

No. 17-168

IN THE
Supreme Court of the United States

ROBIN ANTONICK,
Petitioner,

v.

ELECTRONIC ARTS INC.,
Respondent.

On Petition for Writ of Certiorari
to the United States Court of Appeals
for the Ninth Circuit

**BRIEF OF *AMICI CURIAE*
INTELLECTUAL PROPERTY
LAW PROFESSORS
IN SUPPORT OF PETITIONER**

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INTEREST OF *AMICI CURIAE*

Amici Intellectual Property law professors, listed in the Appendix, are academics who regularly teach and write about copyright law.¹ Their interest in this case stems from their professional academic interest in guiding the development of the law in ways that most benefit society. *Amici* have no personal interest in the outcome of this case.

Amici write to express their concern with the sharp and widening circuit split created by the Ninth Circuit's prohibition on the use of expert testimony to aid the finder of fact during under the so-called "intrinsic prong" of comparing the substantial similarity of computer programs in copyright infringement cases. *Amici* are particularly concerned with the impact of this split on the orderly development and functioning of copyright law and the adjudication of copyright disputes in a significant area of the economy, computer software.

¹ Pursuant to Rule 37.2(a), counsel for both parties received notice of intent to file this brief at least 10 days before its due date. The parties have consented to the filing of this brief; their written consents are on file with the Clerk. No counsel for a party authored this brief in whole or in part, and no party or counsel for a party made a monetary contribution intended to fund its preparation or submission. No person other than the *amici* or their counsel made a monetary contribution to the preparation or submission of this brief.

SUMMARY OF ARGUMENT

In affirming the district court's judgment as a matter of law in favor of Defendant-Respondent, the court below relied on circuit precedent that a jury examining the substantial similarity between two computer programs under the intrinsic prong of the test for copyright infringement had to compare the works without the aid of expert testimony. App. 8a-9a & n.4. The panel acknowledged that other circuits had moved away from this prohibition for "technical works such as computer programs," but it held it was nonetheless bound by precedent and any change would have to come from an en banc court. *Id.* at 9a, n.4. It subsequently denied a petition for rehearing en banc.

The Ninth Circuit is alone in prohibiting expert testimony to aid lay juries comparing complex, highly technical software code. Its rule directly conflicts with those of at least two other circuits that expressly allow for juries to be guided by expert testimony in making such comparisons. Its rule also effectively conflicts with those of several other circuits that permit expert assistance to juries comparing complex, technical works other than software.

The Ninth Circuit's rigid adherence to a rule developed before the emergence of the modern software industry is deeply problematic today. The rule forces lay juries to make complex comparisons of highly technical computer code—material that is impenetrable and incomprehensible to them, as a novel in Russian would be incomprehensible to someone who reads only English—without any guidance or translation from an expert.

Without the ability to decipher or understand what is being compared and whether the comparison is even of copyrightable expression, the result is likely to be an arbitrary, ill-informed, decision that is antithetical to the very premise of the infringement analysis. Such flawed decisions can have the effect of expanding the effective scope of copyright protection in computer programs, contrary to established law and the public interest. And such decisions are antithetical to the proper operation of the fact-finding process itself, leading to uncertainty and arbitrary outcomes well beyond the present case, affecting other companies in the software industry and software innovation generally.

The Ninth Circuit's expert rule and the resulting circuit split are particularly significant. Because a large portion of the nation's software industry is located in the Ninth Circuit, its rules are particularly important in controlling the adjudication of many software copyright disputes. The lack of uniformity and uncertainty over how unlawful copying of software will be determined harms both copyright plaintiffs and defendants, who cannot be assured of a principled, factually accurate outcome, as well as new entrepreneurs and innovators who need reliable rules to guide their software development activities.

This case provides an excellent vehicle for resolving the circuit split and bringing certainty and uniformity to an issue of national importance to the copyright system and the economy. The legal issue is straightforward and cleanly presented, it has been carefully considered by a number of circuits over a fairly long period of time, further percolation would not be helpful, and the issue can only be resolved by

this Court. Accordingly, *amici* urge the Court to grant certiorari.

