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18 UNITED STATES DISTRICT COURT  
 19 NORTHERN DISTRICT OF CALIFORNIA  
 20 SAN FRANCISCO DIVISION

21 ORACLE AMERICA, INC.

22 Plaintiff,

23 v.

24 GOOGLE INC.

25 Defendant.

Case No. CV 10-03561 WHA

**COPYRIGHT BRIEF REGARDING  
 WORK AS A WHOLE**

Dept.: Courtroom 8, 19th Floor  
 Judge: Honorable William H. Alsup

1           **I.       THE COURT SHOULD DETERMINE THE RELEVANT “WORKS AS A**  
2           **WHOLE.”**

3           After searching further, Oracle has still found no case law that squarely addresses whether  
4           determination of what constitutes a “work as whole” for purposes of the defenses of *de minimis*  
5           copying and fair use is properly determined by the court or the jury. However, courts frequently  
6           decide disputed issues regarding the scope of the “work as a whole” in the context of motions for  
7           summary judgment, strongly suggesting it is a question of law for the court. Moreover, courts  
8           also routinely decide the “work as a whole” issue in bench trials, and here both sides have asked  
9           the Court to decide that issue.

10                   **A.       Judges often grant summary judgment on the issue of fair use even**  
11                   **when the scope of the “work as a whole” is contested.**

12           In its April 22, 2012 brief, Oracle identified several cases where courts have determined  
13           the scope of the “work as whole” in the context of the third factor of the fair use analysis: “the  
14           amount and the substantiality of the portion [of the copyrighted work] used.” Cases in which the  
15           parties contested the scope of the “work as a whole” and the court nevertheless resolved the issue  
16           on summary judgment are discussed further below.

17                           **1.       *Hustler Magazine, Inc. v. Moral Majority, Inc.*,**  
18                           **796 F.2d 1148 (9th Cir. 1986).**

19           The defendants copied a one-page parody from a 154-page Hustler magazine and used the  
20           parody in mailers and in connection with their fundraising activities. The “Defendants argue[d]  
21           that they did not copy an entire work, but only one page from a 154-page magazine.” 796 F.2d at  
22           1154. The district court granted summary judgment in the defendants’ favor based on fair use,  
23           and the Ninth Circuit affirmed. Both the district court and the Ninth Circuit determined the scope  
24           of the “entire work” in the context of the third factor of the fair use analysis, with the Ninth  
25           Circuit determining that the defendants had “copied an entire work” when it copied the one-page  
26           parody. *Hustler Magazine, Inc.*, 796 F.2d at 1154-1155.

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**2. *Super Future Equities v. Wells Fargo Bank Minnesota*,  
553 F. Supp. 2d 680 (N.D. Tex. 2008).**

The plaintiff in *Super Future Equities* copied a webpage from one of the defendant’s websites and posted the page on its own website to criticize the defendant. The defendant counterclaimed for copyright infringement. When the plaintiff moved for summary judgment on the copyright claim, the defendant argued that the work as a whole for fair use should be the page that was copied, while the plaintiff argued that it should be the entire website. *Super Future Equities*, 553 F. Supp. 2d at 699-700. On summary judgment the district court determined that the “work as the whole” for purposes of the fair use defense was the one page that was copied, not the entire website, but nonetheless found fair use. *Id.*

**3. *Los Angeles Times v. Free Republic*,  
1999 WL 33644483 (C.D. Cal. Nov. 8, 1999).**

The defendant operated an online bulletin board that allowed its members to post news articles and add commentary. The plaintiffs, the Los Angeles Times and the Washington Post, sued for unauthorized reposting of their copyrighted news articles. The plaintiffs filed a motion for summary judgment, arguing that the defendants could not rely on fair use. The parties contested the scope of the “work as a whole” for purposes of the third prong of the fair use analysis. Defendants contended that plaintiffs’ “work” was the entire daily newspaper because the copyright registration covered the paper as a whole rather than any particular article. The court rejected this argument and held that the individual articles were the “works as a whole.” *Los Angeles Times*, 1999 WL 33644483, at \*18-20.

**4. *Religious Tech. Ctr. v. Arnaldo Pagliarina Lerma*,  
1996 U.S. Dist. LEXIS 15454 (E.D.Va. Oct. 4, 1996).**

The defendant posted on the Internet portions of documents that were copyrighted by the Church of Scientology. The plaintiff moved for summary judgment of copyright infringement, and the court granted the motion. In the fair use analysis the parties disputed the scope of the “work as the whole” for purposes of the third prong of the analysis. The plaintiff argued that it should be each of the documents contained in the collection that was copyrighted, whereas the

1 defendant argued it should be the entire collection of documents. The court held that the  
2 plaintiff's approach was correct and was supported by the Code of Federal Regulations regarding  
3 copyrighted collections. 37 C.F.R. §202.3(b)(3)(B).

