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Evan Weidner

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# **A Little Overlap Never Hurt Anyone: Overlapping IP Rights and *Oracle Am., Inc. v. Google LLC***

*Evan Weidner*\*

## ABSTRACT

Intellectual property (“IP”) protections have traditionally been mutually exclusive; an innovator who obtains one type of protection could not obtain another on the same invention. Though the possibility of overlapping IP rights has changed substantially over the years, the general opinion remained one of disapproval until recently. In *Oracle Am., Inc. v. Google LLC*, the Federal Circuit voiced approval of overlapping IP rights. This article examines the history of overlapping IP rights and advocates that the Federal Circuit’s acceptance of such an overlap is the proper standard.

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\* B.S. Mechanical Engineering, University of Missouri, 2018; Patent Agent, Registration No. 78,455; J.D. Candidate, University of Missouri School of Law, 2021. I would like to thank Zachary Meyer for his guidance. Special thanks to Professor Dennis Crouch for his insight, wisdom, support, and boundless enthusiasm during the process of writing this article.

## I. INTRODUCTION

The domains of copyright and patent laws, specifically utility patent laws, have traditionally remained separate in the kinds of innovation they regulate.<sup>1</sup> Copyright is intended to protect “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>2</sup> Utility patents, however, are intended to protect new and useful technologies such as machines, processes, manufactures, and compositions of matter.<sup>3</sup> The Supreme Court has previously discussed the distinction between copyright and patent protections.<sup>4</sup> Though the differences between copyrights and utility patents are clear, there are conflicting opinions about overlapping these intellectual property (“IP”) protections.<sup>5</sup>

In 2018, the Court of Appeals for the Federal Circuit issued the most recent opinion in *Oracle Am., Inc. v. Google LLC*.<sup>6</sup> Though the decision solely addressed the issue of fair use in copyright law,<sup>7</sup> the initial case saw Oracle asserting both copyright and patent protections in response to the same infringing action by Google.<sup>8</sup> This article discusses the court allowing Oracle to assert overlapping IP protections and argues that courts should allow parties to overlap various IP protections—so long as they are careful not to conflate the standards for obtaining protections provided by each kind of IP protection.

Part II of this article summarizes the procedural history of the *Oracle* case. Part III examines previous legal guidance on the issue of overlapping IP protections, including case law and a well-respected treatise on copyright. Part IV provides an in-depth discussion of the differences between patent and copyright protections, as well as how appropriate judicial interpretation and care at the U.S. Copyright Office can preclude some of the risks associated with overlapping IP rights. Finally, Part V argues that the Federal Circuit expressed the appropriate relationship between patent and copyright protections, and that allowing innovators to place their creations within multiple statutory classes, so long the protections are warranted, furthers the goal of the “Intellectual Property Clause” by providing a greater reward for innovation, thus further incentivizing the “Progress of [s]cience and useful [a]rts . . . .”<sup>9</sup>

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1. The U.S. Constitution distinguishes between copyright and patent, allowing for Congress to “secur[e] for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” U.S. CONST. art. I, § 8, cl. 8.

2. 17 U.S.C. § 102(a) (2012).

3. 35 U.S.C. § 101 (2012).

4. See *Baker v. Selden*, 101 U.S. 99 (1879) (holding that the protections sought by the plaintiff were the domain of patent law and could not be obtained through copyright alone).

5. See *Fulmer v. U.S.*, 103 F. Supp. 1021 (1952) (treating some aspects of IP as copyrightable and others as patentable); *but see* *Louis Dejonge & Co v. Breuker & Kessler Co*, 182 F. 150, 152 (C.C.E.D. Pa. 1910) (“Since it was qualified for admission into the two statutory classes, I see no reason why it might not be placed in either. But it could not enter both. The method of procedure, the term of protection, and the penalties for infringement, are so different that the author or owner of a painting that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by the decision.”).

6. *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179 (Fed. Cir. 2018).

7. *Id.* at 1190.

8. *Oracle Am., Inc. v. Google Inc.*, 872 F. Supp. 2d 974, 975 (N.D. Cal. 2012).

9. U.S. CONST. art. I, § 8, cl. 8.

## II. FACTS AND PROCEDURAL HISTORY OF *ORACLE V. GOOGLE*

The United States District Court for the Northern District of California handed down the first opinion in the *Oracle v. Google* issue in 2012. The case arose from Google's use of the Java language, specifically Oracle's Application Programming Interfaces ("APIs") in creating Google's Android platform.<sup>10</sup> Though Google did discuss the possibility of obtaining a license from Sun Microsystems for the use of Java,<sup>11</sup> the parties failed to reach an agreement.<sup>12</sup> This prompted Google to use the Java language anyway—without permission—to design its own virtual machine. This was achieved by copying 37 API packages, including the name, organization, and functionality, from Java.<sup>13</sup> Oracle filed its lawsuit in 2010, alleging that Google's Android platform infringed both Java-related patents and copyrights.<sup>14</sup> The complexity of the case prompted the court to decide that the jury would be more likely to follow along if the trial were conducted in three phases: the first phase would discuss copyrightability and copyright infringement; the second phase would discuss patent-related aspects of the case; and the third phase (which was precluded by the verdict) would deal with damages.<sup>15</sup> At the conclusion of the trial, the jury was responsible for deciding issues of infringement and fair use, while the judge decided the issue of copyrightability and Google's equitable defenses.<sup>16</sup>