ARGUMENT

I. The Decision Below Perpetuates a Fundamental Disagreement Between the Ninth Circuit and Other Circuits About How to Prove Unlawful Copying of Computer Code

The decision below affirmed the Ninth Circuit's rule that expert testimony is not allowed to assist juries in assessing the similarity of works, including technical works such as computer programs, under the so-called "intrinsic" test. App. 8a-9a- & n.4 (citing *Brown Bag Software v. Symantec Corp.*, 960 F.2d 1465, 1478 (9th Cir. 1992)). This prohibition is grounded in the Ninth Circuit's two-pronged test for substantial similarity first articulated in *Sid & Marty Krofft Television Prods., Inc. v. McDonald's Corp.*, 562 F.2d 1157 (9th Cir. 1977) ("*Krofft*"). Under the extrinsic prong of that test, allegedly infringing and infringed works are to be compared using specific external criteria for which "analytic dissection and expert testimony are appropriate." *Id.* at 1164. Under the intrinsic prong, a jury or other fact-finder then compares the works using "the response of the ordinary reasonable person" as its sole basis. *Id.* On this question, the *Krofft* court concluded that "analytic dissection and expert testimony are not appropriate." *Id.*

The Ninth Circuit's categorical prohibition on expert testimony is based on a misreading of the Second Circuit's decision in *Arnstein v. Porter*, 154 F.2d 464 (2d Cir. 1946), which had adopted its own

two-step test. See *Krofft*, 562 F.2d at 1165. *Krofft*'s conclusion that expert testimony is "not appropriate" under the intrinsic prong of the test was adopted from the Second Circuit's observation that "expert testimony [is] irrelevant" on the second prong of its test. *Id.* at 1164 (quoting *Arnstein*).

The *Arnstein* court, however, did not altogether preclude the use of expert testimony during the actual comparison of the two works, even where the issue was to be determined by a jury. To the contrary, the court emphasized that expert testimony (there from trained musicians) could instead perform an important role to aid the fact-finder in assessing the responses of the intended audience (music listeners) for the work. *Arnstein*, 154 F.2d at 473. The court explicitly determined that use of expert testimony may be appropriate in aiding the fact-finder even under the second prong. *Id.*

In any event, the Second Circuit itself later moved away from *Arnstein* and expressly embraced the use of expert testimony to aid comparisons of computer software. See *Computer Assocs. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 713 (2d Cir. 1992); Section II.A., *infra*.

Other panels of the Ninth Circuit have since modified elements of the *Krofft* test. See, e.g., *Shaw v. Lindheim*, 919 F.2d 1353 (9th Cir. 1990); *Apple Computer v. Microsoft Corp.*, 35 F.3d 1435 (9th Cir. 1994), but the Circuit has retained *Krofft*'s prohibition on the use of expert testimony to aid fact-finders under the intrinsic prong of the test.

The *Krofft* rule was instituted well before the emergence of the modern software industry. But the Ninth Circuit since *Krofft* has *extended* its

prohibition on the use of expert testimony for the intrinsic test even to cases involving complex, technical expression such as computer software. *See* App. 8a-9a & n.4; *Brown Bag Software*, 960 F.2d at 1475. *See, also, Broderbund Software, Inc. v. Unison World, Inc.*, 648 F.Supp. 1127, 1136 (N.D. Cal. 1986). The circuit has done so even though, in the case of technical works like computer software, a lay fact-finder is effectively incapable of comprehending or comparing the works on its own without expert assistance.

A. Only the Ninth Circuit Prohibits Experts from Assisting the Fact-finder in Comparing Software Code

The Ninth Circuit stands alone in refusing to permit expert testimony to assist juries in determining under the intrinsic test whether an allegedly infringing computer program is substantially similar to another program. Other circuits considering infringement of computer code or other highly technical, complex works permit expert testimony to guide the comparison, sometimes as part of the intrinsic test and sometimes under a separate “intended audience” analysis. *See* Mark Lemley, *Our Bizarre System for Proving Copyright Infringement*, 57 J. Copyright Soc’y U.S.A. 719, 733 (2010). The complexity of expression such as computer software has compelled these circuits to reject the categorical prohibition and allow expert testimony to guide the fact-finder’s comparison.

