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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.,  
  
Plaintiff,  
  
v.  
  
GOOGLE INC.,  
  
Defendant.

Case No. 3:10-cv-03561 WHA

**GOOGLE'S MAY 14, 2012 COPYRIGHT  
LIABILITY TRIAL BRIEF**

Dept.: Courtroom 8, 19<sup>th</sup> Floor  
Judge: Hon. William Alsup

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1 **I. The structure, sequence and organization of the 37 API packages is not**  
2 **copyrightable.**

3 The Supreme Court has repeatedly rejected the argument that the Constitutional goal of  
4 promoting the progress of science (U.S. CONST., art. I, § 8, cl. 8) is achieved through a one-sided  
5 grant of rights. Instead, the Court has held that the basic building blocks all authors need to  
6 create must remain free for use. Thus, the Supreme Court explained in *Feist Publications, Inc. v.*  
7 *Rural Telephone Service Co.* that there is nothing improper or untoward about allowing others to  
8 use unprotected aspects of a copyrighted work:

9 It may seem unfair that much of the fruit of the compiler’s labor may be used by  
10 others without compensation. As Justice Brennan has correctly observed,  
11 however, **this is not “some unforeseen byproduct of a statutory scheme.” It is,**  
12 **rather, “the essence of copyright,” and a constitutional requirement.** The  
13 primary objective of copyright is not to reward the labor of authors, but “[t]o  
14 promote the Progress of Science and useful Arts.” Art. I, § 8, cl. 8. To this end,  
15 **copyright assures authors the right to their original expression, but**  
16 **encourages others to build freely upon the ideas and information conveyed by**  
17 **a work.** This principle, known as the idea/expression or fact/expression  
18 dichotomy, applies to all works of authorship.

19 499 U.S. 340, 349-50 (1991) (case citations omitted) (emphases added). As the Court further  
20 explained, “[t]his result is neither unfair nor unfortunate. It is the means by which copyright  
21 advances the progress of science and art.” *Id.* at 350.

22 It is for this reason that the Copyright Act protects the expression of ideas, but not the  
23 ideas themselves, nor systems and methods of operation. *See* 17 U.S.C. § 102(b); *Baker v.*  
24 *Selden*, 101 U.S. 99, 102 (1879) (“To give to the author of the book an exclusive property in the  
25 art described therein, when no examination of its novelty has ever been officially made, would be  
26 a surprise and a fraud upon the public. That is the province of letters-patent, not of copyright.”).  
27 Indeed, “the efficient operation of the federal patent system depends upon substantially free trade  
28 in publicly known, unpatented design and *utilitarian* conceptions.” *Bonito Boats, Inc. v. Thunder*  
*Craft Boats, Inc.*, 489 U.S. 141, 156 (1989) (emphasis added). Thus, “[w]here an item in general  
circulation is unprotected by patent, ‘[r]eproduction of a functional attribute is *legitimate*  
*competitive activity.*’” *Id.* at 164 (quoting *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844,  
863 (1982) (White, J., concurring in result)) (emphasis added).

In *Bonito Boats*, the Supreme Court held that a Florida statute that offered “patent-like

1 protection for ideas deemed unprotected under the present federal scheme” was preempted by the  
2 Supremacy Clause. *Id.* at 167-68. The same principle—that protection for functional features is  
3 left to patent law—applies to copyright law, because the Copyright Act does not protect  
4 functional aspects of an original work of authorship. *See* 17 U.S.C. § 102(b); *see also Sony*  
5 *Computer Entm’t, Inc. v. Connectix Corp.*, 203 F.3d 596, 599 (9th Cir. 2000) (“Copyrighted  
6 software ordinarily contains both copyrighted and *unprotected or functional elements*.”)  
7 (emphasis added) (citing *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1520 (9th Cir. 1992),  
8 and 17 U.S.C. § 102(b)). The functional aspects of a computer program are “aspects that were  
9 expressly denied copyright protection by Congress.” *Sega*, 977 F.2d at 1520 (citing 17 U.S.C.  
10 § 102(b)).

