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16
17 UNITED STATES DISTRICT COURT
18 NORTHERN DISTRICT OF CALIFORNIA
19 SAN FRANCISCO DIVISION

20 ORACLE AMERICA, INC.,

21 Plaintiff,

22 v.

23 GOOGLE INC.,

24 Defendant.

Case No. 3:10-CV-03561-WHA

**GOOGLE'S OPENING COPYRIGHT
LIABILITY TRIAL BRIEF**

Judge: Hon. William Alsup

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1 **I. INTRODUCTION**

2 The Android platform includes over 150 source code libraries¹ for use by Android
 3 developers. Among those libraries are ones that implement the specifications for over 50 Java
 4 API packages that facilitate the use of the freely available Java programming language to write
 5 applications. These Java API packages were originally developed by Sun and/or third parties,
 6 and have been public for many years. They are well-known to and commonly used by
 7 application developers, and have in the past been independently implemented and publicly
 8 distributed by third parties. Like the other independent implementations, the Android API
 9 libraries—37 of which are at issue in Oracle’s copyright claim—utilize the functional elements
 10 of the API specifications (including the names, structure and organization of elements of the
 11 APIs), coupled with implementing source code independently developed by Google or based on
 12 existing, open-source independent implementations. The purpose of the API implementations in
 13 Android is to facilitate the use of the freely available Java programming language, consistent
 14 with application developers’ expectations and enabling code written by third-party developers to
 15 be compatible between Android and other Java programming language environments.

16 **II. BRIEF SUMMARY OF REMAINING COPYRIGHT CLAIMS AND ISSUES**

17 Oracle alleges that Android infringes versions 1.4 and 5.0 of the Java 2 Standard Edition
 18 platform (collectively, “J2SE”). Am. Compl. [Dkt. 36], Ex. H. Oracle asks that the jury address
 19 three forms of alleged copyright infringement:

- 20 (1) Oracle claims that the Android specifications infringe the specifications of 37
 21 Java API packages—that is, the documentation that describes the selection,
 22 arrangement and structure of the API elements, and the narrative descriptions
 23 that explain how the APIs can be used and what they do (the “Specifications
 24 Claims”).
 25 (2) Oracle claims that the source code implementation of the Android core
 26 libraries is a derivative work of the Oracle specifications (the “Derivative
 27 Work Claims”).
 28 (3) Oracle claims that 12 Android files—out of over 50,000 files in Android—
 include code or comments taken from 11 Oracle files (the “File Claims”).

See Oracle’s Proposed Verdict Form [Dkt. 531-1], Question 1.a-c.²

¹ “Libraries” can also be referred to as “packages.” The terms have the same meaning.

² Oracle refers to “[c]opying 12 Java software code files.” *Id.* But two of the Android files

1 Google contends that the selection, arrangement and structure of the API elements are not
2 copyrightable, for several reasons. First, the selection, arrangement and structure are
3 uncopyrightable ideas, processes, systems or methods of operation. Second, the selection,
4 arrangement and structure are functional requirements for compatibility, and thus not
5 protectable. Third, the selection, arrangement and structure are unprotectable *scenes a faire*,
6 and/or their expression has merged into unprotected underlying ideas. Even if they are
7 copyrightable, Google contends that any similarities arising from use of any protectable elements
8 either are not substantial and are therefore noninfringing, or are a fair use.

9 Google contends that the File Claims are moot, because Oracle is entitled to neither
10 damages nor injunctive relief in connection with these claims. To the extent that the File Claims
11 are not moot, Google contends any alleged copying is *de minimis*, and thus not actionable.

12 Finally, Google contends that Oracle's copyright claims are barred by the equitable
13 doctrines of laches, estoppel, waiver and implied license.

14 **III. THE SPECIFICATIONS CLAIMS**

15 In support of the Specifications Claims, Oracle argues (1) that the selection, arrangement
16 and structure of the API elements are copyrightable—separate and apart from the code that
17 *implements* the APIs—and that for the 37 API packages at issue, the Android specifications use
18 substantially the same selection, arrangement and structure as the J2SE specifications; and (2)
19 that the narrative descriptions in the Android specifications for the APIs are substantially similar
20 to the narrative descriptions in Oracle's specifications for J2SE.

21 **A. The Court must decide whether the selection, arrangement and structure of 22 the API elements are copyrightable, including any subsidiary fact questions.**

23 The Court has already held that the *names* of the API elements are not copyrightable.
24 Copyright MSJ Order [Dkt. 433] at 7-8 (“Because names and other short phrases are not subject
25 to copyright, the names of the various items appearing in the disputed API package
26 specifications are not protected.”). Moreover, aside from the File Claims, which are discussed
27 separately below, Oracle does not claim that any of the Android source code that *implements* the
28 allegedly copied the same nine lines from a single Oracle file. Thus, although there are 12
allegedly infringing files, there are only 11 files from which material was allegedly copied.