At least two circuits explicitly disagree with the Ninth Circuit and permit the use of expert testimony to assist in comparing software code in infringement cases.

Second Circuit. In the landmark *Altai* case, the Second Circuit moved away from *Arnstein* and held that the prohibition on expert testimony was inapplicable to comparisons of computer software under the second prong because “we cannot disregard the highly complicated and technical subject matter at the heart of these claims” 982 F.2d at 713. The court observed that “computer programs are likely to be somewhat impenetrable by lay observers—whether they be judges or juries—and, thus, seem to fall outside the category of works contemplated by those who engineered the *Arnstein* test.” *Id.*

Consequently, the *Altai* court concluded that “on substantial similarity with respect to computer programs, we believe that the trier of fact need not be limited by the strictures of its own lay perspective” and it was at “the discretion of the district court to decide to what extent, if any, expert opinion, regarding the highly technical nature of computer programs, is warranted in a given case.” *Altai*, 982 F.2d at 713. While *Altai* neither mandates nor prohibits expert testimony in the comparison of computer programs, it expressly *permits* expert testimony at the discretion of the district court.

The Ninth Circuit’s contrary rule makes precisely the error the Second Circuit warned against in *Altai*; it “disregard[s] the highly complicated and technical subject matter” involved and demands the impossible of lay juries; that they comprehend such “impenetrable” material without assistance. *See Altai*, 982 F.2d at 713. This fundamental split between the Ninth and Second Circuits represents, by itself, a significant conflict because of the large number of copyright cases, particularly those

involving computer software, adjudicated in those two circuits. But additional circuits also disagree, both directly and implicitly, with the Ninth Circuit's approach.

Third Circuit. The Third Circuit has concluded that the *Arnstein* ordinary observer test, on which the *Krofft* opinion is based, was “not useful and is potentially misleading when the subjects of the copyright are particularly complex, such as computer programs.” *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1233 (3d Cir. 1986). The Third Circuit recognized that “the ordinary observer test, which was developed in cases involving novels, plays, and paintings, and which does not permit expert testimony, is of doubtful value in cases involving computer programs on account of the programs' complexity and unfamiliarity to most members of the public.” *Id.* at 1233. As a result, the circuit rejected the Ninth Circuit's *Krofft* rule and joined “the growing number of courts which do not apply the ordinary observer test in copyright cases involving exceptionally difficult materials, like computer programs, but instead adopt a single substantial similarity inquiry according to which *both lay and expert testimony would be admissible.*” *Id.* (emphasis added).²

² *Whelan's* treatment of the idea/expression dichotomy in computer software has been sharply criticized, but not its separate recognition of the appropriateness of expert assistance in comparing computer code.

At least two more circuits have essentially adopted *Altai*'s test for comparing the similarity of works of computer code, which includes the use of expert testimony, though they have been less explicit than the Second and Third Circuits about the role of experts.

Tenth Circuit. The Tenth Circuit has “[i]n substantial part . . . adopt[ed]” the *Altai* test. *Gates Rubber Co. v. Bando Chem. Indus., Ltd.*, 9 F.3d 823, 834 (10th Cir. 1993). Although *Gates Rubber* did not explicitly address expert testimony at all stages of the test, *Altai* allows such testimony, and the *Gates Rubber* court endorsed use of experts in at least some of the inquiry. *Id.* at 834-35 (“in most cases we foresee that *the use of experts will provide substantial guidance to the court* in applying an abstractions test”) (emphasis added).

Fifth Circuit. The Fifth Circuit also has adopted the *Altai* test, though it did not explicitly address the use of experts to aid comparison. *Engineering Dynamics, Inc. v. Structural Software, Inc.*, 26 F.3d 1335, 1342 (5th Cir. 1994), *opinion supplemented on denial of reh’g*, 46 F.3d 408 (5th Cir. 1995) (adopting the *Gates Rubber* and *Altai* abstraction-filtration-comparison method of determining copyright protection for computer programs, which permits the use of expert testimony).

