

No. 18-956

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In the  
**Supreme Court of the United States**

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GOOGLE LLC,  
*Petitioner,*  
v.

ORACLE AMERICA, INC.,  
*Respondent.*

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

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**BRIEF OF *AMICI CURIAE* COPYRIGHT THOUGHT  
LEADERS IN SUPPORT OF RESPONDENT**

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## INTEREST OF AMICI CURIAE

*Amicus curiae*<sup>1</sup> are copyright professors, thought leaders, former senior Copyright Office staff, trade negotiators, Congressional staff, and practitioners. In addition to writing, thinking, and teaching about copyright, they have helped write portions of the U.S. Copyright Act, administer that Act, counsel and litigate copyright matters, and negotiate the copyright provisions of U.S. trade agreements. *Amici* have no stake in the outcome of this case other than our unifying belief that an effective copyright system at home and abroad promotes the creation and distribution of works of original authorship and economic prosperity. The arguments put forth by Petitioner and their amici would unnecessarily confuse copyrightability analysis and dramatically expand fair use, undermining the fundamental, Constitutional role of copyright not only in the context of computer programs but across the creative fields.

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<sup>1</sup> 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. Both parties gave blanket consent to the filing of *amicus* briefs and both parties received timely notice of *amici's* intent to file this brief.

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### **SUMMARY OF ARGUMENT**

The legal arguments made by Petitioner and its amici in support of their policy goals do not withstand scrutiny. Most fundamentally, computer code is copyrightable as a literary work without regard to the function it performs. Petitioner and its amici's focus on the function performed by Respondent's code when operated must be inapposite under the Copyright Act. If it were otherwise, the fact that all computer code ultimately performs a function would render the copyright protection Congress clearly intended to provide for computer programs as literary works a nullity.

Petitioner's merger argument is defeated by the undisputed facts. Merger does not apply when there are multiple forms of expression for the same idea.

Petitioner's Android system was predated and followed by major competing mobile platform operating systems, *both* of which managed to achieve the same functionality with different, original code. Petitioner's attempt to divert this Court's attention from that flaw in its merger argument by claiming it had no choice but to copy Respondent's code is similarly defeated by the fact that other competitors found such an alternative. Further, even if this Court accepts Petitioner's claim that Respondent's code is an unavoidable industry standard, Petitioner's actions and policy arguments fly in the face of accepted behavior regarding standards protected by intellectual property, as well as the Copyright Act.

Petitioner's last line of defense is to claim fair use. Amici consider that this Court has rarely if ever seen such a brazen invocation of that affirmative defense. Petitioner is one of the largest companies in the world. It eschewed participation in a vibrant licensing market for Respondent's code and instead engaged in verbatim copying of that code for commercial purposes and in competition with Respondent. A holding from this Court that these actions were fair use under the Copyright Act will place the United States in violation of sixteen separate treaties and international instruments, including the just-approved U.S.-Mexico-Canada Agreement, and materially harm American efforts to protect intellectual property in foreign markets.

**ARGUMENT****I. RESPONDENT'S COMPUTER CODE IS COPYRIGHTABLE****A. Petitioner And Amici's Policy Arguments Run Counter To The Constitution**

Petitioner and their amici insist that copyright protection for Respondent's code will interfere with innovation.<sup>3</sup> This is a familiar refrain that this Court has heard from them many times before.<sup>4</sup> Those policy

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<sup>3</sup> See, e.g., Brief for the Petitioner at 26-28; Brief of Amici Curiae The Computer & Communications Industry Association and Internet Association in Support of Petitioner at 29-31 ("CCIA"); Brief of Amicus Curiae Electronic Frontier Foundation in Support of Petitioner at 31-21; Brief of Amicus Curiae Engine Advocacy in Support of Petitioner at 27-33; Brief of the R Street Institute, Public Knowledge, and the Niskanen Center as Amici Curiae in Support of Petitioner at 29-31; Brief of 72 Intellectual Property Scholars as Amici Curiae in Support of Petitioner ("Brief of IPS") at 1-3.

<sup>4</sup> Brief for Google, Inc. as Amicus Curiae in Support of Petitioners, *Golan v. Holder*, 565 U.S. 302 (2012)(The statute places an ominous cloud over what had been the property of all Americans, and discourages investment in facilitating access to and use of public domain materials)(The chilling effect would be no less significant for companies and organizations offering products and programs that facilitate the public's access to, and ability to enjoy, explore, and create with public domain materials); Brief of the Computer and Communications Industry Association and Internet Archive as Amici Curiae in Support of Respondents and in Opposition to the Writ of Certiorari, *MGM Studios, Inc, et. al., v. Grokster, Ltd., et. al.*, 545 U.S. 913 (2005)(Any revision of *Sony* to meet this transitory challenge would be fraught with unintended consequences for the American economy and for American information culture); Brief of the Electronic Frontier Foundation,



arguments challenge the Constitutional philosophy of copyright. James Madison led the subcommittee that drafted the Copyright and Patent Clause,<sup>5</sup> which articulates the vision that exclusive rights promote the progress of Science. U.S. CONST. art. I, § 8, cl. 8. In Federalist #43, Madison wrote “[t]he public good fully coincides in both cases [copyright and patent] with the claims of individuals.”<sup>6</sup> President Washington shared Madison’s view that copyright is a benefit to the public and considered the enactment of a federal copyright statute to be of such importance that he used to occasion of the first State of the Union address to implore Congress:

[Y]ou will agree with me in opinion, that there is nothing which can better deserve your patronage, than the promotion of Science and

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Public Knowledge, the Consumer Electronics Association, and Engine Advocacy as Amici Curiae in Support of Respondent, American Broadcasting Companies, Inc., et al. v. Aereo, Inc., 573 U.S. 431 (2013)(the predominant interpretive approach suggested by petitioners and their amici—that the Court should construe exclusive rights to include all financially valuable uses of copyrighted works—would strip away the commercial freedom that led to the home stereo, the videocassette recorder, all manner of personal audio and video technologies, and many Internet-based services); Brief of 36 Intellectual Property and Copyright Law Professors as Amici Curiae in Support of Respondent, ABC, Inc. v. Aereo, Inc.(But if separate and independent transmission can be aggregated into a single “performance” whenever they involve the same underlying work, copyright owners will gain a veto power over new consumer media technologies).