1 APIs was copied. Finally, Oracle does not claim copyright protection for the Java programming
2 language itself. *See id.* at 3 (“The Java programming language has been made freely available
3 for use by anyone without charge. Both sides agree on this.”).

4 Oracle nonetheless argues that Google has copied the selection, arrangement and
5 structure of API elements from the J2SE specifications. There is no dispute that the Android
6 specifications for the 37 API packages at issue have substantially the same selection,
7 arrangement and structure of API elements as the J2SE specifications. The parties disagree
8 whether this selection, arrangement and structure is protected by copyright.

9 Copyrightability is a question of law. The Ninth Circuit has held that “[u]sing analytic
10 dissection . . . *the court* must determine whether any of the allegedly similar features are
11 protected by copyright.” *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1443 (9th Cir.
12 1994) (emphasis added).³

13 The Court must resolve any factual issues relevant to copyrightability; there are no
14 subsidiary fact issues for the jury. *Lotus Dev. Corp. v. Borland Int’l, Inc.*, 788 F. Supp. 78, 96
15 (D. Mass. 1992) (“issues of copyrightability, *including any fact questions bearing upon them*,
16 must be determined by the court, not the jury.” (emphasis added)). As Judge Easterbrook has
17 explained, “[a] jury has nothing to do with” the copyrightability determination. *Pivot Point,*
18 *Int’l, Inc. v. Charlene Prods., Inc.*, 932 F. Supp. 220, 225 (N.D. Ill. 1996).⁴

19 Indeed, there is no practicable way for the jury to decide any subsidiary fact issues. The
20 issue of copyrightability must be decided before the jury deliberates, so that the Court can

21
22 ³ *See also Jonathan Browning, Inc. v. Venetian Casino Resort LLC*, No. C 07-03983 JSW, 2009
U.S. Dist. LEXIS 57525, at *2 (N.D. Cal. June 18, 2009) (“Determinations of copyrightability
are indeed questions of law reserved for the judge, and not the jury.”).

23 ⁴ Oracle has suggested that there are “threshold factual determinations” for the jury. *See*
24 10/27/11 Jacobs Ltr. [Dkt. 566] at 3 (citing 3 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER
ON COPYRIGHT § 12.10[B][1], which cites *Montgomery v. Noga*, 168 F.3d 1282, 1291 n.14 (11th
25 Cir. 1999)). Oracle is incorrect. Although there was a jury trial in *Montgomery*, *see* 168 F.3d at
26 1286, the Eleventh Circuit explained that as to copyrightability it was reviewing a factual finding
by *the district court*, and made no reference to any subsidiary fact findings by the jury. *Id.* at
27 1291 n.14. The court expressly noted that it was reviewing the district court’s factual findings
for clear error, *id.*, which is the standard of review applicable to findings by a *court*, not a jury.
28 Thus, while the question of *infringement* was of course submitted to the jury, the threshold legal
question of copyrightability was decided by the district court, without the jury being asked to
make any subsidiary findings of fact.

1 instruct the jury what elements should be considered when deciding whether there was
 2 infringement.⁵ If there were threshold facts for the jury to decide prior to a copyrightability
 3 determination, the jury would first have to deliberate and decide those factual issues, the Court
 4 would then have to decide copyrightability and instruct the jury thereon, and the jury would
 5 thereafter have to continue its deliberations. Google is aware of no case where any court has
 6 ever adopted such a convoluted procedure for a copyright trial.⁶

7 Different courts have applied different doctrines to conclude that software interfaces are
 8 not copyrightable. While the doctrines relied upon by these courts have varied—with some
 9 concluding that the interfaces are unprotectable methods of operation or otherwise excluded by
 10 17 U.S.C. § 102(b), others that the interfaces are unprotected *scenes a faire*, and others that any
 11 expression has merged with the underlying ideas—the end result has been the same. And the
 12 principles relevant to the inquiry are often the same, regardless of which doctrine is invoked.

13 **1. The APIs and the selection, arrangement and structure of the API**
 14 **elements are uncopyrightable under 17 U.S.C. § 102(b).**

15 The Court must first decide whether the selection, arrangement and structure of the API
 16 elements are copyrightable subject matter. The Copyright Act states:

17 In no case does copyright protection for an original work of authorship extend to
 18 any *idea*, procedure, *process*, *system*, *method of operation*, concept, principle, or
 19 discovery, regardless of the form in which it is described, explained, illustrated, or
 20 embodied in such work.

21 17 U.S.C. § 102(b) (emphasis added). In the order on Google’s copyright motion for summary
 22 judgment, the Court held that the API package *specifications* are not methods of operation.

