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## FAIR USE IN *ORACLE*: PROXIMATE CAUSE AT THE COPYRIGHT/PATENT DIVIDE<sup>†</sup>

WENDY J. GORDON\*

### ABSTRACT

*In Oracle America, Inc. v. Google LLC, the Federal Circuit undermined copyright law's deference to patent law and, in doing so, delivered a blow to both regimes. Copyright's deference to patent law—including a historic refusal*

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A version of this Article was circulated at the conference “A Celebration of the Work of Wendy Gordon” at Boston University School of Law on June 14, 2019. I want to express my deep gratitude to my colleagues at Boston University who organized the conference and to everyone who participated.

This Article brings to culmination several linked projects. I presented preliminary drafts of this piece at the University of Texas Law School under the title *Transformative Use, Proximate Cause, and Copyright*, and at a Harvard Law School “Conference on IP and Private Law” under the title *Integrating Judge Leval's Theory of Fair Use into an Economic View of Copyright Law: From “Proximate Cause” to “Transformative Use.”* I explored some of my current arguments in an essay titled *How Oracle Erred: The Concept of “Use” and the Future of Computer Copyright*, in *COPYRIGHT IN AN AGE OF LIMITATIONS AND EXCEPTIONS* 375 (Ruth L. Okediji ed., 2017). I also analyzed copyright's deference to patent law in the Boston University Annual Lecture of 2017. That lecture, titled *The Liberty to Copy Unpatented Inventions: Potential Collisions with Copyright and Trademark*, focused on the functional aspects of visual and sculptural works rather than on computer programs. It is available online: Boston University, *2017 University Lecture Presented by Wendy J. Gordon, Professor of Law*, YOUTUBE (Jan. 30, 2018), <https://www.youtube.com/watch?v=BDWCVr9OlyI>.

For suggestions on this and prior versions, I owe thanks to a larger community than can fit in a footnote. I am grateful to colleagues at Boston University, Harvard, and the University of Texas at Austin for helpful comments and critique and to staff of the *Harvard Journal of Law & Technology* for preliminary editorial suggestions. The assistance of the brilliant members of the *Boston University Law Review* goes without saying. Let me also mention with gratitude (in a list that is emphatically “not limitative”) Shyam Balganes, Bob Bone, Oren Bracha, Kim Condoulis, Chris Cridler, Randy Davis, Stacey Dogan, Abraham Drassinower, John Goldberg, James Grimmelman, Paul Gugliuzza, Jack Harris, Keith Hylton, Brandy Karl, Ariel Katz, Gary Lawson, Jessica Litman, Mallory Medeiros, Rob Merges, Ruth Okediji, Armineh Peshkam, Matthew Sag, Pam Samuelson, Jessica Silbey, Talha Syed, Rebecca Tushnet, and (especially) Michael Zimmer.

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to enforce rights that might undermine the public's liberty to copy unpatented inventions—is a necessary part of preserving inventors' willingness to accept the short duration, mandatory disclosure, and other stringent bargains patent law demands. Deference to patent law is also integral to copyright law's interior architecture; copyright's refusal to monopolize functional applications of creative work lowers the social costs that would otherwise be imposed by copyright's ease of acquisition and long duration.

If patent law refuses to protect a functional device or other innovation (perhaps because its patent has expired or because the innovation would be obvious to anyone skilled in the field), various copyright doctrines make it difficult for an eager claimant to use copyright law instead. These doctrines act like fences.

For example, under 17 U.S.C. § 102(b), copyright cannot extend to “ideas” or to any “procedure, process, system, [or] method of operation.” This prohibition applies “regardless” of the copyrighted “form” in which the idea, procedure, process, or method appears. Therefore, the public violates no copyright duties when it copies, say, ideas about how to improve the manufacture of steel from a copyrighted instruction manual or video. If the creator of the manufacturing idea wants protection for it, the inventor needs to look to patent law.

Similarly, although copyright can subsist in drawings of a useful article, 17 U.S.C. § 113(b) and the case law disable those copyrights from giving any rights to keep others from making or selling the article. Say the inventors of an automobile engine with improved fuel efficiency want to restrain others from building and selling copycat engines. To restrain such functional copying, the inventors get no mileage out of the copyrights that subsist in their blueprints. Rather, to stop competitors from building and selling the new engine, the inventors must seek the protection of patent law.

Under yet another statutory rule, 17 U.S.C. § 101, sculptured shapes that have “an intrinsic utilitarian function that is not merely to portray the appearance of the article or to convey information” are not copyrightable unless their aesthetic and functional components are separable.

The instant Article discusses these and other limits on copyright law. Their overall impact is to emphasize the importance Congress and the courts give to preventing copyright law from directly or indirectly competing with patent law, or undermining the choices Congress embedded in the patent statute.

Computer-program copyrights were intended to protect a programmer's expression, not their engineering ingenuity. As technology poses new challenges, separate intellectual property laws need to keep congruent with the separate purposes each serves. The Supreme Court has granted certiorari in *Oracle*, allowing the Court to evaluate a judicial opinion that this Article argues ignored these first principles.

A need for congruence (or “fit”) is recognized in most areas of civil liability. For example, in enforcing the Clayton Act, the Supreme Court honored the need for congruence by creating a doctrine it called “antitrust injury” to limit

*liability. The common law of torts generally employs the doctrine called “proximate cause” to similarly assure fit between the facts of a given case and the law’s purposes. In copyright law, the courts and Congress entrust this familiar but crucial task to “fair use.” The instant Article employs analogies from antitrust and the common law of torts to reinforce the appropriateness of using the fair use doctrine to keep copyright law in its own yard.*

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## INTRODUCTION

This Article explains why, in *Oracle America, Inc. v. Google LLC*,<sup>1</sup> the owner of copyright in Java should lose in its attempt to control the ease with which third-party programmers can use a Java-like interface to develop programs for Google's Android platform. Put simply, Oracle has framed its attempt as a suit in copyright, and copyright is an inappropriate vehicle for protecting functional aspects of Oracle's computer code. Copyright's rules were created to deal with a wholly different set of issues, and their details produce social benefit and have normative appeal only when applied to the domain for which they are suited.

Intellectual property regimes are not interchangeable. Rules that suit rhinoceroses might well prove uncomfortable if applied to gazelles. Copyright governs "works of authorship" that are "original" and "fixed in any tangible medium."<sup>2</sup> By contrast, the law of utility patent covers any "process, machine, manufacture, or composition of matter, or any new and useful improvement thereof."<sup>3</sup> Although a judge may look at a set of facts and think that "the propriety of *some* remedy appears to be clear,"<sup>4</sup> such a perception would not

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<sup>1</sup> 886 F.3d 1179 (Fed. Cir. 2018), *cert. granted*, No. 18-956, 2019 WL 6042317 (U.S. Nov. 15, 2019) (mem.).

<sup>2</sup> 17 U.S.C. § 102 (2018). Works that are written down, filmed, taped, or otherwise embodied in a physical copy or "phonorecord" are "fixed." *Id.* § 101. Fixed works are governed (with few exceptions) by federal law. *Id.* § 301 (providing for federal preemption).

State law can protect "unfixed" works, like a human cannonball's circus performance that has not been filmed or otherwise recorded under the performer's authorization. *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575-79 (1977) (applying Ohio law). Sometimes the label for protecting unfixed performance and other unfixed works is "common law copyright," and sometimes (as in the human cannonball case) the label used is "right of publicity." *Compare id.* at 576, with Megan Carpenter & Steven Hetcher, *Function over Form: Bringing the Fixation Requirement into the Modern Era*, 82 FORDHAM L. REV. 2221, 2239, 2250 (2014) (describing as "common law copyright").

<sup>3</sup> 35 U.S.C. § 101. The patent requirement of newness is judged by a high standard: to be patentable, the innovation must be nonobvious to an ordinary person skilled in the art. *Id.* § 103. Copyright's "originality" standard is far easier to meet. *See Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 345 (1991) ("Original, as the term is used in copyright, means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity.").

<sup>4</sup> *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 267 (1918) (Brandeis, J., dissenting) (emphasis added). The quoted phrase appears in Justice Brandeis's classic discussion of comparative institutional competence and its importance for issues in intellectual property. The discussion appears in *International News Service v. Associated Press*, a still-controversial case that concerned the copying of war news during the first World War. *Id.* at 229-33.

In that famous (some say "infamous") case, a majority of the Supreme Court affirmed the grant of an injunction ordering one news service to stop transmitting and using news of the day (facts) that it obtained from a competitor's newspapers and public bulletin boards. *Id.* at 245-46 (majority opinion). The injunction against copying any particular fact lasted "until its commercial value as news to the complainant and all of its members ha[d] passed away." *Id.* at 245 (emphasis omitted).

justify recourse to any particular legal scheme. The copyright scheme has an ease of acquisition and a length of term that are inconsistent with the standards and duration Congress has chosen in patent law to govern technological innovations. It can be tempting for a court to use whatever tool is at hand to “do justice,” but the use of inappropriate tools is more likely to be disastrous than just.<sup>5</sup>

It is desirable to avoid mismatch of circumstance and legal regime here, just as it is desirable to avoid other instances where giving a plaintiff relief would not serve the goals of the law that had created the very cause of action by which the plaintiff sues. To these ends, a variety of legal devices have evolved. In negligence law, “proximate cause” is a primary doctrine that refuses to impose liability when liability would not further the law’s goals. In copyright law, “fair use” is the primary doctrine that performs the task of ensuring that liability will serve copyright’s goals.

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The majority opinion ignored the free speech issues, including the possibility that the plaintiff news service might refuse to sell or license news to the defendant’s newspapers. *See id.* at 266 (Brandeis, J., dissenting). Nor did the majority’s opinion take account of the fact that the defendant news service was barred from much of the European theater of war and might have had no source for war news other than from the plaintiff’s papers and bulletin board. It was only Justice Brandeis, the lone jurist who was willing to face issues of institutional constraint, who found the voice to tackle these issues directly.

In his dissent, Justice Brandeis discussed many possibilities that a legislature but not a court might adopt. For example,

[i]f a legislature concluded . . . that under certain circumstances news-gathering is a business affected with a public interest, it might declare that, in such cases, news should be protected against appropriation, only if the gatherer assumed the obligation of supplying it, at reasonable rates and without discrimination, to all papers which applied therefor. . . .

Courts are ill-equipped to make the investigations which should precede a determination of the limitations which should be set upon any property right in news . . . . Courts would be powerless to prescribe the detailed regulations essential to full enjoyment of the rights conferred . . . . Considerations such as these should lead us to decline to establish a new rule of law in the effort to redress a newly-disclosed wrong, *although the propriety of some remedy appears to be clear.*

*Id.* (emphasis added). For institutional reasons, then, Justice Brandeis would have given victory to the defendant.

<sup>5</sup> I have long learned from Pamela Samuelson’s insights in this regard. *See, e.g.,* Pamela Samuelson, *Strategies for Discerning the Boundaries of Copyright and Patent Protections*, 92 NOTRE DAME L. REV. 1493, 1497 (2017) [hereinafter Samuelson, *Strategies for Discerning Boundaries*]; Pamela Samuelson, *The Story of Baker v. Selden: Sharpening the Distinction Between Authorship and Invention*, in *INTELLECTUAL PROPERTY STORIES* 159, 180-81 (Jane C. Ginsburg & Rochelle Cooper Dreyfuss eds., 2006) [hereinafter Samuelson, *The Story of Baker v. Selden*]. In *Strategies for Discerning Boundaries*, Professor Samuelson examines several strategies that the law employs or could employ to deal with potential copyright/patent overlap. Using her classification scheme, the position I take in the instant Article would be classified as a “layering or segmentation” approach. *See* Samuelson, *Strategies for Discerning Boundaries*, *supra*, at 1495-96, 1517-21.

Fair use and proximate cause are not identical, but they show remarkable similarities. Their parallels are not surprising, since both copyright law and negligence law govern spheres in which everyday activities—most of them legitimate—occasionally conflict. Judges employ fair use and proximate cause to avoid chilling behaviors that happen to stumble over a legal tripwire merely by coincidence.

If one compared the breadth of the two doctrines, there is no reason for fair use to be narrower than proximate cause. If anything, fair use should be the broader and more easily available doctrine because copyright liability can be imposed for harmless use.<sup>6</sup> By contrast, in negligence law, findings of “insufficiently proximate cause” shelter careless defendants who factually contributed (in a “but-for” sense)<sup>7</sup> to someone’s injury.

Proximate cause doctrine has advantages as a source of learning for copyright partly because negligence law emerged from a longer and more gradual period of judicial development than did copyright. Thus, proximate cause case law recognizes a number of typical scenarios in which proximate cause can be lacking. By contrast, though many of these scenarios have parallels in copyright law, the jurisprudence of fair use is only beginning to crystallize them.<sup>8</sup>

The instant Article uses as an analogy the subclass of proximate cause cases that make explicit the doctrine’s function of safeguarding the normative nexus between the law’s actual concerns and the facts of a particular case. Commonly, such cases involve “fortuity” or “coincidence.” In these cases, a lawyer might say that the fortuity “breaks the causal chain.” The “breaking” metaphor simply means that courts tend to relieve negligent actors of liability when there is no logical connection—only a coincidental one—between the facts on the ground and the kind of behavior and effects toward which the law was addressed.

In fortuitous cases, imposing liability would satisfy neither a law’s instrumentalist goals (such as furthering economic welfare) nor a law’s demands for normative structure (through concepts such as corrective justice).<sup>9</sup> Fair use

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<sup>6</sup> In cases where no harm is caused, I have argued, liability should be much less available than current case law would permit. See Wendy J. Gordon, *The Concept of “Harm” in Copyright*, in *INTELLECTUAL PROPERTY AND THE COMMON LAW* 452, 454 (Shyamkrishna Balganesh ed., 2013).

<sup>7</sup> The standard test for factual causation in tort law uses a counterfactual inquiry: how would the plaintiff have fared ‘but for’ the defendant’s negligence?

<sup>8</sup> Classification of fair use subtypes has begun to develop in the literature. See, e.g., Pamela Samuelson, *Unbundling Fair Uses*, 77 *FORDHAM L. REV.* 2537, 2541-42 (2009); see also Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 *COLUM. L. REV.* 1600, 1627-35 (1982) [hereinafter Gordon, *Fair Use as Market Failure*]. General norms can and should exist alongside the identification of subtypes. The most used general norm is probably Judge Leval’s popular criterion, “transformativity.” See, e.g., Pierre N. Leval, *Toward a Fair Use Standard*, 103 *HARV. L. REV.* 1105, 1111 (1990).

<sup>9</sup> For a corrective justice model, I refer primarily to ERNEST J. WEINRIB, *CORRECTIVE JUSTICE* (2012). As for the notion of civil redress, it is a concept that resembles corrective



similarly tends to avoid imposing liability in circumstances that would advance neither the economic goals nor the philosophic goals of copyright law.

In *Oracle*, the Supreme Court must decide, implicitly or explicitly, whether courts are permitted to impose copyright liability in situations where the reasons for copying had nothing to do with the copyright's *raison d'être* and where imposing liability would undercut patent law. Most precedent and logic, this Article argues, indicate that courts are not permitted to disregard statutory and decisional norms in this way.

Part I of this Article introduces three judicially created modes of limiting liability. They are "fair use," which operates to keep wayward results in particular cases from undermining copyright's goals and wasting social resources; "antitrust injury," which bars recovery when plaintiffs' injuries arise in a manner not within the antitrust statutes' sphere of concern; and "proximate cause," a familiar if difficult component of common law torts. Part II gives more detail about the fair use doctrine, and argues that avoiding interference with the operation and attractiveness of the patent system is a goal "interior" both to federal copyright law and to its fair use doctrine. Part III explains the importance of maintaining the statutory and judge-made fences that copyright law employs to give a wide berth to patent law. Part III also addresses how copyright's deference to patent law is threatened by the Court of Appeals decision in *Oracle*. Part IV expands the *Oracle* discussion. It also draws on "antitrust injury" and "proximate cause" to emphasize the impropriety of mechanically applying laws that regulate conflicts among valuable activities. Part IV also ties together the strands of negligence law, antitrust law, and copyright law to explain why copying motivated solely by a desire for technological advantage should be fair use, not infringement. Part V interrogates the analogy from proximate cause and concludes that the analogy truly assists in deciding whether a merely technological use of a copyrighted work is incapable of violating copyright law. A Conclusion follows, urging the Supreme Court to find that it is "fair use" to copy for the technological purpose of furthering interoperability.