<sup>5</sup> Rudd, “*Notable Dates in American Copyright 1783-1969*,” 28 The Quarterly Journal of the Library of Congress, No. 2 at 137 (April, 1971).

<sup>6</sup> The Federalist No. 43 (James Madison).

Literature. Knowledge is in every Country the surest basis of public happiness.<sup>7</sup>

The same philosophy carries through into the modern era. Mere months ago the House Judiciary Committee, in a report about pending legislation to create a process for adjudicating small claims copyright infringement, wrote:

On an individual level, the inability to enforce one's rights undermines the economic incentive to continue investing in the creation of new works. On a collective level, the inability to enforce rights corrodes respect for the rule of law and deprives society of the benefit of new and expressive works of authorship.<sup>8</sup>

Similarly, the Copyright Office has consistently reaffirmed the role of copyright as an engine of creativity for the benefit of all. In calling for a thorough review of the U.S. Copyright Act, then-Register Pallante recalled this Court's jurisprudence:

The issues of authors are intertwined with the interests of the public. As the first beneficiaries of the copyright law, they are not a counterweight to the public interest but instead

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<sup>7</sup> President George Washington, *First Annual Message to Congress on the State of the Union* (Jan. 8, 1790).

<sup>8</sup> H. R. Rep. No. 116-252 at 19 (2019) (quoting Letter from Lamar Smith, Chairman, H. Comm. on the Judiciary, to Maria A. Pallante, Register of Copyrights and Director, U.S. Copyright Office (Oct. 11, 2011), included in U.S. Copyright Office, *Copyright Small Claims: A Report of the Register of Copyrights* (2013), <https://www.copyright.gov/docs/smallclaims/usco-smallcopyrightclaims.pdf>).

are at the very center of the equation. In the words of the Supreme Court, “[t]he immediate effect of our copyright law is to secure a fair return for an ‘author’s’ creative labor. But the ultimate aim is, by this incentive to stimulate artistic creativity for the general public good.”<sup>9</sup>

Petitioner and their amici once again express the opposite, asserting copyright is a battle between the rights of authors and the public good. They would have this Court hold that exclusive rights are a barrier to progress, creativity, and innovation. Facts, experience, and this Court’s precedent teach otherwise.<sup>10</sup> They are entitled to their opinion, but this Court should remain

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<sup>9</sup> Statement of Maria A. Pallante, Register of Copyrights of the United States, “*The Register’s Call for Updates to U.S. Copyright Law*,” Subcommittee on Courts, Intellectual Property and the Internet, Committee on the Judiciary, U.S. House of Representatives at 3 (March 20, 2013)(quoting *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975)).

<sup>10</sup> “[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable rights to use one’s expression, copyright supplies the economic incentive to create and disseminate ideas.” *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003)(citing *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 558 (1985); See also Economics & Statistics Admin. and U.S. Patent and Trademark Office, “*Intellectual Property and the U.S. Economy*,” (2016)(Copyright-intensive industries supplied 5.6 million jobs in the United States); “*Art of the Possible, U.S. Chamber International IP Index*,” Global Innovation Policy Center, U.S. Chamber of Commerce at 20 (8<sup>th</sup> ed., 2020)(Economies with effective IP protection are 70% more likely to produce more innovative output, have 26% greater global competitiveness, and 6 times more high-skilled researchers); Siwek, “*Copyright Industries in the U.S. Economy*,” (2018)(U.S. copyright industries add over \$1.3 trillion to the U.S. economy).

true to the Founder's clearly articulated vision. Petitioner's arguments would not only excuse their appropriation, they would undermine the Constitutional purposes of the Copyright Act.

**B. Respondent Asserts Protection Of The Code, Which Is Copyrightable Without Regard To The Function That Code Performs When Run**

It is undisputed that computer code is copyrightable. Petitioner and its amici offer an array of analogies to try to focus this Court's attention away from the protectable computer code and toward the function the code produces when run. These analogies are all uninformative as Respondent claims copyright in the code as a literary work, not its function. Ironically, the best analogy is from this Court's own precedent in *Baker v. Selden*, 101 U.S. 99 (1879), on which Petitioner relies so heavily. In that case, this Court recognized that Selden's book providing instructions on how to operate his accounting system was a copyrightable literary work, but the system itself was not copyrightable:

There is no doubt that a work on the subject of bookkeeping, though only explanatory of well known systems, may be the subject of a copyright, but then it is claimed only as a book...it may be a very valuable acquisition to the practical knowledge of the community. But there is a clear distinction between the book as such and the art which it is intended to illustrate. The mere statement of the proposition

is so evident that it requires hardly any argument to support it.<sup>11</sup>

Just as Selden's book was a set of instructions on how a human may operate his bookkeeping system, Respondent's code is a set of instructions on how a computer may operate various functions. Thus, the code is the protected literary work, providing instructions to the computer on how to operate an API, while the actual functioning of that code is not the subject of Respondent's infringement claim. The uncopyrightability of methods of operation as held in *Baker*<sup>12</sup> is codified in section 102(b) of the Copyright Act. Congress and the drafters of the National Commission on New Technological Uses of Copyrighted Works ("CONTU Report") were clear on this point:

Section 102(b) is intended, among other things, to make clear that the *expression adopted by the programmer is the copyrightable element in a computer program*, and that the actual processes or methods embodied in the program are not within the scope of copyright law [emphasis added]...Thus, one is always free to make a machine perform any conceivable process (in the absence of a patent), but one is not free to take another's program...All that copyright protection for programs, videotapes, and phonorecords means is that users may not take works of others to operate their machines. In each instance, one is always free to make the machine do the same thing as it would if it has the

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<sup>11</sup> *Id.* at 101-02.

