No. 18-956

In The
Supreme Court of the United States

GOOGLE LLC,

Petitioner,

v.

ORACLE AMERICA, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF OF EIGHT INTELLECTUAL PROPERTY SCHOLARS AS *AMICI CURIAE* IN SUPPORT OF PETITIONER

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INTEREST OF *AMICI CURIAE*[1]

Amici curiae are law scholars who teach and write on topics relating to intellectual property law, particularly copyright law. *Amici* have no direct interest in the outcome of this case. *Amici* are concerned that the Federal Circuit's decision below is based on an erroneous interpretation of the fair use doctrine and will have significant adverse consequences on copyright doctrine throughout the federal courts. A list of *amici* appears in Appendix A, reproduced at App. 1–2.

SUMMARY OF ARGUMENT

I. The Federal Circuit's decision below, reversing the jury's finding of fair use after a full trial on the issue, underscores the existence of multiple intra and intercircuit splits on evaluating fair use.

First, this case represents a fitting opportunity to clarify the application of the "transformative use" test of *Campbell*. When this Court articulated the "transformative use" standard twenty-five years ago, it did

[1] 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. Counsel for *amici* is a faculty co-director of the Berkman Klein Center for Internet & Society at Harvard University, which has received support from Google. Counsel for petitioner gave blanket consent to the filing of *amicus* briefs, counsel for respondent has consented in writing to the filing of this brief, and both parties received timely notice of *amici*'s intent to file this brief.

not provide clear guidelines as to how to evaluate the transformativeness of alleged infringing works. This forced lower courts to develop their own approaches, resulting in conflicting focuses and inconsistent outcomes, ranging from broad interpretations of "transformative" to outright rejections of the "transformative use" test. This Court should grant *certiorari* here to build on *Campbell* and subsequent fair use cases to devise a consistent approach to evaluating transformativeness.

Second, this Court should use this case to clarify its approach to the fair use doctrine. The Court held in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) that a fair use analysis should consider whether the use was "transformative." In so doing, it did not overrule its holding in *Harper*, which focused the fair use analysis on market impact. This has created confusion in the lower courts, and the application of the fair use standard has been highly inconsistent. Courts that followed *Harper*'s approach to fair use held on to the old, market-oriented test, while Courts that followed *Campbell* emphasized transformative use. The resulting intra and intercircuit splits have made outcomes of the fair use analysis highly unpredictable and encouraged forum shopping. This Court should grant *certiorari* here to clarify the correct standard to apply.

II. The Federal Circuit's decision below presents an opportunity for this Court to shed light on its ruling in *Harper & Row, Publrs. v. Nation Enters.*, 471 U.S. 539 (1985), which the Ninth Circuit has interpreted to require *de novo* review of fair use determinations. This

Court should address the standard of review for appellate courts to apply when reviewing jury verdicts on fair use.

ARGUMENT

This case is an ideal vehicle to resolve intra and intercircuit splits in the application of this Court's fair use doctrine. In overruling the district court's finding that Google's use of the Java API "constituted 'a fresh context giving new expression, meaning, or message to the duplicated code,'" *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1199 (Fed. Cir. 2018), the Federal Circuit created confusion by applying the fair use analysis in a way that underscores the existence of splits among the circuits regarding fair use.

I. The Federal Circuit's decision warrants review, as it exemplifies intra and intercircuit splits on the fair use defense.

A. This Court should grant *certiorari* to resolve a Circuit split on applying the "transformative use" doctrine.

This Court first articulated the "transformative use" standard in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), defining "transformation" as "altering the [copyrighted work] with new expression, meaning, or message," *Campbell*, 510 U.S. at 579. There, this Court applied this standard to hold that a parody "has an obvious claim to transformative value,"

id., but did not go further. Most importantly, it failed to elaborate on how lower courts should evaluate the transformativeness of new works in other contexts.