#### I. ANALOGIES FROM STATUTORY AND COMMON LAW

To start the journey, my first offering is a pop quiz.

Consider this statement: "Courts should refrain from imposing liability when finding the defendant liable would fail to further the very purposes of the law being enforced." If that language came from a judicial opinion, what doctrine would the opinion be addressing:

- a) the "antitrust injury" doctrine under the Clayton Act,
- b) the "proximate cause" doctrine of negligence law, or
- c) the "fair use" doctrine of copyright law?

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justice in being noninstrumentalist but that has a contour of its own. For a prominent civil redress approach, see JOHN C.P. GOLDBERG & BENJAMIN C. ZIPURSKY, *RECOGNIZING WRONGS* 122-24 (2020).

It's a trick question, of course. The statement could come from an opinion addressing any of the three doctrines. Each doctrine directs courts to refuse to impose liability where enforcement would have no effect that furthers the law's goals. (As it happens, the statement originates in one of the Supreme Court's most important opinions on the fair use doctrine.<sup>10</sup>)

Courts employ the requirement that there be a normative connection in many contexts. This Article examines situations where the interaction between plaintiff and defendant bears a surface similarity to a relation proscribed by law, but the facts present no normative connection to the law at issue. In such cases, as illustrated by the pop quiz, *refraining* from liability is not only proper but also has often "been thought necessary to fulfill" the "very purpose" of the law being enforced.<sup>11</sup>

In particular, this Article examines *Oracle*, a case in which the defendant has copied some of the plaintiff's computer program for reasons related not to its expressive value but to the functional, utilitarian advantages the copying could bestow. In *Oracle* and cases like it, to impose liability for such copying would not only fail to fulfill copyright's affirmative goals but would also violate patent policy and the many copyright doctrines that explicitly nullify the public's duties not to copy when imposing such a duty would tread on patent law's toes.

Judges employ a variety of doctrinal categories to avoid enforcing legal duties in circumstances that have null or negative fit. One of the key principles animating these various doctrines is parsimony: "[T]he prevailing view is that [the law's] cumbrous and expensive machinery ought not to be set in motion unless some clear benefit is to be derived from disturbing the *status quo*."<sup>12</sup>

Requiring "fit" also has virtues independent of instrumental concerns like parsimony. As Professor Ernest Weinrib emphasizes, a need for normative fit emerges from the societal choice to resolve a dispute by putting it into private hands.<sup>13</sup> When government chooses to resolve a matter through private law, rather than through administrative action or blunt tools such as subsidies and taxes, that choice is important. The choice having been made, the relation between plaintiff and defendant (the relationship that stands at the center of litigation) must be meaningful. From that relationship Professor Weinrib extracts the origin and explanation for proximate cause. It is the proximate cause and duty doctrines to which Professor Weinrib points to illustrate his claim that corrective justice itself requires that liability in private law must express the

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<sup>10</sup> "From the infancy of copyright protection, some opportunity for fair use of copyrighted materials has been thought necessary *to fulfill* copyright's *very purpose*, '[t]o promote the Progress of Science and useful Arts . . .'" *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (alteration and omission in original) (emphases added) (quoting U.S. CONST. art. I, § 8, cl. 8).

<sup>11</sup> *See id.*

<sup>12</sup> O.W. HOLMES, JR., *THE COMMON LAW* 96 (1881). He was speaking of the choice between negligence law and strict liability; proximate cause raises related issues.

<sup>13</sup> WEINRIB, *supra* note 9, at 9-11.

“normative connection” between doer and sufferer.<sup>14</sup> The gain or loss is actionable only if it is the kind of gain or loss at which the law aimed itself.<sup>15</sup>

There must be normative coherence or “fit” between what makes a defendant liable to the plaintiff on the one hand and the logic of the governing law on the other hand.<sup>16</sup> The fact that someone is a wrongdoer does not dictate that they should be required to pay for all the damages that might coincidentally flow from their action.<sup>17</sup> Courts often if not invariably make defendants pay only for those impacts that relate to the goals of the law being applied.<sup>18</sup>

Fit need not be perfect. In some legal domains, less emphasis is placed on whether each case furthers the law’s goals than on whether the system *as a whole* has acceptable fit. But copyright’s fair use doctrine takes a more individualized approach. This makes sense. Much copying behavior constitutes the vehicle for socially useful education and adaptation; because works of authorship can be infinitely multiplied, copying is often harmless, and restraints on copying can impinge on free speech. In addition, analogies from negligence law and antitrust law suggest that the benefits of ensuring “fit” are worth the candle.

The issue of “fit” is no less pressing when more than one legal regime is involved. All forms of IP have reasons both to grant private parties exclusive rights *and* to grant the public liberties of use. The boundaries between duty and liberty, owned and public domain, vary according to subject matter. To identify federal IP policy, the major federal IP statutes must be considered as a linked group.

When considerations of statutory purpose are drawn from both patent law and copyright law, this Article shows that, together, they dictate that copyright law should not impose liability for copying that enables software interoperability.

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<sup>14</sup> See *id.* at 14-15; Ernest J. Weinrib, *Understanding Tort Law*, 23 VAL. U. L. REV. 485, 520 (1989) (“The concepts of proximate cause and duty normatively link the wrongfulness of the defendant’s unreasonable risk-creation with the wrongfulness of the plaintiff’s suffering.”). Corrective-justice theory focuses on the bipolarity of the plaintiff-defendant causative link, as opposed to, say, an economic analysis that might divorce “who pays” from “who causes.” See Weinrib, *supra*, at 494-526.

<sup>15</sup> Weinrib, *supra* note 14, at 494-526.

<sup>16</sup> WEINRIB, *supra* note 9, at 90.

<sup>17</sup> Professors John Goldberg and Ben Zipursky have developed a “civil redress” theory that bears a “cousin-ship” to the corrective justice approach of Professor Weinrib. A new book explores it but came out too recently to be integrated here. See *generally* GOLDBERG & ZIPURSKY, *supra* note 9. In an earlier work, Professor Goldberg said that what matters is whether the defendant “mistreated” the plaintiff. John C.P. Goldberg, *Rethinking Injury and Proximate Cause*, 40 SAN DIEGO L. REV. 1315, 1337-38 (2003). This too tracks aspects of proximate cause: the more coincidental the injury, the less likely is the plaintiff to “justifiably maintain a sense of victimization or indignation with respect to her treatment at the hands of the defendant.” *Id.* (emphasis omitted) (giving examples of recovery barred “because the injury came about too fortuitously”).

<sup>18</sup> See WEINRIB, *supra* note 9, at 94-98.

Such enforcement would at best fail to serve Congress's purposes in copyright law and at worst frustrate Congress's purposes in both copyright and patent law.

A. *Proximate Cause*

One way to understand the commonality among proximate cause, antitrust injury, and fair use is to show the significant role played in each of the three doctrines by coincidence and fortuity.<sup>19</sup> Hopefully these analogies will put us in a better position to understand what went wrong with the Federal Circuit's decision in *Oracle*.<sup>20</sup>

B. *Examples to Raise Preliminary Questions*

The following examples come from the law of antitrust, the common law of negligence, and the laws of copyright and patent.

*Example 1. Antitrust.* The Clayton Act proscribes mergers "whose effect 'may be substantially to lessen competition, or to tend to create a monopoly.'"<sup>21</sup> If an unlawful merger causes some small firms to lose money, one might expect that the small firms could recover damages. In a leading case, *Brunswick v. Pueblo Bowl-O-Mat, Inc.*,<sup>22</sup> the plaintiffs were small bowling alleys who argued that the defendant, a giant-sized merged firm, had taken actions that hurt the small businesses.<sup>23</sup> How did the plaintiffs claim the big firm hurt them? The big firm had acquired bowling centers that competed with the plaintiffs. By keeping these

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<sup>19</sup> The words are close synonyms. *Coincidence* tends to be the word preferred by torts scholars; *fortuity* is the word the Supreme Court employed in the antitrust context. The two should be distinguished from "moral luck," a term sometimes used to designate occasions "when an agent can be *correctly* treated as an object of moral judgment, despite the fact that a significant aspect of what he is assessed for depends on factors beyond his control." Dana K. Nelkin, *Moral Luck*, STAN. ENCYC. PHIL., <https://plato.stanford.edu/entries/moral-luck/> [<https://perma.cc/DZW4-EBHE>] (last modified Apr. 19, 2019).

My approach to fair use has many cousins. For example, I tread territory similar to what Professor Samuelson calls the type of fair use that arises when the facts of a particular case are "orthogonal" to the purposes of copyright law. Samuelson, *supra* note 8, at 2593-97, 2619. I am indebted to her writings on computer copyright generally (though I cannot pretend to have read them all) and to her understanding of key historic moments and developments (particularly with regard to *Baker*). I am also indebted to the insights of Abraham Drassinower. See generally ABRAHAM DRASSINOWER, WHAT'S WRONG WITH COPYING? (2015).

<sup>20</sup> *Baker* is, of course, a leading case from which sprung a number of doctrines that today help keep copyright from entering patent territory. See Samuelson, *The Story of Baker v. Selden*, *supra* note 5, at 180-81.

<sup>21</sup> *Brunswick Corp. v. Pueblo Bowl-O-Mat, Inc.*, 429 U.S. 477, 485 (1977) (emphases omitted) (quoting Clayton Act, ch. 232, § 7, 38 Stat. 730, 731-32 (1914) (current version at 15 U.S.C. § 18 (2018))).

<sup>22</sup> 429 U.S. 477 (1977).

<sup>23</sup> *Id.* at 479.

other small bowling centers open in significant number, the merged firm had prevented the plaintiffs from raising prices.<sup>24</sup>

Plaintiffs had proven an unlawful merger and that their income would have been higher had the unlawful merger not taken place. Should they prevail?

*Example 2. Negligence.* Assume that a roofer carelessly drops rubble on the street. The obstruction delays an auto, whose driver later experiences injuries that otherwise would have been avoided. Say, for example, that the delay makes the car arrive at a particular corner at the moment lightning strikes, or at the moment when another driver speeds through a stop sign.

Should liability follow for the roofer? The roofer was negligent and was a “but-for” cause of the harm, yet the kind of accident that occurred would be reduced in neither frequency nor intensity if roofers took more care.

*Example 3. Copyright is involved but patent law is not.* Assume that a composer’s third symphony happens to create attractive patterns on the page when printed in sheet music form. Assume further that a wallpaper firm notices the visual beauty of the notes on the page, copies the sheet music without permission, and turns it into popular wall coverings.

Copyright law gives composers (or their employers or assignees) rights over the reproduction of sheet music. It’s possible (though debatable) that compositional excellence can be metered, and compositional energy induced, by royalty fees flowing from sheet music, downloads, or performance streams.<sup>25</sup> However, it is undebatable that compositional skill in music cannot be metered by the popularity of wallpaper.<sup>26</sup>

Should the owner of the musical-composition copyright have a good cause of action against the wallpaper firm?

*Example 4. Copyright and patent law are both involved.* An artist sketches an abstract shape that is quite lovely and sculpts it into alabaster. Now assume that a large aviation company sees the sketch or sculpture on sale and somehow realizes that the shape, if duplicated in certain metals, would perform as an especially effective helicopter rotor.<sup>27</sup>

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<sup>24</sup> *Id.* at 482-83.

<sup>25</sup> See JESSICA SILBEY, *THE EUREKA MYTH: CREATORS, INNOVATORS, AND EVERYDAY INTELLECTUAL PROPERTY* 90-92 (2015).

<sup>26</sup> The music-wallpaper example is one where imposing liability will have null positive effects. It fits within what Professor Samuelson calls the “orthogonal” category of fair use, which is quite similar to the proximate cause function this Article presents. See Samuelson, *supra* note 8, at 2593-97, 2619; *supra* note 19. Professor Samuelson illustrates her orthogonal category by pointing to the fair use treatment usually given to court personnel and trial lawyers who reproduce letters and memoranda for use as evidence in court proceedings. *Id.* at 2593-94. The documents are undoubtedly copyrighted literary works, but copying for litigation purposes is fair use because it is being “done for a purpose orthogonal to the purpose for which the work was originally created.” *Id.* at 2619.

<sup>27</sup> The sculpture I have in mind is Constantin Brancusi, *Bird in Space* (1923), <https://www.metmuseum.org/art/collection/search/486757> [<https://perma.cc/4REN-EWJ6>].

The company reproduces the lovely shape in the form of helicopter rotors, without permission from the copyright owner. Assume further that, under one of patent law's many rules, the sculptor has let too much time pass to apply for a utility patent. Should the aviation company's functional use of the artworks count as infringement of copyright?

## II. PRELIMINARY VIEW OF FAIR USE

Fair use can arise from a lack of fit between the facts of a particular case and copyright's own norms. One might say that such types of fair use are motivated by "interior" concerns.<sup>28</sup> Fair use can also arise when enforcing a particular kind of copyright claim would conflict with norms "exterior" to copyright itself.

To illustrate, here is a fact pattern that mixes interior and exterior concerns: Consider a love letter. Like most written communications, it will probably have a copyright. If a hostile party copied the letter to submit it as evidence in a divorce trial, the copying would likely constitute fair use. Part of the reason for fair use would be that permitting nonconsensual copying in this setting will facilitate truth finding in litigation. The latter is a valuable goal but one "exterior" to copyright. Another part of the reason would be that court-related copying is hardly a reliable barometer of a writer's skill or popularity.<sup>29</sup> This lack of connection to authorial incentives is an "interior" reason for the fair-use grant because it rests on copyright's own norms.

Of the many kinds of fair use relevant to *Oracle*,<sup>30</sup> this Article primarily addresses two. Both rely on interior norms. The first type of fair use that

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<sup>28</sup> My "market failure" approach to fair use is primarily interior in this way. In my earlier work, *Fair Use as Market Failure*, I argue that because (1) the central mechanism of copyright law is to incentivize authors by giving them leverage with which to extract payments from markets, (2) fair use is likely appropriate in cases where, even if the copyright were enforced, circumstances would interfere with the market's ability to serve the public interest. See Gordon, *Fair Use as Market Failure*, *supra* note 8, at 1602-04.

<sup>29</sup> Professor Samuelson uses a similar example to illustrate what she calls the "orthogonal" category of fair use. See Samuelson, *supra* note 8, at 2593-97, 2619. She explains that copying for litigation purposes is fair use because it is being "done for a purpose orthogonal to" (at right angles to) "the purpose for which the work was originally created." *Id.* at 2619. Compare this to the proximate cause function of fair use described in this Article. The proximate cause type of inquiry might compare the copier's purposes not to the author's purposes, but only as part of evaluating how imposing liability on the copier would impact on the statute's goals.

<sup>30</sup> For example, copyright owners who invite copying should be estopped from removing their permission if the net effect of the course of behavior is to harm copyists who have relied on the prior permissions. See generally Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533 (1993) [hereinafter Gordon, *A Property Right in Self-Expression*]. It is arguable that Sun, Oracle's predecessor in interest, created such reliance by invitations to copy and that the behavior should be attributed to Oracle in a way that, through fair use, expands the public's liberties. The estoppel argument is highly fact dependent, as is the issue of whether copying by Google should be entitled to the expansion of liberty. See *id.* at 1567.

concerns this Article arises when the fair use doctrine serves as a test for normative fit between copyright's goals and the facts of a given case. This is the most general way to describe fair use: it resembles proximate cause because it reflects judicial insistence on a normative, nonarbitrary connection between the defendant's deeds and the law's purposes.<sup>31</sup>

The second type of fair use this Article addresses is a subset of the first. Sometimes referred to as the "explanation/use distinction," it embeds a dichotomy between two kinds of copying: copying for purposes properly within copyright's domain (such as copying for purposes of explanation, entertainment, or education) and copying for solely functional purposes (such as copying a copyrighted sketch of an invention for the purpose of building the invention).<sup>32</sup> Copying for purely functional use should always be fair, because there is only an arbitrary connection between a work's suitability for functional uses and copyright's desire to provide *authorial* incentives.<sup>33</sup>

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<sup>31</sup> See Wendy J. Gordon, *Reality as Artifact: From Feist to Fair Use*, LAW & CONTEMP. PROBS., Spring 1992, at 93, 94-95; *id.* at 101 ("In a civilized nation, much of reality is artifact. Too broad a set of intellectual property rights can give one set of persons control over how that reality is viewed, perceived, interpreted—control over what the world means. . . . [L]imitations on copyright are appropriate to provide the public a liberty of reconceptualization.").

