. The Circuit Courts' Division

1. The opposition evades Section 102(b), omitting it from Oracle's reformulation of the question presented and failing to address it until page 18. That is telling, as Section 102(b) is the petition's centerpiece. *E.g.*, Pet. i, 1–3. It specifies that "[i]n no case does copyright protection for an

original work of authorship extend to any . . . system [or] method of operation . . . regardless of the form in which it is described, explained, illustrated, or embodied in such work." 17 U.S.C. § 102(b).

Notwithstanding that plain text, the courts of appeals disagree about whether Section 102(b) precludes copyright protection for a system or method of operation. Pet. 14–18. No fewer than four courts of appeals, including the court below, have recognized this division. Pet. 18–20.

By Oracle's reckoning, however, the courts agree on this question—they just don't know it. Oracle asserts that "every circuit to consider the issue recognizes as 'well established' that computer source code is copyrightable as long as it is original." Opp. 12. In reality, the First and Sixth Circuits have held that "even if a work is in some sense 'original' under § 102(a), it still may not be copyrightable because [of] § 102(b)." *Lexmark Int'l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 534 (6th Cir. 2004); *accord Lotus Dev. Corp. v. Borland Int'l, Inc.*, 49 F.3d 807, 818 (1st Cir. 1995).

Oracle claims that *Lotus* "found that the commands at issue there . . . were not creative." Opp. 19 (quoting App. 43). In fact, *Lotus* found the opposite. The First Circuit "[a]ccept[ed] the district court's finding that the Lotus developers made some expressive choices," but held that Lotus's creativity was "immaterial to the question of whether [a computer program's menu command hierarchy] is a 'method of operation.'" 49 F.3d at 816. Far from containing only "one sentence" on point (Opp. 20), *Lotus* addresses Section 102(b) at length, explaining,

for example, that "while original expression is necessary for copyright protection, we do not think that it is alone sufficient. Courts must still inquire whether original expression falls within one of the categories foreclosed from copyright protection by § 102(b), such as being a 'method of operation.'" 49 F.3d at 818; *see also id.* at 815–16.

The First Circuit has never questioned *Lotus*. In *Situation Management Systems, Inc. v. ASP. Consulting LLC*, 560 F.3d 53 (1st Cir. 2009), it held that copied books (not computer programs) were original, and "*descriptions* of a process or system are copyrightable, but the underlying process or system itself is not." *Id.* at 61 (emphasis added). That straightforward recitation of this Court's holding in *Baker v. Selden*, 101 (11 Otto) U.S. 99 (1880), only reinforces Section 102(b)'s exclusion. *See* Pet. 22–23.

Although Oracle argues that this case differs factually from *Lotus*, its purported distinctions have no bearing on the question presented. For example, Oracle argues that, unlike this case and the other circuit-split cases, *Lotus* did not involve computer code. Opp. 2. By any account, *Lotus* addressed "the words and structure of [a computer program's] menu command hierarchy"—"the means by which users control and operate [the program]." 49 F.3d at 810, 815. This case likewise concerns the "command structure" used to operate the Java and Android libraries of pre-written code. *See* Pet. 5–8, 30. There is no meaningful difference between the two. *Lotus* held that the command hierarchy used to control the program (by causing it to print, for example) was not copyrightable even though the court assumed

arguendo that computer code used to carry out those commands was copyrightable. *See Lotus*, 49 F.3d at 816. So too here, Java's system of method headers is not copyrightable but the implementing code that instructs a computer how to perform the relevant functions is. *See* Pet. 27.[1]

In any event, this case and *Lotus* expressly diverge on the same legal question: whether copyright protection extends to an original system or method of operating a computer program. And the Sixth Circuit has also held that computer code is not entitled to copyright protection merely "because [it] 'could be written in a number of different ways.'" *Lexmark*, 387 F.3d at 537.

