

No. 18-956

---

---

IN THE  
**Supreme Court of the United States**

---

GOOGLE LLC,

*Petitioner,*

*v.*

ORACLE AMERICA, INC.,

*Respondent.*

---

ON WRIT OF CERTIORARI TO THE UNITED STATES  
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

---

---

**BRIEF *AMICI CURIAE* OF 25 PROFESSORS  
OF JOURNALISM AND MEDIA LAW IN  
SUPPORT OF RESPONDENT**

---

---

DANIEL J. BROOKS

*Counsel of Record*

SCAROLA ZUBATOV SCHAFFZIN PLLC

1700 Broadway, 41<sup>st</sup> Floor

New York, New York 10019

(212) 757-0007

[dbrooks@szslaw.com](mailto:dbrooks@szslaw.com)

*Counsel for Amici Curiae*



**TABLE OF CONTENTS**

	<i>Page</i>
TABLE OF CONTENTS.....	i
TABLE OF CITED AUTHORITIES .....	iii
INTEREST OF <i>AMICI CURIAE</i> .....	1
SUMMARY OF ARGUMENT.....	2
ARGUMENT.....	3
I. The First Fair Use Factor, the Purpose and Character of the Use, Favors Fair Use Only if the New Work Alters the Expressive Content or Message of the Original Work or Has a Purpose Distinct from the Purpose of the Original Work .....	4
II. Finding Transformative Use Based Solely Upon a Change of Context Where the Original Work Has Not Been Altered or Used for a Transformative Purpose Imperils the Copyright Holder’s Exclusive Right to Create Derivative Works .....	11
III. The Third Fair Use Factor, the Amount and Substantiality of the Portion Used, Weighs against Fair Use Because What Was Taken Was Qualitatively Significant and Constituted More than Was Necessary for the New Work .....	14

*Table of Contents*

	<i>Page</i>
IV. The Fourth Fair Use Factor, the Effect of the Use upon the Potential Market for or Value of the Copyrighted Work, Weighs against Fair Use Even if Google's Infringement Harmed Only Oracle's Potential Markets . . . . .	16
CONCLUSION . . . . .	19
APPENDIX . . . . .	1a

## TABLE OF CITED AUTHORITIES

	<i>Page</i>
<b>Cases</b>	
<i>A&amp;M Records, Inc. v. Napster, Inc.</i> , 239 F.3d 1004 (9th Cir. 2001).....	8
<i>Authors Guild v. Google, Inc.</i> , 804 F.3d 202 (2d Cir. 2015) .....	12, 13
<i>Balsley v. LFP, Inc.</i> , 691 F.3d 747 (6th Cir. 2012).....	18
<i>Campbell v. Acuff-Rose Music, Inc.</i> , 510 U.S. 569 (1994).....	<i>passim</i>
<i>Castle Rock Entm't, Inc. v.</i> <i>Carol Publ'g Grp., Inc.</i> , 150 F.3d 132 (2d Cir. 1998) .....	12
<i>Dellar v. Samuel Goldwyn, Inc.</i> , 104 F.2d 661 (2d Cir. 1939) .....	6
<i>Elvis Presley Enters., Inc. v. Passport Video</i> , 349 F.3d 622 (9th Cir. 2003), <i>overruled on</i> <i>other grounds by Flexible Lifeline Sys., Inc.</i> <i>v. Precision Lift, Inc.</i> , 654 F.3d 989, 995 (9th Cir. 2011) .....	8
<i>Emerson v. Davies</i> , 8 F. Cas. 615 (C.C.D. Mass. 1845).....	5

*Cited Authorities*

	<i>Page</i>
<i>Folsom v. Marsh</i> , 9 F. Cas. 342 (C.C.D. Mass. 1841) . . . . .	5, 6, 10, 17
<i>Harper &amp; Row, Publishers, Inc. v. Nation Enters.</i> , 471 U.S. 539 (1985) . . . . .	10, 14-15
<i>Henley v. DeVore</i> , 733 F. Supp. 2d 1144 (C.D. Cal. 2010) . . . . .	17
<i>Infinity Broad. Corp. v. Kirkwood</i> , 150 F.3d 104 (2d Cir. 1998) . . . . .	8
<i>Kelly v. Arriba Soft Corp.</i> , 336 F.3d 811 (9th Cir. 2002) . . . . .	8
<i>L.A. News Serv. v. CBS Broad., Inc.</i> , 305 F.3d 924 (9th Cir.), <i>as amended</i> , 313 F.3d 1093 (9th Cir. 2002) . . . . .	10
<i>Monge v. Maya Magazines, Inc.</i> , 688 F.3d 1164 (9th Cir. 2012) . . . . .	18
<i>Oracle America, Inc. v. Google LLC</i> , 886 F.3d 1179 (Fed. Cir. 2018) . . . . .	<i>passim</i>
<i>Oracle America, Inc. v. Google, Inc.</i> , No. 3:10-CV-03561-WHA, 2016 WL 3181206 (N.D. Cal. June 8, 2016) . . . . .	7

*Cited Authorities*

	<i>Page</i>
<i>Perfect 10, Inc. v. Amazon.com, Inc.</i> , 508 F.3d 1146 (9th Cir. 2007) .....	9
<i>Ringgold v. Black Entm't Television, Inc.</i> , 126 F.3d 70 (2d Cir. 1997) .....	9
<i>Salinger v. Random House, Inc.</i> , 811 F.2d 90 (2d Cir. 1987) .....	18
<i>Stewart v. Abend</i> , 495 U.S. 207 (1990).....	5
<i>TCA Television Corp. v. McCollum</i> , 839 F.3d 168 (2d Cir. 2016) .....	9, 10
<i>Worldwide Church of God v. Philadelphia Church of God, Inc.</i> , 227 F.3d 1110 (9th Cir. 2000).....	9, 18
 <b>Statutes and Other Authorities</b>	
17 U.S.C. § 101 .....	12
17 U.S.C. § 106(2).....	4
17 U.S.C. § 107 .....	3, 5, 6, 11
Pierre N. Leval, <i>Toward a Fair Use Standard</i> , 103 Harv. L. Rev. 1105 (1990) .....	6
Sup. Ct. R. 37.6 .....	1