<sup>32</sup> Enunciated most clearly in *Baker v. Selden*, 101 U.S. 99, 102-06 (1880), the explanation/use distinction was endorsed for pictorial works by the Copyright Act of 1976. See 17 U.S.C. § 113(b) (2018); *infra* Section V.B.2 (discussing origins of Copyright Act). Its logic would extend to literary and audio works as well, via the fair use doctrine. Fair use too is a judicial development now memorialized in statutory form. 17 U.S.C. § 107.

<sup>33</sup> To briefly summarize what the Article later argues, fair use for functional applications is appropriate for the following reasons: First, the Supreme Court in *Baker v. Selden*, 101 U.S. 99, 102-06 (1880) can be interpreted as holding that copyright owners have no exclusive rights to control utilitarian uses of their copyrighted works. Second, the post-*Baker* cases implicitly referenced in 17 U.S.C. § 113(b) seem to take that view of *Baker*. Although the title of § 113 mentions pictorial and sculptural design, the provision's language is broad enough to encompass other kinds of copyrighted works, including computer programs. See Wendy J. Gordon, *How Oracle Erred: The Concept of "Use" and the Future of Computer Copyright*, in COPYRIGHT IN AN AGE OF LIMITATIONS AND EXCEPTIONS 375, 380-86 (Ruth L. Okediji ed., 2017) [hereinafter Gordon, *How Oracle Erred*]. Third, imposing copyright liability for functional use could weaken inventors' willingness to accept patent law's comparatively harsh terms. And fourth, any injury caused by functional use will impact incentives and interests that copyright does not protect.

My concept of "interests that copyright does not protect" warrants explanation. Any income, admittedly, can impact authorial incentives. Some gains and losses are more closely connected to copyright's goals than are others. The kind of harm most significant in the fair use inquiry occurs when a copyright owner loses income because a copyist makes and sells unauthorized reproductions that satisfy the public's taste for the plaintiff's authorship. Such harm is particularly important because substituting a copy for the original threatens a key goal of copyright—namely, to incentivize authors to satisfy the public's demand for authorship.

It might be wondered why this Article classifies as “interior” a kind of fair use that refers both to copyright and to patent for governing norms. That question is addressed in the next Section.

### III. CONGRESS GIVES THE CROWN TO PATENT LAW, A JEALOUS MONARCH

In the federal scheme of intellectual property, Congress has clearly made patent sovereign. In delving into patents law’s objectives, copyright law’s goals also become clear. The yearning to protect artistry must, by congressional command, yield to patent law when the two conflict. Similarly, the yearning of trademark judges to protect consumers from consumer confusion also yields to patent law when the two conflict. Consider how Congress has ordered the statutes so that preserving patent law’s freedom of action dominates both federal trademark and federal copyright law.

Federal trademark law under the Lanham Act seeks to prevent consumers from being confused about the source or sponsorship of goods and services.<sup>34</sup> Yet the Lanham Act refuses to protect distinctive designs as marks if they are “functional.” Regardless of how many consumers have come to associate the functional design with a particular company, anyone can copy it. Any relief obtained would be modest. For example, a defendant copyist might be ordered to add labels to clarify which company made a particular object.<sup>35</sup>

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The Supreme Court has distinguished substitutionary harm from losses that result from the public losing taste for the plaintiff’s authorship. The latter losses do not weigh against granting fair use, even if the change in taste resulted from copying. *See Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 591-92 (1994) (“[W]hen a lethal parody, like a scathing theater review, kills demand for the original, it does not produce a harm cognizable under the Copyright Act.”) Like taste-changing uses, functional uses of copyrighted works (such as building a machine from a copyrighted blueprint) reflect factors other than the public’s taste for the plaintiff’s authorship. If copying threatens the market for these nonauthorial uses, the losses should not be cognizable under the market impact factor of the fair use inquiry. 17 U.S.C. § 107(4). Although I know of no decisions that have yet applied the logic of *Acuff-Rose* to functional uses, the logic of extending *Acuff-Rose* to these other situations is strong.

<sup>34</sup> *See TrafFix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23, 28-29 (2001).

<sup>35</sup> *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 232 (1964). *Sears* has been subject to varying treatment over the years. Its relevance to the *Oracle* dispute might be questioned also because *Sears* is a preemption case addressing federal/state conflict rather than addressing, as *Oracle* must, comity among federal statutes. *Id.* at 227-28 (noting that question is whether “State’s law of unfair competition is compatible with the federal patent law”). Nevertheless, this core holding remains good law and has been absorbed into the federal Lanham Act both judicially and by statute. *See, e.g.*, 15 U.S.C. § 1052(e) (providing that functional marks are not registrable); *id.* § 1125(a)(3) (“In a civil action for trade dress infringement under this chapter for trade dress not registered on the principal register, the person who asserts trade dress protection has the burden of proving that the matter sought to be protected is not functional.”).



The reason why the distinctive functional design itself can be copied and sold by anyone is straightforward: deference to patent law.<sup>36</sup> Deciding the appropriate balance between protection and free use for functional articles is a decision Congress embodied in the patent statutes. Trademark law must take patent policy into account.<sup>37</sup>

Because a trademark owner's rights are largely limited to preventing confusion,<sup>38</sup> they are narrower than the exclusive rights given to copyright owners. Therefore, copyright poses a greater threat to patent and shows an even stronger deference to patent law than does trademark law. Consider some of the many ways that copyright expresses its deference to patent:

- The copyright statute explicitly refuses to give copyright protection to any "procedure, process, system, [or] method of operation";<sup>39</sup> those are governed by patent law.<sup>40</sup> They go unprotected even if they are "described, explained, illustrated, or embodied" in a work of creative authorship.<sup>41</sup>
- Under both statute and Supreme Court precedent, not all copyrights are equal. Copyrights in the depiction of "useful articles" (such as photos of chairs, cardboard models of machines, and drawings of lamps) are weak; they have no force against persons who copy them to make working versions of the actual articles.<sup>42</sup> Thus, while an artist can copyright a drawing of a highway interchange, the drawing gives

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<sup>36</sup> "The Lanham Act does not exist to reward manufacturers for their innovation in creating a particular device; that is the purpose of the patent law and its period of exclusivity." *TrafFix*, 532 U.S. at 34.

<sup>37</sup> Judicial decisions like *TrafFix* rest on statutory supports. Under the Lanham Act, functionality invalidates any trademark, even an "incontestable" registered trademark. 15 U.S.C. §§ 1064(3), 1065. Similarly, persons who file federal litigation on the basis of an unregistered mark have the burden of proving nonfunctionality. *Id.* § 1125.

<sup>38</sup> I do not mean to understate the danger that trademark doctrine could also pose to patent law were "functional" marks not removed from trademark law's palette. Not only are some trademarks and service marks protected from dilution as well as from confusion, but in addition the meaning of "confusion" has drastically expanded over the last half-century. *See, e.g.,* Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 405 (1990). Further, suits sometimes succeed against uses of marks in roles and contexts outside trademark law's traditional scope. *See, e.g.,* Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1670-74 (2007).

<sup>39</sup> 17 U.S.C. § 102(b).

<sup>40</sup> *See* 35 U.S.C. § 101 ("Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter . . . may obtain a patent . . .").

<sup>41</sup> 17 U.S.C. § 102(b).

<sup>42</sup> *See Baker v. Selden*, 101 U.S. 99, 102-06 (1880) (explaining why it would be a "fraud upon the public" to empower copyright owners to restrict the public from deploying techniques and systems depicted in copyright works).

the copyright owner no power to object or collect royalties when a transportation agency embeds the artist's drawn design choices in a real highway off-ramp.<sup>43</sup>

- Similarly, a sculptured form that is also a useful article cannot gain copyright except to the extent that its utilitarian and aesthetic features are "separable."<sup>44</sup>

In all these cases, copyright is restrained so that patent law's decisions can govern. And often the patent decision is to allow the public to copy.

Deference to patent is so strong a theme in copyright law that, in *Example 4* above—the helicopter-rotor example—a victory for the defendant would be overdetermined by many of the doctrines just mentioned.<sup>45</sup>

- The court might hold that the sculpture lacks copyright on the ground that copyright law declares that "useful articles" with inseparable functional elements are uncopyrightable.<sup>46</sup>

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<sup>43</sup> *Muller v. Triborough Bridge Auth.*, 43 F. Supp. 298, 300 (S.D.N.Y. 1942) (holding that building bridge that duplicates design of drawing does not infringe copyright in drawing). Early cases such as *Muller* are still good law. They are incorporated by reference in 17 U.S.C. § 113(b); see also *infra* Section V.B.2 (outlining history of Copyright Act of 1976).

<sup>44</sup> 17 U.S.C. § 101 (defining "useful article"). The definitional case law on both "useful article" and "separability" is in disarray following *Star Athletica, L.L.C. v. Varsity Brands, Inc.*, 137 S. Ct. 1002, 1007 (2017) (holding that article is protected under copyright only if it "(1) can be perceived as a two- or three-dimensional work of art separate from the useful article and (2) would qualify as a protectable pictorial, graphic, or sculptural work . . . if it were imagined separately from the useful article").

<sup>45</sup> The defendant's victory could be stated either in terms of the copyright not extending to this useful object (noncopyrightability) or in terms of the rights of the copyright owner not being violated ("scope of right"). The Supreme Court opinion in *Baker* seems to embrace both perspectives. *Baker*, 101 U.S. at 102-06; see *infra* notes 154-69 and accompanying text (detailing each perspective).

The statute also provides the same two grounds for a defendant victory. First, the noncopyrightability ground appears in 17 U.S.C. § 102(b), which excludes from copyright protection any "idea, procedure, process, system, method of operation, concept, principle, or discovery." This is further supported by the "separability" limitation that appears in § 101 as part of the definition of "useful article." See 17 U.S.C. § 101 (defining "useful article" as "having an intrinsic utilitarian function that is not merely . . . the appearance of the article or to convey information"). Second, the ground based in scope of right appears in § 107 (defining fair use) and § 113 (defining rights in pictorial, graphic, and sculptural works).

<sup>46</sup> 17 U.S.C. § 113(b).

- Or the court might find that the defendant's helicopter company was not violating copyright law because a copyright owner's "exclusive rights" never extend to functional "use."<sup>47</sup>
- Alternatively, the court might say that the shape "merged" into an uncopyrightable idea.<sup>48</sup>
- Or perhaps the court would state the ground for defendant's victory in terms of "fair use."<sup>49</sup>

Congress grudgingly rations protection under its patent law.<sup>50</sup> This is evidenced by patent law's restraints: an inventor cannot get a patent without applying for it,<sup>51</sup> and the patent must meet standards of "nonobviousness"<sup>52</sup> and "novelty."<sup>53</sup> Further, what's given when these demands are met is a short period of exclusive right: the patented innovation goes into the public domain after a term of twenty years,<sup>54</sup> far shorter than the copyright term of "life of the author" plus seventy years.<sup>55</sup> The statutory pattern suggests that Congress sees significant costs in granting exclusive rights over inventions. The courts certainly seem to think so.

The high cost of "locking up" inventions may be one reason why Congress in the copyright and trademark statutes and courts in preemption cases tend to see copyright and trademark law as obligated to *withhold* their own exclusive rights when such rights might undermine patent law's dominance. Patent needs the ability to make its decisions binding. For example, here is the Supreme Court:

In regard to mechanical configurations, Congress had balanced the need to encourage innovation and originality of invention against the need to insure competition in the sale of identical or substantially identical products. The standards established for granting federal patent protection to machines thus indicated not only which articles in this particular category Congress wished to protect, but which configurations it wished to remain free.<sup>56</sup>

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<sup>47</sup> *Id.*; *Baker*, 101 U.S. at 105 (distinguishing "explanation" from "use"). The animating principle here is a distinction between uses properly regulated by copyright law and uses not regulable by copyright because they belong in the domain of patent law.

<sup>48</sup> *See, e.g.*, *Allen v. Acad. Games League of Am., Inc.*, 89 F.3d 614, 617-18 (1996).

<sup>49</sup> 17 U.S.C. § 107.

<sup>50</sup> I refer to utility patents (rather than to design patents, for example) unless otherwise specified.

<sup>51</sup> *See* 35 U.S.C §§ 111, 151.

<sup>52</sup> *Id.* § 103.

<sup>53</sup> *Id.* § 102.

<sup>54</sup> *Id.* § 154(a)(2).

<sup>55</sup> 17 U.S.C. § 302. The rules of copyright duration are quite complex, but most works created after 1978 will have life-plus-seventy protection.

<sup>56</sup> *Goldstein v. California*, 412 U.S. 546, 569 (1973).

Copyright, by contrast, seems to reflect the judgment that it costs society very little. Consider the statutory pattern: copyrights arise automatically,<sup>57</sup> the applicable standard for protection is absurdly easy to meet,<sup>58</sup> and today the typical copyright will likely last a century or more.<sup>59</sup> Arguably these easy, long-lived rights can be tolerated because, as we are told, they cannot “lock up” an idea or procedure.<sup>60</sup> However, what happens when copyright is used to “lock up” an idea or method of operation? That is the danger with copyrights in software.

That brings us to another example. This one is more controversial, for it lies at the center of *Oracle*. The maker of a program copies symbols such as words and numbers that, standing alone, might resemble part of a literary work. The copying might look like a copyright violation. However, on inspection it is learned that the value of the sequences has nothing to do with expressive merit. Whether the sequences were elegant and well-articulated or drab and clumsy was irrelevant. They were “method headers”—language from Java needed to carry out commands—copied for purposes of furthering interoperability.<sup>61</sup> The act of copying when it has nothing to do with expressive values should not be copyright infringement. Moreover, penalizing the copying can even be counterproductive, for it enables copyright to invade the territory that Congress has given to patent law.

#### A. *Guarding Against Fortuitous Connections*

Courts enforce legal rights according to the purposes those rights are meant to serve.<sup>62</sup> When by fortuity something outside of the purposes of the law falls unexpectedly within its reach, the coincidence must be seen for what it is: an outlier. In a major case currently before the Supreme Court—*Oracle*—hewing to this basic principle can keep the Court from repeating the lower court’s errors.

Both by statute and decisional law, copyright owners cannot use the courts to control copying that, by intention and effect, has nothing to do with authorial expression.<sup>63</sup> As will be shown below, that limitation is particularly sharp when the copier wants to employ the author’s work functionally because copyright’s

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<sup>57</sup> 17 U.S.C. § 101(a).

<sup>58</sup> *Id.* (providing protection for “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>59</sup> *Id.* § 302.

<sup>60</sup> *See supra* notes 42-43 and accompanying text.

<sup>61</sup> *See Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1186 (Fed. Cir. 2018), *cert. granted*, No. 18-956, 2019 WL 6042317 (U.S. Nov. 15, 2019) (mem.).

<sup>62</sup> Jurisprudence scholar Ernest Weinrib goes so far as to claim that such limits must inhere in any plaintiff/defendant private law relation that complies with corrective justice. *See generally* WEINRIB, *supra* note 9.

<sup>63</sup> 17 U.S.C. §§ 107, 113(b); *Baker v. Selden*, 101 U.S. 99, 102-06 (1880); *see also* Gordon, *How Oracle Erred*, *supra* note 33, at 380-86 (collecting cases).

availability in such contexts might undermine innovators' willingness to accept the demands and limitations of patent law.

To illustrate why copyright should not be giving exclusive rights in functional objects, consider this metaphor from Benjamin Kaplan: "[T]o make the copyright turnstile revolve, the author should have to deposit more than a penny in the box . . . ."<sup>64</sup> If what the Copyright Act requires to make its turnstile revolve is a metaphorical nickel, then what patent legislation requires to make *its* turnstile revolve is a metaphorical twenty-dollar bill. Holdings such as the Federal Circuit's holding in *Oracle* would give plaintiffs quasi-patent rights in return for small change.