<sup>12</sup> *Id.* at 103.

copyrighted work placed in it, but only by one's own creative effort rather than by piracy."<sup>13</sup>

None of Petitioner's or its amici's analogies can alter the fact that Petitioner refused a license for Respondent's code and made its machine work in that regard not by its own creative effort, but "rather...by piracy."

This Court recently reaffirmed the distinction between the creative, copyrightable aspects of a work and its function. In *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, this Court held:

Were we to accept petitioner's argument that the only protectable features are those that play absolutely no role in an article's function, we would effectively abrogate the rule of *Mazer* and read "applied art" out of the statute.<sup>14</sup>

The arguments from Petitioner and their amici claiming that the Java API declarations are a method of operation tempts this Court with the path it rejected in *Star Athletica*. While the *function* of the API may be a method of operation, the *code* is not. By definition, computer programs are "a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result. 17 U.S.C. §101. Petitioner itself repeatedly describes the copied declarations as "instructions," albeit in language

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<sup>13</sup> Library of Congress, "*Final Report of the National Commission on New Technological Uses of Copyrighted Works*," at 19-21 (July 31, 1978)(citing S. Rep. No. 473 at 54 (1975); H. R. Rep. No. 1476 at 57 (1976)(emphasis in original).

<sup>14</sup> 137 S. Ct. 1002, 1014 (2017)(citation omitted).

laden with disparagement. *See, e.g.*, Brief for the Petitioner at 1-2 (“Google also reused isolated instructions from a work copyrighted by respondent Oracle, because those were the only instructions that could perform their functions.”)(emphasis omitted); at 4 (“A call will not work correctly unless it corresponds precisely to instructions called ‘declarations’”); at 10 (“The court did not doubt that only the precise instructions that Google reused would perform the declarations’ function....”). To conflate the protectable code with its function is to read “computer programs” out of the statute.

Petitioner’s arguments do more than merely misconstrue the nature of the authorship at issue in this case. By conflating the expressive authorship with its use, Petitioner invites this Court to deconstruct all copyrighted works into nothingness. If thousands of lines of creative code are not copyrightable because they are a method of operation that produce a certain result, then how is sheet music anything more than a series of instructions designed to produce a particular resulting set of sounds? Under this approach, maps and charts are merely a method of operation of navigation, and “*The Philadelphia Spelling Book*” is a method of operation for teaching children. But maps and charts were expressly copyrightable since the Copyright Act of 1790. 1 Stat. 124, chap. 15 (May 31, 1790). “*The Philadelphia Spelling Book*” was the first work registered under that Act.<sup>15</sup> And musical works have been protected under federal copyright law since 1831. 4 Stat. 436, chap. 16 (Feb. 3, 1831). Petitioner’s

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<sup>15</sup> Rudd, *supra* n. 5 at 138.

arguments would throw even the most venerable understandings of copyrightability into a metaphysical morass. See *American Dental Ass'n v. Delta Dental Plans Ass'n*, 126 F.3d 977, 978-79 (7<sup>th</sup> Cir. 1997).

### **C. The Short Phrase Doctrine Is Inapplicable To Respondent's Code**

Petitioner copied over 11,000 lines of code. Amici in support of Petitioner would have this Court consider those individual lines one by one, out of context.<sup>16</sup> By this approach, a novel may be viewed as nothing more than a collection of sentences and short phrases. If amici's analysis is taken to its logical extreme, all literary works become a mere collection of individual words, or a sequence of individual letters of the alphabet, or nothing more than a spread of colored pixels on a screen or paper.<sup>17</sup> Petitioner copied over 11,000 lines from a literary work. The short phrase doctrine offers no shelter for that.

Petitioner asserts significance that “[t]he declarations, in turn, do not appear together but instead are sprinkled throughout the Java SE libraries.” Brief for Petitioner at 25. But computer code, while it is a literary work, is not a narrative work that tells a story to be read in sequence. That the thousands of lines of copied code are not consecutive ought not excuse the infringement of a nondramatic work. See *Folsom v. Marsh*, 9 F. Cas 342 (C.C. Mass. 1841).

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<sup>16</sup> Brief of IPS at 32-34.

<sup>17</sup> 2 Patry on Copyright §4:2 ([A]tomistic parsing of longer works to create artificially shorter components that can then be separately attacked for lack of originality is a fallacious tactic).



Petitioner and their Amici's reliance on *Southco v. Kanebridge*<sup>18</sup> is unavailing.<sup>19</sup> In *Southco*, the primary reason the Third Circuit found the numbers were uncopyrightable was "because they are mechanically produced by the inflexible rules of the Southco system."<sup>20</sup> For similar reasons, the *Southco* court held that the 9-digit numerical product of Southco's numbering system, each of which Plaintiff Southco sought to protect as its own stand-alone work, were "analogous to short phrases."<sup>21</sup> That analogy fails when applied to the case at bar, in which Petitioner acknowledges the originality and creativity of the code.<sup>22</sup>

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<sup>18</sup> 390 F.3d 276 (3d. Cir. 2004).

<sup>19</sup> Brief for Respondent at 14, 29; Brief of IPS at 32-34.