11 And the structure, sequence and organization (“SSO”) of the 37 API packages is  
12 undeniably functional. Java language developers use the fully-qualified names of API  
13 elements—the names of the packages, classes and methods (or fields, constructors, interfaces or  
14 initializers)—to identify where in the 37 API packages those elements can be found, in a manner  
15 analogous to how people use street addresses to identify where buildings are located. RT 772:17-  
16 24, 773:14-16 (Bloch). The SSO is the command structure that Java language developers use  
17 when they write Java language programs. RT 289:8-9, 290:8-12 (Ellison); RT 364:3-10 (Kurian);  
18 RT 1959:12-1960:18 (Schwartz). The SSO strictly follows the rules of the Java programming  
19 language. RT 2187:18-2188:4, 2190:16-23 (Astrachan); RT 769:23-770:9, 774:4-775:5 (Bloch).  
20 The very purpose of the J2SE APIs is to provide access to functionality that the Java  
21 programming language would otherwise lack—without the J2SE APIs, the Java programming  
22 language is, in practical effect, useless. RT 683:14-684:4, 707:18-21 (Reinhold); RT 782:9-14  
23 (Bloch); RT 1477:2-13 (Schmidt); RT 1960:4-8 (Schwartz). Oracle and its witnesses do not  
24 dispute any of this.

25 Moreover, the functionality of the SSO of the APIs is fundamental. To invoke or call an  
26 API, a Java language developer *must* write source code that conforms to the method header of the  
27 API. RT 2154:2-8 (Astrachan). In contrast, the developer is indifferent to the implementing  
28 code—from the developer’s perspective, the implementing code is in a “black box,” the contents

1 of which are irrelevant, so long as the method accepts inputs and provides an output consistent  
2 with the API's specification. RT 2160:18-2161:7 (Astrachan) (adopting the Court's explanation).  
3 That is, the specification identifies the functional requirements an implementation must meet to  
4 be compatible with the API described by the specification. *Sega*, 977 F.2d at 1522; *see also* RT  
5 364:3-10 (Kurian) (explaining that the functionality of the class libraries is "abstracted" through  
6 the APIs).

7 Oracle's SSO claim is an attempt to gain patent-like protection under the guise of a  
8 copyright claim. Both the language of 17 U.S.C. § 102(b) and Ninth Circuit precedent preclude  
9 such an approach. The Court should therefore hold that the SSO of the 37 API packages is not  
10 copyrightable.

11 **II. The APIs in the 37 packages are unprotectable ideas, and that is true even though**  
12 **alternative APIs could have been designed.**

13 In its most recent copyrightability brief, Oracle offered examples of two different ways to  
14 design methods for drawing rectangles. In the first example, one draws rectangles by designating  
15 a starting point using *x* and *y* coordinates, and then stating a width and a height. *See* Oracle  
16 5/10/12 Br. [Dkt. 1118] at 5:4-14. In Oracle's second example, one draws rectangles by stating a  
17 starting point using *x* and *y* coordinates, and then using "turn" and "draw" methods to draw each  
18 side of the rectangle. *See id.* at 5:15-26. Oracle's assumption is that because there is more than  
19 one way to draw rectangles, each different way must be a different "creative expression."

20 Oracle's assumption is plainly incorrect. If Oracle were correct, then anyone who read  
21 Oracle's brief would forever need to avoid creating an API for drawing rectangles using either of  
22 the two approaches Oracle described, lest he or she be sued for copyright infringement by Oracle.  
23 The fact that there are many ways to do the same thing does not mean that any given way is  
24 protected by copyright. The two approaches Oracle describes for drawing rectangles are, simply  
25 put, different ideas, systems or methods of operation—and thus both are uncopyrightable,  
26 regardless of the fact that alternative approaches may exist. 17 U.S.C. § 102(b).