B. *Why Does the Oracle Case Raise the Issue of Interoperability?*

An understanding of the role of interoperability in the *Oracle* case is crucial to reaching a conclusion on fair use. However, the role of interoperability in the case might not be clear, since there seems to be no dispute that Android can "interoperate" with certain elements of Java in the same way any other user can.<sup>65</sup> The particular problem is less a matter of Android/Java linkages than of linkages between Android and third-party applications ("apps").<sup>66</sup>

By the time Google came on the scene with its Android smartphone, a multitude of third-party programs already utilized Java "method headers."<sup>67</sup> Java had encouraged such use.<sup>68</sup> Google and the third-party programmers wanted preexisting and new programs to be easily usable on Android, with minimum alteration to preexisting programs and minimum duplication when a new app was prepared for distribution.<sup>69</sup>

This may sound like a selfish desire. However, it is a selfish desire that redounds to the benefit of the public. If a command to "take the square root of a number" is identified and its syntax structured by a particular method header convention in Java, that particular method header specifies the text that third-party programmers are accustomed to employing to signal that they want to take a square root.

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<sup>64</sup> BENJAMIN KAPLAN, AN UNHURRIED VIEW OF COPYRIGHT 46 (1967).

<sup>65</sup> See *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1368-72 (Fed. Cir. 2014) (noting structure of Google's interoperability argument).

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* at 1348-51, 1360.

<sup>68</sup> Java's slogan had been "write once, run anywhere." DON RAUF, GETTING TO KNOW JAVA 7 (2019) ("Java's catchphrase was 'write once, run anywhere.' Code written on one computer in this new lingo could run on another system. Gosling and colleagues concocted a system that eliminated some of the tedious aspects of writing code. Java allowed the user to write bits of code that could be reused later without needing to rewrite the code over and over again. As internet use became widespread in the 1990s, the designers realized that the new language was ideal for creating online applications.").

<sup>69</sup> *Oracle*, 750 F.3d at 1350-51.

Meanwhile, Google independently created its own implementation code for things like taking square roots. (Any copying of implementation code was disposed of separately in the case.<sup>70</sup> At this stage of the litigation, Google has redone the implementation code on its own.) The district court noted:

It is the method body that does the heavy lifting, namely the actual work of taking the inputs, crunching them, and returning an answer. The method body can be short or long. Google came up with its own implementations for the method bodies and this accounts for 97 percent of the code for the 37 packages.<sup>71</sup>

So what Google seeks in the litigation is the ability to empower programmers to employ Google's implementation code (to do work the programmers need) by calling for various functions by means of Java terminology.

Third-party apps are important to the success of any smartphone. The worry is that a plaintiff victory in this case could get in the way of third-party programs being able to interoperate easily with the Android platform. Like Java, Google tries to save third-party programmers from having to rewrite every module. If third-party programmers have to learn a new set of method headers just to call on the same functions, some potential cost savings disappear. If, when writing for Android, the app programmers have to learn a set of synonyms, everyone is worse off (except maybe the current owner of Java). If the familiar method headers can be used, by comparison, the amount of necessary rewriting will be far less. Usually social policy advises against requiring duplication of effort. There is even a disdainful name for such duplication: "reinventing the wheel."

Admittedly, the disdain is overstated; there might be social benefit to reinventing the wheel in some circumstances.<sup>72</sup> However, that is not copyright's concern. Copyright was crafted to deal with behavior such as copying a sketch (in which a novel wheel might or might not appear), not with inventing improved modes of transport.

Similarly, it seems like good policy to enable programs whose main parts are independently written<sup>73</sup> to use occasional conventions popularized by someone else. However, whether or not it is good policy, the resolution lies with branches of law having to do with technology, not copyright law.

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<sup>70</sup> *See id.*

<sup>71</sup> *Oracle Am., Inc. v. Google Inc.*, 872 F. Supp. 2d 974, 980 (N.D. Cal. 2012), *rev'd*, 750 F.3d 1339 (Fed. Cir. 2014).

<sup>72</sup> Increasing a copier's costs by forcing "reinvention" can help prevent the copier from selling a product much lower in price than the originator's product. Determining whether this is a good idea or not, in particular circumstances, is a matter of empirical investigation, whose results would be evaluated by policies in patent, media, and technology.

<sup>73</sup> The implementation code written independently by Google does the "heavy lifting." *Oracle*, 872 F. Supp. 2d at 980.

At the beginning of software's inclusion into copyright, Congress warned that expressivity and not technological ingenuity is what's being protected.<sup>74</sup> Admittedly, expressivity and ingenuity may be hard to disentangle, particularly because both can be elegantly executed. Nevertheless, the thrill of watching immensely talented people follow their muses should not obscure the truth that the tasks involved differ.

When on the border between patent federal IP and nonpatent federal IP, Supreme Court cases consistently remind us that patent policy must govern.<sup>75</sup> So if a court is uncertain whether subordinate (nonpatent) doctrines should protect a functional symbol or design, precedent suggests that doubts should be resolved *against* letting the nonpatent law regulate the outcome.<sup>76</sup>

C. *Does Copyright Law "Clearly Express" a Desire That Courts Should Impose Liability for Copying That Lacks Normative Significance?*

Recall the *Brunswick* antitrust litigation. When asked to impose antitrust liability that would yield unproductive results, the Supreme Court has directed that defendants should prevail unless the governing statute gives "clear expression" of congressional intent to widen the scope of liability.<sup>77</sup> No such "clear expression" to disregard statutory purpose appears in the copyright

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<sup>74</sup> H.R. REP. NO. 94-1476, at 57 (1976) ("[T]he expression adopted by the programmer is the copyrightable element in a computer program, and . . . the actual processes or methods in the program are not within the scope of the copyright law.").

<sup>75</sup> See, e.g., *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 151 (1989) ("The novelty and nonobviousness requirements of patentability embody a congressional understanding, implicit in the Patent Clause itself, that free exploitation of ideas will be the rule, to which the protection of a federal patent is the exception."); see also *Goldstein v. California*, 412 U.S. 546, 569 (1973) (noting preemption framework and finding that "[t]he standards established for granting federal patent protection to machines thus indicated not only which articles in this particular category Congress wished to protect, but which configurations it wished to remain free"). For patent's impact on federal trademark law see, for example, *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23, 43 (2001). For patent's impact on federal copyright law, the case law *locus classicus* is *Baker v. Selden*, 101 U.S. 99, 102-06 (1880).

<sup>76</sup> See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 215 (2000) ("To the extent there are close cases, we believe that courts should err on the side of caution and classify ambiguous trade dress as product design, thereby requiring [the trademark claimant to prove] secondary meaning." (emphasis added)).

<sup>77</sup> In *Brunswick*, the Court conceded in dicta that limiting a causation requirement to merely factual ("but-for" cause) might be possible. However, the Court cautioned, such a step should be taken only if the statute had a "clear expression" of Congress's desire to expand liability beyond the normative nexus. *Brunswick Corp. v. Pueblo Bowl-O-Mat, Inc.*, 429 U.S. 477, 488 (1977) ("Of course, Congress is free, if it desires, to mandate damages awards for all dislocations caused by unlawful mergers despite the peculiar consequences of so doing. But because of these consequences, 'we should insist upon a clear expression of a congressional purpose,' before attributing such an intent to Congress." (citation omitted) (quoting *Hawaii v. Standard Oil Co.*, 405 U.S. 251, 264 (1972))).

statute. To the contrary, copyright is full of provisions that remind courts and practitioners of the important role that limits on copyright play in achieving the “Progress” contemplated by the U.S. Constitution.<sup>78</sup> In particular, the fair use doctrine has not only flourished judicially but has also been specifically approved by Congress.

In negligence law, the principle of limiting liability to those facts that further statutory purpose is sometimes deployed as a limitation on the “duty” that actors owe.<sup>79</sup> As mentioned, more commonly negligence courts enforce this limiting principle under the label of “proximate cause.”<sup>80</sup>

Another formulation of the principle is “antitrust injury,” which is the rubric the Supreme Court employed when it made explicit that Clayton Act liability should be limited solely to cases that satisfy the need for normative connection.<sup>81</sup> In copyright law, the principle is embodied in a host of limits and exceptions,<sup>82</sup> and, as mentioned, it is embodied in the doctrine that overlaps them all—namely, the doctrine of “fair use.”<sup>83</sup> These embodiments are further discussed below, after a fuller presentation of the *Oracle* dispute.

#### IV. NORMATIVE LIMITS ON LIABILITY IN FEDERAL STATUTORY LAW

##### A. *The Copyright Statutes: Overview of the Oracle Dispute*

It will be useful to drop back and give a fuller factual summary of the *Oracle* dispute to show how the proximate cause issue arises within it. Oracle purchased the copyright to Java, a program useful to many programmers, including those who create apps for smartphones.<sup>84</sup> To help its Android phone attract more apps, Google tried in various ways to emulate Java.<sup>85</sup> Through independent coding, Google created a programs that could implement (carry out) tasks that Java’s programs also perform.<sup>86</sup> Any copying done to create the implementation code, whether of idea or expression, is no longer in dispute.<sup>87</sup>

The current stage of the lawsuit tests another type of copying: the verbatim copying of the method headers Java employed to *name and request* the tasks to

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<sup>78</sup> See *supra* notes 62-63 and accompanying text.

<sup>79</sup> See *infra* Section V.A (discussing leading proximate cause theories in tort law).

<sup>80</sup> See *infra* notes 131-46 and accompanying text (analyzing predominant view in tort law).

<sup>81</sup> *Brunswick Corp.*, 429 U.S. at 488.

<sup>82</sup> See 17 U.S.C. §§ 107-122 (2018).

<sup>83</sup> Gordon, *Fair Use as Market Failure*, *supra* note 8, at 1600 (finding that doctrine of fair use “renders noninfringing certain uses of copyrighted material that might technically violate the statute, but which do not violate the statute’s basic purposes”).

<sup>84</sup> See *Oracle Am., Inc. v. Google LLC*, 886 F.3d 1179, 1186 (Fed. Cir. 2018), *cert. granted*, No. 18-956, 2019 WL 6042317 (U.S. Nov. 15, 2019) (mem.).

<sup>85</sup> *Id.*

<sup>86</sup> *Id.*

<sup>87</sup> See *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1360-61 (Fed. Cir. 2014).



be performed.<sup>88</sup> These are essentially command titles, sometimes known as application program interfaces (“APIs”).<sup>89</sup> Oracle sued in copyright because these keystroke sequences, by coincidence, take the form of letters and other symbols.<sup>90</sup>

Google’s reasons for copying the command names had nothing to do with the communicative qualities of the names. Google wanted third-party programmers to be able to call upon Google’s Java-like functionality by using the *same* keystroke signals programmers use when they call upon the parallel functions in Java itself.<sup>91</sup> It appears that *sameness*—not expressiveness—was the value sought. Google would have copied the keystrokes even if Oracle had used totally arbitrary and meaningless symbols, like the *dot dot dot / dash dash dash / dot dot dot* that signals a cry for help in Morse Code.

It therefore appears likely that a proper awareness of proximate cause would have dictated a decision for the defendants, and the trial court did give the defendants (and the principle of proximate cause) a victory. But the Federal Circuit overturned that result. The Supreme Court granted certiorari in *Oracle* to resolve the interrelated questions of copyrightability and “fair use.”<sup>92</sup>

B. *The Antitrust Statutes: Refusing to Impose Liability for Fortuitous Losses*

As part of the antitrust laws, the Clayton Act is meant to encourage vigorous competition. Sometimes an illegal merger can cause harm of a kind conceptually unrelated to a decrease in competition. Should the proximate cause limiting principle apply and bar plaintiffs from collecting such conceptually unrelated monies?

At one point, the Third Circuit Court of Appeals ruled that *any* kind of loss could be collected so long as it was factually traceable (in a but-for sense) to an “illegal presence” in the market.<sup>93</sup> The Supreme Court sharply disagreed, viewing losses unrelated to the purposes of the statute as “entirely fortuitous.”<sup>94</sup>

As explained above, the plaintiffs in *Brunswick* complained that a merger had resulted in their experiencing more competition, not less.<sup>95</sup> To have let the

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<sup>88</sup> *Oracle*, 886 F.3d at 1185-86.

<sup>89</sup> *Id.* at 1186.

<sup>90</sup> *Id.* I doubt that I am the first to notice that a similar fortuity gave rise to the dispute in *Baker v. Selden*, 101 U.S. 99, 104 (1880) (“In describing the art, the illustrations and diagrams employed *happen to* correspond more closely than usual with the actual work performed by the operator who uses the art.” (emphasis added)).

<sup>91</sup> *Oracle*, 886 F.3d at 1187-88.

<sup>92</sup> See *Google LLC v. Oracle Am., Inc.*, No. 18-956, 2019 WL 6042317 (U.S. Nov. 15, 2019).

<sup>93</sup> *NBO Indus. Treadway Cos. v. Brunswick Corp.*, 523 F.2d 262, 273 (3d Cir. 1975), *vacated sub nom. Brunswick Corp. v. Pueblo Bowl-O-Mat, Inc.*, 429 U.S. 477 (1977).

<sup>94</sup> *Brunswick Corp.*, 429 U.S. at 487.

<sup>95</sup> *Id.* at 481.

plaintiffs prevail would obviously have been counterproductive. As the Court wrote:

[R]espondents complain that by acquiring the failing centers petitioner preserved competition, thereby depriving respondents of the benefits of increased concentration. The damages respondents [sought] are designed to provide them with the profits they would have realized had competition been *reduced*. The antitrust laws, however, were enacted for “the protection of *competition*, not *competitors*.” It is inimical to the purposes of these laws to award damages for the type of injury claimed here.<sup>96</sup>

The *Brunswick* decision took as its touchstone a principle broader than avoiding counterproductive liability. The Court goes further, emphasizing that a “but-for” test of factual causation is inadequate; such an approach “divorces antitrust recovery from the purposes of the antitrust laws without a clear statutory command to do so.”<sup>97</sup> Rather, to be actionable, the injury must be “of the type the antitrust law was intended to prevent”;<sup>98</sup> it must have “[some]thing to do with the reason the merger was condemned.”<sup>99</sup> Relying solely on factual causation, wrote the Court, “would make . . . recovery entirely fortuitous, and would authorize damages for losses which are of no concern to the antitrust laws.”<sup>100</sup> Stepping beyond the counterproductive nature of the relief sought, the Court implied that the plaintiffs should have lost even had the antitrust laws been “*merely indifferent* to the injury claimed.”<sup>101</sup>

In short, the Court took a back-to-basics approach that reinstated the standard principle that forbade imposing liability “for losses which are of no concern to the antitrust laws.”<sup>102</sup> In turn, wrote the Court:

We therefore hold that for plaintiffs to recover . . . they must prove *more* than injury causally linked to an illegal presence in the market. Plaintiffs must prove *antitrust* injury, which is to say injury *of the type the antitrust*

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<sup>96</sup> *Id.* at 488 (emphasis added) (citation omitted) (quoting *Brown Shoe Co. v. United States*, 370 U.S. 294, 320 (1962)).

<sup>97</sup> *Id.* at 487.

<sup>98</sup> *Id.* at 489.

<sup>99</sup> *Id.* at 487.

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 488 (emphasis added).

<sup>102</sup> *Id.* Sounding remarkably similar to judges in negligence actions, the Court further wrote:

[U]nder the Court of Appeals’ holding, once a merger is found to violate § 7, all dislocations caused by the merger are actionable, regardless of whether those dislocations have anything to do with the reason the merger was condemned. This holding would make § 4 recovery entirely fortuitous, and would authorize damages for losses which are of no concern to the antitrust laws.