<sup>20</sup> *Southco* at 285.

<sup>21</sup> *Id.* at n.4.

<sup>22</sup> The Solicitor General clearly also sees the distinction. The United States intervened to support defendant Kanebridge before the Third Circuit, but supports Respondent's infringement claim here. See Brief Amicus Curiae of the United States of American Urging Reversal in Support of Appellant Kanebridge Corp., *Southco*, 390 F.3d 276 (3d. Cir. 2004).

**D. The Facts Demonstrate There Were  
Multiple Forms Of Expression Available  
To Petitioner, Defeating The Merger  
Claim**

Petitioner frames this case by asserting Respondent's code is effectively an industry standard that others *must* use.<sup>23</sup> From this self-asserted predicate, Petitioner insists that in order to make its code function, it must copy all elements of Respondent's code, verbatim.<sup>24</sup>

But that merger claim is fatally flawed because other competitors in the smart mobile device market wrote and implemented their own code to achieve similar functionality, namely Apple and Microsoft. *Oracle Am., Inc. v. Google, Inc.*, 750 F.3d 1339, 1360 n. 5 (Fed. Cir. 2014). The mere existence of these alternatives, much less their global popularity, proves that there *are* alternative expressions for the ideas and functions behind Respondent's expressive code and that invocation of the merger doctrine to deny protection is thus inappropriate.

In asserting it had no choice but to copy Respondent's code, Petitioner glosses over its business decision not to write its own version of that code and not to license the code. Indeed, a close reading of Petitioner's argument reveals its admission that copying

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<sup>23</sup> "Any successful new product must be as compatible as possible with the relevant existing skills and experience of the users it seeks to support." Brief for Petitioner at 26.

<sup>24</sup> "But they reuse the more limited code that is required – because it cannot be written any other way – to allow users to use the commands they already know from the legacy product." *Id.*

Respondent's code was not a technological imperative but a market-based decision. As Petitioner says:

Oracle would require Java developers to learn thousands of new calls to replace those they already know, with no benefit to anyone. That is effectively the equivalent of requiring the developers to learn an entirely new programming language, simply to invoke the same functions using different labels.<sup>25</sup>

Petitioner's colorful policy claims about "obstacles,"<sup>26</sup> "hold hostage,"<sup>27</sup> and "compatibility"<sup>28</sup> ignore the reality that Respondent did and does offer a license and that Petitioner made a business decision not to take that offer.

The existence of alternative expressive codes defeats Petitioner's claim it had only one choice and only one way to achieve that end. Both the first District Court and the Federal Circuit held that Petitioner had other expressive choices to achieve the same functionality.<sup>29</sup> Petitioner's analysis ignores that and emphasizes only the subsequent choices that would make Respondent's

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<sup>25</sup> Brief for Petitioner at 27.

<sup>26</sup> *Id.*

<sup>27</sup> *Id.*

<sup>28</sup> *Id.* at 28.

<sup>29</sup> "As the district court recognized, moreover, 'the Android method and class names could have been different from the names of their counterparts in Java and still have worked.'" *Oracle Am., Inc. v. Google, Inc.*, 750 F.3d 1339, 1361 (Fed. Cir. 2014)(quoting *Oracle Am., Inc. v. Google, Inc.*, 872 F. Supp. 2d 974, 976 (N.D. Cal., May 31, 2012).

code function.<sup>30</sup> Petitioner’s merger argument only survives if this Court disregards the existence of Apple iPhone and the Microsoft Surface platforms.

### **E. Unlicensed Use Does Not Meet Accepted Industry Standards Of Conduct**

Petitioner’s policy arguments insist that it more efficient to copy Respondent’s code, treating it effectively as a necessary industry standard.<sup>31</sup> Even if that is accurate, it does not justify a failure to license the work.

A doctrine from patent law sheds light on Petitioner’s conduct.<sup>32</sup> In the context of patent law, it is not uncommon for industry-standard technologies to be the subject of patent protection, known as standard-essential patents (“SEPs”). To address the potentially anticompetitive use of a patent covering industry-standard art, industry leaders and policy makers have developed the widely accepted practice that SEPs should be made available for licensing on a fair, reasonable, and non-discriminatory basis (“FRAND”). 1 Patent Licensing Transactions §2A.02 (2019). The FRAND policy mutually promotes competition, future innovation and respects existing patent rights.

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<sup>30</sup> Brief for Petitioner at 29-30.

<sup>31</sup> *Id.* at 26-28;

<sup>32</sup> This Court has not hesitated to borrow doctrines from patent law into its copyright jurisprudence where the policy issues are similar. *See Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 442 (1984).

FRAND is widely accepted as a pro-innovation policy. Three federal agencies, the U.S. Patent and Trademark Office, the National Institute of Standards and Technology, and the U.S. Department of Justice, Antitrust Division have recently reaffirmed this in a joint policy statement that not only confirms the positive role of licensing, it also endorses the appropriateness of legal remedies for unlicensed, infringing uses:

As a general matter, to help reduce the costs and other burdens associated with litigation, we encourage both standards-essential patent owners and potential licensees of standards-essential patents to engage in good-faith negotiations to reach F/RAND license terms. All remedies available under national law, including injunctive relief and adequate damages, should be available for infringement of standards-essential patents subject to a F/RAND commitment, if the facts of a given case warrant them. Consistent with the prevailing law and depending on the facts and forum, the remedies that may apply in a given patent case include injunctive relief, reasonable royalties, lost profits, enhanced damages for willful infringement, and exclusion orders issued by the U.S. International Trade Commission.<sup>33</sup>

Despite Petitioner's emphasis on the business and policy imperatives of utilizing Respondent's code due to its widespread adoption, it stops short of invoking by

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<sup>33</sup> *Policy Statement on Remedies for Standards-Essential Patents Subject to Voluntary F/RAND Commitments* (Dec. 19, 2019).

name the SEP doctrine. It is not difficult to imagine why. The SEP doctrine requires the patent owner to offer its code for licensing on a FRAND basis. This is exactly what Respondent offers.<sup>34</sup> Petitioner had every opportunity to license the code, just as many others have done. Instead, it refused a license and simply copied Respondent's code. Even if this Court accepts Petitioner's policy premise that it is better to use Respondent's code than write its own, it should not undermine the principles of copyright protection for software, expand fair use,<sup>35</sup> and ignore FRAND principles.