27 **III. The SSO of the 37 API packages is functionally required for compatibility, and thus**  
28 **is not copyrightable.**

In *Sega*, the Ninth Circuit held that functional requirements for compatibility are not

1 copyrightable. 977 F.2d at 1522. Google has explained that the SSO of the 37 API packages is  
2 functionally required for compatibility with the APIs in those 37 packages. *See* Google 5/10/12  
3 Br. [Dkt. 1116] at 16:12-17:15.

4 But even under the position advanced by Oracle, the Court should conclude that the SSO  
5 of the 37 API packages is not copyrightable. Oracle argues that “compatible” means whatever  
6 Oracle’s business model wants it to mean, and more specifically that an implementation is  
7 compatible only if it passes Oracle’s TCK. *See* Oracle 5/10/12 Br. [Dkt. 1118] at 18:7-11.  
8 According to Oracle, this would require, among other things, implementing *all* of the SSO of *all*  
9 of the 166 J2SE 5.0 API packages. Thus, under Oracle’s definition, *all* of the SSO of *all* 166  
10 J2SE 5.0 API packages is functionally required for compatibility—which includes the SSO of  
11 each and every one of those packages.

12 Under *Sega*, this means that the SSO of all 166 J2SE 5.0 API packages is  
13 uncopyrightable. 977 F.2d at 1522. Notably, although *Sega* was a fair use case, the Ninth Circuit  
14 did not rely on fair use to conclude that functional requirements for compatibility are not  
15 copyrightable. Instead, the court relied on section 102(b). Indeed, the ultimate fair use holding  
16 *depends* on this statement of law. Accolade had copied and disassembled the code from three  
17 copyrighted Sega game cartridges:

18 Accolade used a two-step process to render its video games compatible with the  
19 Genesis console. First, it “reverse engineered” Sega’s video game programs in  
20 order to discover the requirements for compatibility with the Genesis console. As  
21 part of the reverse engineering process, Accolade transformed the machine-  
22 readable object code contained in commercially available copies of Sega’s game  
cartridges into human-readable source code using a process called “disassembly”  
or “decompilation.” Accolade purchased a Genesis console and three Sega game  
cartridges, wired a decompiler into the console circuitry, and generated printouts  
of the resulting source code.

23 *Id.* at 1514-15 (footnote omitted). The question was whether this wholesale copying was  
24 justifiable as a fair use. According to the court,

25 [A]lthough Accolade’s ultimate purpose was the release of Genesis-compatible  
26 games for sale, its direct purpose in copying Sega’s code, and thus its direct use of  
27 the copyrighted material, was simply to study the functional requirements for  
Genesis compatibility so that it could modify existing games and make them  
usable with the Genesis console.

28 *Id.* at 1522. The court further noted that these functional requirements are not protectable:



1 Accolade copied Sega's software solely in order to discover the functional  
2 requirements for compatibility with the Genesis console—**aspects of Sega's  
programs that are not protected by copyright.** 17 U.S.C. § 102(b).

3 *Id.* (emphasis added). The fact that functional requirements for compatibility are not  
4 copyrightable was key to the court's conclusion that "Accolade copied Sega's code for a  
5 *legitimate, essentially non-exploitative purpose*, and that the commercial aspect of its use can best  
6 be described as of minimal significance." *Id.* at 1522-23 (emphasis added).

7 The Ninth Circuit's direct statement that "functional requirements for compatibility" are  
8 not copyrightable—citing 17 U.S.C. § 102(b)—cannot be explained away as a special rule  
9 applicable only in the fair use context. First, that is not what *Sega* says. 977 F.2d at 1522  
10 ("functional requirements for compatibility . . . are not protected by copyright") (citing 17 U.S.C.  
11 § 102(b)). Second, were "functional requirements for compatibility" unprotected only if they  
12 served a fair use, then *Sega* would be circular, because the fact that the Sega Genesis interfaces  
13 were not copyrightable was a substantial part of the basis for concluding that Accolade's copying  
14 and disassembly of code was a fair use.