*Id.*

*laws were intended to prevent and that flows from that which makes defendants' acts unlawful.*<sup>103</sup>

Virtually echoing proximate cause doctrine, the Court wrote that for recovery of a loss to be proper, “[i]t should, in short, be ‘the type of loss that the claimed violations . . . would be likely to cause.’”<sup>104</sup>

## V. WHY DO LIMITING PRINCIPLES MATTER?

### A. Copyright Requires Limits

If copyright law were a movie monster, it would be thirteen feet tall and take over the whole screen. Equipped with time-travel talons, it extracts duties from its contemporaries’ yet unborn great-grandchildren<sup>105</sup> and drags expired copyrights zombie-like from the public domain.<sup>106</sup>

But copyright was not always a dangerous creature. Most observers diagnose congressional vulnerability to interest-group pressure as the primary cause of copyright’s dreadful hypertrophy.<sup>107</sup> One potential route for slimming copyright back to effectiveness is judicial rather than legislative. Copyright courts could employ proximate cause as a model for determining whether a plaintiff has made a prima facie showing that the defendant’s behavior lies within the plaintiff’s exclusive scope of the copyright. As in negligence law’s proximate cause doctrine, courts should deny plaintiffs a victory in those cases where harnessing the behavior complained of would not be likely to provide desired incentives.

Limiting principles are important not only because of copyright’s swollen presence but also because proximate cause amounts to a demand for fit between legal policy and particular facts. Doctrines like trespass that govern property in land have a low threshold; not much fit is required to penalize an entry.<sup>108</sup> As

<sup>103</sup> *Id.* at 489 (first and third emphases added). This case is also usefully discussed in Mark A. Lemley & Mark P. McKenna, *Unfair Disruption*, 100 B.U. L. REV. 71 (2020).

<sup>104</sup> *Brunswick Corp.*, 429 U.S. at 489 (omission in original) (quoting *Zenith Radio Corp. v. Hazeltine Research*, 395 U.S. 100, 125 (1969)).

<sup>105</sup> Most copyrights now endure for seventy years after the author’s death. 17 U.S.C. § 302(a) (2018). Therefore, for example, adult grandchildren might inherit from an eighty-year-old author her copyright in a book she wrote in her youth sixty years before. At the grandmother’s death, the copyright will still have seventy years to run, for a total duration of 130 years.

<sup>106</sup> Restoration of many foreign citizens’ expired U.S. copyrights is mandated by 17 U.S.C. § 104A. *See, e.g.*, U.S. COPYRIGHT OFFICE, CIRCULAR 38B: RESTORATION UNDER THE URAA 1 (2013), <http://www.copyright.gov/circs/circ38b.pdf> [<https://perma.cc/ZZ6J-SGDY>] (explaining restoration).

<sup>107</sup> *See, e.g.*, Louis Menand, *Crooner in Rights Spat: Are Copyright Laws Too Strict?*, NEW YORKER, Oct. 20, 2014, at 84, 88 (contending that “[a]t bottom, the argument about copyright is not really a philosophical argument. It’s a battle between interest groups”).

<sup>108</sup> *See* Wendy J. Gordon, *Trespass-Copyright Parallels and the Harm-Benefit Distinction*, 122 HARV. L. REV. F. 62, 69-70 (2009) [hereinafter Gordon, *Trespass-Copyright Parallels*].

compared with the law of physical property, copyright has long mandated a higher degree of fit before liability could be imposed. Negligence law similarly demands a degree of fit higher than that required by trespass.

B. *Negligence Law's "Proximate Cause" Doctrine Informs Copyright's "Fair Use" Doctrine*

As law students learn when they first meet the unforeseeably injured plaintiff in *Palsgraf v. Long Island Railroad*,<sup>109</sup> legal rights and their correlative duties have limits.<sup>110</sup> "Proximate cause" is another common law formulation of the same principle. Both doctrines are part of negligence law, the main goal of which is to incentivize careful behavior. By insisting on "duty" and "proximate cause," negligence courts respond to that central goal by declining to impose liability for injuries that, being unforeseeable, no one can be incentivized to avoid.<sup>111</sup>

U.S. copyright law has far more inbuilt limits than does negligence law,<sup>112</sup> which is appropriate given the central contribution that copying makes to cultural life. The most general label for these limits is "fair use." Just as negligence courts should invoke "lack of duty" or "lack of proximate cause" when liability would fail to induce the community to take appropriate precautions, copyright courts should find "fair use" and decline to impose liability that would fail to induce expressive creativity.

Employing common law analogy to illuminate statutory regimes is not always appropriate. One of the factors that makes a negligence-law analogy helpful for analyzing federal copyright is that litigation over copyright infringement shares a key characteristic with common law litigation over accidents: both are structured around a claim of factual causation—what Professor Weinrib would call a "correlative" relation linked by doing and impact.<sup>113</sup> Duplication of a

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<sup>109</sup> 162 N.E. 99 (N.Y. 1928).

<sup>110</sup> *Palsgraf* ruled that railroad employees helping an individual to board the train had no "duty" to take reasonable care to avoid injuring someone standing far off. She was hit by an unusual combination of circumstances. *Id.* at 101.

<sup>111</sup> Cf. Justin Hughes, *Copyright and Its Rewards, Foreseen and Unforeseen*, 122 HARV. L. REV. F. 81, 94-95 (2009) (noting "gaming" costs associated with case-by-case foreseeability analysis in copyright law).

<sup>112</sup> See 17 U.S.C. §§ 107-122 (2018) (establishing multiple limitations to copyright).

<sup>113</sup> Common law cases usually involve two parties, one of whom has changed the other's position. Of the various noneconomic approaches to law, "corrective justice" pays particular attention to this causal link. See, e.g., Weinrib, *supra* note 14, at 520.

The distinction between economic and noneconomic views of litigation structure can be overstated, however. Many economic analysts of law also find it useful to follow the causation chain. For example, the economic notion of "externality" is a caused effect that a causal agent does not feel. Thus, to "internalize" a negative externality is to make a harm causer pay for costs they have causally imposed on others; to "internalize" a positive externality is to require persons who have causally benefited from the actions of another to pay the benefit causer. On economic views of the common law, see generally RICHARD POSNER, *ECONOMIC ANALYSIS OF LAW* (9th ed. 2014) (1977).

copyrighted work causes no infringement unless the plaintiff can show that the defendant somehow borrowed ("copied") from the plaintiff's work. That is the same as requiring the plaintiff to show that use of the copyrighted work was a factual *cause* of what the defendant was able to do.<sup>114</sup> If *but for* the contact with plaintiff's work, the defendant's work product would have taken a different form, then copying (or factual causation) is proven. If contact with the plaintiff's work made no difference, then there is no cause, no copying, and no liability.

By contrast, in patent law, inventors are often found liable for practicing innovations that they independently conceived but that happen to duplicate something patented.<sup>115</sup> In U.S. trademark law, too, a factual causal connection need not be present in order for liability to arise; someone who happens by coincidence to use a symbol or name in commerce that confusingly resembles a previously established unregistered mark can infringe, even if the defendant can prove she had never seen or heard the senior mark.<sup>116</sup>

To benefit from someone else's efforts or resources without paying them is to take a "free ride." In neither patent law nor trademark law is proof of free riding required.<sup>117</sup> Lacking the causality fulcrum of free riding or injury, then, patent and trademark are accordingly less likely than copyright to benefit from being

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<sup>114</sup> It does not suffice for liability that a copyright owner can show similarities between the copyrighted work and the defendant's product or performance. The similarities must result from copying. *See Arnstein v. Porter*, 154 F.2d 464, 468 (2d Cir. 1946) ("Of course, if there are no similarities, no amount of evidence of access will suffice to prove copying. If there is evidence of access and similarities exist, then the trier of the facts must determine whether the similarities are sufficient to prove copying."); *see also Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 54 (2d Cir. 1936) ("[I]f by some magic a man who had never known it were to compose anew Keats's *Ode on a Grecian Urn*, he would be an 'author,' and, if he copyrighted it, others might not copy that poem . . . [J]ust as he is no less an 'author' because others have preceded him, so another who follows him, is not a tort-feasor unless he pirates his work." (emphases added)).

<sup>115</sup> Only in a narrow class of patent cases will lack of causation (independent invention) shelter a patent defendant from liability. *See Leahy-Smith America Invents Act* § 3, 35 U.S.C. § 102(b) (providing for two exceptions to requirement of novelty). When similar inventions arise near the same time, the cause is unlikely to be pure "coincidence." At different states of science, many teams may be working to solve a salient puzzle.

<sup>116</sup> Federal trademark registration will, of course, give a remote user reason to know the senior mark exists. However, even without federal registration, a trademark plaintiff sometimes succeeds against a business that uses a word or symbol confusingly similar to the plaintiff's mark, even though the defendant acted in good faith and did no copying. *See, e.g., Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 415-19 (1916) (finding that only under defined circumstances will senior trademark owner lack rights to proceed against good-faith user).

<sup>117</sup> Patent law gives rights against anyone who duplicates the invention, however independently and harmlessly. (There might be, however, some defense for experimental use. *See, e.g., Embrex, Inc. v. Serv. Eng'g Corp.*, 216 F.3d 1343, 1349 (Fed. Cir. 2000).) Contemporary trademark law asks only for proof of "likelihood of confusion," not actual injury. *See* 15 U.S.C. § 1114.

viewed through a common law lens. Suits against independent inventors and noncopyist trademark users may even fall out of the corrective justice model.<sup>118</sup>

What makes this particularly interesting is that in copyright law, as in negligence law, factual cause is a necessary but not sufficient basis for liability.<sup>119</sup> In negligence, an actor is not liable for injuries that she factually caused by her negligent act if the peril that eventuated had only a coincidental relation to the risks that made her act carelessly.<sup>120</sup> The reason for the plaintiff's loss in such instances is usually termed "a lack of proximate cause."<sup>121</sup> The same label is also used to express the judgment that a negligent actor should not be liable into infinity to all the potential plaintiffs who might experience an injury that can be factually traced to that actor's carelessness.<sup>122</sup> At some point, other actors will have more influence on outcomes, and courts will find the distant injuries insufficiently "proximate" to the initial negligent act.

Much the same logic that generates these limits in negligence law helps to explain why a creative author cannot use her copyright to claim a reward from everyone who experiences a benefit factually traceable to copying the author's work. In the face of impacts that are remote, coincidental, or otherwise irrelevant to policy, crafting legal remedies generates few benefits and many costs.<sup>123</sup> The

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<sup>118</sup> See Lawrence C. Becker, *Deserving to Own Intellectual Property*, 68 CHI-KENT L. REV. 609, 615-16 (1992). A devil's advocate might say that even if the defendant has gained nothing from the plaintiff, they may have inflicted injury on the plaintiff, and that should suffice for a causal nexus.

<sup>119</sup> Not only is fit addressed by available copyright defenses, such as fair use, but in addition a copyright plaintiff must prove wrongfulness, sometimes known by the label "substantial similarity." This wrongfulness does not fully correspond to ordinary moral fault (for even unconscious copying can incur infringement liability) but rather reflects copyright's incentive goals—namely, whether the copying interferes with the incentives the law seeks to create. Thus, the reaction of audience members is key. See *Arnstein*, 154 F.2d at 472-73 ("Assuming that adequate proof is made of copying, that is not enough; for there can be 'permissible copying,' copying which is not illicit. . . . The question . . . is whether defendant took from plaintiff's works so much of what is *pleasing to the ears of lay listeners* . . . that defendant *wrongfully appropriated* something which belongs to the plaintiff." (emphases added) (footnote omitted)).

<sup>120</sup> RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 29 cmt. d (AM. LAW INST. 2010).

<sup>121</sup> See *id.* cmt. f.

<sup>122</sup> *Id.* cmt. d ("[Proximate cause] serves the purpose of avoiding what might be unjustified or enormous liability by confining the liability's scope to the reasons for holding the actor liable in the first place.").

<sup>123</sup> Administrative costs are not the only issue. Overcentralizing legal incentives can leave some actors without reason or ability to act. For example, internalizing all negative effects to negligent drivers may make pedestrians careless; internalizing all positive effects to initial copyright owners can discourage creativity in later generations of artists. See Wendy J. Gordon, *Copyright and Tort as Mirror Models: On Not Mistaking for the Right Hand What the Left Hand Is Doing*, in *COMPARATIVE LAW AND ECONOMICS* 311, 311-12 (Theodore

central lesson is in the fit between the facts of particular cases and the purposes of the law: restricting liability to cases where liability is likely to yield the kind of changes at which the law aims.

Copyright already employs notions of fit, but the application is sporadic and sometimes suffers from being unspoken. It can learn from “fit” as applied in negligence law—that is, fit between the facts of a particular case and the problems of incentives that the negligence tort was primarily meant to address. Personal-injury law and copyright law bear a close relationship to each other. The relationship is symmetrical but inverse, as in a mirror.<sup>124</sup> Just as harms are a target for tort policy, benefits are a target for copyright policy.<sup>125</sup> This Article also reviews some potential objections that might be raised against using the personal injury tort of negligence as a model for copyright.

### 1. Negligence Law’s Goal of Deterrence Mirrors Copyright’s Goal of Incentivizing Creative Production

The inquiry into tort law may seem an odd model for copyright, since in the two doctrines most factors are reversed.<sup>126</sup> Consider the roles of plaintiff and defendant. In negligence law, the usual focus is on giving incentives to the defendant (the injurer). In copyright, the usual focus is on giving incentives to

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Eisenberg & Giovanni B. Ramello eds., 2016) [hereinafter Gordon, *Copyright and Tort as Mirror Models*] (discussing mirrored policy goals of negligence law and copyright).

<sup>124</sup> See generally Wendy J. Gordon, *Copyright as Tort Law’s Mirror Image: “Harms,” “Benefits,” and the Uses and Limits of Analogy*, 34 MCGEORGE L. REV. 533 (2003) [hereinafter Gordon, *Copyright as Tort Law’s Mirror Image*] (discussing similarities between tort law and copyright).

<sup>125</sup> Thus, the tort of negligence, which deals with accidental injuries of this kind, is seen as a law governing harms or loss. By contrast, receiving royalties is usually seen as receiving a benefit or a gain. Similarly, a person who sues to be paid for unrequested services that she has rendered is likely to be seen as seeking a benefit or a gain. Thus, copyright law (which provides royalties) and restitution law (which on rare occasions imposes liability on the recipient of unrequested benefits) can both be seen as laws that govern gains. See Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutionary Impulse*, 78 VA. L. REV. 149, 228-29 (1992) [hereinafter Gordon, *On Owning Information*].

In that light, a copyist who has not paid for reproductions is not necessarily doing a harm to the copyright owner; he more plausibly might be said to be withholding a benefit. As the behavioral research suggests, people tend to fear foregoing a benefit *less strongly* than they fear an out-of-pocket loss in the same amount. See Gordon, *Trespass-Copyright Parallels*, *supra* note 108, at 69-70 (discussing empirical research).

Admittedly, once out of the realm of physical damage, characterizing a prospect as harm or benefit becomes more contestable. For example, after a steady stream of royalty income has commenced for long enough to become a reference point, the person receiving the income is likely to perceive any diminution in revenue flow as a loss rather than merely a benefit that she is foregoing. Nevertheless, copyright is best seen as a law of benefits, I think, because that is how it would have been perceived historically when the decisions were first made to extend authorial control beyond the point at which the author could physically control the manuscript.

<sup>126</sup> See Gordon, *Copyright and Tort as Mirror Models*, *supra* note 123, at 330.

the plaintiff (the creator of the work, her assignee, or her employer). In torts, duty is emphasized; in copyright law, rights are emphasized. In negligence, the effects to be internalized by the primary actor are negative: the injurer should be forced to take account of the injury caused. In copyright, the effects to be internalized by the primary actor are positive: the value a copyrighted work gives to society should be something its author should be empowered to harness.

The reversals continue: negligence primarily uses the law as a stick, while copyright primarily uses the law as a carrot. To the extent moral responsibility plays a role, the same reversal occurs. The moral fulcrum of personal injury law is a kind of fault,<sup>127</sup> while the moral fulcrum of copyright is a kind of merit. Fault warrants liability, while merit deserves reward. And so on.

Nevertheless, each area of law seeks to bring to bear the consequences of an individual's actions on his or her decision-making. The effects in question might be negative, like a broken leg, or positive, like enjoyment of art, but the policy concern is the same: in the absence of the law, important actors might behave unproductively or wastefully because effects that they cause might mean nothing to their pocketbooks.<sup>128</sup>

The relationship between copyright and tort is like the relationship between a face and its reflection in a mirror. Looking into the mirror, the left ear appears as if it were on the right side and vice versa. Such reversals might cause occasional blunders, but if the reversal is properly taken into account, a mirror provides extremely accurate information. Similarly, the common law's long acquaintance with torts (a law of harms) can provide extremely helpful information about this newly important expansive thing called copyright (a law of benefits).