## **II. PETITIONER'S VERBATIM COPYING FOR COMMERCIAL USE WITH THE SAME CHARACTER AND PURPOSE IS NEITHER TRANSFORMATIVE NOR FAIR USE**

### **A. This Court Must Keep The Transformative Use Doctrine Tethered To The Purposes Of The Copyright Act**

In articulating the transformative use doctrine, this Court connected transformation to the fundamental aims of the Copyright Act in promoting creative expression:

The central purpose of this investigation is to see, in Justice Story's words, whether the new work merely "supercede[s] the objects" of the original creation, *Folsom v. Marsh, supra*, at

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<sup>34</sup> *Oracle Am., Inc. v. Google, Inc.*, 750 F.3d 1339, 1350 (Fed. Cir. 2014)

<sup>35</sup> See Parts II and III, *infra*, for an analysis of why a finding of fair use is inappropriate in this case.

348; accord, *Harper & Row, supra*, at 562 (“supplanting” the original), or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message....<sup>36</sup>

Petitioner has done nothing that qualifies as transformative. It engaged in verbatim copying to use the copied code in commercial competition with others who either licensed the works or avoided infringement by applying their own creativity to write different code to perform those functions. While Petitioner surrounded the copied code with its own code, nothing new is added to the copied code: it is used for the same purpose and character for which Respondent offered a license and Petitioner refused. Nor is there alteration of the work with new expression, meaning, or message. Petitioner chose to copy Respondent’s code to free ride on its popularity and built a platform that competes directly with Respondent and its licensees.<sup>37</sup> Petitioner’s arguments on the issue of copyrightability in this case constitute an admission that it used the verbatim code in precisely the same way and for the same purpose for which it was authored.<sup>38</sup> Those assertions are incompatible with Petitioner’s subsequent claim that its use is transformative.

This Court should not denigrate the doctrine of fair use to condone an unlicensed use of copyrighted works that is merely popular or cool. Popularity is not a basis

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<sup>36</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 579 (1994).

<sup>37</sup> Brief for Respondent at 14-15.

<sup>38</sup> *See, supra*, n24.

for reducing protection; that would run contrary to the purposes of the Copyright Act.

**B. Petitioner’s Copying And Use In Competition With Respondent Weighs Against Fair Use**

This case presents the unlicensed commercial use of thousands of lines of a creative copyrighted work by one of the largest companies in the world, contributing to corporate revenues of over forty billion dollars.<sup>39</sup> Further, Respondent has a thriving business licensing the very works Petitioner copied and used in direct competition with Respondent.<sup>40</sup> This is the strongest evidence of harm to the market. *Harper & Row*, 471 U.S. at 567.

This brazen commercial use in competition with Respondent and the indisputable harm to the market doom Petitioner’s fair use claim. That Petitioner claims that its verbatim copying is transformative is an indication of how distorted that doctrine has become.<sup>41</sup>

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<sup>39</sup> Brief for Respondent at 18.

<sup>40</sup> *See, supra*, n37.

<sup>41</sup> *See* Statement of June M. Besek, “Hearing: The Scope of Fair Use,” House Judiciary Committee (Jan. 28, 2014).



**C. Labels Of “Interface” And  
“Interoperability” Do Not Change The  
Fact That Petitioner Copied  
Copyrightable Code To Create A  
Competing Platform**

Petitioner and their amici invoke the term “interface” like a mantra. Of course, they cite no “interface” exception in the Copyright Act. Congress provided for the copyrightability of “computer programs” through a definition that does not distinguish one type of code from another. 17 U.S.C. §101. Nor should this Court create through its jurisprudence a *per se* rule Congress has not seen fit to enact.

Rather, Petitioner and their amici hope to influence this Court into believing that Respondent’s code is too important to protect. It should not go without note that denying protection because the work is in demand turns copyright on its head. Regardless, this is just another incarnation of Petitioner’s claim that it, unlike Apple and Microsoft, somehow had no choice but to copy Respondent’s code.<sup>42</sup>

This version of that claim also tries to borrow sympathy from copyright jurisprudence favoring interoperability. There should be no mistake: case law permitting intermediate copying for purposes of creating interoperable complementary products would not permit Petitioner’s verbatim appropriation for use in direct competition with other companies that did not make unlicensed use of Respondent’s code.

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<sup>42</sup> See, *supra*, Part I.D and I.E.

Some of Petitioner's amici, most notably CCIA,<sup>43</sup> rely heavily on the Ninth Circuit decision in *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510 (9<sup>th</sup> Cir. 1992), without ever acknowledging that the present case is distinguishable, both because copyrightability was not at issue in *Sega* and because of critical differences in the facts. In *Sega*, Accolade did not seek to produce a competing product and did not incorporate Sega's code into what it sold. It merely copied Sega's operating code as an intermediate step to study it in order to create its own, completely original application that would run on Sega's gaming platform. Thus, the Ninth Circuit held:

[T]here is no evidence in the record that Accolade sought to avoid performing its own creative work. Indeed, most of the games that Accolade released for use with the Genesis console were originally developed for other hardware systems. Moreover, with respect to the interface procedures for the Genesis console, Accolade did not seek to avoid paying a customarily charged fee for use of those procedures, nor did it simply copy Sega's code; rather, it wrote its own procedures based on what it had learned through disassembly. Taken together, these facts indicate that although Accolade's ultimate purpose was the release of Genesis-compatible games for sale, its direct purpose in copying Sega's code, and thus its direct use of the copyrighted material, was simply to study the functional requirements for

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<sup>43</sup> Brief of CCIA.

