WESTERN NEW YORK
THE DAILY RECORD
YOUR TRUSTED SOURCE FOR LEGAL AND REAL ESTATE NEWS
NYDAILYRECORD.COM APRIL 13, 2021

IP Frontiers: Google v. Oracle: Supreme Court opens up fair use to copying of computer code

By THOMAS SICA

On April 5, 2021, the Supreme Court released its decision in the case of *Google LLC v. Oracle Am., Inc.*, 593 U.S. ___, No. 18-956 (U.S. 2021), ending an 11-year legal battle between the two companies over Google, LLC's ("Google") copying of certain aspects of Oracle America, Inc.'s ("Oracle") Java programming code for Google's Android platform for smartphones.

Java is a popular computer programming language that was invented by Sun Microsystems in the 1990s. Oracle bought Sun Microsystems in 2010. The Java language was designed in a way to make computer programming more accessible to developers, in part by creating a series of shortcuts that developers may use for certain common functions rather than writing their own code from scratch. As relevant to this case, there are two different types of programming code within the Java language: implementing code and declaring code. In simplest terms, implementing code is the code that instructs the computer how to perform a certain task. In contrast, declaring code is the code that instructs the computer what task is to be performed. In other words, the declaring code directs the computer to the location of the implementing code. Google, in the development of the Android program, copied approximately 11,500 lines of Java's declaring code, but wrote its own corresponding implementing code. Google's implementing code constituted a majority of the interface used in Google's Android system. Google copied only the declaring code which they claimed was necessary for Java-trained programmers to use their system. Google did not dispute that they copied a portion of the Java declaring code, but claimed that such code cannot be protected by copyright and, even if it could, that Google's use was a "fair use." Oracle disagreed and sued Google for copyright infringement over the copied declaring code.

Congress has determined that "computer programs" fall under the protection of copyright law, rather than patent law. See, 17 U.S.C. § 101. But, securing a copyright in computer programs is inherently contradictory because these programs, by their very nature, are functional. Works with a primarily functional rather than aesthetic value are typically more appropriate for patent protection. Due to the highly functional nature of declaring code, Google argued that it was unable to secure copyright protection. The Supreme Court was asked to answer two questions in this case: (1) is the Java declaring code copyrightable, and (2) if so, was Google's copying of the code a "fair use"? Despite the fact that it was one of only two questions posed to the Supreme Court, the majority elected to side-step the first question. Rather, Justice Breyer, writing for the 6-2 majority, wrote the opinion under the assumption that the code was copyrightable, and went directly into the fair use question, ultimately holding that Google's use was, in fact, fair.

Fair use is an important doctrine in copyright law. Essentially, fair use allows for the unauthorized use of copyrighted content in some specific instances. For instance, fair use may apply in situations involving criticism, comment, news reporting, teaching, scholarship, or research. 17 U.S.C. § 107. However, those listed reasons are not exclusive. The Supreme Court has also held that fair use may be applied to a parody of a copyrighted work, as it is akin to criticism. See, *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 114 S. Ct. 1164, 1167, 127 L. Ed. 2d 500 (1994). Pursuant to 17 U.S.C. § 107, there are four factors under which fair use must be evaluated by the courts:

1. "the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
2. the nature of the copyrighted work;
3. the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
4. the effect of the use upon the potential market for or value of the copyrighted work."

The Supreme Court weighed all of these factors in the *Google v. Oracle* case and the majority held that all factors weighed in favor of fair use. As for the "purpose and character of the use," the Court held that the fact that Google copied Oracle's code in order to create new and useful products outweighed the fact that Google's use was primarily commercial. As to the second factor, the Court found that the "nature" of declaring code was "far from the core of copyright" and was designed in a way to be shared and recognized by computer programmers. Thus, this factor also favored Google. Regarding the "amount and substantiality of the portion used," the Supreme Court recognized that the 11,500 lines of code copied by Google only constituted 0.4 percent of the total Java interface, and determined Google used it "only insofar as needed to allow programmers to call upon those tasks without discarding a portion of a familiar programming language and learning a new one." Finally, regarding the potential market for Oracle's work, the

Reprinted with permission of The Daily Record © 2021

Court decided this factor in favor of Google for two reasons: (1) the Court feared that an opposite conclusion would stifle progress in computer programming because it would mean than any programmer familiar with the Java interface would necessarily have to go through Oracle, and (2) the Court was not convinced that Oracle could have entered the smartphone market, thus concluding that Oracle may not have lost any revenue due to Google's use of the Java declaring code in Android smartphones. As the majority found that Google's use of the code was fair, they opined that they need not determine whether the code was copyrightable.

Justice Thomas, joined by Justice Alito, dissented from the majority opinion. He believed that the majority was mistaken in failing to consider the first question posed: whether the declaring code was copyrightable. Justice Thomas argued that the majority's holding makes it so that declaring code may never be copyrightable, despite clear statutory language that states otherwise. See, 17 U.S.C. § 101. The dissent also worried about the effects of the majority's ruling on the future creation of new computer code stating: "if companies may now freely copy libraries of declaring code whenever it is more convenient than writing their own, others will likely hesitate to spend the resources Oracle did to create intuitive, well-organized libraries that attract programmers and could compete with Android." Thus, the dissent would have found in favor of Oracle in determining that Google's use was not a fair use.

The effect of the Supreme Court's ruling in Google v. Oracle remains to be seen. On the one hand, the Supreme Court's decision could have the effect of sprouting new and inventive computer programs by allowing those who are familiar with a programming language to use only so much of it as is necessary to create something new without the need for a license. Conversely, this ruling may reduce computer programmers' motive to create new programs for fear that they cannot adequately protect their works from copying. Copyright practitioners, especially those working with computer programs, should carefully follow this case's progeny to see how the computer programming industry will shift.

Thomas Sica is an associate with the law firm of Heslin Rothenberg Farley & Mesiti P.C. His experience includes litigation work, trademark prosecution, and general IP counseling. He can be reached at (518) 452-5600 or thomas.sica@hrfmlaw.com.