Without clear guidance, lower courts had to develop their own doctrines on transformativeness. In the twenty-five years since *Campbell*, courts have primarily applied the transformative use in two contexts – transformative-content and transformative-purpose. In the former, a defendant uses parts of a copyrighted work to create a new meaning, while in the latter transforms the original for a new purpose. *See* Rebecca Tushnet, *Content, Purpose, or Both*, 90 WASH. L. REV. 869, 869–70 (2015). Courts looked to the statutory preamble of 17 U.S.C. § 107 to find allowable purposes that can be applied clearly, and have successfully developed clear categories over the years. One such example is cases involving using copyrighted work in search engines, where courts have consistently held that such uses are transformative. *See*, *e.g.*, *Authors Guild v. HathiTrust*, 755 F.3d 87 (2d Cir. 2014); *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015); *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146 (9th Cir. 2007); *Kelly v. Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003).

But in content-transformation cases, circuits disagree over how to evaluate a change in content. In *Cariou v. Prince*, the Second Circuit found that changes in content were transformative for fair use purposes when they "manifest an entirely different aesthetic." *See Cariou v. Prince*, 714 F.3d 694, 705–08 (2d Cir. 2013). The Ninth Circuit built on *Cariou*'s approach

and ruled a work to be transformative, despite minimal modifications to the original. *See Seltzer v. Green Day, Inc.*, 725 F.3d 1170, 1176–78 (9th Cir. 2013). Together, these two cases represent a broad approach to content transformation. *See* Brian Sites, *Fair Use and the New Transformative*, 39 COLUM. J.L. & ARTS 513, 534–36 (2016). On the other end of the spectrum, the Seventh Circuit in *Kienitz v. Sconnie Nation LLC* criticized *Cariou*'s broad view of "transformative," arguing that it would result in a conflict with the derivative works right under 17 U.S.C. § 106(2). 766 F.3d 756, 758–59 (7th Cir. 2014).

This split manifests itself in the Federal Circuit decision. In rejecting Google's fair use defense, the Federal Circuit took a narrow view of "transformative," holding that Google's use of Oracle's API code did not constitute content-transformation. *Oracle*, 886 F.3d at 1198–1202. The Court focused on the fact that Google did not contribute creatively in its use of the Oracle code. *See Oracle*, 886 F.3d at 1200–02. Yet this goes against the numerous cases, including Ninth Circuit precedents, that do not focus on the work of the second creator. *See*, *e.g.*, *Seltzer*, 725 F.3d at 1177 ("[a work is transformative] as long as new expressive content or message is apparent . . . even where . . . the allegedly infringing work makes few physical changes to the original[.]"); *Los Angeles News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 939 (9th Cir. 2002) (overlooking the lack of changes made to the original work to find fair use), *opinion amended and superseded*, 313 F.3d 1093 (9th Cir. 2002); *Castle Rock Entm't, Inc. v. Carol Pub. Grp.,*

Inc., 150 F.3d 132, 142 (2d Cir. 1998) (quoting Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1111 (1990)) (listing several instances where "the secondary use adds value to the original" as articulated by Judge Leval, none of which evaluates the work of the second creator).

The lower courts have reached a doctrinal fork, and this Court needs to resolve it. Twenty-five years have passed since *Campbell*, and the decisions below indicate that the lower courts are still uncertain of the standard to apply in evaluating transformativeness of content. Further, these twenty-five years saw the widespread application of computer programs to all aspects of our society. Yet this Court has not ruled on the application of the fair use doctrine to the important context of computer codes. This Court should, in light of these developments, grant *certiorari* to build on *Campbell*, and guide the lower courts in drawing the line on the relationship between transforming the content of a work and transformative fair use.

B. This Court should grant *certiorari* to resolve *Harper*'s market-oriented approach and *Campbell*'s "transformative use" test.

The Copyright Act's statutory fair use scheme – embodied in 17 U.S.C. § 107 – sets forth a non-exhaustive list of four factors to be considered when assessing fair use. But, it includes no explicit instructions on the relative weight of factors. *See Sony Corp. of Am. v.*

Universal City Studios, Inc., 464 U.S. 417, 476 (1984) (noting that "[n]o particular weight . . . was assigned to [the statutory fair use factors]"). And, it offers no indication of considerations that may be relevant beyond the four prescribed factors.