The jury found no copyright infringement and no patent infringement.<sup>17</sup> The judge ruled that an API was not copyrightable, stating that "it is nevertheless a command structure, a system or method of operation—a long hierarchy of over six thousand commands to carry out pre-assigned functions. For that reason, it cannot receive copyright protection; however, patent protection may still be possible."<sup>18</sup> This ruling comes from 17 U.S.C. § 102(b), which excludes processes and systems from copyright protection; copyright is meant to protect "expression," while patents protect new and useful inventions or processes.<sup>19</sup> The ruling of the court was not extended to cover the issue of patentability.<sup>20</sup>

The case was appealed by both parties to the United States Court of Appeals for the Federal Circuit, but the patent claims were no longer at issue.<sup>21</sup> After deliberating, the Federal Circuit reached a conclusion on copyrightability contrary to that of the previous court.<sup>22</sup> When considering the copyrightability of an API, the Federal Circuit stated, "[s]ection 102(b) does not bar the packages from copyright protection just because they also perform functions."<sup>23</sup> Though the patent claims were not at issue in this appeal, Google argued that the subject matter should only be

10. *Oracle Am., Inc.*, 872 F. Supp. 2d at 978.

11. Sun Microsystems developed Java in 1996 and was obtained by Oracle Corporation in 2010. *See id.* at 975, 977–78.

12. *Id.* at 978.

13. *Id.* at 977–78.

14. *Id.* at 975.

15. *Id.*

16. *Id.*

17. *Id.* at 976.

18. *Id.* at 999–1000.

19. *See* 17 U.S.C. § 102(b); 35 U.S.C. § 101 (1952).

20. *Oracle Am., Inc.* 872 F. Supp. at 976.

21. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1347 (Fed. Cir. 2014).

22. *Id.* at 1381.

23. *Id.* at 1368. (17 U.S.C. § 102(b) details the subject matter of copyright, enumerating several protected categories and excluding several others.)

protectable by patent.<sup>24</sup> The Federal Circuit rejected this contention, declining to set precedent that computer programs are protectable only through patent, and citing several critics who argue that copyright is a more appropriate medium for protecting software.<sup>25</sup> The court's decision effectively allows programming to be classified as a type of creative endeavor, the product of which may be creative enough to earn copyright protection instead of a purely functional product only suitable for patent protection. With the decision that an API is copyrightable subject matter, the case then rested on whether Google's use of the API could be considered fair use—a question to be answered by the Northern District of California.<sup>26</sup>

On remand in 2016, a jury once again found for Google, stating that here, the company's use of the Java APIs fell within the fair use defense.<sup>27</sup> In response, Oracle argued that no reasonable jury could have come to a finding of fair use and moved for judgment as a matter of law.<sup>28</sup> The court then analyzed the four fair use factors: (1) the purpose and character of the use, (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.<sup>29</sup> After interpreting these factors in light of the facts at issue, the court held that a reasonable jury could have found fair use and denied Oracle's motion.<sup>30</sup>

Oracle once again appealed the case to the Federal Circuit from the district court's final judgment, denial of judgment as a matter of law, and denial of Oracle's motion for a new trial.<sup>31</sup> The Federal Circuit examined each factor of the fair use affirmative defense at length, starting with the purpose and character of the use.<sup>32</sup> Despite Google's arguments that Android was free under an open-source license, and that Google made its money from advertisements instead of the Android system itself, the court held that giving a product away for free does not preclude a finding of commercial use: Google's use could be—and ultimately was—commercial (a fact which, in turn, weighed *against* a finding of fair use).<sup>33</sup> Additionally, the court found that since Google had not substantially changed the APIs, but rather copied 11,500 lines of code directly, the use was not transformative.<sup>34</sup> Taking the first factor as a whole, the Federal Circuit found that, even without a finding of bad faith from Google, the purpose and character of the use “strongly support[s] the conclusion that the first factor weighs against a finding of fair use.”<sup>35</sup>

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24. *Id.* at 1379–1380.

25. *Id.* at 1380 (citing Technology Quarterly, *Stalking Trolls*, ECONOMIST (Mar. 8, 2014), <http://www.economist.com/news/technology-quarterly/21598321-intellectual-property-after-being-blamed-stymying-innovation-america-vague>; Timothy B. Lee, *Will the Supreme Court save us from software patents?*, WASH. POST (Feb. 26, 2014, 1:13 PM), <http://www.washingtonpost.com/blogs/the-switch/wp/2014/02/26/will-the-supreme-court-save-us-from-software-patents/>).

26. *Id.* at 1381. (Fair use of copyrighted subject matter is not considered infringement).

27. *Oracle Am., Inc. v. Google Inc.*, C 10-03561 WHA, 2016 WL 3181206, (N.D. Cal. June 8, 2016), *rev'd and remanded sub nom.* 886 F.3d 1179 (Fed. Cir. 2018).