23 ⁵ *Harper House, Inc. v. Thomas Nelson, Inc.*, 889 F.2d 197, 207-08 (9th Cir. 1989) (“Given the
 24 extremely limited protection that Harper House’s organizers receive, the jury instructions
 25 covering copyright infringement liability did not adequately distinguish between protectable and
 26 unprotectable material. . . . We hold that, viewing the jury instructions as a whole, the trial
 27 court’s instructions on copyrightability were not adequate to ensure that the jury fully understood
 28 the issues, and therefore constituted error requiring a new trial on the liability and damages phase
 of the infringement claim.”).

⁶ Notably, Oracle’s proposed verdict form does not ask the jury to decide any factual questions
 on which the issue of copyrightability supposedly depends. *See* Dkt. 531-1. Instead, in its
 proposed jury instructions, Oracle states that “upon the close of evidence, the Court should
 instruct the jury as to which works are protected by copyright” Joint Proposed Jury
 Instructions [Dkt. 539] at 54. Thus Oracle proposes that the Court decide copyrightability
 without first having the jury make any threshold factual determinations.

1 Copyright MSJ Order [Dkt. 433] at 11.

2 The Court, however, expressly left open whether the APIs described in the specifications
3 are methods of operation. *Id.* at 10 (“Because the issue is not properly teed up for summary
4 judgment, this order does not decide whether APIs are methods of operation.”). “[T]he party
5 claiming infringement may place no reliance upon any similarity in expression resulting from
6 unprotectable elements.” *Apple*, 35 F.3d at 1446 (quotation marks and citation omitted). Thus,
7 even if the *specifications* are not methods of operation, Oracle cannot rely on any similarity
8 between Android and J2SE that results from any *elements* of the specifications (such as the APIs,
9 and the selection, arrangement and organization of the elements of the APIs) that are methods of
10 operation (or ideas, processes or systems).

11 The API package specifications at issue provide access to standard Java language
12 libraries that programmers learn to use when they learn to program in the Java programming
13 language. The APIs themselves, which are described in the API package specifications, are the
14 means by which developers can access the implementing code in the Java language libraries.
15 They provide, in a very literal sense, the methods for operating the libraries. In the words of
16 Oracle’s expert, Dr. Mitchell, “an API consists of a set of names that can be used to access
17 features of the library, together with specified conventions about their use,” and an “API
18 specification . . . describes a set of rules that the code implementing the library must follow.”
19 Mitchell Copyright Opening Report [Dkt. 341-1] ¶¶ 52, 175. The APIs (including the individual
20 elements of the APIs) are thus uncopyrightable methods of operation. *See Lotus Development*
21 *Corp. v. Borland Int’l, Inc.*, 49 F.3d 807, 815-16 (1st Cir. 1995), *aff’d by an evenly divided court*,
22 516 U.S. 233 (1996) (“We hold that the Lotus menu command hierarchy is an uncopyrightable
23 ‘method of operation.’ The Lotus menu command hierarchy provides the *means by which users*
24 *control and operate* Lotus 1-2-3.” (emphasis added)).

25 The Court has asked “whether or not the copyrightability of the selection, arrangement,
26 and structure of the APIs depend on the underlying programming language being Java as
27 opposed to Python or QBASIC or other non-Java programming language.” Order Requesting
28 Discussion in Copyright Briefs [Dkt. 754] at 1. It does not. In offering the opinions quoted

1 above, Dr. Mitchell was explaining what APIs are *generally*, and did not limit his description to
2 the Java language APIs. Similarly, in *Lotus*, which did not involve the Java language, “Borland
3 did not copy any of Lotus’s underlying computer code; it copied only the words and structure of
4 Lotus’s menu command hierarchy.” 49 F.3d at 810. “As the Lotus menu command hierarchy
5 *serves as the basis for Lotus 1-2-3 macros*, the Lotus menu command hierarchy is a ‘method of
6 operation.’” *Id.* at 818 (emphasis added). As with the unprotectable Lotus menu hierarchy
7 (which functioned as an API for a macro programming language), APIs in any programming
8 language serve as the means for accessing and controlling the code in the associated libraries.

9 The Ninth Circuit has held that 17 U.S.C. § 102(b) precludes copyright protection for
10 “functional requirements for compatibility.” *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510,
11 1522 (9th Cir. 1992) (citing 17 U.S.C. § 102(b)).⁷ The selection, arrangement and structure upon
12 which Oracle relies to prove infringement are functional requirements for compatibility with
13 code that uses the Java language APIs. Even according to Oracle’s expert, in order to be
14 compatible with the 37 Oracle API package specifications at issue, Google had to ensure that the
15 Android libraries that implemented those specifications used the same “set of names” and the
16 same “specified conventions” for their use, and that the packages followed the “set of rules”
17 described in the specifications. Mitchell Copyright Opening Report [Dkt. 341-1] ¶¶ 52, 175.
18 Oracle’s expert thus confirmed that the APIs at issue—and, necessarily, the selection,
19 arrangement and structure of the API elements described in the API specifications—are excluded
20 from copyright protection by 17 U.S.C. § 102(b).