In *Harper & Row Publishers, Inc. v. Nation Enterprises*, this Court suggested that the fourth factor (which considers "effect on potential market") was "the most important element of fair use." 471 U.S. 539, 566 (1985). In *Campbell v. Acuff-Rose Music, Inc.*, this Court introduced the "transformative use" test as a key inquiry in the fair use analysis. *See* 510 U.S. 569, 579 (1994) (holding that "the central purpose of [an inquiry into "the purpose and character" of use] is . . . whether and to what extent the new work is 'transformative' "). The Court stated that "transformative use" is sufficiently important to outweigh the other statutory factors in the fair use analysis. *See id.* (" . . . the more transformative the new work, the less will be the significance of other factors").

Lower courts have had considerable difficulty reconciling *Campbell* and *Harper*. Some circuits have held that *Campbell* explicitly rejects *Harper*, and the correct way to view the fair use factors is for "[a]ll [factors] are to be explored, and the results weighed together[.]" *Murphy v. Millennium Radio Grp. LLC*, 650 F.3d 295, 306 (3d Cir. 2011) (citing *Campbell*, 510 U.S. at 578); *see also Brownmark Films, LLC v. Comedy Partners*, 682 F.3d 687, 693 (7th Cir. 2012). Other circuits disagree. The Second Circuit, for example, has held on to this Court's prior holding, and still regards the fourth

factor as "the most important." *See*, *e.g.*, *Fox Broad. Co. v. Dish Network, L.L.C.*, 723 F.3d 1067, 1076 (2d Cir. 2013); *Authors Guild v. Google, Inc.*, 804 F.3d 202, 214 (2d Cir. 2015).

This clash represents a circuit split between the two most important circuits for copyright cases, *see* Barton Beebe, *An Empirical Study of U.S. Copyright Fair Use Opinions, 1978-2005*, 156 U. PA. L. REV. 549 (2008) ("The district and circuit courts of the Second and Ninth Circuits dominated the [copyright cases from 1978-2005]"), making this circuit split independently ripe for review. Additionally, the Seventh Circuit has explicitly held that the "transformative use" test overlaps with the "derivative work" right, and refused to adopt it. *See Kienitz*, 766 F.3d at 758 ("To say that a new use transforms the work is precisely to say that it is derivative and thus . . . protected under § 106(2) . . . [w]e think it best to stick with the statutory list [of 17 U.S.C. § 107].").

The split is not just intercircuit. Within the Ninth Circuit, where this case originated, both views are present, and the circuit has never explicitly resolved the conflict. *Compare Seltzer*, 725 F.3d at 1175 (exploring all four factors, with "the results evaluated together") *with Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1180 (9th Cir. 2012) (stating that the fourth factor is the most important).

This inconsistency is also evident in the decision below. The Federal Circuit discussed both standards, and seemed to acknowledge that the *Campbell* and

Harper standards are in tension. *See Oracle*, 886 F.3d at 1207 (discussing the two factors). Resolution of this tension is vitally important, as an emphasis on transformativeness here might be seen to favor petitioner Google while an emphasis on market factors might be seen to favor respondent Oracle.

This confusion exemplifies the clash between two competing paradigms of fair use – "transformative use" and "market-centered." *See* Neil Weinstock Netanel, *Making Sense of Fair Use*, 15 LEWIS & CLARK L. REV. 715, 734–36 (2011). This Court's *Harper* holding stems from a "market-centered" view, which tolerates limiting fair use when it "disrupts the copyright market without a commensurate public benefit." *Harper*, 471 U.S. at 566 n.9. In adopting the "transformative use" test in *Campbell*, this Court accepted a broader vision for the fair use standard first articulated by Judge Leval. *See Campbell*, 510 U.S. at 578 (citing Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1110–11 (1990)). But by not doing so explicitly, the debate unnecessarily dragged on for more than twenty years, leaving behind a trail of unpredictable decisions. *See* Neil Weinstock Netanel, COPYRIGHT'S PARADOX 66 (2008) ("[I]t is exceedingly difficult to predict whether a given use in a given case will qualify [for fair use.]").

