

Keywords: copyright, fair use defense, Google, Oracle

General: Determining whether the fair use defense to copyright infringement of an API applies is based on an analysis of four factors: (a) the purpose and character of the use; (b) the nature of the copyrighted work; (c) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (d) the effect of the use upon the potential market for or value of the copyrighted work.

Google LLC v. Oracle America Inc.

Supreme Court of the United States

Case No. 18-956

Cited as 593 U.S. ____ (2021)

Decided April 5, 2021

I. Background

In 2005, Google acquired Android, Inc. to develop a software platform that was open for software developer to use tools on the platform free of charge to build mobile device applications. At that time, about six million software developers understood and wrote programs using Java programming language. In 2010, Oracle acquired Sun Microsystems (“Sun”). Prior to that, negotiations broke down between Google and Sun for Java SE’s application programming interface (API)¹ developed by Sun. As a result, Google wrote the Android platform using millions of lines of new code, of which roughly 11,500 lines of code were copied from Java SE’s API. An API provides a set of shortcuts to programmers based on an organization system and naming convention set up by the API.² The 11,500 lines of code copied by Google correspond to shortcuts associated with Java SE’s API that allow programmers to call on these shortcuts to execute tasks instead of having to develop and learn an entirely new system that could be used to execute the same tasks.

Trial 1

Oracle sued Google, contending that Google’s use of the Sun Java API violated copyright and patent law. The district court organized the issues into three proceedings: (1) patent issues, (2) copyright issues, and (3) damages issues. Regarding (2), the court determined, first, that the judge could decide whether copyright protection extends to an API, and second, that the jury could decide whether Google’s use of Oracle’s API infringed its copyright and whether a fair use defense nonetheless applied. The jury found limited copyright infringement, but was deadlocked as to whether Google could successfully assert a fair use defense. The judge then decided as a matter of law the API’s declaring code was not the kind of creation to which copyright law extended protection, noting that Google had written its own implementing code and only copied the declaring code and the organizational structure that was necessary for Java-trained programmers to activate familiar tasks. The judge concluded that under 17 U.S.C. § 102(b) copyright law prevents “system or method of operation” from being copyrighted. On appeal, the Federal Circuit reversed, holding that the API’s declaring code and organizational structure could be copyrighted because Google

¹ Federal Circuit described an API as a tool that “allow[s] programmers to use . . . prewritten code to build certain functions into their own programs, rather than write their own code to perform those functions from scratch [to draw upon a vast library of prewritten code to carry out tasks].” *Oracle America, Inc. v. Google, Inc.*, 750 F.3d 1339, 1349 (Fed. Cir. 2014).

² See Appendix.

could have written its own declaring code as it wrote its own implementing code. Additionally, the Federal Circuit remanded the case for another trial on the issue of whether Google’s use constituted fair use. Google petitioned for a writ of certiorari, seeking the review of the Federal Circuit’s decision on copyrightability. The Supreme Court denied the writ.

Trial 2

District court held another jury trial to determine fair use of the Java SE API, which the jury answered in the affirmative. Google had shown fair use. On appeal, the Federal Circuit again reversed the district court contending that “‘fair use’ is a question of law . . . [and that t]here was nothing fair about taking a copyrighted work verbatim and using it for the same purpose and function as the original in a competing platform.” The Federal Circuit remanded the case again for determination as to damages. Google again petitioned for a writ of certiorari, seeking the review of the Federal Circuit’s copyrightability and fair use. The Supreme Court granted the writ.

II. Issues

1. Did the Federal Circuit err in holding that the Java SE API is subject to copyright protection under federal copyright law?
2. Did the Federal Circuit err in reversing the district court to hold that Google’s use of Java SE API did not constitute fair use?