Genesis compatibility so that it could modify existing games and make them usable with the Genesis console.<sup>44</sup>

This is the *opposite* of what Petitioner did in the present case. Here, it simply copied Respondent's code, avoided paying a customarily charged license fee, and used the copied code to create a *competing platform, not a complimentary application*.

Petitioner claims credit for the authorship of the developers who created apps to run on the Android platform.<sup>45</sup> That subsequent to Petitioner's appropriation of Respondent's code, third parties developed applications that are interoperable with Android does not retroactively justify Petitioner's copying. After refusing a license precisely because it would have prevented them from maintaining Android as a *proprietary* platform,<sup>46</sup> Petitioner may not stand in the shoes of third party app developers who create computer programs that use the code Petitioner copied for its commercial advantage. *Princeton Univ. Press v. Mich. Document Servs.*, 99 F.3d 1381, 1386 (6<sup>th</sup> Cir. 1996).

Amici CCIA's reliance on exceptions to the prohibitions on circumvention in the Digital Millennium Copyright Act<sup>47</sup> is similarly misplaced. The statutory exception is only available to those who

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<sup>44</sup> *Sega*, 977 F.2d at 1522.

<sup>45</sup> Brief for Petitioner at 45.

<sup>46</sup> Brief for Respondent at 13-14.

<sup>47</sup> CCIA at 21-23.

“lawfully obtained the right to use a copy of a computer program” and such use is explicitly restricted to “the sole purpose of identifying and analyzing those elements of the program that are necessary to achieve interoperability...to the extent such acts of identification and analysis do not constitute infringement under this title.” 17 U.S.C. §1201(f)(1). Nothing in that provision authorizes copying of code into a competing product as Petitioner did here.

The same is true of the Copyright Office rule making to which amici CCIA cites.<sup>48</sup> The Copyright Office’s analysis is predicated on “a private, noncommercial use intended to add functionality to a device owned by the person making the modification...not engaging in any commercial exploitation of the firmware....”<sup>49</sup> Rather than finding support for Petitioner’s copying, amici CCIA succeeds only in highlighting that Petitioner’s acts exceed what courts, Congress, and the Copyright Office have heretofore sanctioned.

Amici CCIA’s references to interoperability policies abroad,<sup>50</sup> even if accurate, are unavailing for the same reasons -- they do not address the conduct at issue in this case. CCIA also cherry-picks its consideration of international considerations, omitting the globally-

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<sup>48</sup> *Id.* at 23.

<sup>49</sup> U.S. Copyright Office, “*Recommendation of the Register of Copyrights in RM 2008-8; Rulemaking to Exemptions from Prohibition on Circumvention of Copyright Protection Systems for Access Control Technologies*,” 93 (June 11, 2010)(subsequent consideration of related issues cite back to this original analysis).

<sup>50</sup> CCIA at 23-31.

accepted rule that “[c]omputer programs, whether in source or object code, shall be protected as literary works under the Berne Convention (1971).”<sup>51</sup> Moreover, as discussed below, a ruling from this Court that Petitioner’s unlicensed verbatim use of Respondent’s copyrighted code for commercial purposes in direct competition with the right holder and its licensees was a fair use would constitute a violation of international norms and sixteen specific treaties and agreements to which the United States has acceded.

### **III. INTERNATIONAL CONSIDERATIONS MAKE CLEAR THAT PETITIONER’S CONDUCT SHOULD BE DEEMED INFRINGEMENT**

One of the very few policy agreements across the American political spectrum is the threat to the American economy from foreign-based intellectual property violations.<sup>52</sup> Excusing Petitioner’s conduct as fair use would place the United States out of compliance with no fewer than *sixteen* treaties and international agreements,<sup>53</sup> including trade agreements proffered by both Republican and Democrat

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<sup>51</sup> W.T.O., Agreement on Trade-Related Aspects of Intellectual Property Rights art. 10 (1994)(“TRIPS”). That same agreement includes a prohibition on copyright protection extending to “ideas, procedures, methods of operation or mathematical concepts as such.” *Id.* at art. 9. As discussed above, copyright protection for the expressive code, without regard to the function it performs when run, is consistent with U.S. law and thus also with the same distinction in TRIPS.

<sup>52</sup> “*2020 Democrats raise alarm about China’s intellectual property theft.*” The Hill (Sept. 15, 2019).

<sup>53</sup> *See, infra*, n60.

Administrations and ratified by Houses of Congress alternately controlled by both parties. Such a ruling would also undermine both the legal and moral authority of the United States to pursue diplomatic efforts to ensure adequate and effective protection for American intellectual property abroad.<sup>54</sup>

For a century American copyright law provided no protection to foreign authors. Congress remedied this in 1890, recognizing that lack of protection for *foreign* authors was also deeply harmful to *American* authors:

Since such American publishers pay nothing to the English authors whose stories they appropriate and publish, other American publishers cannot afford to pay American authors...English publishers now appropriate the stories of American writers as American publishers appropriate the stories of English