21 Because *all* API specifications, by design, describe precisely the elements of APIs that
22 are needed for compatibility between implementations of the APIs, and with programs that use
23 the APIs, *Sega* applies to APIs regardless of the programming language. As Oracle’s expert has
24

25 ⁷ *Sega* is a fair use decision, but its analysis of section 102(b) is not limited to that context. The
26 Ninth Circuit held that Accolade’s copying and disassembly of Sega object code was a fair use,
27 because the “disassembly [was] the only means of gaining access to . . . unprotected aspects of
28 the program” *Id.* at 1520. The reason the Ninth Circuit so held was because it agreed with
Accolade that the disassembly of Sega’s code was “necessary in order to gain access to the ideas
and functional concepts embodied in the code, which are not protected by copyright.” *Id.* at
1519. The *Sega* court’s ultimate finding of fair use depended on the predicate legal principle that
section 102(b) precludes copyright protection for functional requirements for compatibility.

1 explained, APIs provide the “rules” that must be followed when implementing the specifications.
2 Thus, because functional requirements for compatibility are not copyrightable, *Sega*, 977 F.2d at
3 1522, APIs are not copyrightable, regardless of the programming language.

4 Google does not believe there are any facts material to copyrightability that truly can be
5 disputed. To the extent that the Court must resolve any subsidiary fact questions to decide
6 whether the APIs are copyrightable subject matter, however, Oracle bears the burden of proof. A
7 copyright plaintiff “must show that he or she owns the copyright and that defendant copied
8 *protected* elements of the work.” *Jada Toys, Inc. v. Mattel, Inc.*, 518 F.3d 628, 636 (9th Cir.
9 2008) (quotation marks and citation omitted, and emphasis added). Because Oracle bears the
10 burden of proving that protected elements were copied, it necessarily bears the burden of proving
11 the elements are copyrightable and thus protected.

12 **2. Alternatively, the selection, arrangement and structure of the APIs**
13 **are unprotected *scenes a faire*.**

14 “Under the *scenes a faire* doctrine, when certain commonplace expressions are
15 indispensable and naturally associated with the treatment of a given idea, those expressions are
16 treated like ideas and therefore not protected by copyright.” *Swirsky v. Carey*, 376 F.3d 841, 850
17 (9th Cir. 2004). In the computer context, this includes situations where

18 a programmer’s freedom of design choice is . . . circumscribed by extrinsic
19 considerations such as (1) the mechanical specifications of the computer on which
20 a particular program is intended to run; (2) *compatibility requirements of other*
21 *programs with which a program is designed to operate in conjunction*;
22 (3) computer manufacturers’ design standards; (4) *demands of the industry being*
23 *serviced*; and (5) *widely accepted programming practices within the computer*
24 *industry*.

25 *Computer Assocs. Int’l, Inc. v. Altai*, 982 F.2d 693, 709-10 (2d Cir. 1992) (emphasis added).

26 Here, Google had to use the same selection, arrangement and structure of API elements in
27 the 37 API package specifications to ensure compatibility with the APIs described in those
28 specifications (*Computer Assocs.* point 2); to meet demands of the Java language programming
community (*Computer Assocs.* point 4); and to comply with accepted Java language
programming practices (*Computer Assocs.* point 5).

Oracle’s expert essentially concedes these points. As discussed above, he has opined that

1 the specifications provide the “rules” that implementations of those specifications “must” follow.
2 And although Dr. Mitchell argues that Google did not *need* to implement the APIs, he does not
3 dispute that Java language programmers *expect* to be able to use the APIs, and that it is *accepted*
4 *practice* to use the APIs when programming in the Java language. Indeed, Dr. Mitchell claims
5 that if Google had not adopted the Java APIs, it would have “went to market with an unfamiliar
6 application development environment” Mitchell Copyright Opp. Report [Dkt. 341-2] ¶ 60.
7 Dr. Mitchell even suggests that Java programmers “may want and expect” Java APIs *in addition*
8 to the ones that Google implemented. *Id.* ¶ 107. Industry demand and accepted programming
9 practices are also evidenced by the fact that two other major independent and open source Java
10 library implementations (Apache Harmony and GNU Classpath) include implementations of all
11 37 of the API package specifications at issue, and have done so openly for years.⁸