In addition, three more circuits have approved the use of expert testimony to evaluate substantial similarity in cases involving difficult or complex works other than software. Despite their slightly different contexts, these holdings fundamentally conflict with the Ninth Circuit’s expert rule. Their reasoning for permitting the use of experts in

somewhat less-complex comparisons involving music, technical drawings, or architectural works would necessarily apply with even greater force to cases of computer code involving even more complex, specialized, and technical comparisons.

Fourth Circuit. The Fourth Circuit firmly rejected the approach of refusing to permit expert testimony, noting that “only a reckless indifference to common sense would lead a court to embrace a doctrine that requires a copyright case to turn on the opinion of someone who is ignorant of the relevant differences and similarities between two works.” *Dawson v. Hinshaw Music Inc.*, 905 F.2d 731, 735 (4th Cir. 1990). Instead, it endorsed a version of the two-prong test used by the Ninth Circuit, but where the “ordinary observer” is replaced with the “intended audience” of the work, and the fact-finder may rely on expert testimony. *Id.* at 736 (“When conducting the second prong of the substantial similarity inquiry, a district court must consider the nature of the intended audience of the plaintiff’s work. . . . Such an inquiry may include, and no doubt in many cases will require, admission of testimony from members of the intended audience *or, possibly, from those who possess expertise with reference to the tastes and perceptions of the intended audience.*”) (emphasis added). And though the works at issue were musical, the *Dawson* court noted that the trend towards allowing expert testimony for complex subject matter was forced by “the advent of computer programming infringement actions.” *Id.* at 736.

Sixth Circuit. The Sixth Circuit addressed the issue in the context of patent drawings. *See Kohus v. Mariol*, 328 F.3d 848 (6th Cir. 2003). Its two-step

test contemplates use of expert testimony; in its second step, “the trier of fact should make the substantial similarity determination from the perspective of the intended audience. *Expert testimony will usually be necessary to educate the trier of fact* in those elements for which the specialist will look.” *Id.* at 857 (emphasis added).

First Circuit. The First Circuit uses a traditional “ordinary observer” test. However, in at least one case involving architectural works, it recognized that “*the need for expert testimony may be greater in cases involving complex subject matters* where an ordinary observer may find it difficult to properly evaluate the similarity of two works without the aid of expert testimony.” *T-Peg, Inc. v. Vermont Timber Works, Inc.*, 459 F.3d 97, 116 (1st Cir. 2006) (emphasis added). It then explicitly “[e]ft to the district court the determination of whether this may be a case in which expert testimony would be helpful on the issue of substantial similarity.” *Id.* at 116 (reversing the district court’s decision in part for rejecting expert testimony on substantial similarity).³

³ Although *T-Peg* endorses a rule that allows use of experts in some circumstances, at least one later First Circuit opinion indicates that the issue is not fully settled. See *Airframe Sys., Inc. v. L-3 Commc’ns Corp.*, 658 F.3d 100, 106 (1st Cir. 2011) (“Where, as here, the copyrighted work involves specialized subject matter such as a computer program, some courts have held that the ‘ordinary observer’ is a member of the work’s ‘intended audience’ who possesses ‘specialized expertise.’ . . . This court has yet to directly address this issue, and it is unnecessary to do so here.”) (citing *Dawson*, *Kohus*, *Altai*, and *Whelan*) (additional citations omitted).

Finally, at least one additional circuit has noted the trend of allowing expert testimony for comparison of complex works like software, though without explicitly addressing the issue. *See Sturdza v. United Arab Emirates*, 281 F.3d 1287, 1300-01 (D.C. Cir. 2002) (noting that “[a] growing number of courts now permit expert testimony regarding substantial similarity in cases involving computer programs, reasoning that such testimony is needed due to the complexity and unfamiliarity of computer programs to most members of the public” and remanding for further development) (quotation omitted).

B. The Ninth Circuit Acknowledges the Circuit Split Its Decisions Have Created

The Ninth Circuit itself has recognized that its rule is in conflict with those of other circuits. In the decision below, the panel acknowledged that Petitioner “is not alone in contending that experts should be allowed to help juries assess the holistic similarity of technical works such as computer programs,” citing Judge Sneed’s concurrence in *Brown Bag Software* and the Second Circuit’s *Altai* decision. App. 9a n.4. In that concurrence, Judge Sneed noted the “poor analytic structure” of the Ninth Circuit’s position and suggested that expert testimony should be admissible during the comparison process. *See* 960 F.2d at 1478.