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<sup>127</sup> I say it is a "kind of" fault (rather than fault *tout court*) because negligence law has elements that are insensitive to a particular defendant's limitations. Someone can be trying his best and still be negligent. See Weinrib, *supra* note 113, at 519. Similarly, copyright extends its rights regardless of the work's merit, except at the extremes; judges long ago announced they are reluctant to judge the quality of artwork. *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) ("It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.").

<sup>128</sup> See Gordon, *Copyright and Tort as Mirror Models*, *supra* note 123, at 312 ("The policy logic of copyright like the policy logic of torts focuses on using internalization to produce incentives, but copyright emphasizes the harnessing of positive rather than negative externalities, that is, copyright's focus is primarily on encouraging rather than discouraging particular activities."); see also Gordon, *Copyright as Tort Law's Mirror Image*, *supra* note 124, at 534-35 (discussing internalization of risks and benefits as goal of tort law and copyright law, respectively); Gordon, *How Oracle Erred*, *supra* note 33, at 403-07 (arguing that "fit" is required to achieve appropriate level of liability); Wendy J. Gordon, *Intellectual Property Law*, in *OXFORD HANDBOOK OF LEGAL STUDIES* 617, 622 (Peter Cane & Mark Tushnet eds., 2003) ("IP law encourages persons to become more productive by allowing them to capture some of the benefits their useful behavior gives to others.").



2. Each Doctrine Seeks to Advance the Multiple Goals of Corrective Justice, Aligning Economic Incentives, and Ensuring Judicial Efficiency

Many everyday torts, like auto accidents and medical malpractice, are governed by the tort of negligence. Negligence law leaves many injured persons without recourse. Earlier I quoted Oliver Wendell Holmes, Jr., defending such results: “[C]umbrous and expensive machinery ought not to be set in motion unless some clear benefit is to be derived from disturbing the *status quo*.”<sup>129</sup>

The “cumbrous and expensive machinery” Holmes envisions is lawmaking and adjudication. What can justify setting this imperfect and costly machinery into motion is a “clear benefit.” Implicitly, the nature of the relevant benefit will be defined by the purposes a particular law seeks to achieve. Within negligence law, proximate cause is a doctrine that limits the imposition of liability to cases where the impact of imposing liability is sufficiently clear to satisfy Holmes’s demand for some clear benefit.

This principled limit on liability can be defended both in terms of corrective justice and in terms of economic incentives.<sup>130</sup> The proximate cause doctrine implicitly tells courts (and sometimes juries) to avoid imposing damages when the prospect of such liability will be unlikely to induce risk-reducing behavior and instead to restrict liability to instances where imposing liability for the allegedly bad act will encourage cost-justified precautions.

Recall the driver who was delayed by some rubble negligently dropped into the road by a roofer. Had there been no rubble to slow him down, the driver would have been through a particular intersection before lightning struck there or anyone drove through the stop sign. It was only the delay caused by the roofer’s negligence that placed the driver at the intersection at the worst possible

<sup>129</sup> HOLMES, *supra* note 12, at 96.

<sup>130</sup> RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 30 (setting forth basic requirement that plaintiff should prevail on given set of facts if liability imposed on defendant delivers incentives that will reduce hazards). Comments (a) and (b) to section 30 indicate that the proximate cause limitation is based in corrective justice concerns as well as concerns with ex ante incentives. *See id.* cmt. a (“When tortious conduct does not generally increase the risk of the type of harm that occurred, the wrongful aspect of the actor’s conduct is merely serendipitous or coincidental in causing the harm.”); *id.* cmt. b (“This limitation on scope of liability contributes both to appropriate incentives for deterrence and to affirming corrective justice concerns.”). Related to corrective justice is the notion of “juridical integrity.” Professor Drassinower uses the latter to argue that a law concerned with communication should only impose liability when the defendant communicates. *See* DRASSINOWER, *supra* note 19, at 8 (“Copyright law protects the integrity of the work as a communicative act. . . . [C]opyright infringement is wrongful because it is compelled speech.”); *see also* Matthew Sag, *Copyright and Copy-Reliant Technology*, 103 NW. U. L. REV. 1607, 1682 (2009) (“[A]cts of copying which do not communicate the author’s original expression to the public should not generally be held to constitute copyright infringement.”). Professor Drassinower’s analysis of the explanation/use distinction has influenced my discussion *infra* Sections V.B.1 and V.B.3.

moment. Therefore, the roofer's negligence is a "but-for" or "factual" cause of the driver's injuries. Yet most American courts would not require the roofer to pay compensation. This is because changing the behavior of roofers will have no impact on accidents involving lightning or being hit by speeding scofflaws. As the *Third Restatement of Torts* puts it: "[T]he harm that occurred must be one that results from the hazards that made the defendant's conduct tortious in the first place."<sup>131</sup>

Exercising a society's expensive judicial machinery when the result will encourage productive or otherwise desirable behavioral change adds social value that may outweigh the administrative costs involved in litigation.<sup>132</sup> This added value is lacking when liability is imposed in ways that are unlikely to encourage changes in how people and companies behave.

Because the primary goal of negligence law is usually taken to be reduction of unintentionally caused injuries, risk reduction is the main "clear benefit" sought. Therefore, proximate cause doctrine asks of a particular set of facts: "Can one see that using the precaution would have significantly reduced the incidence of that kind of accident?"<sup>133</sup> One cannot see that proper roofing precautions will make a difference to such random accidents. If avoiding the negligent act would *not* have "significantly reduced the incidence of that kind of accident," then "proximate cause bars liability."<sup>134</sup>

From a corrective justice perspective, one might say that the relation between roofer and driver was wrongful only in regard to a kind of risk that did not occur. The rubble did not hit the driver in the head, scratch his car, or break his windshield. Had any of that occurred, the driver could have successfully sued the roofer. However, the roofer's conduct only caused injury through a freakish risk that was no part of what made his behavior negligent.

The *Third Restatement of Torts* summarizes the negligence doctrine this way: "An actor is not liable for harm when the tortious aspect of the actor's conduct was of a type that does not generally increase the risk of that harm."<sup>135</sup> Imposing liability is likely to be not only costly when the unjustified aspect of the conduct is unrelated to the harm caused but also wasteful (at least in the absence of other factors such as asymmetries between the parties in information, risk aversion, or utility functions for money).<sup>136</sup> Proximate cause is not the only formulation that

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<sup>131</sup> RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 29 cmt. b (AM. LAW INST. 2010).

<sup>132</sup> See generally Mark F. Grady, *Proximate Cause Decoded*, 50 UCLA L. REV. 293 (2002) (discussing value of proximate cause doctrine).

<sup>133</sup> *Id.* at 323 (explaining that liability is only imposed where relationship exists between accident and "untaken precaution").

<sup>134</sup> *Id.*

<sup>135</sup> RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 30.

<sup>136</sup> In areas where defendants are likely to have better information and less risk aversion than plaintiffs, strict liability tends to be used rather than negligence. See A. MITCHELL

courts employ to limit the scope of negligence liability. It can also be expressed as a limitation on “duty.”<sup>137</sup> The “duty” formulation can also be stated in terms of its correlative: determining the scope of the plaintiff’s right to complain. The result is the same.<sup>138</sup> Courts will make negligent injurers pay for harm they cause only “when the tortious aspect of the actor’s conduct was of a type” the elimination of which “generally [decreases] the risk of that harm.”<sup>139</sup> When making defendants pay would not decrease the type of harm that occurred in a particular instance, proximate cause denies the plaintiff relief.

Another way that negligence law shows the importance of fitting legal results to the factual context involves defining what behaviors violate the standard of reasonable care. Criminal or regulatory statutes often prohibit behavior that also causes accidents, but a physical identity between the criminally prohibited behavior and the behavior of the defendant in a civil negligence suit does not automatically lead to finding the defendant negligent. Violating a criminal or regulatory duty will be *irrelevant* to assessing whether behavior satisfies the negligence tort’s standard of care unless the statute in question aims to ameliorate the same dangers as those that arose in the particular case.<sup>140</sup>

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POLINSKY, AN INTRODUCTION TO LAW AND ECONOMICS 95-104 (1983) (discussing liability for product defects).

<sup>137</sup> Judge Cardozo famously used a “duty” rather than a “proximate cause” formulation. See *Palsgraf v. Long Island R.R.*, 162 N.E. 99, 101 (N.Y. 1928) (denying relief on ground that defendant owed no duty to someone standing far away from negligent act). The significance of classifying this as a question of duty is at least partly procedural: questions of duty are for the judge while questions of proximate cause can be decided by juries. This Article does not proceed beyond that procedural distinction. The reader should, however, be aware that storms of controversy surround duty in tort law, including disputes over whether negligence duties do serve (as I think they do) or should serve (as I think they should) instrumentalist social and economic purposes as well as purposes of individual redress. See, e.g., W. Jonathan Cardi & Michael D. Green, *Duty Wars*, 81 S. CAL. L. REV. 671, 671-73 (2008) (discussing splits in views of duty element of negligence tort); John C.P. Goldberg & Benjamin C. Zipursky, *Seeing Tort Law from the Internal Point of View: Holmes and Hart on Legal Duties*, 75 FORDHAM L. REV. 1563, 1581-91 (2006) (discussing objections to formulating tort law in terms of genuine duties).

<sup>138</sup> Limits on rights (by definition) correspondingly reduce the scope of the correlative duties, just as changes in duties work a corresponding change in rights. See WESLEY NEWCOMB HOHFELD, *FUNDAMENTAL LEGAL CONCEPTIONS AS APPLIED IN JUDICIAL REASONING AND OTHER LEGAL ESSAYS* 36-38 (Walter Wheeler Cook ed., 1919) (exploring correlative nature of “right” and “duty”).

<sup>139</sup> The quoted language is from a *Restatement* principle that describes when liability will not be imposed; I have reworded the principle to emphasize when imposition would instead be proper. See RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 30 (“An actor is not liable for harm when the tortious aspect of the actor’s conduct was of a type that does not generally increase the risk of that harm.”).

<sup>140</sup> *Id.* § 14 (“An actor is negligent if, without excuse, the actor violates a statute *that is designed to protect against the type of accident the actor’s conduct causes*, and if the accident victim is *within the class of persons the statute is designed to protect*.” (emphases added)).

### 3. Objections to the Parallel: Losses and Foregone License Fees; Harms and Benefits; Duties and Rights

Negligence law emphasizes duties (owed to defendants), and copyright law emphasizes rights (held by plaintiffs). Although the words “right” and “duty” are correlatives, each has different connotations<sup>141</sup> and thus potentially different framing effects.<sup>142</sup> Perceiving that the public owes the author a duty to refrain from copying her works without permission, for example, is not necessarily *psychologically* or *behaviorally* the same as perceiving that the author has an exclusive right over the reproduction of her works. That asymmetry in perception needs to be taken into account when drawing on tort law to better understand copyright law.<sup>143</sup> It is my view that fair use should be more demanding than proximate cause, for proximate cause doctrine can leave injured parties without redress while fair use often does no more than deprive plaintiffs of potential licensing fees.

In addition, a plethora of experiments over the last few years has indicated that many people do not respond symmetrically to gain and loss. The tendency is for a greater impact on utility to result from the prospect of paying out-of-pocket costs (e.g., paying a liability judgment) than from the prospect of

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That a criminal statute is relevant only if its goals fit the goals of negligence law reinforces the point that behaviors have legal significance depending on *context*. Copying that is rightful in one context may be wrongful in another.

<sup>141</sup> This claim may seem odd in light of Wesley Hohfeld’s familiar conclusion that in private law duty and right are inseparable conceptual correlatives; per his view, duties can logically be inferred from rights and vice versa. That is, every right can be redefined in terms of its correlative duty, and every duty can be redefined in terms of its correlative rights. See HOHFELD, *supra* note 138, at 38 (“[I]f X has a right against Y that he shall stay off the former’s land, the correlative (*and equivalent*) is that Y is under a duty toward X to stay off the place.” (emphasis added)).

<sup>142</sup> Professors Kahneman and Tversky provide several examples of how a given choice can be reframed in terms of either gain or loss. Daniel Kahneman & Aaron Tversky, *Choices, Values, and Frames*, 39 AM. PSYCHOLOGIST 341, 342-44 (1984), *reprinted in* DANIEL KAHNEMAN, THINKING FAST AND SLOW 433, 436-44 app. B (2011) (describing how people’s acceptance of risk is altered by framing outcomes as either gains or losses).

<sup>143</sup> The person who has rights tends to think mainly in terms of the rights they have rather than the burdens their rights impose on others. Conversely, the person who bears duties tends to think mainly of the obligations they have rather than of the benefits to others the duties will generate.

It is telling that for each of these two fields of law—copyright and negligence—the courts and litigants employ language that characterizes the viewpoints of the parties in these terms. Thus, that negligence law is usually formulated in terms of a defendant’s duty of reasonable care reinforces the consistent message of negligence law that its focus is on incentivizing defendants. Similarly, that copyright law is usually formulated in terms of a plaintiff’s rights reinforces the consistent message of copyright law that its focus is on incentivizing plaintiffs.

foregoing a benefit (e.g., not receiving a payment).<sup>144</sup> Depending on how robust a finding this turns out to be in relevant contexts, loss aversion and other apparent gain/loss asymmetries suggest that perhaps tort law should be *stronger* than copyright law in imposing liability.<sup>145</sup> If lack of proximate cause eliminates liability in the stronger law of harms, then *a fortiori* the same principles should also eliminate liability for the putatively weaker law of benefits that we call copyright.

C. *How to Choose the Level of Fit: Guidance Needed*

The negligence tort is hardly the only locus where the law demands a proximate connection between its purpose and the impact of imposing liability in particular cases. It is rooted in due process: the facts of a case must fit closely enough to a law's rationale for the application of law to make sense.<sup>146</sup> However, many factors affect *how* close a fit is required. In constitutional challenges to statutes, courts debate the "level of scrutiny" explicitly,<sup>147</sup> but even in ordinary

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<sup>144</sup> See EDWARD CARTWRIGHT, BEHAVIORAL ECONOMICS 40-42, 396 (1st ed. 2011). *But see*, e.g., Gregory Klass & Kathryn Zeiler, *Against Endowment Theory: Experimental Economics and Legal Scholarship*, 61 UCLA L. REV. 2, 3 (2013) (arguing that "recent experimental data have cast doubt on the hypothesis that ownership sets the reference point and loss aversion generates reluctance to trade").

<sup>145</sup> In addition, common observation suggests that most people seem to fear losses more than they dislike foregoing a benefit. One might wonder if the apparently greater importance Americans give to avoiding harm (as opposed to seeking benefits) undermines the legitimacy of copyright, for at bottom copyright operates as a law that facilitates payment for benefits. Such speculation at first glance appears ratified by the common law of restitution, also known as unjust enrichment. This body of law is reluctant to award relief in most cases of volunteered benefits, which stands in sharp contrast to some courts' willingness to order relief in cases of harms caused. However, further research persuaded me that the difference in treatment was best explained not by differences between harm and benefit but rather by concerns such as preserving autonomy and avoiding harm. See Wendy J. Gordon, *Of Harms and Benefits: Torts, Restitution, and Intellectual Property*, 21 J. LEGAL STUD. 449, 465 (1992); see also Gordon, *On Owning Information*, *supra* note 125, at 279-80 (discussing validity of, and desirable limits on, restitutionary principles in intellectual property contexts).

<sup>146</sup> As congressional enactments must, at a minimum, satisfy review for constitutionality, so must judicially created rules. See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 264-65 (1964) (applying strict scrutiny to defamation law).