28. *Id.* at \*1.

29. *Id.* at \*6–\*10; 17 U.S.C. § 107 (1992).

30. *Oracle Am., Inc.*, 2016 WL 3181206, at \*1.

31. *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1186 (Fed. Cir. 2018).

32. *Id.* at 1196–98.

33. *Id.* at 1197 (citing *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1015 (9th Cir. 2001)).

34. *Id.* at 1187–1202.

35. *Id.* at 1204.

The second factor of the fair use analysis lent itself to a finding of fair use.<sup>36</sup> Nevertheless, the Federal Circuit noted that, despite this factor supporting Google's position, the Ninth Circuit "has recognized[ . . . ] that this second factor 'typically has not been terribly significant in the overall fair use balancing.'"<sup>37</sup> The amount and substantiality of the portion used compared with the copyrighted work as a whole was stated by the Federal Circuit to be a more flexible determination which could not be solved by simply taking a ratio of the amount of work that was copied verbatim.<sup>38</sup>

The court also emphasized that consideration of the third factor requires examining the magnitude of the copied work in light of the original work, not the infringing work.<sup>39</sup> Though Google only copied a small portion of Java as a collective language, the APIs themselves contained a substantial amount of code, enough that the Federal Circuit did not consider the copying to be "insignificant."<sup>40</sup> Overall, the third fair use factor did not weigh heavily in favor of either party.<sup>41</sup>

The final fair use factor, the effect upon the potential market, was emphasized by the Federal Circuit to be the single most important factor in the fair use inquiry.<sup>42</sup> In examining this factor, the court dispensed with Google's assertion that a jury could have found no market harm based on the fact that Oracle was not a device manufacturer and did not have a smartphone platform.<sup>43</sup> Direct competition is not the only form of market harm. For example, the fourth fair use factor also includes the potential to enter related markets and the ability of a copyright holder to "determine 'when, 'whether, and in what form to release'" the copyrighted work into new markets."<sup>44</sup> According to this formulation, Google's use of Oracle's APIs had a substantial effect upon the market, thus, the factor weighed against fair use.<sup>45</sup>

Due to its application of the four fair use factors, the Federal Circuit held that Google's use of the 37 Java APIs was not fair use as a matter of law and remanded the case to the Northern District of California for a finding on damages.<sup>46</sup> Most recently, Google petitioned for certiorari, and the Supreme Court has asked the Solicitor General for his thoughts on the case.

### III. LEGAL BACKGROUND

This part provides an overview of doctrines and treatises pertinent to the issue of overlapping IP protections. Subpart A examines the evolving view of the courts on the issue of overlapping IP rights. Subpart B discusses the Nimmer treatise on copyright law and its suggestions about how copyright and patent *should* be allowed to interact.

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36. *Id.* at 1205 (stating that a "reasonable jurors could have concluded that functional considerations were both substantial and important." The thrust of the discussion was whether creating APIs was a creative process).

37. *Id.*

38. *Id.*

39. *Id.*

40. *Id.* at 1207.

41. *Id.*

42. *Id.*

43. *Id.* at 1209.

44. *Id.* at 1208–10.

45. *Id.*

46. *Id.* at 1211.

### A. Overview of Case Law Regarding Overlapping IP Protections

One of the first cases regarding overlapping IP protections is the 1879 Supreme Court case *Baker v. Selden*.<sup>47</sup> The complainant (Selden) in *Baker* had appropriately copyrighted a book that contained instructions on using a particular system of bookkeeping.<sup>48</sup> The defendant (Baker) made and used books containing a very similar system to the one present in Selden's copyrighted work.<sup>49</sup> The question at issue was whether the use of a particular bookkeeping system could be restricted based solely upon a copyright on a book describing the process of how to use the system.<sup>50</sup> The Court also took the opportunity to discuss the differences between copyright protections and utility patent protections.<sup>51</sup>

The first question addressed by the Court was whether Selden could prevent other people from using his bookkeeping system on the basis of his copyright—a proposition which the Court firmly denied.<sup>52</sup> Instead of granting the desired exclusivity, the Court stated that “[t]he copyright of a work on mathematical science cannot give to the author an exclusive right to the methods of operation which he propounds, or to the diagrams which he employs to explain them, so as to prevent an engineer from using them whenever occasion requires.”<sup>53</sup> In making this statement, the Court effectively ruled that a copyright protects only the particular expression of the author, not the underlying method of the work.<sup>54</sup>

The second important point made by the Court concerned the difference in the dominions of patent and copyright protections.<sup>55</sup> The Court summarized the differences between the two types of IP protections, using medicine as an example:

[i]f the discoverer writes and publishes a book on the subject. . .he gains no exclusive right to the manufacture and sale of the medicine; . . . If he desires to acquire such exclusive right, he must obtain a patent for the mixture as a new art, manufacture, or composition of matter. He may copyright his book, if he pleases; but that only secures to him the exclusive right of printing and publishing his book.<sup>56</sup>

*Baker* has since been interpreted as treating utility patent and copyright as “mutually exclusive forms of IP protections for intellectual creations.”<sup>57</sup> This interpretation of *Baker* has carried over to other cases from lower courts, such as the decision in *Taylor Instrument Cos. v. Fawley-Brost Co*, a case concerning graphical charts created by the plaintiff for use in conjunction with a recording thermometer which

47. *Baker v. Selden*, 101 U.S. 99 (1879).