4 **B. Courts often conduct bench trials on the issue of fair use and, in the**  
5 **course of those bench trials, rule on the scope of the "work as a**  
6 **whole."**

7 Google and Oracle agree that the "work as a whole" should be determined by the Court.  
8 Submitting this question to the Court is appropriate, just as if the parties had agreed to a bench  
9 trial, as in the cases discussed below.

10 **1. *Pacific and Southern Co., Inc. v. Duncan,***  
11 **744 F.2d 1490 (11th Cir. 1984).**

12 Plaintiff was a news station that broadcast programming on television. Plaintiff alleged  
13 that defendant infringed its copyrights by videotaping the news broadcasts, and selling clips to  
14 individuals shown in the different segments of the news broadcasts. The district court held after a  
15 bench trial that the defendant had infringed plaintiff's copyrighted material and that defendant's  
16 use did not qualify as "fair use." In conducting the fair use analysis, the district court considered  
17 the entire work to be the segments of the broadcast that were copied, and not the entire newscast.  
18 The Second Circuit affirmed both the district court's determination that the segments were works  
19 as a whole, and the finding of copyright infringement. *Pac. & S. Co., Inc.*, 744 F.2d at 1496-97.

20 **2. *American Geophysical Union v. Texaco Inc.,***  
21 **60 F.3d 913 (2d Cir. 1994).**

22 The plaintiff, American Geophysical Union, along with 82 other publishers of scientific  
23 and technical journals brought a class action claiming that Texaco's unauthorized photocopying  
24 of articles from their journals was copyright infringement. *Am. Geophysical Union v. Texaco*  
25 *Inc.*, 60 F.3d at 914. The parties agreed to try fair use in a bench trial.

26 American Geophysical Union published a periodical entitled the Journal of Catalysis.  
27 Each issue of the journal contained between 20 and 25 articles. The district court ruled that "the  
28 photocopying of eight articles from the Journal of Catalysis for use by one of Texaco's  
researchers was not fair use." *Id.*

1 On appeal the defendant argued that the copyrighted journal should be considered the  
2 work as a whole for the purpose of the third factor of the fair use analysis. The Second Circuit  
3 rejected that argument, holding that “Texaco copied [] entire works” by copying individual  
4 articles within the journal. 60 F.3d at 926. On that basis, the Second Circuit agreed with the  
5 district court that defendants could not carry their burden in proving fair use.

6 **II. THE 37 API PACKAGES, TAKEN INDIVIDUALLY AND AS A UNIT,**  
7 **COMPRISE THE WORKS AS A WHOLE FOR PURPOSES OF**  
8 **COMPARISON TO THE INFRINGING PRODUCT.**

9 The copyrighted works at issue are the APIs for the 37 packages and their associated class  
10 libraries (and their associated source code) and the 11 individual computer program code files.  
11 Those works were encompassed within the copyright registration for J2SE 5.0 and J2SE 1.4, and  
12 also in various earlier registrations identified in the registrations for J2SE 5.0 and J2SE 1.4.

13 Google argues that the entire Java platform is necessarily the “work as a whole” because  
14 that is what was registered with the Copyright Office. Courts have soundly rejected that  
15 argument.. As explained in *Los Angeles Times v. Free Republic, supra*:

16 Defendants contend that plaintiffs' “work” is the entire daily newspaper because  
17 their copyright registration covers the paper as a whole rather than any particular  
18 article. Thus, they assert, copying an individual article constitutes reproduction of  
19 only a small portion of the entire work. This proposition is not supported by the  
20 case law. See [Texaco, supra, 60 F.3d at 925-26](#) (copying an entire article from a  
21 journal where the copyright registration covered the journal as a whole constituted  
22 a copying of the entire work); [Hustler Magazine, supra, 796 F.2d at 1155](#) (finding  
23 that “[a] creative work does not deserve less copyright protection just because it is  
24 part of a composite work” and holding that the copying of a one-page parody from  
25 a 154-page magazine constituted a copying of the entire work); [Netcom On-Line  
26 II, supra, 923 F.Supp. at 1247](#) (“although many of Hubbard's lectures, policy  
27 statements, and course packets are collected into larger volumes, and registered as  
28 a whole, they may still constitute separate works for the purposes of this factor”);  
[Lerma, supra, 1996 WL 633131 at \\*9](#) (“we find that the Works at issue in this case  
are combined in ‘collections’ and that each subpart must be considered a ‘single  
work’ for the purposes of fair use analysis”).