Moreover, *Altai*’s framework for analyzing computer software has been cited with approval in the circuit, even if its rule on expert testimony has not been expressly endorsed. *See, e.g., Sega Enterps. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1524-25 (9th Cir. 1992). *See also Broderbund Software, Inc. v. Unison World, Inc.*, 648 F.Supp. 1127, 1136 (N.D.

Cal. 1986) (noting that, while “an integrated test involving expert testimony and analytic dissection may well be the wave of the future in this area,” the Ninth Circuit’s rule “clearly marked out in *Krofft*” precludes such a result).

The Ninth Circuit’s pre-*Brown Bag Software* decision in *Johnson Controls, Inc. v. Phoenix Control Systems, Inc.*, 886 F.2d 1173 (9th Cir. 1989), implicitly identified the need for such a standard when it noted that for computer programs, the reasonable person who matters for the comparison is not merely the ordinary reasonable person, but instead “a reasonable person in the intended audience” because the intended audience for computer programs is an expert, technically-knowledgeable, audience. *See id.* at 1176 n.4.

Yet, as the case below demonstrates, the Ninth Circuit has steadfastly refused to adopt the rule of *Altai* and other circuits that recognizes the common-sense need for, and thus permits, expert testimony in cases involving computer software and other complex works. This refusal has resulted in the current deep and widening split with other circuits on a question of national importance.

II. The Circuit Split Involves an Important Question of Federal Law That Has Significant Impact on a Major National Industry and on Innovation Generally

The software industry is a source of tremendous innovation and a substantial contributor to the American economy. It is also an industry in which copyright protection often plays a significant role and is frequently litigated.

A well-crafted and uniform approach to determining whether software has been unlawfully copied for infringement purposes is critical to the effective and balanced operation of the copyright system. Such an approach requires juries that are properly informed and guided in understanding the otherwise inaccessible and impenetrable complexity of computer code, rather than juries that are uninformed and forced to resort to little more than a metaphorical coin toss to make their comparison.

A. The Circuit Split Undermines the Rationality and Proper Operation of the Copyright System

The circuit split perpetuated by the Ninth Circuit’s prohibition on expert testimony to guide a fact-finder’s comparison of computer programs undermines the rationality and working of the copyright system in several respects. *See* Lemley, *Our Bizarre System*, *supra*, at 739-40; Shyamkrishna Balganesh, *The Questionable Origins of the Copyright Infringement Analysis*, 68 *Stan. L. Rev.* 791, 855-58 (2016).

i. The Ninth Circuit’s Prohibition on Expert Testimony Encourages Uninformed Comparisons of Two Works Resulting in Arbitrary Decisions by Lay Fact-finders

The Ninth Circuit’s expert prohibition puts fact-finders—usually lay juries—in the impossible position of needing to decipher incomprehensible software code during their assessment of similarity. Computer programs embody complex, technical expression that is “unfamiliar[] to most members of

the public,” *Whelan*, 797 F.2d at 1232, and “impenetrable by lay observers—whether they be judges or juries,” *Altai*, 982 F.2d at 713. Requiring lay fact-finders to compare the bare expression of the two computer programs side-by-side without the aid of testimony on the meaning of such technical expression is indeed “reckless indifference to common sense.” It is tantamount to asking the fact-finder to compare two works written in a foreign language, without understanding that language or even having the aid of a dictionary.

In cases where the fact-finder is unable to comprehend the expression at issue, this comparison may result in an arbitrary, ill-informed decision that is antithetical to the very premise of the infringement analysis (and of the fact-finding process itself). Additionally, since this decision is ordinarily made by a jury it is not easily amenable to judicial review. Lemley, *Our Bizarre System supra*, at 739; Balganesch, *supra*, at 857.