<sup>147</sup> Compare, for example, the different positions on "levels of scrutiny" taken by majority and dissent in *Eldred v. Ashcroft*, the Supreme Court case upholding an extension of copyright duration. 537 U.S. 186, 195-222 (2003) (applying rational basis review to act extending copyright duration and recognizing it as part of Congress's enforcement powers of Copyright Clause); *id.* at 222-43 (Stevens, J., dissenting) (arguing that Congress's actions under Copyright Clause are unreviewable by judiciary and finding statute beyond congressional authority); *id.* at 244-48 (Breyer, J., dissenting) (discussing need for higher scrutiny because "this statute involves not pure economic regulation, but regulation of expression, and what may count as rational where economic regulation is at issue is not necessarily rational where we focus on expression").

cases, where judges are asked not to invalidate but to interpret, judges have to choose a level of scrutiny, either explicitly or implicitly. Analogy can be useful for this task.

What makes issues of fit particularly difficult is that more tailoring isn't necessarily better. Perfect fit would mean that legal outcomes would vary with extreme sensitivity to circumstances. A legal system that embraced such close tailoring could be particularly vulnerable to abuse because it can be difficult to identify or prove culpable bias by a judge or jury when outcomes normally vary case by case. Moreover, with rules that penalize physically identical behaviors differently in different contexts, it might be difficult to give the public the kind of notice about law that is fundamental both to sensible planning and to fairness.<sup>148</sup> Laws must be somewhat general and unparticularized to enable the populace to understand them, to save excessive costs of processing disputes, and to foster courts' abilities to treat like cases alike.<sup>149</sup>

In short, courts can demand too much as well as too little in the way of fit. Because there is no easy answer about how closely courts should require particular facts to fit the law's purpose,<sup>150</sup> use of heuristics and analogy can be helpful for developments, such as copyright's recent hypertrophy, that are newly struggling with these issues. American copyright law has good reasons for looking to negligence law for analogy on this issue.<sup>151</sup>

1. Functional Uses Are Outside the Scope of a Copyright Owner's Rights of Control

Of the various copying behaviors that lie outside copyright's concern, copying for functional use is perhaps the most important. The Supreme Court has often emphasized the many distinctions that Congress has drawn between copyright law and patent law.<sup>152</sup> Patent's short term (rather than copyright's long term) and difficulty of acquisition (rather than copyright's automatic acquisition) reflect a far different judgment about how best to incentivize or

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<sup>148</sup> See generally Thomas W. Merrill & Henry E. Smith, *Optimal Standardization in the Law of Property: The Numerus Clausus Principle*, 110 YALE L.J. 1, 24-25 (2000) (discussing information costs arising from rights with uncertain legal boundaries).

<sup>149</sup> Another factor that might explain why law cannot demand perfect fit for all fact patterns is a concern with legitimacy and perceptions of fairness; many citizens would complain if, for example, a driver who was able to persuade a court of her expertise at the wheel could escape liability for having caused injury when driving at seventy-five miles per hour, when sixty miles per hour would have been the speed considered "reasonable" for ordinary folks.

<sup>150</sup> There is a rich literature comparing the virtues and weaknesses of rules versus standards, exploration of which would take us too far afield. See, e.g., Louis Kaplow, *Rules Versus Standards: An Economic Analysis*, 42 DUKE L.J. 557, 621 (1992) (arguing that rules reduce cost of frequent undesirable conduct).

<sup>151</sup> Cf. Hanoch Dagan, *Pluralism and Perfectionism in Private Law*, 112 COLUM. L. REV. 1409, 1421-29 (2012) (calling for pluralistic approaches to law).

<sup>152</sup> See, e.g., *Baker v. Selden*, 101 U.S. 99, 102-06 (1880) (noting distinctions between patents on processes and methods and copyrights on original works of authorship).

reward works of authorship as opposed to inventions and how to treat a defendant's behavior that is communicative as opposed to functional.<sup>153</sup>

In the leading case of *Baker v. Selden*,<sup>154</sup> the Supreme Court distinguished between a copyright owner's powers to prevent unauthorized copying for purposes like explanation, contemplation, and entertainment on the one hand and, on the other, a copyright owner's attempts to use copyright to extract profit from uses that serve the ends that patent law<sup>155</sup> rather than copyright law was crafted to manage.<sup>156</sup> The law of copyright is for encouraging expression, and its domain is creativity; the law of patent is for encouraging technology, and its domain is innovation.

The language "functional" or "utilitarian" is often applied to the items covered by utility patents. Examples include a wide range of inventions, such as new forms of lighting, new pharmaceuticals, new jet engines, and new computerized processes.<sup>157</sup> A book that teaches how to build a novel mousetrap can have copyright, but copyright controls only the expression of the instructions. It gives no control over carrying the instructions out.<sup>158</sup> An inventor turns to other doctrines, notably utility patent, to keep someone from actually *building* the mousetrap so described.

The *scope* of a copyright extends only to explanation, appearance, conveyance of information, and the like, not to functional use of the kind that is the concern of utility patent.<sup>159</sup> The former use of copyright is appropriate; the latter constitutes an intrusion on areas where there is no fit between the law and the behavior sought to be controlled. The rights of a copyright owner do not extend to controlling copying for functional uses.<sup>160</sup>

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<sup>153</sup> See Wendy J. Gordon, *The Core of Copyright: Authors, Not Publishers*, 52 HOUS. L. REV. 613, 648-50 (2014) (distinguishing decisions investors must make about disclosure from creators' incentives to disclose works of authorship).

<sup>154</sup> 101 U.S. 99 (1880).

<sup>155</sup> My focus in this text is on utility patents. Federal patent law also contains design patents, which address aesthetic shapes for utilitarian objects, and plant patents. See 35 U.S.C. §§ 161, 171 (2018).

<sup>156</sup> *Baker*, 101 U.S. at 100-01.

<sup>157</sup> Nevertheless, contemporary debate surrounds the patentability of computer software. See, e.g., Jonathan Stroud & Derek M. Kim, *Debugging Software Patents After Alice*, 69 S.C. L. REV. 177, 178 (2017) (noting that debate over patentability of software because it is "difficult to describe in traditional patent claims (due in part to lack of any requirement to provide enabled computer code when applying for patent protection), the patent office has struggled with the contours of software patentability, while courts have struggled with interpreting software claims and applying them to actual technologies in infringement cases").

<sup>158</sup> See *Baker*, 101 U.S. at 102-03.

<sup>159</sup> 17 U.S.C. § 102(b) (stating that copyright does not extend to "any idea, procedure, process, system, method of operation, concept, principle, or discovery").

<sup>160</sup> In *Baker*, the Supreme Court explained that copyright was not crafted with utilitarian applications in mind. *Baker*, 101 U.S. at 102-03. Utilitarian applications are, roughly, functions other than conveying information or portraying appearance. See 17 U.S.C. § 101

## 2. To Have a Copyright Is Not to Have the Right to Control All Uses

To implement *Baker*, Congress commissioned Copyright Office Reports (“Reports”). One important Report in 1961 reviewed the case law and found that courts were *not* imposing liability when manufacturers copied from copyrighted drawings, blueprints, or scale models to make working, life-size, functional products.<sup>161</sup> Often citing *Baker* itself, those Reports recognized that granting exclusivity that restrained functional behavior was patent law’s province.<sup>162</sup> As the 1961 Report summarized, “[C]opyright protection would not extend to . . . [a] copyrighted scale model of an automobile, used to manufacture automobiles of that design” or a “copyrighted technical drawing showing the construction of a machine, used to manufacture the machine.”<sup>163</sup> Congress set out to implement the 1961 Report.

Congress implemented the principle in the following provision:

This title does not afford, to the owner of copyright in a work that portrays a useful article as such, any greater or lesser rights with respect to the making, distribution, or display of the useful article so portrayed than those afforded to such works under the law, whether title 17 or the common law or statutes of a State, in effect on December 31, 1977, as held applicable and construed by a court in an action brought under this title.<sup>164</sup>

Section 113(b) addresses the rights that attach to a “portrayal” (such as the scale model or technical model just mentioned) that depicts “a useful article as

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(defining “useful article”). Copyright’s easy acquisition and long duration were adapted for works of communication and authorship, not for efforts of inventorship and utility. The latter, as Congress has indicated and as myriad courts since *Baker* have ratified, should be left to patent law because of patent’s requirement of administrative preapproval requirements, standards of novelty and nonobviousness, and short duration. For further discussion, see Gordon, *How Oracle Erred*, *supra* note 33, at 389-91 (explaining that *Baker* and its progeny rejected copyright claims on systems and results because patent is more suited to protecting those interests).

<sup>161</sup> H. COMM. ON THE JUDICIARY, 89TH CONG., REP. OF THE REGISTER OF COPYRIGHT ON THE GENERAL REVISION OF THE U.S. COPYRIGHT LAW 14 (1961), [http://www.copyright.gov/history/1961\\_registers\\_report.pdf](http://www.copyright.gov/history/1961_registers_report.pdf) [<https://perma.cc/X8SN-YPDZ>] [hereinafter 1961 REPORT OF THE REGISTER] (“[E]xisting court decisions indicate that copyright in the ‘work of art’ does not protect against manufacture of the useful article portrayed.”).

<sup>162</sup> *See, e.g., id.* at 13-14.

<sup>163</sup> *Id.* at 14. The 1961 Report was approved in the 1965 Supplementary Report. H.R. COMM. ON THE JUDICIARY, 89TH CONG., SUPPLEMENTARY REP. OF THE REGISTER OF COPYRIGHTS ON THE GENERAL REVISION OF THE COPYRIGHT LAW: 1965 REVISION BILL, pt. 6, at ix, 47-49, 81 (1965). Congress, in turn, relied upon that Report in the drafting of § 113(b) of the Copyright Act of 1976. *See* H.R. REP. NO. 94-1476, at 105 (1976).

<sup>164</sup> 17 U.S.C. § 113(b).



such.”<sup>165</sup> The provision then declares that the case law in existence prior to the effective date of the section continues to be authoritative thereafter.<sup>166</sup>

What makes the statute clearer are the examples presented by legislative history. A “copyright in a drawing or model of an automobile” was not supposed to “give the artist the exclusive right to make automobiles of the same design.”<sup>167</sup>

This is significant in light of the fact that copyright in a two-dimensional drawing ordinarily gives its owner rights to control three-dimensional sculptures based on it.<sup>168</sup> Section 113(b), set out above, is a particular application of proximate cause: copyright’s deference to patent law as well as copyright’s inherently limited purposes disable an ordinarily applicable derivative-work right when the result would be to allow copyright law to control functional behaviors.<sup>169</sup> The statute is particularly interesting because it makes clear that limits on *copyrightability* are not the only ways in which copyright must defer to patent law. Even copyrightable works of authorship are affected by patent law’s primacy. As with lack of duty and lack of proximate cause in negligence law, behaviors outside the governing law’s concern should be outside a plaintiff’s “scope of right.”

However, the copyright statute says none of this clearly. Unfortunately, § 113(b) is obscure, incorporating prior law by reference. And that means that courts sometimes ignore both the statute and the important prior case law, including *Baker*, from which it emerged.<sup>170</sup>

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<sup>165</sup> *Id.*

<sup>166</sup> The language in § 113(b) was enacted as part of the Copyright Act of 1976, which became effective January 1, 1978. *See* Copyright Law Revision Act of 1976, Pub. L. No. 94-553, § 102, 90 Stat. 2541, 2598-99. Therefore, the reference in § 113(b) to law “in effect on December 31, 1977,” is a reference to law as it existed just prior to § 113(b) becoming effective. *See* 17 U.S.C. § 113(b).

<sup>167</sup> *See* H.R. REP. NO. 94-1476, at 105.

<sup>168</sup> 17 U.S.C. § 106(2) (granting exclusive right to prepare derivative works). If the three-dimensional work is not “useful” in the statutory sense, then the concern with patent drops away, and someone making a nonuseful derivative work does need permission to do so. Making nonuseful derivative works is a behavior that lies within the scope of rights possessed by the owner of a copyright. *See* *King Features Syndicate v. Fleischer*, 299 F. 533, 538 (2d Cir. 1924) (finding that defendant infringed by making three-dimensional doll from plaintiff’s two-dimensional cartoon horse).

The *King Features* opinion took pains to identify the purpose of the toy horse in words that echoed the *Baker* opinion. The toy was described as serving the “production of amusement in contemplation.” *Id.* at 537. In *Baker*, the Supreme Court approved as a copyright-appropriate purpose “the production of pleasure in . . . contemplation.” *Baker v. Selden*, 101 U.S. 99, 104 (1880), *quoted in King Features*, 299 F. at 537.

<sup>169</sup> *See* H.R. REP. NO. 94-1476, at 105.

<sup>170</sup> For example, the Ninth Circuit Court of Appeals did not even mention § 113(b) when the question arose whether copyright in a drawing of a car can give the copyright owner rights over how actual autos are designed. The answer should have been, “No.” Under § 113(b), copyrighted portrayals of useful objects—such as drawings of the Batmobile—should give

For copyright law to empower someone who has drawn a picture of an auto to control manufacturers' ability to use the design is problematic for several reasons. Two are particularly worth mentioning: First, such an expansion of copyright might raise the price of functional products and make it difficult for innovators to improve on unpatented but copyrighted designs for useful articles. Giving designers derivative-work rights over the manufacture of useful articles could threaten patent law with a kind of legal kudzu.

Second, attractive designs often confer functional advantages: For example, a sleek and aerodynamic design for a car body can save on gasoline. If so, making auto manufacturers pay for copying an unpatented design confuses the message conveyed by the royalties. The design might be popular because of its ability to save gasoline, which is a consideration irrelevant to authorship. Increasing artists' royalties from "applied art" such as auto design might not increase the kind of activities copyright seeks to foster.

Recall two principles from negligence law discussed above<sup>171</sup> and note the parallel arguments in copyright law. The first principle mentioned was that "[t]he harm that occurred must be one that results from the hazards that made the defendant's conduct tortious in the first place."<sup>172</sup> In copyright an author should not be entitled to payment when the copying is done for a purpose unrelated to the reasons authors were given copyright initially (e.g., as evidence in litigation).<sup>173</sup>

The second principle is that "[a]n actor is not liable for harm when the tortious aspect of the actor's conduct was of a type that does not generally increase the risk of that harm."<sup>174</sup> The copyright parallel is that a copyist should not be liable when the conduct she engaged in was outside the range of uses whose potential for profit usually induces creative expression. Liability for such copyists does not generally increase the likelihood of reward to authors or encourage authors to work harder.<sup>175</sup>

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no derivative-work rights to control the manufacture or sale of working versions of the depicted object. The decision, however, went the other way. *See* *DC Comics v. Towle*, 802 F.3d 1012, 1027 (9th Cir. 2015) (finding builder of replica Batmobiles liable for copyright infringement).

<sup>171</sup> *See supra* Section V.A.

<sup>172</sup> RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 29 cmt. b (AM. LAW INST. 2010).

<sup>173</sup> Gordon, *How Oracle Erred*, *supra* note 33, at 406 ("Only in the area of 'fit' – authorial works being used for authorial purposes – is the ability of copyright enforcement to produce more benefits than costs likely to be more than coincidental.").

<sup>174</sup> RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 30.

<sup>175</sup> Gordon, *How Oracle Erred*, *supra* note 33, at 406 (suggesting that allowing hypothetical composer to collect copyright infringement damages against people who use copyrighted sheet music as decorative wallpaper "does nothing to reward composing skill or encourage its further development").

### 3. Interoperability and the Scope of Computer Copyrights

For another example of how clearer notions of fit would slim down copyright's mass, consider computer interfaces. Interfaces promote software compatibility and sometimes allow consumers and even whole industries to avoid lock-in. An interface might have authorial characteristics that entitle its creator to copyright,<sup>176</sup> but when the interface is copied for purposes of interoperability, the copier is indifferent to the authorial elements. As an analogy, consider cutting a key to enable a guest to enter one's house. When ordering a key, the typical buyer won't care whether the key's notches, pins, and grooves form a graceful shape or not. The key's grace does not matter; all that matters is that the notches, pins, and grooves fit the shape of the lock.<sup>177</sup>

Rewarding the designer of the key for each duplicate made would not encourage good quality design; the frequency of copying is unrelated to any aesthetic or expressive quality the Copyright Act would want to encourage. Such copying is not done for reasons connected to the reasons Congress created the copyright grant.<sup>178</sup> Just as proximate cause doctrine rules out injuries unrelated to the risks tort law seeks to affect, "fair use" and other copyright doctrines rule out liability for copying for purposes unrelated to the incentives copyright means to give to the initial author.