2. Courts have also divided on the relevance of compatibility and lock-in to Section 102(b)'s exclusion. *See* Pet. 18. Oracle asserts that "the circuits uniformly recognize that copyright subsists in a computer program's particular expression when it is not the only way to achieve the program's purpose or carry out the program's function." Opp. 21. But that vague formulation does nothing to diminish the circuit split: some courts ask only whether the author of the copyrighted program could have written it in different ways; others recognize that a subsequent programmer's need to replicate a portion of the program for compatibility is an

---

[1] *Lotus* indicates that whether Section 102(b) excludes computer code from copyright protection turns on whether the code's "precise formulation" is "necessary for the program to work." 49 F.3d at 816. The Java method headers' precise formulation is essential. *See* Pet. 29–32.

important consideration in determining whether that portion is a system or method of operation. Pet. 18–19.

Oracle claims that *Lexmark*'s discussion of compatibility is *dicta*. Opp. 24. But the Sixth Circuit stated that compatibility provided an independent basis for its decision—"perhaps [the] most significant[]" one—because "compatibility requirements justified [defendant's] copying of the [code]." 387 F.3d at 541–42. The Second Circuit has also held that "compatibility requirements of other programs with which a program is designed to operate" are relevant to copyrightability. *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 709–10 (2d Cir. 1992).

3. *Merger.* The courts of appeals further disagree on whether the merger doctrine: (i) limits copyrightability or serves only as a defense to infringement; and (ii) precludes copyright protection for "a particular code sequence" necessary for interoperability, *Lexmark*, 387 F.3d at 536. Pet. 19. On merger, Oracle only repeats arguments addressed above.

II. The Federal Circuit's Error

1. Oracle's merits argument is a shell game. Oracle asserts that Section 102(b) reflects a dichotomy between unprotectable ideas and protectable expression; original and creative works are expressive; and Section 102(b) therefore imposes no limitation on original creative works. *See* Opp. 18–20.

That effort to eviscerate Section 102(b)'s

exclusion of systems and methods of operation runs headlong into the statutory text, this Court's decisions, and the legislative history. Pet. 20–23. "[M]ethods embodied in a [computer] program are not within the scope of the copyright law," H.R. REP. NO. 94-1476, at 57 (1976), because Section 102(b) "identifies specifically those elements of a work for which copyright is not available," *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 356 (1991).

Lacking a credible statutory interpretation, Oracle resorts to hyperbole. Oracle contends that Google would "strip all code of copyright protection." Opp. 2. Google has always been clear that original computer code may generally be entitled to copyright protection, but the portions of a program that include or embody systems or methods of operation are not. *E.g.*, Pet. 27.

That does not mean that a work "loses all copyright protection if it also describes" a system or method of operation, as Oracle contends. Opp. 26. Like *Baker*, Section 102(b) excludes from protection only the elements of the work that comprise a system or method of operation. 101 U.S. at 103. As this Court has explained, "[t]he mere fact that a work is copyrighted does not mean that every element of the work may be protected." *Feist*, 499 U.S. at 348. It is Oracle that would rewrite the statute by treating copyright protection as an all-or-nothing proposition even though Congress chose a middle ground.

Oracle would also use copyright law as an end-run around important limits on patent protection. Pet. 23–29. Oracle responds that the domains of patent and copyright law are not mutually exclusive.

Even if there is overlap, *Baker* and Section 102(b) make clear that systems and methods of operation are not within it.

2. This case illustrates the basic distinction between a copyright-eligible computer program and an unprotected system or method of operation. As Oracle acknowledges, each of the Java methods (pre-written programs) has two different parts: a header (declaration) that specifies the method's name, parameters, and functionality; and a body (implementing code) that instructs a computer how to perform the relevant function. Opp. 6; Pet. 5–6. Google replicated only the headers. Pet. 7; Opp. 7.

Those headers are not entitled to copyright protection because they are, in Oracle's words, a "command structure" that programmers use to operate the libraries of pre-written code. Pet. 30 (quoting C.A. App. 20457). Programmers use a shorthand command derived from a header to call the method's implementing code and thereby cause a computer to perform the method. Pet. 5–6. If Google had not replicated the method headers precisely, code written in Java with the shorthand commands would not have worked on Android. Pet. 7; App. 159–60.