1999 WL 33644483, at \*19; *see also* 37 C.F.R. 202.3(b)(4)(i)(A); *Am. Geophysical Union v.*  
*Texaco Inc.*, 802 F. Supp. at 17 (holding that each article within a journal was protected by a  
copyright even though the publisher chose to register only each issue of the journal with the  
Copyright Office); *Religious Tech. Ctr.*, 1996 U.S. Dist. LEXIS 15454, at \*27 (E.D.Va. Oct. 4,  
1996) (“[a]lthough Lerma did not post the entirety of [the materials registered with the Copyright

1 Office], he did post the entirety of certain discrete subparts of these series. Under the Code of  
2 Federal Regulations and under case law, these subparts constitute single works and are the  
3 benchmark against which to compare Lerma's actions.") Thus each of the 37 API packages  
4 stands as a "work as a whole" entitled to copyright protection.

5 Each individual API package can be considered a work as a whole. The evidence at trial  
6 established that they have been individually developed over a long period of time through a  
7 formal process. (RT at 624:3-627:17 (Reinhold).) The 37 API packages as a unit also constitute  
8 a work as a whole for purposes of copyright protection. Google has argued that the 37 API  
9 packages it copied form a natural subset of the total number of Java API packages, and Google's  
10 testimony supports grouping the 37 API packages together as a "work as a whole" for the  
11 purposes of the fair use analysis. Specifically, Google has introduced evidence that these 37 API  
12 packages are the core API packages to running Java on a smartphone platform. As Google's  
13 engineer Dan Bornstein testified on April 25, 2012:

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15  
16 **Q.** Did Android implement all the API packages present in any particular Java  
Platform?

17 **A.** No.

18 **Q.** All right. And why not?

19 **A.** That wasn't a goal of the project. The goal of the project was to provide  
20 something that was familiar to developers. It wasn't to provide any particular  
preexisting set of packages.

21 **Q.** Did you make any judgments in deciding what packages would be implemented  
22 in the core library based on whether or not certain APIs are even appropriate for a  
mobile platform?

23 **A.** Yeah, absolutely.

24 **Q.** And, please, explain what you mean by that?

25 **A.** Well, if you look at the -- say, the universe of packages that have been made for  
26 the Java language in general, some of them just don't really apply in -- or, you  
27 know, didn't apply in the case of what we were doing with Android. And you can  
remember that, again, the point was to be a good mobile platform and there are  
28 certain constraints that that makes. You know, you can assume that the thing that  
you're running on is running on a battery, and that's -- that's a particular limitation.

1 You can know that there's going to be less memory available than, say, on a  
2 desktop or a server. You'll know that, say, the typical CPU speed is going to be  
3 slower than you would find on a -- you know, on a desktop or server. And you'll  
4 also know that -- just the sorts of things that you would do as a mobile application  
5 are going to be different than the things that you would do if you're, say, sitting in  
6 a data center running a web server, for example. It's just -- there's different -- there  
7 are different needs. And so to the extent that some of those needs are represented  
8 in potential Java packages, those are Java packages that we wouldn't necessarily --  
9 you know, or, we wouldn't really want to -- to have an implementation for,  
10 especially in that it takes -- implementation takes up space and, you know, storage  
11 space on a mobile device an also limited.

12 **Q.** So did you, in fact, exclude from the API packages in the core library certain  
13 Java language APIs because you believed they were not appropriate for the mobile  
14 platform?

15 **A.** That's right.

16 (RT at 1783:15-1785:4 (April 25, 2012).)

17 Regardless of how the Court ultimately defines the “work as a whole,” in determining  
18 whether Google’s use of the 37 Java API packages constitutes “fair use,” the jury must consider  
19 the amount and substantiality of the portion used in relation to the copyrighted work as a whole.  
20 *Harper & Row*, 471 U.S. 539, 564 (1984). Thus, in addition to instructing the jury about the  
21 appropriate scope of the “work as a whole,” the Court should also instruct the jury that in  
22 determining whether or not the portion used was substantial (the quantitative analysis), the jury  
23 should conduct a qualitative analysis. Whether or not a use of the work is *quantitatively*  
24 substantial, it may nonetheless be *qualitatively* substantial if the infringer takes the parts of the  
25 work that are among the best or most important, as Google admits it has done here. *See e.g.*,  
26 *Harper & Row*, 471 U.S. at 610 (300 words out of a book was not insubstantial when they were  
27 “among the most powerful” in the book.); *Roy Export Co. Establishment etc. v. CBS*, 503 F.  
28 Supp. 1137, 1144 (S.D.N.Y. 1980) (holding that snippets of Charlie Chaplin films, even as small  
as fifty-five seconds out of an one hour and twenty-nine minute film, could nonetheless be  
considered qualitatively substantial, when the material was chosen because it was among the best  
in the film.) Google’s testimony establishes that its copying of the 37 Java API packages cannot  
be fair use, regardless of its quantitative significance in relation to the work as a whole

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Dated: April 25, 2012

MORRISON & FOERSTER LLP

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Michael A. Jacobs

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