12 But according to Oracle, the constraints that Google faced when designing Android are
13 irrelevant. Oracle urges the Court to look only at the constraints Sun may have faced at the time
14 the APIs were designed. Copyright MSJ Opp. [Dkt. 339] at 16 (citing *Control Data Sys., Inc. v.*
15 *Infoware, Inc.*, 903 F. Supp. 1316, 1323 (D. Minn. 1995)). The Ninth Circuit, however, has held
16 that when “specific [computer] instructions, *even though previously copyrighted*, are the only
17 and essential means of accomplishing a given task, their later use by another will not amount to
18 infringement.” *Sega*, 977 F.2d at 1524 (quotation marks and citation omitted, and emphasis
19 added). While the Ninth Circuit did not specifically identify the legal doctrine on which it was
20 relying, the result is that APIs are not copyrightable.⁹

21 Similarly, in *Baystate Techs. v. Bentley Sys.*, the court explained that “[u]nder the *scenes*
22 *a faire* doctrine, protection is denied to those elements of a program that have been dictated by
23 external factors.” 946 F. Supp. 1079, 1088 (D. Mass. 1996) (citing *Gates Rubber Co. v. Bando*

24 _____
25 ⁸ At trial, Jonathan Schwartz, who was Sun’s CEO when Android was being developed and
26 when it was released, will testify that he was well aware of the Apache Harmony and GNU
27 Classpath API implementations, that Sun never objected to those implementations, and that he
28 believed that widespread use of the APIs was good for Sun.

⁹ See also PAUL GOLDSTEIN, GOLDSTEIN ON COPYRIGHT § 2.3.2.1 (3d ed. 2011) (in the Ninth
Circuit, “it is the range of expressive choice *that existed at the time the competing product was*
created—not the range of expression that existed at the time the copyrighted work was created—
that controls” (emphasis added)).

1 *Chemical Industries, Ltd.*, 9 F.3d 823, 838 (10th Cir. 1993)). The *Baystate* court concluded that
 2 the selection and organization that the defendant had copied was dictated by external factors:

3 The product being developed is a data translator that is designed to “read” the data
 4 files of CADKEY. The process of “reading” the CADKEY data files requires that
 5 the elements contained within the data structures of the Translator be organized in
 6 the same manner as the elements in the data structures of CADKEY. Without
 7 such compatibility, the Translator would not function because it would “misread”
 8 the CADKEY data files.

9 946 F. Supp. at 1088. That the *plaintiff* could have chosen a different selection and organization
 10 for the elements of the CADKEY data files did not keep the district court from concluding that
 11 the *scenes a faire* doctrine precluded copyrightability. *See id.*

12 These principles apply to any set of APIs that is considered standard by that language’s
 13 developer community. Such APIs are unprotectable *scenes a faire* because, regardless of the
 14 language, the APIs represent standard tools learned and then used by that particular developer
 15 community. *See Sega*, 977 F.2d at 1524; *Computer Assocs.*, 982 F.2d at 709-10.

16 Finally, although Google has the burden of raising the doctrine of *scenes a faire*, *Sega*
 17 demonstrates that Oracle has the ultimate burden of persuasion. In *Sega*, the Ninth Circuit held
 18 there was no infringement by relying on the absence of evidence showing alternatives to the
 19 defendant’s copying of a twenty to twenty-five byte segment of the plaintiff’s software. 977
 20 F.2d at 1524 n.7. If the defendant had the burden of proof, that lack of evidence could not have
 21 cut against the plaintiff’s position. Implicitly, then, the Ninth Circuit held that the plaintiff has
 22 the burden of proof. This is consistent with the court’s statement, in *Jada Toys*, that the plaintiff
 23 has the burden of proving that *protected* elements have been copied. 518 F.3d at 636.

24 **3. Alternatively, any expression in the selection, arrangement and
 25 structure of the APIs has merged with the underlying ideas.**

26 The merger doctrine is closely related to the doctrine of *scenes a faire*. When an idea
 27 “can only be expressed in so many ways,” the expression has “merged” with the idea. *Apple*, 35
 28 F.3d at 1444. In such a situation, “even verbatim reproduction of a factual work may not
 constitute infringement.” *Allen v. Academic Games League of Am., Inc.*, 89 F.3d 614, 617-18
 (9th Cir. 1996).¹⁰

¹⁰ *See also Computer Assocs.*, 982 F.2d at 707 (in analyzing computer programs, “expression

1 In *Allen*, the Ninth Circuit noted that the doctrine of merger is “particularly applicable
2 with respect to games” because they “consist of abstract rules and play ideas.” 89 F.3d at 617-18
3 (quotation marks and citation omitted). The same principle applies here, where the Court has
4 already noted that an API is “the abstract concept of an interface between programs.” Copyright
5 MSJ Order [Dkt. 433] at 10. “In order not to confer a monopoly of the idea upon the copyright
6 owner, such expression should not be protected.” *Computer Assocs.*, 982 F.2d at 708 (citing
7 *Herbert Rosenthal Jewelry Corp. v. Kalpakian*, 446 F.2d 738, 742 (9th Cir. 1971)).