**INTEREST OF *AMICI CURIAE*<sup>1</sup>**

The authors of this brief are professors of journalism and media law whose interest is to urge the Court, in its first elucidation of the fair use doctrine since 1994, to articulate an objective and predictable fair use standard which protects journalists, in their dual capacities as both creators of original content and secondary users of copyrighted material, from uncertainty and economic harm in the application of this sometimes confusing doctrine. Journalists and media organizations invest considerable time, energy, financial resources and expertise in creating newsworthy reporting. They need a reasonable and understandable fair use standard to protect them from unfair appropriation of their work. The Fourth Estate has an indispensable role in our democracy – allowing unlimited “transformative” appropriation of copyrighted news reporting would result in the financial destruction of this vital underpinning of our free society. Although this case specifically involves computer programming code, the Court’s decision inevitably will have a ripple effect on numerous other categories of copyrightable material, including works of journalism. The Court, therefore, is respectfully requested to consider the critical role played by a vibrant and financially secure press in our democracy, and ensure that its decision in this case maintains robust copyright protections while clarifying

---

1. Pursuant to Sup. Ct. R. 37.6, *amici* represent that no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amici* made a monetary contribution to its preparation or submission. Counsel for the parties have consented in writing to the filing of this brief.

the fair use standard that is so crucial to the successful functioning of the American news media.

### **SUMMARY OF ARGUMENT**

The Federal Circuit’s decision that Google’s appropriation of Oracle’s copyrighted code was not fair use should be affirmed. A contrary decision would significantly weaken copyright protection in the United States, exposing the news media to considerable potential harm, thereby jeopardizing our democracy. The affirmative defense of fair use – consisting of four non-exclusive statutory factors, three of which weigh heavily in favor of the decision for Oracle in the Federal Circuit – does not protect Google’s unauthorized copying of Oracle’s Java programming code. This holds true even if one accepts each of Google’s arguments: that its secondary use occurred in a different “context” or medium (smartphones and tablets instead of the desktop or laptop computers for which Oracle’s Java software purportedly was designed); that it took only a small percentage of Oracle’s computer code; and that its copying and use affected only the potential markets for Oracle’s Java software. As none of these arguments stands up to scrutiny, fair use weighs heavily against Google. Additionally, the fair use standard advocated by Google should be rejected because it would imperil the copyright owner’s exclusive right to create or license the creation of derivative works by blurring the line between derivative works (which, by statutory definition, are “transformative” and require the consent of the copyright owner) and unauthorized fair use (which is codified in statutory language which never mentions the term “transformative”).



## ARGUMENT

As codified in the 1976 Copyright Act, the statutory fair use provision begins with a preamble containing examples of secondary uses that have been found to be fair uses, and then lists four non-exclusive factors distilled from common law cases which need to be explored in assessing the fair use defense:

[T]he fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include –

- (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 first fair use factor militates strongly against a finding of fair use in this case because verbatim copying done for an identical purpose with no alterations to the expressive content or message of the original is not “transformative.” An alleged change in “context” or format, *e.g.*, from desktop and laptop computers to smartphones and tablets, is not transformative. To hold otherwise would imperil the copyright holder’s exclusive right to “prepare derivative works based upon the copyrighted work.” 17 U.S.C. § 106(2). While the second fair use factor does not weigh against fair use, examination of the third and fourth fair use factors demonstrates that Google’s copying was not fair. Regarding the third factor, Google took a quantitatively small but qualitatively significant and valuable portion of Oracle’s Java code and took more than was necessary in order to accomplish its purpose. As for the fourth factor, Google’s copying substantially harmed Oracle’s actual *and* potential markets for its original software and its derivatives, though all that is required under the fourth factor is harm to a potential market. Aggregating the four factors, the Federal Circuit properly reversed the jury verdict of fair use in favor of Google. The Federal Circuit’s decision is supported not only by the facts of this case, but also with an eye toward the potential ill effects a contrary decision could have on the most critical functions of the American news media.

**I. The First Fair Use Factor, the Purpose and Character of the Use, Favors Fair Use Only if the New Work Alters the Expressive Content or Message of the Original Work or Has a Purpose Distinct from the Purpose of the Original Work**

The goal of incentivizing creativity and innovation by giving copyright owners exclusive rights to their works

has long co-existed with the recognition that, “[i]n truth, in literature, in science and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout. Every book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.” *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (No. 4,436). The fair use doctrine, a judge-made rule subsequently codified in the Copyright Act of 1976, 17 U.S.C. § 107, was developed to accommodate the tension between protecting creators of intellectual property and allowing others to express themselves by reference to copyrighted works (*i.e.*, allowing them to copy those works without permission), thereby “permit[ting] courts to avoid rigid application of the copyright statute when, on occasion, it would stifle the very creativity which that law is designed to foster.” *Stewart v. Abend*, 495 U.S. 207, 236 (1990) (internal quotation marks and citation omitted).

The last time this Court visited the fair use doctrine, in *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994), it provided guidance on the “purpose and character” prong of the first fair use factor, stating that the “central purpose of this investigation is to see, in Justice Story’s words, 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, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’” *Campbell*, 510 U.S. at 579 (citations omitted).