48. *Id.* at 100.

49. *Id.* at 100-101.

50. *Id.* at 101 (More broadly, the issue was whether a copyright on a book provides exclusivity to the contents of the book).

51. *Id.* at 102-103.

52. *Id.* at 103.

53. *Id.*

54. *Id.*

55. *Id.*

56. *Id.* at 102-103.

57. Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493, 1500 (2017).

were copied by the defendant.<sup>58</sup> The defendant presented several patents which covered recording thermometers and included representations of the copied charts.<sup>59</sup> The plaintiff responded that “none of these patents would give the defendant measurements necessary for printing the charts alleged to infringe.”<sup>60</sup> In its discussion of patents and copyrights, the Seventh Circuit addressed this argument and opined that the two IP protections should remain separate, stating that “[t]his argument, if true, ignores the fact that it now seeks protection in the copyright field for an art long protected in the field of patents, and where undoubtedly it still belongs.”<sup>61</sup>

Though *Baker* has echoed throughout case law for more than a century, the Supreme Court has expressed views somewhat at odds with the principles that its older decision has come to stand for. One such decision is *Mazer v. Stein*, a case concerning statuettes meant to be used as lamp bases.<sup>62</sup> In *Mazer*, the petitioners copied and sold lamp bases that were copyrighted by the respondent, resulting in the respondent filing for copyright infringement.<sup>63</sup> The petitioner responded, saying that a copyright did not provide protection from “industrial reproduction of the protected article.”<sup>64</sup> The Court noted that the petitioner fought against the idea of overlapping IP protections that would give an inventor “a choice between patents and copyrights.”<sup>65</sup> Despite this argument, the Court held—contrary to its earlier decision in *Baker*—that “the patentability of the statuettes, fitted as lamps or unfitted, does not bar copyright as works of art. Neither the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted. We should not so hold.”<sup>66</sup>

The Court went on to discuss the difference in the protections between copyright and patent—namely that copyright protects originality, whereas a patent protects novelty.<sup>67</sup> This was further explained by a metaphor of two men who independently make the exact same map, resulting in both men having the exclusive right to reproduce their own map, even though they are identical, without either infringing the other’s copyright.<sup>68</sup> Furthermore, the Court expressly addressed the economic policy of allowing both patent and copyright protections:

[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’ Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.<sup>69</sup>

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58. *Taylor Instrument Cos. v. Fawley-Brost Co.*, 139 F.2d 98 (7th Cir. 1943).

59. *Id.* at 101.

60. *Id.*

61. *Id.* at 101.

62. *Mazer v. Stein*, 347 U.S. 201, 202 (1954).

63. *Id.* at 203.

64. *Id.* at 205.

65. *Id.* at 216.

66. *Compare id.* at 217, with *Baker v. Selden*, 101 U.S. 99 (1879).

67. *Mazer*, 347 U.S. at 218.

68. *Id.* (citing *Fred Fisher, Inc. v. Dillingham*, D.C., 298 F. 145, 151).

69. *Id.* at 219.



Though this decision represents a more favorable view regarding overlapping IP protections, the Court still limited the ability to overlap.<sup>70</sup> *Mazer* has been interpreted to represent the “election” doctrine as opposed to the “siloining” doctrine of *Baker*.<sup>71</sup> The doctrine of “siloining” forces subject matter into separate categories, meaning a single work or invention may be either copyrightable or patentable, but not both.<sup>72</sup> The less stringent doctrine of “election” acknowledges that subject matter may be considered both copyrightable and patentable subject matter, but requires the claimant to choose only one type of protection for their innovation.<sup>73</sup> While “election” represents a favorable trend for overlapping IP rights, the end result for “siloining” and “election” remains largely the same. Following this decision, the Copyright Office adopted the election doctrine.<sup>74</sup> Though not fully embracing the idea of overlapping IP protections, the shift from “siloining” to “election” signifies the Supreme Court’s gradual transition from an overwhelmingly negative view on overlapping IP protections to a more positive one.

### B. *The Nimmer Treatise*

The *Mazer* decision was an early step toward increasingly widespread acceptance of overlapping IP rights. A well-respected (and regularly-updated) treatise on copyright, written by Melville Nimmer in 1963 (“the *Nimmer* treatise”), fully supports the idea of allowing a single innovation to be covered by multiple types of IP protections, especially by highlighting the possibility of overlapping copyright and patent protections.<sup>75</sup> As originally published, the *Nimmer* treatise supported the notion that protection under one body of IP law should not serve as a strict bar against the ability to gain other protections.<sup>76</sup> This view is criticized at the Copyright Office’s adoption of the election doctrine, which states that

[i]t would seem on principle that if a work otherwise meets the requirements of copyrightability, it should not be denied such simply because the claimant happens to be entitled to supplementary protection under other legislation. In any event, such Regulations go beyond the teachings of a recent case which suggest that even if a patent has been issued if such patent is subsequently found to be invalid then copyright protection should be available.<sup>77</sup>

The *Nimmer* treatise focuses extensively on the co-existence of design patents and copyright protections, but the advent of *Oracle v. Google* spurred the authors to address copyright’s potential overlap with utility patents.<sup>78</sup> Initially, the *Nimmer*

70. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT §2A.07 (2019).