Indeed, in the *Arnstein* case, relied on by *Krofft*, the court recognized that it was futile to utilize fact-finders for the comparison when they were incapable of comprehending the works at issue in the first place. *See Arnstein*, 154 F.2d at 473 n.22 (giving the example that it would be “proper to exclude tone-deaf persons from the jury” when the comparison is of musical similarity). Similarly, it makes little sense to have lay fact-finders undertake a comparison of complex, technical expression in computer programs where they are not empowered with the capacity to understand the works they are to compare. *See Pamela Samuelson, A Fresh Look at Tests for Nonliteral Copyright Infringement*, 107 Nw. L. Rev.

1821, 1844-45 (2013) (acknowledging concerns with the use of experts but recommending “giving trial courts discretion to allow expert testimony in appropriate cases . . . as in cases involving software or otherwise inaccessible subject matters.”).

ii. The Ninth Circuit’s Prohibition on Expert Testimony Also Encourages the Comparison to Cover Unprotected Elements in the Work and Thereby Unduly Expand the Scope of Copyright Protection

Prohibiting expert assistance in complex computer code comparisons allows lay fact-finders to altogether ignore considerations relating to the scope of protected expression in their comparison of two works. *See* Mark A. Lemley & Mark P. McKenna, *Scope*, 57 Wm. & Mary L. Rev. 2198, 2232-39 (2016); Lemley, *Our Bizarre System supra*, at 739-40. Determining the scope of protected expression in a computer program is a complex exercise because not all parts of the program obtain copyright protection. *See Johnson Controls*, 886 F.2d at 1175 (“Whether the non-literal components of a program, including the structure, sequence and organization and user interface, are protected depends on whether, on the particular facts of each case, the component in question qualifies as an expression of an idea, or an idea itself.”); *Altai*, 982 F.2d at 703, 707-10 (noting the importance of determining “the scope of copyright protection that extends to a computer program’s non-literal structure” and eliminating elements based on efficiency, external factors, and those in the public domain); *Oracle America, Inc. v. Google Inc.*, 750 F.3d 1339, 1356 (Fed. Cir. 2014) (observing that ideas and

unoriginal expression are unprotected parts of a computer program).

To eliminate the unprotected elements from consideration, courts must disaggregate a computer program into its constituent parts and permit a finding of infringement only if the defendant copied protectable expression rather than uncopyrightable ideas, systems, or processes. In the Ninth Circuit that dissection is for the judge, not a jury. *Brown Bag Software*, 960 F.2d at 1475-76 (validating the court's "analytic dissection" of a computer program under the extrinsic test to determine the "scope" of protection); *Johnson Controls*, 886 F.2d at 1175-76 (affirming the district court's analysis of copyrightability for a computer program).

The judge relies on expert testimony in dissecting the work to remove the uncopyrightable elements before the fact-finder's comparison of the works under the intrinsic prong. *Brown Bag Software*, 960 F.2d at 1474-5. Yet, when the jury is subsequently asked to compare the programs for their similarity under the intrinsic prong, the prohibition on expert assistance denies it access to the very testimony that may be crucial to delineating the scope of the protected work under the initial analysis.

Without expert guidance on the scope question, there is a risk that juries will include significant unprotected parts of a computer program in their comparison and will find the two works to be similar even where such similarity relates substantially to

the unprotected parts of a work.⁴ See Lemley, *Our Bizarre System*, *supra*, at 739 (“Without the benefit of expert testimony ... judges and juries are more likely to find infringement in dubious circumstances, because they aren’t properly educated on the difference between protectable and unprotectable elements.”). This erroneous inclusion expands the effective scope of copyright protection in computer programs, contrary to established law and the public interest. See Christopher Buccafusco and Mark A. Lemley, *Functionality Screens*, ___ Va. L. Rev. (forthcoming); Stanford Public Law Working Paper No. 2888094 (December 20, 2016), *available at* <https://ssrn.com/abstract=2888094> or <http://dx.doi.org/10.2139/ssrn.2888094> (difficulties juries face in separating expression from function, especially in works like computer software, “will tend towards over-protection” of such works and “generate substantial competition costs.”).

