ELECTRONIC FRONTIER FOUNDATION

May 29, 2019

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Deputy Solicitor General
Office of the Solicitor General
United States Department of Justice
950 Pennsylvania Ave., NW
Washington, DC 20530-0001

[By email to Malcolm.L.Stewart@usdoj.gov]

Re: No. 18-956, *Google LLC v. Oracle America, Inc.*

Dear Mr. Stewart:

The U.S. Court of Appeals for the Federal Circuit was created with the goal of providing uniform nationwide precedent and expertise in patent law. Whether or not that goal has been achieved, the Federal Circuit was definitely ***not*** intended to establish nationwide precedent in copyright law, a subject in which it has no special expertise. But as a practical matter, that is what has happened in this case—to the detriment of both copyright law and the software innovation that relies upon it. The Electronic Frontier Foundation ("EFF") urges you to recommend that the Supreme Court grant certiorari in this case in order to correct this dangerous precedent.

EFF's February 25, 2019 amicus brief in support of Google's petition explains how the Federal Circuit has made a mess of copyright law. Having accepted a case appealed from a California district court, the Federal Circuit should have analyzed the copyright claims in light of Ninth Circuit precedent. It did not. Instead, the Federal Circuit twice created its own law regarding functional aspects of computer programs. And it gets worse: those decisions are now being treated as *de facto* binding precedent in copyright cases around the country, displacing conflicting regional circuit rulings.

The problem began with the court's copyrightability opinion, *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339 (Fed. Cir. 2014) (*"Oracle I"*), *cert. denied*, 135 S. Ct. 2887 (2015). A key holding of that opinion was that copyrightability is determined by "the choices available to the plaintiff" when it created its computer program. *Oracle I*, 750 F.3d at 1370-71. The court therefore held that "under Ninth Circuit law, an original work—even one that serves a function—is entitled to copyright protection as long as the author had multiple ways to express the underlying idea." *Id.* at 1367. This holding conflicts with decisions by both the Ninth and First Circuits. *See* EFF Br. at 19-21. Yet, district courts in both of those circuits have looked to *Oracle I* instead of their regional circuit authority, as they are supposed to do—even where those cases do not include any patent claims and will therefore never end up before the Federal Circuit. EFF Br. at 4-7.

For example, a Massachusetts district court copyright case looked to both *Lotus Dev. Corp. v. Borland Int'l, Inc*., 49 F.3d 807 (1st Cir. 1995) *("Lotus")*, *aff'd by an equally divided court*, 516 U.S. 233 (1996) and *Oracle I* in determining the scope of copyright protection for a software program. *McEnroe v. Mantissa Corp.*, 2016 WL 7799636, at *6–7 (D. Mass. 2016). And even though *Lotus* remains binding authority in the First Circuit, the court adopted a conflicting principle from *Oracle I:* that a program's copyrightability is contingent "on the choices made by" the plaintiff upon the program's creation. *Id*. at *8; *compare Lotus*, 49 F.3d at 816 ("expressive choices" do not "magically" change uncopyrightable commands into copyrightable subject matter). Also, a district court in the Ninth Circuit followed *Oracle I* for the proposition that the Ninth Circuit rejects *Lotus*, even though a Ninth Circuit decision subsequent to *Oracle I* uses the same reasoning as *Lotus*. *See Bikram's Yoga College of India, L.P. v. Evolation Yoga, LLC*, 803 F.3d 1032, 1042 (9th Cir. 2015); EFF Br. at 4-5, 19-20.

EFF's February 2019 brief in support of certiorari predicted that, over time, the CAFC's 2018 fair use decision, *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179 (Fed. Cir. 2018) (*"Oracle II"*) would have the same improper influence as *Oracle I*. EFF Br. at 2. Indeed, we are already seeing that influence, within the Ninth Circuit, in a widely publicized copyright and trademark dispute between the estate of Dr. Seuss and the creators of a *Star Trek*-themed work called, "Oh, the Places You'll Boldly Go!." *See Dr. Seuss Enterprises, L.P. v. ComicMix LLC*, No. 16-cv-2779 (S.D. Cal. filed November 10, 2016) ("*Dr. Seuss*").