15 The accurate reading of *Sega* is that the Ninth Circuit meant exactly what it said—that  
16 section 102(b) requires that functional requirements for compatibility are not copyrightable. And  
17 if the SSO of the 166 J2SE API packages is not copyrightable—because it is functionally required  
18 for compatibility with J2SE—then it cannot change character and become copyrightable when  
19 only part of it is used. That is, whether the issue of compatibility is framed by stating that the  
20 SSO of *all*—i.e., *each and every one* of the—166 J2SE API packages is required for compatibility  
21 with J2SE 5.0, or by stating that the SSO of the 37 API packages at issues is required for  
22 compatibility with those 37 API packages, the end result is that the SSO of the 37 API packages  
23 is not copyrightable under *Sega*.

24 **IV. The doctrines of merger and *scenes a faire* bar copyright protection for any arguable  
25 expression in the SSO of the 37 API packages.**

26 Even if the Court were to conclude that section 102(b) does not bar copyright protection  
27 for the SSO of the 37 API packages, the doctrines of merger and *scenes a faire* preclude  
28 copyright protection. "When the 'idea' and its 'expression' are thus inseparable, *copying the*

1 ‘expression’ will not be barred, since protecting the ‘expression’ in such circumstances would  
2 confer a monopoly of the ‘idea’ upon the copyright owner free of the conditions and limitations  
3 imposed by the patent law.” *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F. 2d 738, 742  
4 (9th Cir. 1971) (emphasis added) (citing, among other cases, *Baker v. Selden*, 101 U.S. 99, 103  
5 (1879)). Similarly, under the *scenes a faire* doctrine, creative expression is treated as an idea—  
6 and thus not protected—where it is “indispensable and naturally associated with the treatment of  
7 a given idea.” *Swirsky v. Carey*, 376 841, 850 (9th Cir. 2004). In the Ninth Circuit, the Court  
8 must consider these doctrines in light of the constraints on *Google* at the time of the alleged  
9 infringement. *Sega*, 977 F.2d at 1524; *see also Lotus Dev. Corp. v. Borland Int’l, Inc.*, 49 F.3d  
10 807, 818 (1st Cir. 1995), *aff’d by an equally divided court*, 516 U.S. 233 (1996); *Baystate Techs.*  
11 *v. Bentley Sys.*, 946 F. Supp. 1079, 1087-90 (D. Mass. 1996). And, in order to be compatible with  
12 the APIs in the 37 packages, *Google* had to implement the SSO of those packages.

13 These doctrines are regularly applied in the software context. *See, e.g., Apple Computer,*  
14 *Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1444 (9th Cir. 1994) (icon representing a document can  
15 only be expressed in a limited number of ways, and therefore is unprotectable under merger);  
16 *Lexmark Int’l, Inc. v. Static Control Components, Inc.*, 387 F.3d 522, 535-36 (6th Cir. 2004) (in  
17 the software context, the *scenes a faire* doctrine applies to “elements of a program dictated by  
18 practical realities—e.g., by hardware standards and mechanical specifications, software standards  
19 and compatibility requirements, computer manufacturer design standards, target industry  
20 practices, and standard computing practices”); *Mitel, Inc. v. Iqtel, Inc.*, 124 F.3d 1366, 1376 (10th  
21 Cir. 1997) (“although Mitel’s values constitute nonarbitrary original expression, they are  
22 unprotectable as scenes a faire because they were dictated by external functionality and  
23 compatibility requirements of the computer and telecommunications industries”).

24 The evidence in the record establishes that any arguable expression in the SSO of the 37  
25 API packages is tightly constrained, and the doctrines of merger and *scenes a faire* therefore  
26 preclude copyright protection for the SSO. *See Google’s Proposed Findings of Fact and*  
27 *Conclusions of Law* [Dkt. 1047], Findings 1-9, 11-36, Conclusions 13-20.