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<sup>54</sup> Shortly after this Court's decision in *Lotus Development Corp. v. Borland*, 516 U.S. 233 (1996) the United States was peppered with questions from its trading partners in a formal meeting at the WTO about the consistency of that decision with the three-step test. Similar questions were raised about the rulings in *Sega Enterprises v. Accolade, Inc.*, *Campbell v. Acuff-Rose Music, Inc.*, and other fair use issues. See WT/IP/Q/USA/1 (Oct. 30, 1996). The United States seeks to hold other nations accountable for decisions of their courts that are under-protective of intellectual property. See Office of the United States Trade Representative, *Special 301 Report* at 52, 75 (2019) ("Court cases and government memoranda also raise concerns that a broad range of published works will not be afforded meaningful copyright protection.") ("Implementation of a 2010 decision by the Swiss Federal Supreme Court has been interpreted to prevent copyright holders and prosecutors from collecting and using certain data in anti-piracy actions, making it difficult to enforce Swiss copyright law online.").

authors. Reciprocity in copyright would give the English market to American authors.<sup>55</sup>

As early as the 1920s, at the urging of the first Register of Copyrights, Congress introduced and considered legislation to overhaul the American copyright system in order to comply with international standards and earn more widespread protection for American works abroad.<sup>56</sup> Through the Twentieth Century the importance of the global economy became increasingly obvious and Congress finally made it a priority in the 1980s for this country to join the international copyright community by adhering to the Berne Convention.<sup>57</sup> In the 1990s, copyright protection and enforcement were introduced into the global trading

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<sup>55</sup> H. R. Rep. No. 51-2401 at 9-10 (1890).

<sup>56</sup> See Kaplan, Benjamin, "*Copyright Law Revision*," Committee on the Judiciary, United States Senate, Study 17, 86th Cong. 2d Sess. (1960).

<sup>57</sup> "The benefits of the legislation will be multifold. United States adherence to the Berne Convention will establish multilateral relations with twenty-four countries with whom such relations do not currently exist. Further, U.S. membership in the Berne Union is a part in the larger picture of reform of our trade laws, as the Berne standards, it is hoped, will ultimately serve as standards for the General Agreement on Tariffs and Trade (GATT). Since the United States runs a positive balance of trade for copyrighted items, Berne membership should contribute to a continuation of that net advantage. Moreover, the legislation is rooted in the proposition that the United States can join the Union while maintaining a strong and vibrant Library of Congress, which of course serves the public by being a depository of our cultural heritage. Last, by placing American copyright law on a footing similar to most other countries, especially in the industrial world, our domestic law as well as the international legal system are improved. The net benefits will flow to American authors and to the American public." H.R. Rep. No. 100-609 at 6 (1988).

system of the World Trade Organization, just as Congress had foreseen, to which the United States also acceded. Uruguay Round Agreements Act, Pub. L. No. 103-465 (1994).

The 1990s and 2000s saw the United States emerge as a global leader in global copyright norm setting, pursuing bilateral and regional trade agreements (“FTAs”) with updated copyright provisions. Today, copyright-intensive industries contribute over \$1.3 trillion to the U.S. economy annually.<sup>58</sup> Even in the relatively short time since this Court granted certiorari in this case, Congress and the Administration have agreed on ratification of an updated FTA with our largest trading partners, Mexico and Canada, United States-Mexico-Canada Agreement Implementation Act, Pub. L. No. 116-113 (2020)(“USMCA”), which included updated and expanded obligations regarding the protection of copyright.

**A. A Ruling that Verbatim Copying for Commercial Use in Competition with the Copyrighted Work is Non-Infringing Would Place the United States in Violation of Sixteen Treaties and International Agreements**

The USMCA, like the other FTAs the United States has sought, negotiated, and ratified over the past two decades, includes copyright obligations. These agreements provide that copyright rights may be circumscribed by reasonable exceptions and limitations

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<sup>58</sup> *See, supra*, n10.



in national laws, subject to a standard articulated by the three-step test:

1. Certain special cases;
2. Which do not conflict with a normal exploitation of the work; and
3. Do not unreasonably prejudice the legitimate interests of the right holder.<sup>59</sup>

This standard originated in the Berne Convention and with the blessing and insistence of the United States has been incorporated into the World Trade Organization (“WTO”) TRIPS Agreement, the World Intellectual Property Organization (“WIPO”) Copyright Treaty, and over a dozen FTAs to which the United States is a party.<sup>60</sup> Unlike fair use, the three-step test is not a balancing of factors. Failure to satisfy any of the three prongs results in noncompliance.<sup>61</sup>

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<sup>59</sup> Berne Convention for the Protection of Literary and Artistic Works, art. 9 (1971)(“Berne”).

<sup>60</sup> Berne art. 9 (1971); TRIPS, art. 13 (1994); WIPO Copyright Treaty, art. 10 (1996); US-Jordan FTA art. 4.16; US-Singapore FTA art. 16.4.10; US-Chile FTA art. 17.7.3; US-Australia FTA art. 17.4.10(a); US-Bahrain FTA art. 14.4.10(a); US-Central America FTA art. 15.5.10(a); US-Columbia Trade Promotion Agreement art. 16.7.8; US-Morocco FTA art. 15.5.11(a); US-Oman art. 15.4.10(a); US-Korea FTA art. 18.4.10(a); US-Panama art. 15.5.10(a); US-Peru Trade Promotion Agreement art. 16.7.8; USMCA art. 20.64.

<sup>61</sup> Ficsor, Mihaly, “*Guide to the Copyright and Related Rights Treaties Administered by WIPO*,” World Intellectual Property Organization at 56-57 (Nov. 2003).

In 1999 Ireland brought a dispute under the auspices of the WTO against the United States for noncompliance with the three-step test. The WTO panel's decision in that case provides helpful guidance about the application of the test.<sup>62</sup> The following discussion focuses on the second and third prongs of the three-step test, both of which would be offended by a fair use ruling in this case.