This Court’s reference to Justice Joseph Story was to his seminal opinion in *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4,901), the first decision importing

the English doctrine of fair use into this country. As Justice Story stated, fair use involved “the metaphysics of the law, where the distinctions are, or at least may be, very subtle and refined, and, sometimes, almost evanescent.” *Id.* at 344. Nearly a century later, the fair use doctrine remained “the most troublesome in the whole law of copyright.” *Dellar v. Samuel Goldwyn, Inc.*, 104 F.2d 661, 662 (2d Cir. 1939) (per curiam).

The troublesome and unpredictable nature of fair use was commented on by then-District Judge Pierre N. Leval in an influential article written in 1990, which argued that: “Judges do not share a consensus on the meaning of fair use. Earlier decisions provide little basis for predicting later ones. Reversals and divided courts are commonplace. The opinions reflect widely differing notions of the meaning of fair use.” Pierre N. Leval, *Toward a Fair Use Standard*, 103 Harv. L. Rev. 1105, 1106 (1990). Judge Leval’s enduring contribution to the evolution of the fair use doctrine is found in his discussion of the first fair use factor, the purpose and character of the use, which he believed “raises the question of justification[,]” which, in turn, depends “primarily on whether, and to what extent, the challenged use is transformative.” *Id.* at 1111. Judge Leval elaborated on transformativeness, stating, “[t]he use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original. A quotation of copyrighted material that merely repackages or republishes the original is unlikely to pass the test; in Justice Story’s words, it would merely ‘supersede the objects’ of the original.” *Id.* In *Campbell*, when it introduced the concept of a “transformative” use (a term which is not found in § 107 of the Copyright Act, 17 U.S.C. § 107), this Court cited to and borrowed

the reasoning of Judge Leval's article. *Campbell*, 510 U.S. at 579. The Court's invocation of the transformative use doctrine in *Campbell* allowed parody to be included among uses that could be deemed "fair," which is logical since parody involves commentary and/or criticism of the original.

Although Google avoids mentioning this procedural history in the brief it filed with this Court, the district court in this case denied Oracle's motion for judgment as a matter of law and ruled, in connection with the first prong of the first fair use factor (the purpose and character of the use), that the jury reasonably could have concluded that Google's use, in the Android mobile operating system, of Oracle's packages of Java computer source code, without alteration of their content and for the same purpose as in the Java system, was transformative. This was because, the district court found, Google's use occurred in a different "context"; namely, in smartphones rather than in the desktop or laptop computers for which Java supposedly was designed. This change in media, the court reasoned, coupled with the addition of new implementing code and a new mobile smartphone platform, could have been considered by the jury to have given "new expression, meaning, or message to the duplicated code," sufficient to render the new work transformative. *Oracle America, Inc. v. Google, Inc.*, No. 3:10-CV-03561-WHA, 2016 WL 3181206, at \*9 (N.D. Cal. June 8, 2016).

The Federal Circuit, relying on law from this Court and other Circuits, correctly rejected the notion that verbatim copying of a small but qualitatively important portion of Java's code, without alteration of its content or purpose, but with the addition of Google's own

implementing code, was transformative. As the Federal Circuit stated: “where, as here, the copying is verbatim, for an identical function and purpose, and there are no changes to the expressive content or message, a mere change in format (e.g., from desktop and laptop computers to smartphones and tablets) is insufficient as a matter of law to qualify as a transformative use.” *Oracle America, Inc. v. Google LLC*, 886 F.3d 1179, 1202 (Fed. Cir. 2018).

Courts have consistently held that a mere change in context, format or medium, without any alteration of the expressive content or purpose of the original work, is not transformative. *Infinity Broad. Corp. v. Kirkwood*, 150 F.3d 104, 108 (2d Cir. 1998) (retransmission of radio broadcasts over telephone lines was not transformative because, despite the different medium, it did not “alter[] the first [work] with new expression, meaning or message”); *see also Kelly v. Arriba Soft Corp.*, 336 F.3d 811, 819 & n.19 (9th Cir. 2002) (“Courts have been reluctant to find fair use when an original work is merely retransmitted in a different medium”); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1011, 1015 (9th Cir. 2001) (copying an audio compact disk directly onto a computer’s hard drive by compressing the audio information on the CD into the MP3 format was not transformative). If there is no change in expression, meaning or message, a secondary work, in order to be transformative, must “use copyrighted material for purposes distinct from the purpose of the original material.” *Elvis Presley Enters., Inc. v. Passport Video*, 349 F.3d 622, 629 (9th Cir. 2003), *overruled on other grounds by Flexible Lifeline Sys., Inc. v. Precision Lift, Inc.*, 654 F.3d 989, 995 (9th Cir. 2011) (television clips of the singer were transformative where they were used as historical reference points in his life,

thereby transforming the purpose of showing the clips, but the use of other film clips for their entertainment purposes was not transformative). *See also Worldwide Church of God v. Philadelphia Church of God, Inc.*, 227 F.3d 1110, 1117 (9th Cir. 2000) (“where the ‘use is for the same intrinsic purpose as [the copyright holder’s] . . . such use seriously weakens a claimed fair use.”) (internal citations omitted); *Ringgold v. Black Entm’t Television, Inc.*, 126 F.3d 70, 79 (2d Cir. 1997) (the use of a poster as decoration on a television show was not transformative because it was used for “precisely a central purpose for which it was created – to be decorative”).