71. *Id.* § 2A.07(B)(3).

72. *Id.*

73. *Id.*

74. *Id.* § 2A.07(C)(3)(a).

75. *Id.*

76. 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 38 (1963) (footnote omitted).

77. *Id.* (referencing *Barton Candy Corp. v. Tell Chocolate Novelties Corp.*, 178 F. Supp. 577 (E.D.N.Y. 1959), which found that the design patent and copyright at issue covered different subject matter).

78. NIMMER & NIMMER, *supra* note 70, § 2A.07(A).

treatise posits that the facts of *Oracle v. Google* may not have given rise to the ideal situation for addressing the overlap of utility patents and copyrights, because the patents at issue in the first iteration of the case did not cover *identical* subject matter to the copyrights that have been extensively litigated since.<sup>79</sup> Despite this objection, the treatise responds to the Federal Circuit’s action of throwing down the proverbial gauntlet on the issue of overlapping IP rights, taking a more conservative view when the overlap concerns a utility patent.<sup>80</sup> The treatise supports the idea that a physical product could be protected by copyrights and utility patents, but does not accept such an overlap when it protects subject matter such as software—something that has a more nebulous distinction between its physical form and functional purpose.<sup>81</sup>

#### IV. DISCUSSION OF OVERLAPPING IP RIGHTS

Subpart A of Part IV provides a more in-depth examination of the differences between the protections provided by the grant of a patent and the grant of a copyright. Subpart B expounds on how judicial care can allow for overlapping IP protections while minimizing risk of abuse by the rights-holders.

##### *A. Discussion of Differences Between Patent and Copyright*

One common argument posed against the concept of allowing overlapping IP rights is the fear of a rights holder either obtaining greater rights than their disclosure should allow (i.e., obtaining the rights of a patent holder while only making a showing sufficient for a copyright similar to the attempt in *Baker*) or maintaining strong rights for longer than statutorily allowed (i.e., trying to enforce the rights of a patent holder for the term of a copyright).<sup>82</sup> This is a valid concern; patents grant stronger protections than copyrights, while copyrights have a much longer term than patents.<sup>83</sup> Allowing an inventor who holds both a patent and a copyright on one innovation to conflate the rights and term of the grants could result in an improper monopoly far beyond what was contemplated in the Constitution.<sup>84</sup> Judicial care in

79. *Id.* at § (4)(b) (“Accordingly, it would have been preferable for the Federal Circuit to decline to enter this hornet’s nest. Instead, however, the court willingly entered the fray.”).

80. *Id.* § 2A.07(4).

81. *Id.* (“As thus viewed, it no longer becomes accurate to refer to patent and copyright protection attaching to the identical subject matter. To be sure, they could both pertain to matters embodied in the same physical item. But their protection is separate, inasmuch as they attach to different aspects of that item.”) (This hesitance arises from the seemingly conflicting requirements for obtaining a utility patent and a copyright on innovations such as software. Whereas a patent on a process performed by code may be obtained, 17 U.S.C. § 102(b) excludes from copyrightability procedures, processes, and methods of operation, along with several other things. In a situation where the expression is closely tied to the functionality of an innovation, the treatise posits that a utility patent may serve as evidence that the expression *is* the process).

82. See Viva R. Moffat, *Mutant Copyrights and Backdoor Patents: The Problem of Overlapping Intellectual Property Protection*, 19 BERKELEY TECH. L.J. 1473, 1512–13 (2004).

83. 17 U.S.C. § 302 (1998) (“Copyright in a work created on or after January 1, 1978, subsists from its creation and, except as provided by the following subsections, endures for a term consisting of the life of the author and 70 years after the author’s death.”); 35 U.S.C. § 154(a)(2) (2015) (“such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States. . .”); 35 U.S.C. § 173 (“Patents for designs shall be granted for the term of 15 years from the date of grant.”).

84. See U.S. CONST. art. I, § 8, cl. 8.

both granting and interpreting IP rights, however, can ameliorate this particular issue.

A clear understanding of the difference between utility patents and copyrights is essential to understand why overlapping these protections should not prove problematic. The grant of a copyright and the grant of a patent are quite different in the rights they provide to their respective rights holders. A copyright grants its holder the right to *do*.<sup>85</sup> Specifically, a copyright holder can reproduce, prepare derivative works from, distribute copies of, perform, or display their copyrighted work.<sup>86</sup> The grant of a copyright explicitly gives its holder the right to *do* any of these things with their work.<sup>87</sup> Though a holder of a copyright may use their copyrighted subject matter, they do not have an absolute right to bar others from using that same subject matter.<sup>88</sup> Fair use,<sup>89</sup> certain reproduction by libraries,<sup>90</sup> and various other exceptions allow others to use copyrighted subject matter without infringing a copyright.<sup>91</sup>

Finally, the subject matter of copyright is limited to “original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device.”<sup>92</sup> Not only does § 102 limit the scope by identifying what may be *included* in copyright protection; it also limits the scope of copyright by *excluding* certain subject matter from copyright protection.<sup>93</sup> Section 102(b) excludes “any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.”<sup>94</sup> This section provides a significant hurdle for one seeking to obtain copyright protections.