The panel decision clarified that an exception to copyright rights in a nation's law that permits an otherwise infringing use to "enter into economic competition with the ways that right holders normally extract economic value from that right to the work (i.e., the copyright) and thereby deprive them of significant or tangible commercial gains"<sup>63</sup> violates the second prong of the three-step test.

In the present case, Respondent has a thriving licensing market for the code Petitioner copied for use in its commercial mobile device platform. Petitioner's admitted intent from the beginning was to use Respondent's code to enter into economic competition with Respondent and Respondent's licensees. And it cannot be seriously disputed that Petitioner's refusal to license the works it copied has cost Respondent "significant or tangible commercial gains." The WTO Panel's articulation of the test for the second prong of the three-step test reads as though it were describing the facts before the Court today. A ruling that such use is fair under U.S. law could scarcely survive scrutiny under this analysis.

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<sup>62</sup> WT/DS160/R (June 15, 2000).

<sup>63</sup> *Id.* at 48, paragraph 6.183.

Failure of the second prong alone is enough to throw the United States out of compliance with its international obligations. Even if it were not, a ruling of fair use in this case would fare equally poorly under the third prong, that the exception must not unreasonably prejudice the legitimate interests of the right holder. The WTO Panel applied that prong by determining “if an exception or limitation causes or has the potential to cause an unreasonable loss of income to the copyright owner.”<sup>64</sup> Petitioner has generated over forty billion dollars of income from the Android platform and its unlicensed use of Respondent’s code. If even 1/100 of that income is attributable to the pirated code, it would amount to four hundred million dollars in lost income. Given the widespread use of Petitioner’s platform incorporating Respondent’s code, the unreasonable prejudice to the legitimate interests of Respondent through past and continuing loss of income is self-evident.

**B. This Court’s precedent points towards a resolution of this case that is compliant with our international obligations**

In *Murray v. Schooner Charming Betsy*, this Court held, “an act of Congress ought never to be construed to violate the law of nations if any other possible construction remains.” 6 U.S. (2 Cranch) 64, 118 (1804). It is as much a matter of separation of powers as it is respect for international commitments. “The conduct of the foreign relations of our Government is committed by the Constitution to the Executive and Legislative – ‘the political’ – Departments of the Government....”

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<sup>64</sup> *Id.* at 59, paragraph 6.229.

*Oetjen v. Cent Leather Co.*, 246 U.S. 297, 302 (1918). This venerable precedent remains good law. See *Weinberger v. Rossi*, 456 U.S. 25, 32 (1982); *Edward J. DeBartolo Corp. v. Fla. Gulf Coast Bldg. & Constr. Trades Council*, 458 U.S. 568, 575 (1988). Further, the *Charming Betsy* doctrine has been followed recently and specifically in the context of copyright by the U.S. Copyright Office in interpreting the U.S. Copyright Act in light of international obligations.<sup>65</sup>

A ruling that Petitioner's unlicensed verbatim copying of copyrighted code for commercial purposes in competition Respondent is fair use would be inconsistent with the three-step test. The United States has bound itself to that standard in at least sixteen separate international instruments, including many for which it was the primary demandeur. This would create a prospect of foreign trade sanctions against the U.S. and severely undermine American standing around the world.

**C. A Ruling that Verbatim Copying for Commercial Use in Competition with the Copyrighted Work is Non-Infringing Would Undermine the United States' Credibility and Negotiating Position in its Attempts to Secure Protection of American Copyright Rights Abroad**

The U.S. remains out of compliance with the WTO's ruling in the case discussed above and as such is required to make monthly reports to the WTO on the

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<sup>65</sup> *"The Making Available Right in the United States,"* United States Copyright Office at 55-56 (Feb. 2016).

matter.<sup>66</sup> This single and relatively minor instance of noncompliance consistently hinders our trade negotiators to this day by giving foreign governments an excuse to rebuff American efforts to improve copyright protection.<sup>67</sup> A negative ruling in this case, given the scope and importance of the legal and business issues, would increase that criticism by a several orders of magnitude.

This nation is currently locked in a trade war with China, in substantial part over that country's shortcomings on intellectual property protection.<sup>68</sup> After years of withering criticism by the United States government and American creative industries, the Government of China is eager for any opening to criticize the United States' trade policy, especially regarding intellectual property.<sup>69</sup> A ruling from this Court that undercuts the effectiveness of our own law and places us in violation of our own trade agreements on such a grand scale would instantly harden Chinese positions and become a weakness in our negotiating posture that would be exploited to our detriment.

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<sup>66</sup> See, e.g., WT/DS160/24/Add.177 (Dec. 6, 2019). The WTO panel held that Section 110(5) of the U.S. Copyright Act, as amended, was inconsistent with the three-step test.

<sup>67</sup> "China and U.S. accuse each other of hypocrisy as WTO litigation begins," Reuters (Nov. 21, 2018).

<sup>68</sup> "Findings of the Investigation into China's Acts, Policies, and Practices Related to Technology Transfer, Intellectual Property, and Innovation Under Section 301 of the Trade Act of 1974," Office of the United States Trade Representative, Executive Office of the President (March 22, 2018).

<sup>69</sup> See, e.g., Bodeen, Christopher, "China criticizes US moves on intellectual property, telecoms," The Seattle Times (Jan. 17, 2018).

#### IV. CONCLUSION

Petitioner's choice to improve its position in the marketplace by copying Respondent's copyrighted works should not be sanctioned by this Court. Doing so would not only reward activity that should be deterred; it would also undermine the well-settled copyrightability of software and other works or expand fair use to such a degree that it no longer furthers the goals of the Copyright Act. Finally, a ruling of fair use would also do substantial harm to the international interests of the United States in ensuring strong and effective copyright protection abroad.

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