Moving material to a new context is not transformative in and of itself – even if the change in context is stark. In *TCA Television Corp. v. McCollum*, 839 F.3d 168, 181-83 (2d Cir. 2016), the Second Circuit rejected a fair use claim even though the copyrighted material (the iconic Abbott and Costello comedy routine, *Who’s on First?*) was used in the “sharply different context” of a Broadway play, a dark comedy about an introverted student in a religious small town. *Id.* at 182. As the court stated, “The Play may convey a dark critique of society, but it does not transform Abbott and Costello’s Routine so that it conveys that message. To the contrary, it appears that the Play specifically has its characters perform *Who’s on First?* without alteration [so that it would be recognizable].” *Id.* at 181 (emphasis in original). Critically, a change in context is only significant if that change enables a change in purpose, which is determinative. *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1165 (9th Cir. 2007) (“Here, Google uses Perfect 10’s images in a new context *to serve a different purpose.*”) (Emphasis supplied).

Finally, there is no merit to Google’s contention that its use was transformative because it selectively used only a small portion of the Java packages and wrote its own implementing code. Taking only select passages of a copyrighted work without altering their expressive content or message is not, by itself, transformative. *L.A. News Serv. v. CBS Broad., Inc.*, 305 F.3d 924, 938 (9th Cir.) (“Merely plucking the most visually arresting excerpt from . . . nine minutes of footage cannot be said to have added anything new”), *as amended*, 313 F.3d 1093 (9th Cir. 2002). This is especially so when, as set forth in this brief’s discussion of the third fair use factor, *infra*, the appropriated material is qualitatively significant. *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 569 (1985) (finding that verbatim copying of 300 words from a manuscript of more than 200,000 words was not a fair use); *see also Folsom*, 9 F. Cas. at 345 (Story, J.) (“There must be real, substantial condensation of the materials, and intellectual labor and judgment bestowed thereon; and not merely the facile use of the scissors; or extracts of the essential parts, constituting the chief value of the original work.”). Nor does adding its own implementing code mean that Google’s appropriation of the Java code was transformative, particularly because there is no evidence that the new implementing code somehow changed the expression or message of Java’s declaring code. In *TCA Television*, the Second Circuit held that, although the playwright included significant original material in addition to the copyrighted Abbott and Costello routine, the new material did not make the use of the copyrighted work transformative. As this Court stated in *Harper & Row*, 471 U.S. at 565, “no plagiarist can excuse the wrong by showing how much of his work he did not pirate.” As the Federal Circuit put it: “The relevant



question is whether Google altered ‘the *expressive content or message* of the original work’ that it copied – not whether it rewrote the portions it did not copy.” *Oracle*, 886 F.3d at 1201 (emphasis in original).

Cabining the transformative use principle by requiring, without consideration of the amount taken, that the secondary work alter the original work’s expressive content or use it for a different purpose will protect journalists (and the public) by providing a more concrete standard for distinguishing between fair use and infringement. A manageable and predictable standard of transformative use is essential because journalistic output has become increasingly digitized and easy to copy. This makes it difficult to police infringement. Because all copying inherently changes the “context” in which the original work is situated, the difficult burden of detecting and preventing infringement will only be exacerbated if, when infringement is discovered, the reporter or media company has to navigate a malleable and vague standard such as the district court employed in ruling that Google’s use could be considered transformative because Oracle’s copyrighted material was used in a different context.

## **II. Finding Transformative Use Based Solely Upon a Change of Context Where the Original Work Has Not Been Altered or Used for a Transformative Purpose Imperils the Copyright Holder’s Exclusive Right to Create Derivative Works**

Fair use, as codified in Section 107 of the Copyright Act, does not employ the word “transformative.” In contrast to the statutory fair use provision, the statutory definition of a derivative work expressly speaks of an original

work being “transformed.” Section 101 of the Copyright Act defines a “derivative work” as “a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, *transformed*, or adapted.” (Emphasis supplied).

As the lower federal courts began to apply *Campbell*’s transformative use standard, the potential tension between the first fair use factor’s emphasis on transformativeness and the copyright owner’s exclusive right to create or license others to create transformative derivative works came into focus. See *Castle Rock Entm’t, Inc. v. Carol Publ’g Grp., Inc.*, 150 F.3d 132, 143 (2d Cir. 1998) (noting “potential source of confusion in our copyright jurisprudence over the use of the term ‘transformative’” but asserting that “[a]lthough derivative works that are subject to the author’s copyright transform an original work into a new mode of presentation, such works – unlike works of fair use – take expression for purposes that are not ‘transformative’”).

Judge Leval, who coined the use of the term “transformative” in fair use jurisprudence, addressed this interplay between first factor transformativeness and the right to create derivative works, which, by definition, transform a preexisting work, in *Authors Guild v. Google, Inc.*, 804 F.3d 202 (2d Cir. 2015). Writing for the Second Circuit, Judge Leval explained, “[t]he statutory definition suggests that derivative works generally involve transformations in the nature of *changes of form*.” 804 F.3d at 215 (citing 17 U.S.C. § 101) (emphasis in original).

Derivative works “ordinarily are those that re-present the protected aspects of the original work, *i.e.*, its expressive content, converted into an altered form, such as the conversion of a novel into a film, the translation of a writing into a different language . . . or other similar conversions.” *Id.* at 225 (internal citation omitted). “By contrast, copying from an original for the purpose of criticism or commentary on the original or provision of information about it, tends more clearly to satisfy *Campbell’s* notion of the ‘transformative’ purpose involved in the analysis of Factor One.” *Id.* at 215-16.