This crisp fact pattern, set forth in the district court's careful findings of fact, makes this case an excellent vehicle for considering the question presented. Oracle's efforts to muddy the waters only confirm that conclusion. Oracle emphasizes that the method headers comprise 7,000 lines of code. But Section 102(b) is not limited to "small" systems or methods of operation; it covers "any" system or method of operation, "regardless of the form in which

it is described, explained, illustrated, or embodied." 17 U.S.C. § 102(b). Bigger computer programs may have bigger methods of operation. But the amount of work involved is irrelevant. *Feist*, 499 U.S. at 343, 353 (7,700 listings in directory not copyrightable); *see also Lotus*, 49 F.3d at 811 (reversing decision that relied on "extent" of copying).

While Oracle denigrates Google for "capturing Oracle's fan base" (Opp. 1), it is Oracle that seeks to lock in Java programmers. The parties agree that languages such as Java are not entitled to copyright protection. *See* Pet. 5. Oracle is nonetheless attempting to control programmers' use of the Java language by preventing them from using Java's shorthand commands when writing software for other platforms.

Oracle criticizes Google's use of the term "shorthand commands" and seeks to distinguish between the Java language and platform. Opp. 3–4, 16–17. That extended discussion of word choice is beside the point because the underlying facts are undisputed: programmers use familiar commands to call implementing code in the Java and Android platforms; the command for each method corresponds to the method's header; and the command would no longer work if the header were changed. *See* Pet. 5–8; Opp. 4–8. The district court found, moreover, that "[t]he Java language itself is composed of keywords and other symbols and a set of pre-written programs to carry out various commands" and "there is no bright line between the language and the API [application programming interface]." App. 106, 116.

Oracle contends that code should not "los[e]

copyright protection just because that code became wildly popular." Opp. 3. Under Section 102(b), however, the method headers never had any protection to lose. Compatibility and lock-in provide powerful evidence supporting that conclusion: If one must use specific commands to operate a program, those commands are by definition part of a system or method of operating the program; and programmers learn and repeatedly use commands to the point where they become "second nature" (Opp. 5) precisely because the commands operate the program. *See, e.g., Lotus*, 49 F.3d at 815–17; Pet. 29–32.

Oracle emphasizes that Java and Android are not compatible in all respects because Google only replicated the method headers for the 37 packages of pre-written programs that are most relevant to mobile devices and that programmers would expect to be able to use. *See* Opp. 33–34; Pet. 31–32. Oracle's apparent contention that Google had to copy *more* of the method headers to invoke Section 102(b) makes no sense. Those headers either are or are not a system or method of operation. *See* Pet. 31–32.

3. Finally, Oracle contends that Google raised its Section 102(b) argument in the court of appeals only as to Oracle's "structure, sequence, and organization" (SSO) claim, but presented it to this Court only as to Oracle's claim for literal copying of the method headers. Opp. 35–36. Not so. Google explained to both courts that there is "no 'daylight' between the . . . [headers] and the 'overall SSO.'" Google C.A. Br. 39. "Oracle premised its 'structure, sequence, and organization' claim on the theory that the method headers 'embody the structure' of the application

programming interface by specifying the name, package, and class of each method." Pet. 8 (quoting App. 21). The Federal Circuit agreed, equating the "taxonomy" of names included in the headers with the "SSO" and noting that, "[a]s Oracle explains," Google copied the claimed structure, sequence, and organization by copying the headers (declarations). App. 10, 22.

In any event, Google has always disputed the copyrightability of both the headers and the claimed structure, sequence, and organization, arguing in the court of appeals that the headers are not copyrightable and "the same conclusion applies *a fortiori* to the 'overall SSO.'" Google C.A. Br. 38–39. The question presented in this Court broadly asks "[w]hether copyright protection extends to *all elements* of an original work of computer software . . . ." Pet. i (emphasis added). As the body of the petition confirms (at 8), that question is not limited to either one of Oracle's theories. *See Daimler AG v. Bauman*, 134 S. Ct. 746, 760 n.16 (2014). Oracle's final waiver argument—that the petition abandoned the merger doctrine (Opp. 36)—is equally baseless. *See* Pet. 30–31 (briefing that issue).