B. The Large Number of Software Companies and Software Copyright Cases in the Ninth Circuit Heightens the Negative Impact of Its Rule

The Ninth Circuit’s erroneous rule has a disproportionate impact on copyright litigation and

⁴ When the finder of fact is the same as the decision-maker on the extrinsic test (e.g., during a bench trial or on a motion) the categorical prohibition produces an even greater absurdity since it then requires the finder of fact to effectively “forget” the expert testimony lawfully received in the first step. *Whelan Assocs., Inc. v. Jaslow Dental Lab., Inc.*, 797 F.2d 1222, 1232-33 (3d Cir. 1986).

on the software industry and innovation. The Ninth Circuit is particularly important for the adjudication of software copyright disputes because an outsized portion of the software industry is located there, much of it in California's Silicon Valley and Washington's Seattle region.

The Ninth Circuit's rule, which relegates juries in the numerous software copyright disputes in that circuit to comparing incomprehensible software code without the benefit of expert assistance, will have an outsized harm on companies that produce software—be they potential plaintiffs or defendants. This harm is greater than the harm a similarly flawed rule in another circuit with less of a software industry and less software copyright litigation would have. Yet while other circuits have moved toward sensible rules that ensure an informed and capable fact-finding process, the Ninth Circuit has persisted with its rule that leaves fact-finders largely in the dark in making code comparisons in software copyright cases.

The uncertainty and arbitrary outcomes created by the Ninth Circuit's rule extend well beyond the present case. They potentially harm not only other companies currently creating or selling software but also software innovation generally, which can be particularly sensitive to the operation of the copyright system.

C. A Consistent National Approach to Determining If Software Has Been Unlawfully Copied Is Important to the Software Industry and to Innovation Generally

Differential treatment of software copyrights across circuits harms anyone who develops or uses

software—in other words, everyone. As the House Judiciary Committee explained in passing the Copyright Act of 1976, uniformity isn't just better—it's part of the *core purpose* of federal copyright law:

One of the fundamental purposes behind the copyright clause of the Constitution . . . was to promote national uniformity and to avoid the practical difficulties of determining and enforcing an author's rights under the differing laws and in the separate courts of the various States. Today, when the methods for dissemination of an author's work are incomparably broader and faster than they were in 1789, national uniformity in copyright protection is even more essential than it was then to carry out the constitutional intent.

H.R. Rep. No. 94-1476 at 129 (1976), reprinted in 1976 U.S.C.C.A.N. 5659. The Ninth Circuit's misguided rule and its conflict with other circuits undermines that uniformity for many software copyright cases, adding uncertainty and unnecessary cost to one of the country's important economic sectors.

With the advent of the internet, software has become even more important and widely disseminated than Congress could have predicted in 1976. Software companies often have operations and employees in multiple circuits, and commonly do business nationwide. But the circuit split caused by the Ninth Circuit's rule means that, if a software developer is accused of infringing another's copyrighted code, far too much turns on the circuit in

which the lawsuit is filed. In several circuits, a jury will determine unlawful copying assisted by computer experts, as it would do in any other area of law where specialized knowledge is required, but in the Ninth Circuit the developer will be at risk of a highly arbitrary and erroneous outcome because copying must be judged by a lay jury with no expert assistance.

The circuit split also may allow plaintiffs with weak cases of similarity and copying to forum shop to take advantage of a rule that keeps juries uninformed about and unable to comprehend critical technical details. The concentration of software companies in the Ninth Circuit means a plaintiff will often be able to choose to file suit there. The circuit's prohibition on expert assistance in resolving the similarity analysis may raise the risk that even a weak infringement case, with little genuine similarity between software code, may succeed. Defendants, knowing this, may choose to settle rather than roll the dice.

On the other hand, legitimate software developers with meritorious claims of copying of computer code may be deterred from suing in the Ninth Circuit to vindicate their rights because of the difficulty of demonstrating substantial similarity without the assistance of an expert. Neither of these outcomes is healthy for innovation, the software industry or the rationality and proper operation of our federal copyright system.

III. This Case Presents an Excellent Vehicle to Resolve the Circuit Split

This case is a proper vehicle for addressing the circuit split because the relevant legal issue is clearly

and cleanly presented, the positions of the circuits have become well-developed over a long period of time, and the Ninth Circuit has demonstrated its unwillingness to reconsider its rule en banc to try to resolve the circuit split.