Applying this distinction, if Google engaged in exact copying of the Java declaring code and SSO of the API packages, without altering their expressive content or message, and in order to use them in the Android for the identical purpose they serve in Java, but used them in the different context of smartphones or tablets instead of desktops or laptops, this would appear to be a quintessential example of a change in form, the hallmark of a derivative work, rather than a fair use, which alters the original for a transformative purpose. Whether characterized as a change in form, medium, or context, Judge Leval’s statutory interpretation would appear to indicate that, if Google used Oracle’s computer code without alteration and for an identical purpose, that use was derivative rather than transformative within the meaning of fair use, and therefore required the permission of the copyright owner. To hold otherwise would blur the line between permissible transformative fair uses and infringing derivative works and could result in the impairment of the derivative works right, as the Federal Circuit in fact noted in the decision below. *Oracle*, 886 F.3d at 1202, n.8.

Protection of the derivative works right is of paramount importance to journalists, whose reporting could later be converted into books or screenplays, or whose articles could be abridged or translated into other languages. Moreover, because journalism is a multimedia endeavor, there are derivative works created in different media than the original, such as an audio report based on a piece of print journalism. Other new media will be invented in the future that could be used in journalism to create other derivative works and the copyright owners of those original works of news reporting should not have their derivative work rights infringed by non-transformative copying which occurs in a different “context.” As the Federal Circuit put it: “To some extent, any use of copyrighted work takes place in a slightly different context than the original[,]” but that does not mean that verbatim copying in a different format, for an identical purpose, without changes to the expressive content or message, should qualify as a transformative use, immune from the copyright holder’s derivative works right. 886 F.3d at 1202.

### **III. The Third Fair Use Factor, the Amount and Substantiality of the Portion Used, Weighs against Fair Use Because What Was Taken Was Qualitatively Significant and Constituted More than Was Necessary for the New Work**

Google argues that there was testimony that the total amount of code it reused comprised less than 0.5% of the code in the Java SE libraries, which are themselves only a subset of the Java SE work as a whole. Br. for Petitioner, at 46-47. As this Court has held, however, the percentage of work copied is not dispositive where the portion copied is qualitatively significant. *Harper & Row*, 471 U.S. at 566

(“In view of the expressive value of the excerpts and their key role in the infringing work, we cannot agree with the Second Circuit that the ‘magazine took a meager, indeed an infinitesimal amount of Ford’s original language.’”) (citation omitted). As noted, *supra*, *Harper & Row* involved the copying of 300 words from the manuscript of President Ford’s forthcoming memoirs, which totaled more than 200,000 words. 471 U.S. at 569. Just as those 300 words, pertaining to the pardon of President Nixon, were qualitatively significant, the Federal Circuit in this case found that “Google sought ‘to capitalize on the fact that software developers were already trained and experienced in using the Java API packages at issue.’ But there is no inherent right to copy in order to capitalize on the popularity of the copyrighted work or to meet the expectations of intended customers.” *Oracle*, 886 F.3d at 1206-07 (internal citations omitted). As the Federal Circuit explained, “no reasonable jury could conclude that what was copied was qualitatively insignificant, particularly when the material copied was important to the creation of the Android platform. Google conceded as much when it explained to the jury the importance of the APIs to the developers it wished to attract.” *Id.* at 1207.

Google also argues that it took no more than was necessary in order to accomplish its purpose (citing *Campbell*, 510 U.S. at 589). Br. for Petitioner, at 47. This overlooks *Campbell*’s underlying rationale: when making a parody of an original song (which, unlike Google’s copying of Oracle’s Java code, was found to be transformative), it is necessary to copy substantially. As this Court explained: “Parody’s humor, or in any event its comment, necessarily springs from recognizable allusion to its object through distorted imitation. Its art lies in the tension between a

known original and its parodic twin. When parody takes aim at a particular original work, the parody must be able to ‘conjure up’ at least enough of that original to make the object of its critical wit recognizable.” *Campbell*, 510 U.S. at 587-88 (citation omitted).

Not only is *Campbell* inapposite, therefore, but it is undisputed that Google actually copied substantially more code than was necessary to accomplish its purpose. As the Federal Circuit noted, “the parties stipulated that only 170 lines of code were necessary to write in the Java language. It is undisputed, however, that Google copied 11,500 lines of code – 11,330 more lines than necessary to write in Java. That Google copied more than necessary weighs against fair use.” *Oracle*, 886 F.3d at 1206.

This analysis has implications for journalists, whose news reports often consist of articles or segments containing substantial background leading up to a kernel of breaking news, such as a memorable quote or description of an historic event. To allow the heart of these reports to be appropriated merely because they are quantitatively minor would disincentivize the type of investigative reporting that is essential to a vibrant press.

#### **IV. The Fourth Fair Use Factor, the Effect of the Use upon the Potential Market for or Value of the Copyrighted Work, Weighs against Fair Use Even if Google’s Infringement Harmed Only Oracle’s Potential Markets**

There is evidence in the record that Google’s use harmed Oracle’s actual existing markets because Oracle had already licensed its code for use in smartphones and

tablets. Br. for Respondent, at 11-12, 46-48. Even if that were not the case, harm to Oracle’s potential markets would suffice to tilt the fourth fair use factor against fair use.

Google argues that its Android smartphones “did not supplant or supersede” Oracle’s actual markets (servers and desktop computers) and that Oracle’s “mere wish” to enter other potential markets is too speculative to support the type of harm that is cognizable under the fourth fair use factor. Br. for Petitioner, at 48-49. Neither of these arguments stands up to scrutiny.

The four fair use factors all derive from Justice Story’s formulation in *Folsom*, 9 F. Cas. at 348 (“[Courts] must often . . . look to the nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work.”). Notably, the examples of market harm are stated in the disjunctive (“prejudice the sale, *or* diminish the profits, *or* supersede the objects”) (emphasis supplied). Thus, adverse effects upon the potential market for or value of the copyrighted work, within the meaning of the fourth fair use factor, should not be limited to infringements which completely supersede (or supplant or usurp) existing markets. See *Henley v. DeVore*, 733 F. Supp. 2d 1144, 1163 (C.D. Cal. 2010) (holding that a politician’s unauthorized use of a copyrighted song in his campaign could harm the copyright owner, who was himself neither considering running for office nor allowing other political candidates to use the song, because “licensees and advertisers do not like to use songs that are already associated with a particular product or cause.”).