Patent protections grant rights in opposition to those rights gained through copyright protections.<sup>95</sup> A patent grants the right to *exclude*.<sup>96</sup> While a patentee may prevent all others from making, using, offering for sale, or selling their invention, it does not give them the right to perform their invention.<sup>97</sup> A patent on an invention containing subject matter that would be illegal to make or use, while valid, does not suddenly allow the patentee to perform illegal acts to make use of their patented invention. Additionally, the exclusive right given by patent is stronger than that given by copyright, as there are far fewer limitations on the exclusive right provided by a patent. Utility patents are also limited in the subject matter they are allowed to cover.<sup>98</sup> Section 101 limits patentable subject matter to “any new and useful process, machine, manufacture, or composition of matter, or any new and useful

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85. 17 U.S.C. § 106 (2002).

86. *Id.*

87. *Id.*

88. 17 U.S.C. §§ 107–112.

89. 17 U.S.C. § 107.

90. 17 U.S.C. § 108 (2005).

91. *See* 17 U.S.C. §§ 109–112 for other limitations on exclusive rights.

92. 17 U.S.C. § 102(a) (the statute then enumerates several examples of “works of authorship,” reciting: literary works; musical works; dramatic works; choreographic works; pictorial, graphic, and sculptural works; audiovisual works; sound recordings; and architectural works).

93. 17 U.S.C. § 102(b).

94. *Id.*

95. *See* 35 U.S.C. § 154(a)(1) (2018).

96. *Id.*

97. *Id.*

98. *See* 35 U.S.C. § 101.

improvement thereof. . .”<sup>99</sup> Aside from providing the four traditional categories, this statute also provides the requirement of usefulness.<sup>100</sup>

Examining the language that defines copyrights and patents shows the several distinctions that, when carefully construed by courts, can eliminate the risk of allowing rights holders to improperly gain or extend IP rights. Copyrights only protect the rights holder’s particular expression, whereas utility patents protect the underlying invention.<sup>101</sup> The *Nimmer* treatise mentions this distinction when it states that, where there is a patented physical product, the patent and the copyright, while embodied in the same product, cover very different *aspects* of that product.<sup>102</sup> As expressed in the treatise,

[t]o be sure, they could both pertain to matters embodied in the same physical item. But their protection is separate, inasmuch as they attach to different aspects of that item. In Weil’s example, copyright applies to the external shape of the novel household utensil, utility patent to its internal mechanism.<sup>103</sup>

### *B. Preventing Abuse with Care at the Copyright Office and in the Courts*

Distinguishing between an inventor’s individual expression and the novel, underlying functionality (the *Nimmer* treatise’s “internal mechanism”) allows for the existence of overlapping IP protections by preventing innovators from improperly obtaining, expanding, or extending those rights. The difference between expression and functionality is readily apparent, especially where there is a physical product. The patentable subject matter—the novel process, machine, manufacture, or composition of matter—should be separated from the copyrightable subject matter before evaluating the rights provided by each protection.<sup>104</sup>

When the patent term expires, the patentable subject matter, which should be clearly separate from the copyrightable subject matter, enters the public domain.<sup>105</sup> Others may now practice the patent or its equivalents so long as they create their own expression, or “external shape,”<sup>106</sup> while doing so. Using the book and bookkeeping system in *Baker* as an example, had Selden obtained a utility patent on the bookkeeping system as well as the copyright on the book,<sup>107</sup> he would have been able to exclude others from using the book-keeping method enumerated in the book for 20 years. During the same period, Selden’s copyright would give him the right to *do* the subject matter of the copyright. During the co-existence of the rights, Selden would have the right both to exclude others from using the method and the right to use his book describing the use of the system. Once the patent expires, Selden would lose his right to exclude others from using the bookkeeping method. He is

99. *Id.*

100. *Id.*

101. See 17 U.S.C. § 102; 35 U.S.C. § 101.

102. NIMMER & NIMMER, *supra* note 70, § 2A.07(D)(4)(c)(ii).

103. *Id.*

104. 35 U.S.C. § 101.

105. 35 U.S.C. § 154 (2015).