1     **V.     The cases cited by Oracle are inapposite and/or unpersuasive.**

2             The Seventh Circuit’s decision in *American Dental Ass’n v. Delta Dental Ass’n*, 126 F.3d  
3     977 (7th Cir. 1997)—a decision never cited or adopted by the Ninth Circuit—was either only  
4     about the copyrightability of a book *describing* a taxonomy, in which case it is irrelevant to the  
5     issues before the Court, or it was poorly reasoned and wrongly decided. *See* Google 5/10/12 Br.  
6     [Dkt. 1116] at 13:10-15:6. In discussing *American Dental Ass’n*, Oracle cites several cases, none  
7     of which are relevant to the issues before the Court.

8             First, the Ninth Circuit’s decision in *Practice Mgmt. Info. Corp. v. American Medical*  
9     *Ass’n*, 121 F.3d 516 (9th Cir. 1997), held that a *book describing* a code system was copyrightable.  
10    The work at issue was the AMA’s *book*, the *Physician’s Current Procedural Terminology*  
11    (“CPT”). *Id.* at 517. The *CPT* identifies “more than six thousand medical procedures and  
12    provides a five-digit code *and brief description* for each.” *Id.* (emphasis added). Nothing in the  
13    opinion suggests that the *code system*, divorced from the AMA’s *book*, was at issue. *See id.* at  
14    518-20. The Ninth Circuit affirmed the AMA’s copyright in “the CPT,” which the opinion earlier  
15    defined as the book itself, and which included the text descriptions. *See id.* at 517, 520.

16            Moreover, the Ninth Circuit did not address whether the code system in the *CPT*, as  
17    opposed to the book itself, was unprotectable because it was required for compatibility with the  
18    system adopted by Health Care Financing Administration. There was no need to address this  
19    issue because the Ninth Circuit held that the AMA’s copyright was unenforceable due to  
20    copyright misuse. *See id.* at 518-20. Had the issue been raised, however, the panel would have  
21    been bound by the Ninth Circuit’s decision in *Sega*, and *Sega* would have required a holding that  
22    the code system itself was not protected by copyright. 977 F.2d at 1522; 17 U.S.C. § 102(b).

23            Second, in *Edwin K. Williams & Co., Inc. v. Edwin K. Williams & Co.-East*, 542 F.2d  
24    1053 (9th Cir. 1976), the Ninth Circuit held that a book that included both blank forms and  
25    “several pages of instructions” was copyrightable. *Id.* at 1060-61. The defendant had distributed  
26    a book that was “almost identical” to the plaintiff’s book. *Id.* at 1061. The copyrightability of the  
27    blank forms alone was not at issue. Oracle offers no explanation why this decision is relevant to  
28    the present case. *See* Oracle 5/10/12 Br. [Dkt. 1118] at 14:19-24.

1 Third, *Educational Testing Serv. v. Simon*, 95 F. Supp. 2d 1081 (C.D. Cal. 1999), which  
2 Oracle suggests is similar to *Edwin K. Williams*, is similarly irrelevant. The *ETS* court held that a  
3 coaching service that copied questions used in a standardized test infringed the testing service's  
4 copyrights. *Id.* at 1087-90. Among other distinguishing facts, there was no claim that the  
5 material the defendant used was an idea, system or method of operation. Nor was there any claim  
6 that the material used was functionally required for compatibility.