In *Campbell*, which involved a parody of the Roy Orbison rock ballad, *Oh, Pretty Woman*, by the rap group 2 Live Crew, the Court concluded that, in the case of parody, harm to the market for the original work was unlikely because a parody does not serve as a substitute for the original work, but rather serves a different market function. The Court also held that harm to a derivative market for parodies was unlikely because the “market for potential derivative uses includes only those that creators of original works would in general develop or license others to develop[.]” but that there was a potential derivative market that could have been harmed – the market for a non-parodic rap version of the original Roy Orbison song. *Campbell*, 510 U.S. at 592-93.

As for Google’s contention that Oracle’s mere wish to enter the smartphone market did not suffice as an indicia of market harm, the copyright holder has the exclusive right to determine “when, ‘whether and in what form to release’ the copyrighted work into new markets.” *Monge v. Maya Magazines, Inc.*, 688 F.3d 1164, 1182 (9th Cir. 2012), quoting *Harper & Row*, 471 U.S. at 553. Even a copyright owner who had disavowed any intention to publish his work during his lifetime was entitled to copyright protection because “the relevant consideration was the ‘potential market’” and “he has the right to change his mind.” *Worldwide Church*, 227 F.3d at 1119 (citing *Salinger v. Random House, Inc.*, 811 F.2d 90, 99 (2d Cir. 1987)). See also *Balsley v. LFP, Inc.*, 691 F.3d 747, 761 (6th Cir. 2012) (plaintiff lacking any present desire to sell her copyrighted photo prevailed over a fair use defense on the grounds that the copying could adversely affect her potential market in the event that she later changed her mind). Thus, even putting aside the record evidence of harm to Oracle’s



actual existing markets (Br. for Respondent, at 11-12, 46-48), potential harm to new markets is sufficient to weigh the fourth factor in Oracle's favor.

With the news media facing some of its most challenging financial struggles in modern history, this is not the time to create additional opportunities for unscrupulous freeloaders to infringe the market for the journalism that keeps our democracy vital. The proliferation of new forms of media is only going to accelerate with the continuing development of new technology. The news media should remain free, in the exercise of its business judgment, to utilize these new opportunities as they become available and should not have its rights abridged due to any delay in implementing a particular new form of technology.

### CONCLUSION

For the foregoing reasons, and to help ensure the continued survival of the American news media, the judgment of the Federal Circuit should be affirmed.

Respectfully submitted,

DANIEL J. BROOKS

*Counsel of Record*

SCAROLA ZUBATOV SCHAFFZIN PLLC

1700 Broadway, 41<sup>st</sup> Floor

New York, New York 10019

(212) 757-0007

dbrooks@szslaw.com

*Counsel for Amici Curiae*

## **APPENDIX**

**APPENDIX — LIST OF *AMICI***

*Amici* sign this brief on their own behalf, not on behalf of the institutions with which they are affiliated. *Amici* are listed in the order in which they agreed to be signatories to this brief.

**Beth Knobel, Ph.D.**, is an Associate Professor in the Department of Communication and Media Studies at Fordham University. Dr. Knobel had a 20-year career in journalism – in newspapers, magazines, television, radio, and Internet – prior to joining Fordham University in 2007. From 1999 to 2006, she was the Moscow Bureau Chief for CBS News. She is the recipient of Emmy, Edward R. Murrow, and Sigma Delta Chi awards for her work. Dr. Knobel is the author of the book, *The Watchdog Still Barks: How Accountability Journalism Evolved for the Digital Age*, and a co-author with Mike Wallace of CBS News of *Heat and Light: Advice for the Next Generation of Journalists*.

**Aaron Chimbél** is dean of St. Bonaventure University's Jandoli School of Communication. Chimbél previously taught journalism at Texas Christian University for nine years. His academic writing has appeared in the *Newspaper Research Journal*, *MediaShift* and *Electronic News*, among others. He has published two books: *Introduction to Journalism* and *Why I'm a Journalist: Personal Stories from Those Who Cover the News*. Before academia, Chimbél worked at WFAA-TV in Dallas as a mobile journalist, earning five Advanced Media Emmy Awards and a national Edward R. Murrow Award. Chimbél was also a reporter at KWTX-TV (Waco-Temple-Killeen) and a producer at Texas Cable News.

*Appendix*

**Kathleen O'Toole, Ph.D.**, is an instructor in the Bellisario College of Communication at the Pennsylvania State University. Prior to joining the Penn State faculty in 2010, Dr. O'Toole had a 24-year career in public television as an Emmy award-winning broadcast journalist and producer, primarily with Penn State Public Broadcasting. She has also worked in radio and newspapers. Dr. O'Toole leads the International Reporting program at Penn State, taking student journalists around the world to report from foreign countries.

**Jonathan Sanders, Ph.D.**, is an Associate Professor in the School of Journalism at Stony Brook University. Dr. Sanders enjoys a journalism career stretching back to the 1960s. Most recently, from 2008-2018, he served as Senior International Correspondent at the United Nations for *icastnews.com*. He was the longest-serving CBS News Moscow Correspondent (1986-1997) in the Tiffany Network's history. He is the recipient of Emmy, Edward R. Murrow and Golden Verb awards. Sanders was a founder of the Harriman Institute of Columbia University. He has also taught at Princeton, Fordham, and SUNY Purchase. Professor Sanders, who began teaching at Stony Brook in 2012, is the author of *1917 The Unpublished Revolution* (with Heidi Hollinger, introduction by Mikhail Gorbachev) and *The Russians Emerge*, as well as a host of scholarly articles focusing on dissent, dissidence, and freedom of expression.