106. NIMMER & NIMMER, *supra* note 70, § 2A.07(A)(4)(c)(ii).

107. No patent was actually obtained, but for the purpose of clarification we are pretending there was.

left with a copyright protecting his work of authorship—the book—but can no longer prevent others from using the underlying system (so long as they do not copy the book). The copyright grants only the exclusive right to reproduce, prepare, distribute, etc., the book itself, it does not cover the bookkeeping method.<sup>108</sup>

By strictly limiting the copyright to the expression of the original product and excluding from copyright the functionality of the product, courts can quickly dispatch rights holders who attempt to use their copyright to prevent others from using the formerly patented subject matter. They would simultaneously be able to prevent attempts to extend patent protections beyond their term. Returning to the hypothetical example above, after the patent expires, Selden may attempt to argue, as he did in the actual case, that his copyright over the book describing the use of his method grants him exclusive right to the method itself.<sup>109</sup> As the Court held in 1879,<sup>110</sup> without a patent on the bookkeeping method, or in the hypothetical case after the expiration of a patent on the bookkeeping method, Selden can only prevent others from copying the expression within his book. So long as the party using the method creates a new expression, as did Baker, they can use the method with impunity.<sup>111</sup> Properly construing the subject matter of copyrights and patents can allow courts to permit overlapping IP rights without increasing the risk of improper use of those rights.

Distinguishing copyrightable and patentable aspects of an innovation is relatively simple when there is a physical embodiment of that product. The issue becomes more complicated, however, when the product is more abstract, such as the APIs in *Oracle Am., Inc. v. Google Inc.*<sup>112</sup> In instances such as this, the expression becomes much more difficult to extricate from the idea itself. Indeed, even the *Nimmer* treatise is hesitant to accept the Federal Circuit's contention that patentability does not bar copyrightability even when there is not a physical item in consideration.<sup>113</sup> Once again, carefully granting IP rights and construing the protections they provide can reduce the risk of improper exclusivity.

Before courts get the chance to construe the protections granted by overlapping IP rights, the Copyright Office should be able to reduce the chance of exploitation of that overlap, even when the protections cover a virtual product instead of a physical one. First, both offices must distinguish between the expression and the idea behind the innovation. With virtual products, such as the APIs in *Oracle Am., Inc. v. Google Inc.*, there is another necessary step: the Copyright Office must solve the intertwinement issue for the expression of a virtual product, such as lines of code, with the functionality of the product itself.

Though there is generally more than one way to write code to perform a function, this may not be true in every case. Depending on the Copyright Office's decision on whether the functionality is entirely dependent on the expression, the *Nimmer* treatise presents the appropriate solution in the merger doctrine.<sup>114</sup> If the functionality of the product is not exclusive to the particular expression employed by

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108. See 17 U.S.C. § 102(b).

109. See *Baker v. Selden*, 101 U.S. 99 (1879).

110. *Id.*

111. See *id.* at 100 (discussing how the defendant had used a different arrangement of columns and different headings).

112. See *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339 (Fed. Cir. 2014).

113. NIMMER & NIMMER, *supra* note 70, § 2A.07(A)(4).

114. *Id.* § 2A.06(B)(1)(b).

the inventor, there should be no risk—assuming courts interpret the coverage of the rights properly—that granting a copyright would result in a patent-like monopoly for the rights holder.<sup>115</sup> When the expression is too closely intertwined with the functionality of the product, *Nimmer* states that

[o]nly in those few instances in which conferring a monopoly over a given expression would in fact stymie others from expressing the idea embodied therein, such that the idea and its expression ‘merge’ into one, should the courts afford relief, either as a question of copyrightability or during the infringement analysis.<sup>116</sup>

The preceding quotation provides two separate ways of preventing copyright from extending into the area of patent: using the dependence of functionality on expression as a qualification for copyrightability, or using the same dependence as a defense against infringement.<sup>117</sup> While both of these solutions work, care at the Copyright Office is more efficient, as it provides the inventor with the knowledge that their product is not copyrightable much earlier, possibly giving them the opportunity to apply for a more suitable IP protection. By separating the idea behind a product from the expression of that idea, while refusing to grant copyrights on products in which the function is unique to the expression (instead forcing those inventions into only patent protections), overlapping IP rights can be safely applied to products without a definite physical form.

Some scholars worry that allowing patent and copyright to exist in the same product will result in a scheme that runs contrary to the constitutionally-stated purpose of promoting the advancement of science.<sup>118</sup> The argument, in short, states that copyright can limit the ability of third parties to improve patented subject matter, and that patents can pre-empt fair use.<sup>119</sup> As to this latter point, the argument ignores that fair use is not pre-empted for the lifetime of the *copyright*, but instead, the lifetime of the *patent*. If the rights holder can make a showing sufficient to obtain a patent, it follows that they would be rewarded with exclusive rights beyond the scope of copyright. These stronger rights, however, are the result of the patent and disappear when the patent term ends, once again allowing fair use.

It is unlikely that copyright would limit the ability of third parties to improve a patented invention. While it is conceivable for a scenario to arise where a copyrighted expression is substantially similar to every possible improvement to a patented invention, or is required for any improvement to function, this scenario would surely draw the gaze of the merger doctrine as functionality becomes increasingly dependent upon expression. Furthermore, any prohibitive effect copyright may have is likely already imposed by patent law itself.<sup>120</sup>

Another issue that courts must take care to avoid is overlapping damage awards. In allowing overlapping IP protections, courts open the possibility of attempted double collecting on the part of plaintiffs suing for infringement. The problem of double collecting is solved, as many of the issues associated with

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115. *Id.*

116. *Id.*

117. *Id.*

118. See Moffat, *supra* note 82, at 1512–13.

119. *Id.*

120. See 35 U.S.C. § 102 (2015); see also 35 U.S.C. § 103.

overlapping IP rights are, with judicial care. Ensuring that judges understand the exact scope of all IP rights associated with a product and when those rights are impinged can lessen the risk that a rights holder will be allowed to collect twice for a single infringement.