This Court should put this argument to rest here once and for all. The confusion over the transformative use doctrine has created disparities among the circuits that will encourage forum shopping in copyright cases. "An intra-circuit split accompanied by an inter-circuit divide followed by lack of conformity to a Supreme

Court decision normally warrants en banc review," *Int'l Union v. Kelsey-Hayes Co.*, 872 F.3d 388, 390 (6th Cir. 2017) (Sutton, J., concurring), but the Federal Circuit refused to do so. This Court should, therefore, grant *certiorari* to clarify the correct legal standard to apply when analyzing transformative use.

II. This Court should grant *certiorari* to clarify the standard of review for fair use determinations.

While the Ninth and Second Circuits have applied a *de novo* standard of review to fair use decisions, the Fifth, Sixth, and Seventh Circuits have applied more deferential standards. *Compare Fisher v. Dees*, 794 F.2d 432 (9th Cir. 1986), *and Infinity Broad. Corp. v. Kirkwood*, 150 F.3d 104, 107 (2d Cir. 1998) *with Compaq Computer Corp. v. Ergonome Inc.*, 387 F.3d 403, 410–11 (5th Cir. 2004), *and Bridgeport Music, Inc. v. UMG Recordings, Inc.*, 585 F.3d 267, 277–78 (6th Cir. 2009), *and Eisenschiml v. Fawcett Publ'ns, Inc*., 246 F.2d 598, 604 (7th Cir. 1957). *See also Piper Aircraft Corp. v. Wag-Aero, Inc.*, 741 F.2d 925, 936 (7th Cir. 1984) (Posner, J., concurring) ("[C]lear error has been held to be the proper standard for reviewing determinations of most mixed questions of law and fact in intellectual-property cases – such questions as similarity, copying, access, and fair use in copyright cases . . . ") (citations omitted).

Resolving the circuit split in the standard of review will allow this Court an opportunity to clarify the

effect of its ruling in *Harper*, 479 U.S. at 539. Lower courts treated fair use as a question of fact before *Harper*. One year later, in *Fisher*, the Ninth Circuit interpreted *Harper* as declaring fair use to be a mixed question of law and fact and treating historical facts as the only issues of fact in the determination. 794 F.2d at 432; *see also* Ned Snow, *Fair Use as a Matter of Law*, 89 DENV. U.L. REV. 1, 10–12 (2011). Though *Harper* does not necessitate this interpretation, *see Fisher*, 704 F.2d at 432, it has been adopted in Ninth Circuit decisions that followed.

This Court has previously granted *certiorari* to resolve circuit splits regarding the proper standard of review that an appellate court must apply when resolving an important issue. *See*, *e.g.*, *Teva Pharmaceuticals USA, Inc. v. Sandoz, Inc.*, 135 S. Ct. 831, 835 (2015) (stating that the case "requires us to determine what standard the Court of Appeals should use when it reviews a trial judge's resolution of a factual dispute"); *U.S. Bank Nat. Ass'n ex rel. CWCapital Asset Management*, 138 S. Ct. 960, 963 (2018) ("In this case, we address how an appellate court should review [a non-statutory insider] determination): *de novo* or for clear error?"); *Cooter & Gell v. Hartmarx Corp.*, 496 U.S. 384, 399–401 (1990) (describing circuit split in standard of review for Rule 11 sanctions); *Pierce v. Underwood*, 487 U.S. 552, 557–64 (1988) (determining correct standard of review for decision under the Equal Access to Justice Act). Similarly here, this Court should grant

certiorari to clarify the appropriate standard of review in fair use cases.

CONCLUSION

For the foregoing reasons, *amici* respectfully request that this Court grant *certiorari* in this case.

Respectfully submitted,

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