**Mitchell Bard, J.D., Ph.D.**, is an associate professor in the Media and Strategic Communications Department of Iona College, where he heads the journalism concentration.

*Appendix*

Before entering the academe, Mitchell spent 16 years as a writer and editor for content providers in New York, ranging from books to newsletters to the internet. He has published peer-reviewed journal articles, law review articles and an invited book chapter on journalism-related topics such as fake news, the practices of Fox News, the journalism attitudes and practices of Generation Z and the effects of the Supreme Court's ruling in *Citizens United* on issue advertising.

**Kimberly Voss, Ph.D.**, is a Full Professor of Journalism at the University of Central Florida. She spent more than a decade as a journalist before spending the past twenty years in higher education as a professor teaching media law. Dr. Voss is the author of *Re-Evaluating Women's Page Journalism in the Post-World War II Era: Celebrating Soft News, Women Politicking Politely: Feminists Making a Difference in the 1960s and 1970s* and *The Food Section: Newspaper Women and the Culinary Community*.

**Gerry Lanosga, Ph.D.**, is an associate professor in the Media School at Indiana University, where he teaches and researches in the areas of journalism practice, media law and journalism history. His work has been published in journals including *American Journalism*, *Journalism*, *Journalism Practice*, and *Journalism Studies*. Previously, he had a 20-year career as an investigative journalist, winning numerous national awards, including the George Foster Peabody award, Sigma Delta Chi's national public service award and the Freedom of Information Medal from Investigative Reporters and Editors.

*Appendix*

**Peter Klein** is former director of the University of British Columbia Graduate School of Journalism, where he serves as a full professor, teaching investigative and global reporting. He is the founder of the university-based Global Reporting Centre, a journalism organization focused on studying, innovating and producing global journalism. He was a longtime producer at CBS News *60 Minutes*, and previously worked at ABC News and New York Times TV. He is the recipient of numerous journalism awards, including several Emmy, Murrow and Sigma Delta Chi awards.

**Barbara Selvin** is an Associate Professor in the School of Journalism at Stony Brook University. Professor Selvin had a 20-year career in newspaper and magazine journalism prior to joining Stony Brook in 2000. She was a business reporter at *New York Newsday* from 1985 to 1993. She has written about the changing business model for news organizations, community journalism, family and work issues, and health care financing.

**William R. Davie, Ph.D.**, is the Regents Professor of Communication at the University of Louisiana at Lafayette. Dr. Davie had a career in journalism with radio and television stations in Texas, Missouri and Virginia before taking graduate courses in media law at the Universities of Missouri and Texas. He is the co-author with Dom Caristi (Ball State University) of *Communication Law: Practical Applications in the Digital Age*, and co-editor with T. Michael Maher of *First Amendment Law in Louisiana*.

*Appendix*

**Joseph Russomanno, Ph.D.**, is a Professor in the Cronkite School of Journalism and Mass Communication at Arizona State University. He has been on the faculty there for 25 years. Prior to that, he worked as a broadcast journalist for 10 years. Dr. Russomanno now teaches courses in “Mass Communication Law” and “Freedom of Expression Theory.” His research is on First Amendment issues, with a recent focus on “speech on campus” and a forthcoming book on that topic. His most recent publication was a 2019 law review article, “Tribalism on Campus: Factions, iGen and the Threat to Free Speech.”

**Andrew Ciofalo**, founder of the Journalism Program at Loyola (Md.), pioneered the use of digital media and the internet in journalism education abroad. Now Professor Emeritus, he heads the Institute for Education in International Media (ieiMedia) and works with U.S. universities to develop summer media programs abroad for grads and undergrads. He has taught on-line travel writing at both Loyola and Gonzaga universities. A member of AEJMC, he is the former head of the magazine division. He earned his B.A. at Brooklyn College and M.S. in Journalism at Columbia University.

**C.W. Anderson, Ph.D.**, is a Professor of Media and Communication at the University of Leeds and the author, co-author, or co-editor of five books: *Rebuilding the News: Metropolitan Journalism in the Digital Age* (Temple University Press), *Remaking the News* (with Pablo Boczkowski, The MIT Press), *The Sage Handbook of Digital Journalism* (with Tamara Witschge, David Domingo, and Alfred Hermida, Sage), *Journalism: What*

*Appendix*

*Everyone Needs to Know* (with Len Downie and Michael Schudson, Oxford University Press) and *Apostles of Certainty: Data Journalism and the Politics of Doubt* (Oxford University Press.)

**Susan E. Swanberg, J.D., Ph.D.** is an assistant professor of journalism at the University of Arizona School of Journalism where she teaches news reporting, science journalism, environmental journalism and media law. Swanberg is a former criminal lawyer and bench scientist whose current research examines the history of science and environmental journalism with a focus on World War II-era journalists. Her most recent projects explore the historical impact of propaganda, disinformation and misinformation on the public understanding of science. Swanberg has published peer-reviewed academic articles in both science and journalism and has written science stories for the public.

**Michael T. Martínez, Ph.D.**, is an Assistant Professor in the School of Journalism and Electronic Media at the University of Tennessee. Dr. Martínez turned to academe after working for 26 years at four newspapers and a wire service — the Associated Press in New York, the *Louisville Courier-Journal*, the *Detroit News*, the *Cincinnati Enquirer* and the *Fort Worth Star-Telegram*. Dr. Martínez' research interests include media law, with a specific focus on media and the courts, the history of journalistic practices and political coverage in visual communication. He is a co-author with Prof. Bill Loving of *Law of Mass Communications: Freedom and Control of Print and Broadcast Media* (15th Edition).