## V. THE CONSTITUTION AND THE WISDOM OF ORACLE V. GOOGLE

The Federal Circuit expressed the appropriate rule concerning the intersection of copyright and patent when it quoted *Mazer*:

Importantly for our purposes, the Supreme Court has made clear that “[n]either the Copyright Statute nor any other says that because a thing is patentable it may not be copyrighted.” Until either the Supreme Court or Congress tells us otherwise, we are bound to respect the Ninth Circuit’s decision to afford software programs protection under the copyright laws. We thus decline any invitation to declare that protection of software programs should be the domain of patent law, and only patent law.<sup>121</sup>

With this decision, the Federal Circuit acknowledged that Oracle’s APIs could be protected by both copyright and patent laws.

This decision fits with the analysis of virtual products in Part IV. The most recent decision in the string of cases explains the events leading to Google’s infringement, recounting that “Google wanted to move quickly to develop a platform that would attract Java developers to build apps for Android. The Android team had been working on creating its own APIs, but was unable to do so successfully.”<sup>122</sup> Google’s actions suggest that it was possible for Google to create another set of APIs that performed the same function as Oracle’s without using an identical expression. Because the functionality of the APIs at question is detached from the expression used by Oracle, there is no need for the Federal Circuit to restrict the scope of Oracle’s copyright. The lack of identical coverage by the patents and copyrights at issue in the first ruling makes the facts of the situation less than ideal for the Federal Circuit’s holding, but the principle stated by the court remains an appropriate and sustainable statement of the law. So long as courts, the Copyright Office, and the Patent Office are careful in granting and construing IP protections, overlapping IP rights can help innovators gain stronger protections for their inventions without increased risk of abuse by rights holders.

Where multiple forms of IP protections are available on a single product, the protections can be construed as “thin” protections, which narrowly protect either the underlying idea or the exact expression. *Oracle v. Google* is a timely example of this. The first iteration of the case resulted in dismissal of both patent and copyright claims.<sup>123</sup> The first appeal to the Federal Circuit revived the copyright claims, which promptly failed again at the district court, this time on fair use grounds.<sup>124</sup> Oracle did not obtain a favorable judgment until a second appeal to the Federal

121. *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1380–81 (Fed. Cir. 2014) (quoting *Mazer v. Stein*, 347 U.S. 201, 217 (1954)).

122. *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1187 (Fed. Cir. 2018).

123. *Oracle Am., Inc. v. Google Inc.*, 872 F. Supp. 2d 974 (N.D. Cal. 2012).

124. *See Oracle Am., Inc.*, 750 F.3d at 1339; *see also Oracle Am., Inc. v. Google Inc.*, C 10-03561 WHA, 2016 WL 3181206 (N.D. Cal. June 8, 2016).

Circuit, in which the court walked through every element of fair use.<sup>125</sup> The struggle for Oracle to successfully assert its rights illustrates how judicial interpretation can protect against improper expansion of IP protections.<sup>126</sup>

Overlapping IP rights also further the aim of the IP Clause of the Constitution by “promot[ing] the progress of science and useful arts...”<sup>127</sup> We grant patents and copyrights in the hope that the limited monopoly will provide enough of an incentive to make investment into making new, unique expressions and novel, useful inventions attractive to both companies and individuals. The possibility of a copyright and a patent both have value. By allowing overlapping IP rights, the total value that could be provided by one innovation increases, meaning that a greater investment into science and useful arts can be justified. The value provided by overlapping IP rights very well could be the final straw that results in the creation of an invention or expression that otherwise may have never seen the light of day. The Federal Circuit’s statement of the law upholds and furthers the goals of the Constitution and allows a greater reward for innovation, consequently clearing the path for a brighter future.

## VI. CONCLUSION

The concept of overlapping IP rights has a tumultuous history of interpretation. From “siloing” and “election,” to being accepted by the Copyright and Patent Offices, to finally being supported by the Federal Circuit, the idea remains divisive. Despite this, the Federal Circuit’s acceptance of overlapping IP rights is a wise one. So long as judges and examiners are careful in construing the protections provided by IP rights, and in granting those rights, we can obtain the benefits of allowing multiple IP rights in a single product, while minimizing any risks that may arise.

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125. *Oracle Am., Inc.*, 886 F.3d at 1179.

126. *See id.*; *Oracle Am., Inc.*, 750 F.3d at 1339; *Oracle Am., Inc.*, 2016 WL 3181206, at \*1; *Oracle Am., Inc.*, 872 F. Supp. 2d at 974.

127. U.S. CONST. art. I, § 8, cl. 8.