A. This Case Squarely Presents a Fundamental Disagreement Among Circuits Over a Clear, Straightforward Legal Issue

The issue raised by this case is straightforward: when comparing original and allegedly infringing software code to determine if there was misappropriation of protected elements, can an expert assist the jury with that comparison, or is the jury limited to its lay understanding—which is likely to be effectively none—of software code? The Ninth Circuit has barred expert assistance. Every other circuit to address the issue directly has permitted expert assistance and several additional circuits have strongly indicated in analogous contexts that they will do so as well when the specific issue arises.

B. This Important Issue Has Percolated Thoroughly Among the Circuits and Needs to be Resolved by this Court

The current circuit split on the role of expert testimony in assessing similarity in cases involving computer software code is longstanding. Some of the decisions are now 25 years old. The positions taken by various circuits giving rise to the split have evolved over time, particularly as the software industry has emerged and matured, and are now carefully considered and well-developed. The decisions of circuits other than the Ninth are well-

reasoned and grounded in a common-sense recognition of the differences between comparing complex computer code and comparing straightforward works such as costumed characters, art, and books. These decisions also recognize the practical impossibility of asking lay fact-finders to attempt to compare complex works that are effectively incomprehensible to them, such as computer source code. Thus, the issues are unlikely to benefit from additional time to further percolate.

Nor is the split likely to be resolved other than by this Court. The Ninth Circuit has had ample time and opportunity since *Brown Bag Software* to reconsider its position and reconcile its sharp divergence from other circuits and its disconnect from the reality jurors face when comparing unintelligible software code. During oral argument in the Ninth Circuit in the case below, one of the judges on the panel said, regarding the Ninth Circuit's unwillingness to allow expert, "I think that's a nutty rule," and "we may have been nutty all these years." https://www.ca9.uscourts.gov/media/view_video.php?pk_vid=0000009278 Oral Argument Citation 25:11-25:26; 26:34-26:42.

But that judge and the panel understood themselves to be bound by Ninth Circuit precedents and recognized that changes to the rule regarding expert testimony in comparisons of complex works like computer programs would have to be resolved en banc. See *id.* at 27:40-28:06; App. 9a n.4. Nevertheless, the circuit declined the Petitioner's request to reconsider the issue en banc, thus foregoing a ready opportunity to bring its rule in line with other circuits and with the realities of proving

copying in complex technical areas like computer software. Consideration by this Court is necessary to resolve the split.

C. The Failure-of-Proof Identified by the Opinion Below Does Not Undermine the Suitability of the Expert Question for Certiorari

After reiterating the *Brown Bag Software* prohibition on the use of expert testimony, the decision below concluded that, because Petitioner did not introduce into evidence the actual source code of the video games at issue, there had been a failure of proof. App. 8a-10a. Because this conclusion rests on the expert witness prohibition, however, it does not undermine the appropriateness of this case as a vehicle for resolving the circuit split on the question of such a prohibition.

The panel below identified three reasons for its conclusion that Petitioner needed to introduce the source code in order to prevail. The first was that the admitted evidence demonstrated access and possibly motive, but not “that the protected portions of the works are substantially similar.” App. 8a. (quotation omitted). But of course, if expert testimony were allowed on substantial similarity, that testimony could have provided the missing evidence.

The second reason was merely a restatement of the expert rule: expert testimony can satisfy the plaintiff’s burden of production under the extrinsic test, but not the intrinsic test. App. 8a-9a. The final reason was that the lay testimony in the case did not address copying of the code itself, but only the game’s audiovisual appearance. App. 9a-10a. Again, however, if expert testimony were allowed, any

defects in the lay testimony might have been cured by the expert.

Because all three reasons given for why the evidence was insufficient could effectively have been addressed had the circuit rule permitted expert testimony, the failure-of-proof finding does not undermine this case's suitability as a vehicle for examining the Ninth Circuit's rule and for resolving its conflict with other circuits.

CONCLUSION

For the foregoing reasons, this Court should grant certiorari to resolve the direct and substantial circuit split on a matter of substantial national importance.

Respectfully submitted,

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September 1, 2017

APPENDIX

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