Some liberties to copy for interoperability are implicit and inherent in *Baker*,<sup>179</sup> and their mandate should be implemented. *Baker* stands in part for the principle that rights under a particular species of law should be enforced only if the facts presented have a logical connection to the kind of disputes that species of law was crafted to resolve and the kinds of purposes that species of law was crafted to serve.<sup>180</sup> A century after *Baker*, though, Congress's unfortunate

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<sup>176</sup> When Congress brought computer programs into copyright in 1980, the recommendations upon which Congress relied depended on making a division between "the copyrightable element of style and expression in a computer program" and the uncopyrightable "process which underlies it." NAT'L COMM'N ON NEW TECH. USES OF COPYRIGHTED WORKS, FINAL REPORT 55 (1978), <https://files.eric.ed.gov/fulltext/ED160122.pdf> [<https://perma.cc/S78M-9Y9V>] ("It is difficult, either as a matter of legal interpretation or technological determination, to draw the line between the copyrightable element of style and expression in a computer program and the process which underlies it."); see also 17 U.S.C. § 102(b) (2018) (prohibiting copyright in ideas, methods of operation, processes, etc.); H.R. REP. NO. 94-1476, at 57.

<sup>177</sup> I employed essentially the same illustration in Gordon, *How Oracle Erred*, *supra* note 33, at 347. I borrow some other illustrations and arguments from that piece as well.

<sup>178</sup> See *supra* Section V.B.2 (discussing congressional copyright policies and limitations).

<sup>179</sup> Gordon, *How Oracle Erred*, *supra* note 33, at 394-95 ("[T]he *Baker v. Selden* opinion contains language about the 'necessity' of using Selden's forms – language that some have interpreted as the Court assuming that few alternative accounting forms would do the job.").

<sup>180</sup> See *Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1360-61, 1365-66 (Fed. Cir. 2014) (holding Java's applied programming interface and its structure, sequence, and organization, copyrightable as against claims of "merger" and "method of operation"). The lower court had held the copied portions of Java uncopyrightable as "methods of operation." *Oracle Am., Inc.*

decision to put some computer programs into copyright has given rise to many uncertainties.<sup>181</sup> Copying method headers that are necessary to make one's program operate with another machine or program should be outside the scope of a copyright owner's control. Harnessing licensing fees for uses that are indifferent to authorship, aesthetics, or communication will not increase the likelihood of creative authorship occurring.<sup>182</sup> Any relationship between the physical acts of copying and the desired incentives is merely coincidental. As in *Brunswick* and in *Baker*, when the connection between the acts complained of and the law's goals is purely fortuitous, no liability should result.<sup>183</sup>

#### 4. Fair Use More Generally

Copyright law in the United States has always contained a doctrine particularly sensitive to whether imposing liability in particular cases will serve copyright's purposes. This is the fair use doctrine.<sup>184</sup>

When a defendant receives fair use shelter because her work has a purpose far different from that of the work of authorship she has copied, the difference in purpose<sup>185</sup> warns that giving the copied author a share of the defendant's profits might not provide reliable signals to authors about what kinds of creativity are socially valuable.<sup>186</sup> To return to a now-familiar example, sometimes when documents are relevant to litigation, a party who authored the documents tries to employ his or her copyright interest to prevent the documents from being copied for court use. Courts have almost unanimously rejected such attempts. This makes sense in terms of fit with the statutory purpose of incentivizing

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v. Google Inc., 872 F. Supp. 2d 974, 976-77 (N.D. Cal. 2012), *rev'd*, 750 F.3d 1339 (Fed. Cir. 2014).

<sup>181</sup> See Gordon, *How Oracle Erred*, *supra* note 33, at 421 ("Congress could be seen as eliminating one barrier to enforcing copyright in computer programs but retaining another. It eliminated the old visual-bound definition of 'copy,' but retained the public's liberty to employ copyrighted portrayals of useful articles to make and sell functioning versions of those articles without authorization.").

<sup>182</sup> See *id.* at 427 ("[I]ncentives to create more or better expression can have only random correlation with copying that is motivated by expressive-indifferent concerns.").

<sup>183</sup> Cf. *Brunswick Corp. v. Pueblo Bowl-O-Mat, Inc.*, 429 U.S. 477, 477 (1977) (holding that plaintiff in antitrust action "must prove injury of the type that the antitrust laws were intended to prevent and that flows from that which makes the defendants' acts unlawful"). I am indebted to Professor Ariel Katz for this point and to Lemley & McKenna, *supra* note 103, for their examination of the issue.

<sup>184</sup> Although the origin of fair use was in judicial opinions, today's statute recognizes the doctrine at 17 U.S.C. § 107 (2018).

<sup>185</sup> Samuelson, *supra* note 8, at 2593-97, 2619; see also Leval, *supra* note 8, at 1111 (arguing that fair use justification turns on whether "challenged use is *transformative*," meaning that "use must be productive and must employ the quoted matter in a different manner or for a different purpose from the original").

<sup>186</sup> Gordon, *How Oracle Erred*, *supra* note 33, at 404 ("Lack of 'fit' in a particular instance shows merely that enforcement will fail to further a particular law's goals.").

creation: there is little likelihood that generating fees for courtroom use would increase the amount of valuable authorship. It is unlikely that authors would create more works for the purpose of collecting licensing fees for litigation.

Fair use is under attack in many quarters. The U.S. government has even entered into international treaties that, in the eyes of some, have both restricted other nations from following our fair use model and imperiled fair use on its own ground in the United States.<sup>187</sup> A better understanding of fair use would make clear its legitimacy and might have given the government pause before agreeing to such unfortunate treaty developments.

##### 5. Summarizing the Analogy: From “Proximate Cause” to “Proximate Use”

These applications of fit can be restated in terms of “proximate cause.” We begin with repeating a statement from the *Third Restatement of Torts*: “An actor is not liable for harm when the tortious aspect of the actor’s conduct was of a type that *does not generally increase the risk* of that harm.”<sup>188</sup> Translating that sentence into copyright’s terms: “An author is not entitled to remedy when the nature of the defendant’s conduct was of a type which, if licensed, *would not generally increase the likelihood* of desirable authorial works being created.” The durational limits on copyright, the use/explanation distinction of *Baker*, the § 113(b) limitations on copyrights on design, and the doctrine of fair use are all attempts to implement this principle.

#### CONCLUSION

The copyright statute lists a number of actions over which copyright owners have dominion—notably, copying the work, adapting or preparing variations on the work, publicly displaying the work, publicly performing the work, and distributing the work.<sup>189</sup> If a physical description of the defendant’s behavior matches a physical behavior that appears on the list, then some courts will resolve the *prima facie* scope-of-right issue in the plaintiff’s favor. Most courts, though, are sensitive to context, as mandated by many of copyright’s doctrines, including fair use.

Fair use arises when enforcing an exclusive right would fail to further copyright’s goals. One form of fair use arises when benefiting from expressivity

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<sup>187</sup> The United States has acceded to both the Berne Convention and the TRIPS Agreement, each of which uses a three-step test for copyright limitations. Many fear the three-step test will curtail fair use. *See generally* ELEC. FRONTIER FOUND., THE THREE-STEP TEST, [https://www EFF.org/files/filenode/three-step\\_test\\_fnl.pdf](https://www EFF.org/files/filenode/three-step_test_fnl.pdf) [https://perma.cc/W6QH-B75J] (last visited Feb. 13, 2020).

<sup>188</sup> RESTATEMENT (THIRD) OF TORTS: LIABILITY FOR PHYSICAL & EMOTIONAL HARM § 30 (AM. LAW INST. 2010) (emphasis added).

<sup>189</sup> 17 U.S.C. § 106. After 1976, rights over other behaviors, such as defacing certain original paintings, *id.* § 106A, or bypassing encryption, *id.* § 1201, have been grafted onto the basic copyright statute.

had no role in motivating the defendant's decision to copy. That is, if the defendant's acts of copying, adaptation, public display, etc. were done for purposes unrelated to the author's communicative skills, a court should rule that the defendant violated no duty and cannot be held liable. As Professor Drassinower puts a similar point, "a re-producing of certain shapes of ink on a page" is not necessarily "a reproduction of the work *as a work*."<sup>190</sup>

It is not using a work "*as a work of authorship*" to copy it to serve as evidence in litigation.<sup>191</sup> The copying is fair use. Nor is it using a work "*as a work of authorship*" to incorporate a sketch of highway designs into the shape of an actual highway interchange.<sup>192</sup> A defendant who copies to enable interoperability between computer programs is similarly not using the work as a work of authorship; to that defendant, the expressive value of the bits copied are irrelevant. Liability should only attach to copying that, if controlled by the author, would increase the quantity or quality of expressivity.

In holding Google liable, the Federal Circuit turned its back on decades of federal cases that have held technological interoperability to be a sufficient ground for fair use treatment. The cause of the Federal Circuit's erroneous decision to impose liability is hard to fathom.

One possible explanation might be a popular intuition that links responsibility and credit to causation. Under such a view, anyone who causes a harm should be forced to pay for it, and anyone who causes a benefit should be given exclusive rights to profit from it. In tort, the view has sometimes been termed "causal maximalism."<sup>193</sup> In IP, commentators sometimes employ the phrase "anti-free-riding" to designate this view;<sup>194</sup> another signifier is the agricultural metaphor "do not reap where you have not sown."<sup>195</sup> Professor Rochelle Cooper

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<sup>190</sup> Abraham Drassinower, *Authorship as Public Address: On the Specificity of Copyright Vis-à-Vis Patent and Trade-Mark*, 2008 MICH. ST. L. REV. 199, 223; see also DRASSINOWER, *supra* note 19, at 85-88 (discussing "work as a work" method of analyzing copyright).

<sup>191</sup> See Samuelson, *supra* note 8, at 2593-97, 2619.

<sup>192</sup> Unsurprisingly, courts refrain from imposing liability on attorneys who publicly display duplicated copyrighted documents for evidentiary purposes or on municipalities who employ copyrighted plans to guide their road constructions. See Samuelson, *supra* note 8, 2592-97 (discussing precedent).

<sup>193</sup> H.L.A. HART & TONY HONORÉ, *CAUSATION IN THE LAW*, at lxvii-lxviii (2d ed. 1985).

<sup>194</sup> This is Professor David Franklyn's locution, in his candid and articulate defense of the principle. David J. Franklyn, *Debunking Dilution Doctrine: Toward a Coherent Theory of the Anti-Free-Rider Principle in American Trademark Law*, 56 HASTINGS L.J. 117, 117-18 (2004).

<sup>195</sup> *Int'l News Serv. v. Associated Press*, 248 U.S. 215, 239, 245-46 (1918) (enjoining one news-gathering service from copying facts from similar news organization). The majority opinion combined two sorts of reasoning: (a) that as a moral matter, viewed ex post, the copier was trying to "reap where he had not sown" and (b) that as a consequentialist matter, taking an ex ante view, the Court worried that refusing plaintiff any relief might fatally damage the news business. See Gordon, *On Owning Information*, *supra* note 125, at 178-80, 223-23, 266-73; see also Mark A. Lemley, *Ex Ante Versus Ex Post Justifications for Intellectual Property*, 71 U. CHI. L. REV. 129, 129-30 (2004) (describing each approach to intellectual property).

Dreyfuss identifies it with a logical leap that she calls “if value, then right.”<sup>196</sup> Sometimes the intuition is linked to John Locke’s labor theory of property.<sup>197</sup>

Despite a century of criticism, the anti-free-riding intuition retains some allure. Some of its surface shine comes from simple shortsightedness. Consider the following breezy reasoning. “No social purpose is served by having the defendant get free some aspect of the plaintiff that would have market value and for which he would normally pay.”<sup>198</sup>

Ask any IP scholar to describe the big issues of the field in a thimble and she will probably reply: “The tension between two desirable goals—incentives and dissemination.” To say that “no social purpose” is served by refusing to grant exclusive rights against copying—as was quoted above—largely wipes the public’s interest in dissemination off the map. Just to mention the basics: Exclusive rights against copying raise prices above marginal cost. Pricing above marginal cost imposes deadweight loss and impedes dissemination. Often a mix of limited exclusive rights with natural advantages (such as lead time and customer loyalty) yields better social returns than sole reliance on exclusive rights. And so on.

The anti-free-riding impulse has some defenders. Professor David Franklyn, for example, has argued that courts will not go overboard in following the impulse because judges are able to identify those defendants whose actions are justified.<sup>199</sup> Even if one concedes arguendo some force to the anti-free-riding impulse, copying for purposes of interoperability must be fair use under copyright law.

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The majority opinion has not carried the day historically. Even at its birth, two Justices objected to the majority’s approach, subjecting the ruling both to trenchant philosophic critique (by Justices Holmes) and to objections based on administrability (by Justice Brandeis). See *supra* note 4 (describing Brandeis’s approach).

<sup>196</sup> Dreyfuss, *supra* note 38, at 405 (reviewing impact of “value/right” impulse in case law). Justice Holmes was unconvinced by the majority in *International News Service*. In a separate opinion, he wrote: “Property, a creation of law, does not arise from value, although exchangeable—a matter of fact. Many exchangeable values may be destroyed intentionally without compensation.” *Int’l News Serv.*, 248 U.S. at 246 (Holmes, J., dissenting).

<sup>197</sup> See, e.g., Gordon, *On Owning Information*, *supra* note 125, at 167-70, 208-10 (discussing Lockean labor theory).

<sup>198</sup> *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (quoting Harry Kalven, Jr., *Privacy in Tort Law—Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROBS. 326, 331 (1966)).

<sup>199</sup> See generally Franklyn, *supra* note 194 (defending the anti-free-riding notion in the context of one type of trademark dispute) However, I think it is a mistake to place a burden on defendants to justify their free riding, at least when it is harmless. What the courts should be doing is putting a burden on *plaintiffs* to show that, when they bring suit, their victory would further the goals of the law that gave them IP rights in the first instance. So far, most courts would refuse such an invitation and put at least a burden of going forward on the proponents of fair use. To investigate those issue further would take us too far afield.

Yes, it is undeniable that in developing the Android platform, Google copied from Oracle's Java a set of method headers. Yes, there is undoubtedly enough creativity somewhere in the Java program to support Oracle's claim of holding a copyright in it. And yes, one can imagine the Federal Circuit judges asking themselves: "If Oracle's predecessor in interest did something socially valuable, and Google benefits without paying when it uses a part of that valuable product, why shouldn't we reward Oracle and punish the free rider? Wouldn't funneling monetary incentives to entities that provide popular products, such as Java, and leaching incentives away from free riders further goals of efficiency? Given the coincidence that software uses words and numbers, copyright is an available tool to do all of this. Why not use the tool at hand? Java has sowed the seeds and only its owner Oracle should reap them."

The answer is institutional. It is patent law—not copyright law—that should evaluate the extent to which these seeds should be permitted to flower. Copyright is simply not calibrated to handle technological issues such as interoperability. As many judges and scholars have emphasized, copyright's very ease of acquisition and long duration can make copyright law a buzz-saw when a scalpel is required.

Moreover, Congress and the courts have made clear that copyright must defer to patent law, filling copyright with doctrines fashioned precisely to diminish copyright's potential for spilling into patent territory. Consider the useful-article doctrine,<sup>200</sup> the use/explanation distinction,<sup>201</sup> the prohibition on copyright in ideas and methods of operation,<sup>202</sup> the doctrine of fair use,<sup>203</sup> and the rule on "merger"<sup>204</sup>—all these overlapping provisions keep copyright from awarding exclusive rights that might conflict with patent's dominance. Each of these rules or doctrines refuses to impose liability for copying that more properly lies near or within patent law's sphere of concern. Imposing liability that ignores such a basic component of federal IP law would impair not only interoperability but also fair use and the interior logic of copyright law.

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<sup>200</sup> 17 U.S.C. § 113 (2018).

<sup>201</sup> *See, e.g., Baker v. Selden*, 101 U.S. 99, 101-02 (1880).

<sup>202</sup> *See* 17 U.S.C. § 102(b).

<sup>203</sup> *See id.* § 107.

<sup>204</sup> *See, e.g., Oracle Am., Inc. v. Google Inc.*, 750 F.3d 1339, 1359-62 (Fed. Cir. 2014).