8 The *Allen* court held that the plaintiff had “not shown that it is possible to distinguish the
9 expression of the rules of his game manuals from the idea of the rules themselves.” 89 F.3d at
10 618. Here, the selection, arrangement and structure of the APIs are, according to Oracle’s own
11 expert, “rules” that must be followed by implementing libraries. Mitchell Copyright Opening
12 Report [Dkt. 341-1] ¶¶ 52, 175. This result does not depend on the Java programming language
13 in particular, but is true for APIs generally.

14 And, as with *scenes a faire*, Oracle bears the burden of persuasion. In *Allen*, the Ninth
15 Circuit affirmed the district court’s grant of summary judgment because “Allen has not shown
16 that it is possible to distinguish the expression of the rules of his game manuals from the idea of
17 the rules themselves.” 89 F.3d at 618. A mere failure of proof would not support summary
18 judgment for the defendant unless the plaintiff had the burden of proof.

19 **B. The Court must decide whether the standard of substantial similarity or**
20 **virtual identity applies to Oracle’s Specifications Claims.**

21 Choosing between the substantial similarity and virtual identity standards is an issue for
22 the Court. *See Apple*, 35 F.3d at 1443 (“Depending on the degree of protection, the court must
23 set the appropriate standard for a subjective comparison of the works to determine whether, as a
24 whole, they are sufficiently similar to support a finding of illicit copying.”). If the Court
25 concludes that the range of protectable expression is narrow, the standard for copying is not just
26 substantial similarity but virtual identity. *See id.* at 1446; *see also Satava v. Lowry*, 323 F.3d
27 necessarily incidental to the idea being expressed” is unprotectable); *Gates Rubber*, 9 F.3d at
28 836-38 (software that is “inseparable from or merged with the ideas, processes, or discoveries
underlying the expression” is unprotectable to avoid “unwittingly grant[ing] protection to an idea
by granting exclusive rights to the only, or one of only a few, means of expressing that idea.”).

1 805, 812 (9th Cir. 2003) (“Satava possesses a thin copyright that protects against only virtually
 2 identical copying.”); *Ets-Hokin v. Skyy Spirits, Inc.*, 323 F.3d 763, 766 (9th Cir. 2003) (“When
 3 we apply the limiting doctrines, subtracting the unoriginal elements, Ets-Hokin is left with only a
 4 ‘thin’ copyright, which protects against only virtually identical copying.”).

5 Once the Court resolves the copyrightability issue, Google believes that it will be entitled
 6 to a judgment as a matter of law of noninfringement.¹¹ If, however, the Court concludes that the
 7 infringement question should be sent to the jury, Google believes that the virtual identity
 8 standard should apply. Whichever standard applies, Oracle bears the burden of proof. *E.g.*,
 9 *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1472 (9th Cir. 1992).

10 **C. To the extent there are material disputed facts, the jury must decide whether**
 11 **Google’s use is a fair use.**

12 Although fair use can be decided by the Court if the relevant facts are undisputed, *see*,
 13 *e.g.*, *Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 817-22 (9th Cir. 2003), fair use is a jury issue
 14 where there are material disputes of fact. The Copyright Act lists several non-exhaustive factors
 15 to be considered in determining whether a use is fair: “(1) the purpose and character of the use,
 16 including whether such use is of a commercial nature or is for non-profit educational purposes;
 17 (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in
 18 relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential
 19 market for or value of the copyrighted work.” 17 U.S.C. § 107.

20 “The four factors are to be considered together in light of the purposes of copyright, not
 21 in isolation.” *Sony v. Bleem*, 214 F.3d 1022, 1026 (9th Cir. 2000) (citation omitted). Copyright’s
 22 “very purpose” is “[t]o promote the Progress of Science and useful Arts. . . .” *Campbell v.*
 23 *Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (quoting U.S. Const., Art. I, § 8, cl. 8).

24 With respect to the first factor, the Supreme Court has explained that

25 The central purpose of the investigation is to see, in Justice Story’s words,
 26 whether the new work merely “supersede[s] the objects” of the original creation,
 or instead adds something new, with a further purpose or different character,

27 ¹¹ If the Court concludes the selection, arrangement and structure of the API elements is not
 28 copyrightable, Oracle may still argue that the narrative descriptions in the Android specifications
 infringe. Google, however, believes that no reasonable jury could find infringement on that
 basis, and that it therefore will be entitled to judgment as a matter of law.

1 altering the first with new expression, meaning, or message; it asks, in other
2 words, whether and to what extent the new work is “transformative.”

3 *Campbell*, 510 U.S. at 579 (citations omitted).