7 **VI. The SSO of the 37 API packages is an uncopyrightable idea, system or method of**  
8 **operation, and thus cannot be protected by copyright.**

9 The facts and law cited above and in Google's prior copyrightability filings reflect well  
10 the reasons why courts have consistently and repeatedly cautioned that software—while  
11 potentially copyrightable—is a technical form of expression for which only limited copyright  
12 protection is available. As the Second Circuit explained in its groundbreaking decision  
13 concerning alleged non-literal infringement of computer software, “[t]he essentially utilitarian  
14 nature of a computer program further complicates the task of distilling its idea from its  
15 expression. . . . Thus, compared to aesthetic works, computer programs hover even more closely  
16 to the elusive boundary line described in § 102(b).” *Computer Assocs. Int’l, Inc. v. Altai, Inc.*,  
17 982 F.2d 693, 704 (2d Cir. 1992). The Ninth Circuit concurred: “Under a test that breaks down a  
18 computer program into its component subroutines and sub-subroutines and then identifies the idea  
19 or core functional element of each, such as the test recently adopted by the Second Circuit in  
20 [*Computer Assocs. Int’l*], many aspects of the program are not protected by copyright. In our  
21 view, in light of the essentially utilitarian nature of computer programs, the Second Circuit’s  
22 approach is an appropriate one.” *Sega*, 977 F.2d at 1524 (citation omitted); *see also Engineering*  
23 *Dynamics, Inc. v. Structural Software, Inc.*, 46 F.3d 408, 409 (5th Cir. 1995), *clarifying* 26 F.3d  
24 1335 (5th Cir. 1994) (“copyright only protects originality of user interface to the extent that the  
25 selection of variable inputs form the universe of potential inputs reflects non-functional  
26 judgments”). Software is unlike novels, plays, poems, paintings, movies or songs, and analogies  
27 to those more traditional types of creative works are not appropriate when dealing with software.  
28 *See* RT 3368:17 (Jacobs) (“Obviously, software is not a symphony. Software is not a poem.”).

1 Moreover, even cases considering the extent to which executable computer programs  
2 should be protected by copyright are an ill fit with respect to the API packages at issue. A typical  
3 executable computer program has a “sequence” for its instructions—i.e., the author of the  
4 program writes implementing source code with instructions that are executed in a specific order.  
5 But there is no way to “execute” the J2SE API packages in a “sequence” chosen by the “author”  
6 of the APIs, because that is not how they are used. Sun did not choose a sequence in which the  
7 multitude of methods that are part of the 37 API packages should be ordered when they are  
8 executed.<sup>1</sup> Instead, Java language developers invoke the elements of the 37 API packages in  
9 whatever order is needed for their computer programs. A developer may invoke one, several or  
10 none of them in his or her program.

11 There are many alternative bases for concluding that the SSO of the 37 API packages is  
12 not copyrightable, the most direct of which is the idea/expression dichotomy. The House Report  
13 that accompanied section 102(b) of the Copyright Act explained:

14 Section 102(b) is intended, among other things, to make clear that the expression  
15 adopted by the programmer is the copyrightable element in a computer program,  
16 and that the actual processes or methods embodied in the program are not within  
the scope of the copyright law.

17 H.R. Rep. No. 1476, 94th Cong., 2d Sess. 57 (1976), *reprinted in* 1976 U.S.C.C.A.N.N. 5659,  
18 5670. The code implementing the 37 API packages is, like other computer code, on the creative  
19 expression side of the idea/expression dichotomy, and thus is protected by copyright unless such  
20 protection is precluded by other limiting doctrines, such as merger and *scenes a faire*. The SSO  
21 of the 37 API packages, however, is on the other side of the divide, and is an unprotectable idea,  
22 system or method of operation.

23 *Feist* teaches that the promotion of the progress of science is a two-sided coin and that the  
24 unprotectable side of the divide is just as important as the protected side. A ruling that the SSO  
25 of the 37 API packages is not protectable is neither unfair nor unfortunate. To the contrary, it is

26 <sup>1</sup> The authors of the *implementations* of the J2SE APIs chose sequences for instructions in the  
27 *implementing code*. That is, within a given method body, the code is implemented in a sequence  
28 specified by the author of that code. But, of course, aside from the nine-line `rangeCheck` method,  
Google is not accused of having copied any *implementing code* from Oracle’s implementation of  
the 37 J2SE API packages.

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the only possible way to promote the Constitutional goal of the Copyright Act.

Dated: May 14, 2012

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