*Appendix*

**Seth C. Lewis, Ph.D.**, is the Shirley Papé Chair in Emerging Media in the School of Journalism and Communication at the University of Oregon. Before academia, he worked as a journalist at *The Miami Herald* and other news organizations. Presently he is a visiting fellow with the Reuters Institute for the Study of Journalism at the University of Oxford, a fellow with the Tow Center for Digital Journalism at Columbia University, and an affiliate fellow of the Information Society Project at Yale Law School. He is co-editor of *Boundaries of Journalism: Professionalism, Practices and Participation*.

**Michael J. Socolow, Ph.D.**, is an Associate Professor in the Department of Communication and Journalism at the University of Maine. The author of *Six Minutes in Berlin* (2016), Socolow is a media scholar who writes on the history of broadcast network regulation, competition in the developmental era of U.S. radio, and propaganda and advertising. He is a former CNN Assignment Editor, and worked as an Information Manager for the host broadcast organizations at the Barcelona, Atlanta, and Sydney Olympic Games.

**Phil Terrigno** is a communications and journalism lecturer at Fordham University. He has been published by *The New York Times*, the Associated Press, *Billboard*, *Vice* and other national outlets. He holds an M.S. from Columbia University and an M.B.A. from Texas Tech University.

*Appendix*

**Paulette D. Kilmer, Ph.D.** teaches journalism as storytelling, media history, and ethics at the University of Toledo. Her research analyzes news as archetype, folklore, and human drama. She has published two books, book chapters, scholarly articles, and essays. She graduated from the University of Wisconsin, Madison, with a B.A. and M.A., from the University of Kansas, Lawrence, with a M.A., and from the University of Illinois, Urbana-Champaign with a Ph.D.

**Mary T. Rogus** is an Associate Professor in the E.W. Scripps School of Journalism at Ohio University. She teaches in the areas of media ethics, electronic journalism and diversity in media. She has traveled the world training journalists and journalism professors through U.S. State Department grants. Ms. Rogus is an award-winning broadcast journalist who worked 20 years in multiple local television markets as a reporter, producer and executive producer. She and two colleagues brought that professional experience to a textbook, *Managing Television News: A Handbook for Ethical and Effective Producing*, which was endorsed by Walter Cronkite.

**Charlie Butler** is a journalism instructor at the University of Oregon's School of Journalism and Communication. During his journalism career, he has worked as an editor and writer for such publications as *Runner's World*, *SmartMoney*, and *SportsTravel*. His freelance work has appeared in *The New York Times*, *Fortune*, *Men's Health* and *CJR*. He is the co-author of two books. A graduate of the college and journalism school at Columbia University, Butler also completed the

*Appendix*

University's Knight-Bagehot Fellowship in Economics and Business Journalism program. Butler has also taught journalism at Lehigh University, Ursinus College, and Rosemont College.

**Matthew A. Baum, Ph.D.**, is the Marvin Kalb Professor of Global Communications and Professor of Public Policy at Harvard University's John F. Kennedy School of Government. His research focuses on the role of the media and public opinion in American politics, the interaction of media and electoral institutions, fake news and misinformation, the relationship between partisan media and polarization, and the domestic sources of foreign policy. His research has appeared in over a dozen leading scholarly journals, such as the *American Political Science Review* and *Science*. His most recent book is *War and Democratic Constraint: How the Public Influences Foreign Policy* (2015, Princeton University Press, co-authored with Phil Potter). He is also principal investigator and co-editor of the *Harvard Kennedy School Misinformation Review*.

**Diana Stover Tillinghast, Ph.D.**, joined the faculty at San Jose State University in 1983. She teaches courses in media law and ethics and communication law and public policy. She has journalism degrees from the University of Nebraska (B.A.) and Columbia University (M.S.) and a Ph.D. in mass media from Michigan State University. She was a reporter for two newspapers and the Associated Press. She covered politics including presidential campaigns, heading the *Omaha World Herald's* Iowa statehouse bureau, and covering the Ohio Senate and governor's office for the Associated Press. She lectures

*Appendix*

internationally and had three back-to-back Fulbrights in China. She publishes in refereed journals.

**Genelle I. Belmas, Ph.D.**, is an associate professor of journalism at the William Allen White School of Journalism and Mass Communication at the University of Kansas who teaches and researches First Amendment law. She is co-author of a major media law textbook, *Major Principles of Media Law*, and has published legal research on free speech and press issues including anonymity, privacy, student speech and press rights, and flag display and desecration. Prior to joining the University of Kansas in 2014, she taught journalism and media law classes as a tenured professor at California State University, Fullerton.

**David Hawkins** is an Emmy award-winning journalist and producer who is a lecturer in Communication and Media Studies at Fordham University. His international experience reporting for CBS News and Al Jazeera has taken him to over 30 countries. He was CBS News's Moscow bureau chief and producer from 1995-1998 and Moscow correspondent from 1999-2000. From 2000-2006, he was the Middle East correspondent for CBS News based in Tel Aviv. He was then based in Kuala Lumpur for Al Jazeera English, where he reported on politics and events in Southeast Asia, China, South Korea and Japan. Hawkins received a B.A. in Russian and Soviet Studies from Cornell University. In 2009, he was a Knight-Wallace Fellow at the University of Michigan, where he studied the effect of digital technology on the business and practice of journalism and went on to obtain an M.B.A. degree from the university's Ross School of Business.