4 According to the Ninth Circuit,

5 The second statutory factor, the nature of the copyrighted work, reflects the fact
6 that not all copyrighted works are entitled to the same level of protection. The
7 protection established by the Copyright Act for original works of authorship does
8 not extend to the ideas underlying a work or to the functional or factual aspects of
9 the work. 17 U.S.C. § 102(b). To the extent that a work is functional or factual, it
10 may be copied, *Baker v. Selden*, 101 U.S. (11 Otto) 99, 102-04, 25 L.Ed. 841 (1879),
11 as may those expressive elements of the work that “must necessarily be used as
12 incident to” expression of the underlying ideas, functional concepts, or facts, *id.* at
13 104. Works of fiction receive greater protection than . . . works that have strong
14 functional elements, such as accounting textbooks, *Baker*, 101 U.S. at 104.

15 *Sega*, 977 F.2d at 1524.

16 With respect to the third factor, “[i]f the secondary user only copies as much as is
17 necessary for his or her intended use, then this factor will not weigh against him or her.” *Kelly v.*
18 *Arriba Soft Corp.*, 336 F.3d 811, 820-21 (9th Cir. 2003).

19 Finally, although the fourth factor considers market harm, not all “harms” are cognizable.
20 In *Sony Comp. Ent’t, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000), the Ninth Circuit
21 explained, for example, that “an attempt to monopolize the market by making it impossible for
22 others to compete runs counter to the statutory purpose of promoting creative expression and
23 cannot constitute a strong equitable basis for resisting the invocation of the fair use doctrine.” *Id.*
24 at 607-08 (citing *Sega*, 977 F.2d at 1523-24). In particular, a transformative use that “does not
25 merely supplant” the original work can render the secondary user a “legitimate competitor,” in
26 which case “some economic loss . . . does not compel a finding of no fair use.” *Id.* at 607.

27 Weighing these factors together, the evidence will show that Google’s use is a fair use.
28 *See* Google’s Copyright MSJ [Dkt. 260] at 19-22; Copyright MSJ Reply [Dkt. 368] at 9-10.

29 **IV. THE DERIVATIVE WORK CLAIMS**

30 Oracle also claims that the source code implementation of the Android core libraries is a
31 derivative work, because it allegedly is “derived” from Oracle’s specifications. Oracle’s
32 argument is breathtaking. If Oracle is correct, *any* implementation of *any* API specification is a
33 derivative work, because as Oracle’s expert concedes, implementing the APIs requires following

1 the “rules” described in the specifications. Mitchell Copyright Opening Report [Dkt. 341-1]
 2 ¶¶ 52, 175. Thus, although the Ninth Circuit has held that “functional requirements for
 3 compatibility” are not copyrightable, *Sega*, 977 F.2d at 1522, following functional requirements
 4 for compatibility—according to Oracle—leads directly to infringement.

5 Regardless, material only qualifies as an unlawful derivative work if derived from
 6 material that is itself infringing.¹² Thus, if the Specifications Claims fail, then the source code
 7 implementation of the Android core libraries is not a derivative work. The legal issues relevant
 8 to the Specifications Claims are therefore also relevant to the Derivative Work Claims.

9 V. THE FILE CLAIMS

10 A. The Court should hold that the File Claims are moot.

11 The Court should hold that the File Claims are moot, and thus that there is no need to
 12 present them to the jury. As the Court has noted, Oracle’s damages expert performed no analysis
 13 of damages caused by the alleged copying of portions of the 11 Oracle files. Order re Google’s
 14 MIL No. 3 [Dkt. 685] at 10. Indeed, Oracle has never articulated any damages theory based on
 15 the File Claims. Moreover, the allegedly copied portions of these files have all been removed
 16 from Android. Thus, there is no basis or need for injunctive relief.

17 Because Oracle is entitled neither to damages nor equitable relief with respect to the File
 18 Claims, a verdict in Oracle’s favor would not redress any alleged harm arising from the File
 19 Claims. On these facts, Oracle’s File Claims are moot. *See Lujan v. Defenders of Wildlife*, 504
 20 U.S. 555, 560-61 (1992) (“the irreducible constitutional minimum of standing contains three
 21 elements,” the third of which is redressibility).

22 B. If the File Claims are not moot, the Court should determine the relevant 23 “work as a whole,” and the jury should decide whether the alleged infringement was *de minimis*.

24 If, however, the File Claims are tried, the jury will need to decide whether any alleged
 25 copying in the 12 Android files is *de minimis*. *De minimis* acts of copying are not actionable.

26 _____
 27 ¹² *Mirage Editions v. Albuquerque A.R.T. Co.*, 856 F.2d 1341, 1343 (9th Cir. 1988) (“a work will
 28 be considered a derivative work only if it would be considered an infringing work if the material
 which it has derived from a preexisting work had been taken without the consent of a copyright
 proprietor of such preexisting work”) (quotation marks and citation omitted).