III. The Issue's Importance

This Court's grant of *certiorari* in *Lotus*, the numerous *amicus* briefs, and the extensive commentary on the Federal Circuit's decision leave no doubt that the question presented is exceptionally important. *See, e.g.*, Computer Scientists Br. 5–6 (citing articles). By disputing which legal standard would best serve the industry, Oracle only underscores the question's importance. Moreover,

Oracle's policy arguments, like its legal arguments, rest on the fallacy that copyright protection is an all-or-nothing proposition. *See* Opp. 31–34.

The petition and *amicus* briefs gave numerous real-world examples of innovations made possible by open access to interfaces. Pet. 33–35; Computer Scientists Br. 6–27; HP Br. 10; OSI Br. 7–9, 14–19, 23–26. Although Oracle assures the Court that there was either a license or no copying in those examples (Opp. 32), Oracle ignores many of the examples and mischaracterizes others. For example, Phoenix and Compaq took licenses to the IBM BIOS system's *implementing* code, but did not license the BIOS *interface*, which was free for all to use. *See* Computer Scientists Br. 6–8; Van Lindberg, *Intellectual Property and Open Source* 240–41 (2008). Apple took only a free, open-source "license" to the UNIX system. *See* FreeBSD Project, *The FreeBSD Copyright* (2014), https://www.freebsd.org/copyright/ freebsd-license.html. None of those companies did what Oracle insists Google must do: pay a licensing fee for the right to build on an existing interface.

Oracle accuses Google and the *amici* of "drastically over-read[ing] the opinion below to protect anything that might be called an 'interface.'" Opp. 34. It would be hard to overread a decision holding that "interoperability arguments are irrelevant to copyrightability" because all elements of a computer program are copyrightable "as long as the author had multiple ways to" write them. App. 47, 50. Oracle assures the Court that "[m]any [interfaces] are not sufficiently original or expressive" to be eligible for copyright protection under Section

102(a). Opp. 34. That unsupported assertion is so implausible that Oracle itself refutes it by (correctly) emphasizing that originality poses a very low and easily satisfied bar. *See* Opp. 30; *Feist*, 499 U.S. at 345.

Finally, Oracle's reliance on the interlocutory posture of this case is makeweight. The Federal Circuit resolved all copyrightability issues and remanded only for a second trial on fair use. Reversing the Federal Circuit on this threshold question would obviate the need for that remand by restoring the district court's final judgment.

The multi-factor fair-use defense is, moreover, fundamentally different from Section 102(b)'s legal limit on copyrightability. Pet. 28–29; CCIA Br. 27; HP Br. 18. Fair use cannot substitute for Section 102(b) any more than patent-infringement defenses could substitute for the Patent Act's limits on patent eligibility. Pet. 27–28. Especially considering the "urgen[t]" need for this Court's review to protect ongoing innovation in fast-moving industries, HP Br. 18; Pet. 36–37, there is no reason to require a second trial on fair use before correcting the Federal Circuit's threshold legal error. *See, e.g.*, Robert L. Stern & Eugene Gressman, Supreme Court Practice 4.18, at 283 (10th ed. 2013).

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

BRUCE W. BABER
KING & SPALDING LLP
1180 Peachtree Street, NE
Atlanta, GA 30309

ROBERT A. VAN NEST
STEVEN A. HIRSCH
CHRISTA M. ANDERSON
MICHAEL S. KWUN
DAN JACKSON
KEKER & VAN NEST LLP
633 Battery Street
San Francisco, CA 94111

DARYL L. JOSEFFER
 Counsel of Record
ASHLEY C. PARRISH
ADAM M. CONRAD
ETHAN P. DAVIS
KING & SPALDING LLP
1700 Pennsylvania Ave., NW
Washington, DC 20006
(202) 737-0500
djoseffer@kslaw.com

RENNY HWANG
GOOGLE INC.
1600 Amphitheatre Parkway
MOUNTAIN VIEW, CA 94043

Counsel for Petitioner