III. Discussion (Breyer, J.)

1. The Court altogether dodges this issue, contending that for the sake of argument, the Court assumes that the Sun Java API is eligible for copyright protection under federal law, and will examine if Google’s use nevertheless constitutes fair use. Under the Copyright Act, copyright law only applies to certain works.³ For example, copyright protection does not extend to “any idea, procedure, process, system, method of operation, concept, principle, or discovery.”⁴ Even if works are entitled to copyright protection, Congress has imposed limitations on the scope of copyright protection. For example, a copyright holder cannot prevent another person from making a “fair use of a copyright work.”⁵ The “fair use” doctrine is an equitable rule of reason that permits courts to avoid the stifling of creativity that the law was designed to foster.
2. Yes, the Federal Circuit erred in holding that Google’s use of the Sun Java API did not constitute fair use. The fair use question is a mixed question of fact and law, which on appeal is reviewed with substantial deference to the jury’s findings of underlying facts, but the ultimate question whether those facts amount to a fair use is a legal question for reviewing judges to decide *de novo*. The Court examined the following four guiding factors set forth in the Copyright Act’s fair use provision: (a) the nature of the copyrighted work; (b) the purpose and character of the use; (c) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (d) the effect of the use upon the potential market for or value of the copyrighted work.⁶ All four factors pointed in favor of fair use.
 - (a) First, the copied lines of code are part of a “user interface” that provides a way for programmers to access prewritten computer code through the use of simple commands. As a result, this code is different from many other types of code, such as the code that actually instructs the computer to execute a task. As part of an interface, the copied lines are inherently

³ See 17 U.S.C. § 102(a) (“Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression . . . include[ing] the following categories (1) literary works; (2) musical works . . . (3) dramatic works . . . (6) motion pictures.”).

⁴ 17 U.S.C. § 102(b).

⁵ 17 U.S.C. § 107.

⁶ See *id.*

- bound together with uncopyrightable ideas (the overall organization of the API) and the creation of new creative expression (the code independently written by Google).
- (b) Second, analysis on this factor turns on whether the copying was “transformative,” *i.e.*, whether it “adds something new, with a further purpose or different character.”⁷ Google’s limited copying of the API is a transformative use because Google only copied what was needed to allow programmers to work in a different computing environment without discarding a portion of a familiar programming language to create a platform—the Android platform.
 - (c) Third, Google copied hundreds of different tasks. Those 11,500 lines, however, are only 0.4 percent of the entire Java SE API, which consists of 2.86 million total lines. Thus, the 11,500 lines of code are one small part of the greater whole.
 - (d) Fourth, Google’s new smartphone platform is not a market substitute for Java SE. The record also showed that Java SE’s copyright holder would benefit from the reimplementing of its interface into a different market. Finally, enforcing the copyright on these facts risks causing creativity-related harms to the public, which is contrary to the public policy considerations of copyright law.

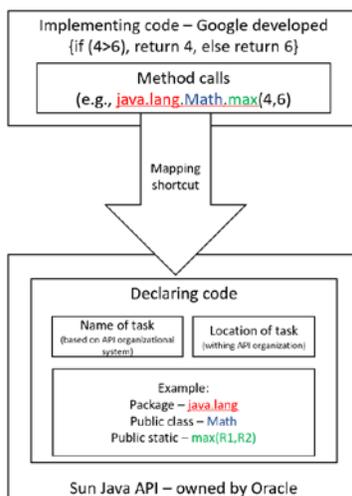
IV. Conclusion

The Federal Circuit erred in holding that Google’s use of the Java SE API did not constitute a fair use to copyright infringement. Thus, the Federal Circuit’s contrary judgment is reversed and remanded. The Supreme Court clarified that it was not overturning or modifying any precedent concerning fair use.

V. Dissent (J. Thomas)

First, after licensing negotiations broke down between Google and Oracle’s subsidiary for the API library of the subsidiary, Google copied verbatim 11,500 lines of code from the library, erasing 97.5% of the value of Oracle’s partnership with Amazon, made billions of dollars, and established its position as the owner of the largest mobile operating system in the world. Second, beyond failing to consider whether the declaring code of an API is eligible for copyright protection (which dissent contends is), the majority erroneously found Google’s actions to constitute fair use under the four-factor test.

VI. Appendix



⁷ *Campbell v. Acuff-Rose Music, Inc.* 510 U.S. 569, 579 (1994).