1 *Newton v. Diamond*, 388 F.3d 1189, 1192-93 (9th Cir. 2004). Where the only similarity is as to
2 “nonessential matters,” the copying is *de minimis*. *See id.* at 1195 (quoting 4 NIMMER ON
3 COPYRIGHT § 13.03[A][2], at 13-48). Where a defendant copies only “a portion of the plaintiff’s
4 work exactly or nearly exactly . . . the dispositive question is whether the copying goes to trivial
5 or substantial elements.” *Id.* That substantiality is judged by “considering the qualitative and
6 quantitative significance of the copied portion in relation to the plaintiff’s work as a whole.” *Id.*
7 (emphasis added); *see also Computer Assoc.*, 982 F.2d 693 at 714-15. Oracle bears the burden
8 of proving the significance of any copied code. *MiTek Holdings, Inc. v. ArcE Eng’g Co.*, 89 F.3d
9 1548, 1560 (11th Cir. 1996) (“The burden is on the copyright owner to demonstrate the
10 significance of the copied features, and, in this case, MiTek has failed to meet that burden.”).

11 To instruct the jury, the Court will need to determine what the relevant “work as a whole”
12 is. Google contends that the relevant “work as a whole” is J2SE, the works that Oracle
13 registered with the Copyright Office. Oracle, in contrast, has previously argued that the
14 allegedly copied material in each of the 12 Android files must be compared to the individual file
15 from which the material allegedly was taken. Oracle’s Opp. to Copyright MSJ [Dkt. 339] at 23.

16 The Court has not yet decided this issue. *See Copyright MSJ Order* [Dkt. 433] at 6-7. To
17 the extent that the Court concludes that an individual Oracle code file could ever be the “work as
18 a whole” for purposes of the *de minimis* analysis, Oracle has the burden of proving, at a
19 minimum, that the individual files have “independent economic value.” *Tattoo Art, Inc. v. TAT*
20 *Int’l, LLC*, 794 F. Supp. 2d 634, 652 (E.D. Va. 2011) (quoting *Gamma Audio & Video, Inc. v.*
21 *Ean-Chea*, 11 F.3d 1106, 1117 (1st Cir. 1993), and considering what constitutes a “work” for
22 purposes of statutory damages). Google is unaware of any evidence suggesting that the
23 individual code files have any independent economic value.

24 VI. GOOGLE’S EQUITABLE DEFENSES

25 The Court should follow its inclination to “ask the jury for an advisory verdict on all
26 equitable defenses.” Final Pretrial Order [Dkt. 675] at 2. The evidence will demonstrate that
27 Oracle’s claims are barred by Google’s defenses of laches, estoppel, waiver and implied license.

28 As early as 2005, Sun was fully aware of Google’s efforts to develop the free, open

1 source, full stack Android mobile operating platform partly written in the Java programming
2 language. Despite this knowledge, Sun never said a cross word to Google when Android was
3 publicly announced in 2007 and then released in late 2008. Certainly Sun never asserted that
4 Android infringed copyright or threatened to sue over it. Sun didn't change its tune until after it
5 changed its name to Oracle America in early 2010, by which time Google and its many partners
6 in the Open Handset Alliance had invested enormous amounts of time, money and sweat in
7 building the Android platform into a commercial success.

8 By its actions and inactions, Sun conceded that Google was not infringing any Sun
9 copyright. Indeed, Sun publicly applauded Android's release as an open source platform. When
10 Google first announced Android in 2007, Sun CEO Jonathan Schwartz publicly congratulated
11 Google, and declared that "Google and the Open Handset Alliance just strapped another set of
12 rockets to the community's momentum." And Sun and Oracle have both consistently treated
13 APIs as unprotectable, both by copying and incorporating third-party APIs into their own
14 products, even to this day, and by not challenging as infringements other implementations of the
15 Java API specifications.

16 These and other similar statements by Sun establish Google's equitable defenses—each
17 premised on the fact that Sun expressly and publicly approved of Android and never suggested it
18 would sue Google. In fact, even before it completed its acquisition of Sun, Oracle applauded the
19 Android platform, announcing in 2009 at the Java One conference that it was "flattered" by
20 Android and further emphasizing that there were likely to be Android netbooks using the Java
21 programming language as a result of the efforts of "our friends at Google." Oracle cannot renege
22 on these representations, claiming entitlement to revenues associated with Android now that
23 Android is a success.

24 Dated: March 9, 2012

KEKER & VAN NEST LLP

25 /s/ Robert A. Van Nest
26 By: ROBERT A. VAN NEST

27 Attorneys for Defendant GOOGLE INC.
28