The procedural history of the case is informative. The case was filed in 2016, well before *Oracle II*.[1] The defendants moved to dismiss the copyright claims on the ground of fair use. The district court largely agreed with many of the defendants' arguments on fair use, but denied the motion to dismiss in order to permit discovery. *Dr. Seuss*, Order Granting in Part and Denying in Part Motion to Dismiss (Docket No. 38, June 9, 2017).[2] In December 2018, after *Oracle II* was decided, the parties cross-moved for summary judgment. Docket Nos. 107, 108. The plaintiff claimed that *Oracle II* meant that the court should "reconsider" its June 2017 opinion "in light of further legal developments" because *Oracle II* "provides an important clarification" of the first fair use factor. Plaintiff's Motion for Summary Judgment, Docket No. 107, at 14.[3]

The district court in this case is in the Ninth Circuit, and there are many Ninth Circuit fair use decisions to guide its district courts. The district court could have, and should have, rejected the plaintiff's argument out of hand, dismissing *Oracle II* or at least treating it as non-binding authority. Instead, the district court treated *Oracle II* as

[1] The docket for the case is available from PACER; an unofficial docket is available at: https://www.courtlistener.com/docket/4496668/dr-seuss-enterprises-lp-v-comicmix-llc/
[2] Available at: https://www.courtlistener.com/recap/gov.uscourts.casd.517627.38.0.pdf
[3] Available at: https://www.courtlistener.com/recap/gov.uscourts.casd.517627/gov.uscourts.casd.517627.107.1.pdf

controlling law, citing it extensively and never questioning its basic analysis (though it went on to distinguish the case on the facts). *See Dr. Seuss*, Order Granting Defendants' Motion for Summary Judgment, etc. (Docket No. 149, March 12, 2019).[4]

A recent Fourth Circuit decision also cites *Oracle II* regarding fair use factor one—in this case, as equally persuasive authority as that from other circuits. *Brammer v. Violent Hues Productions, LLC.*, No. 18-1763 (4th Cir. April 26, 2019), at 13.

During Google's first petition for certiorari, the Government's prior invitation brief claimed that *Oracle I* would have "limited precedential value. The Federal Circuit's decision applying Ninth Circuit law would not bind a future Ninth Circuit panel, and it would bind future Federal Circuit panels only in cases arising within the Ninth Circuit." 14-410 U.S. Br. at 22 (May 2015). That prediction has not come true—the Federal Circuit opinions here have had *significant, misplaced* precedential value. When district courts in the First and Ninth Circuits follow *Oracle I* and *Oracle II* for computer copyright principles instead of their regional circuit law, then the Federal Circuit has undeniably—and improperly—established nationwide precedent in copyright law. And on the merits, if *Oracle I* means that functional aspects of computer programs (such as APIs) are copyrightable, and if *Oracle II* means that a jury isn't allowed to decide that using a competitor's APIs is a fair use, then as a matter of *nationwide* law, there are few, if any, ways that a second competitor can enter a market with an API-compatible product.

EFF's amicus briefs in this litigation contain a more detailed discussion of how the Federal Circuit is re-shaping copyright law, upending decades of settled expectations and undermining innovation.[5] The Supreme Court should exercise its supervisory authority over the circuit courts, and clarify the role of the Federal Circuit where, as here, the gravamen of the case goes beyond the Federal Circuit's customary and authorized purview.

Thank you for your consideration, and please let me know if EFF can be of further assistance with this matter.

Sincerely yours,

Michael Barclay

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[4] Available at: https://www.courtlistener.com/recap/gov.uscourts.casd.517627/gov.uscourts.casd.517627.149.0.pdf

[5] EFF's amicus briefs in this case can be found at: https://www.eff.org/cases/oracle-v-google