

**UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT**

Nos. 93-16867, 93-16869 and 93-16883

**Apple Computer, Inc.,
Plaintiff-Appellant-Cross Appellee,**

vs.

**Microsoft Corporation and Hewlett-Packard Company,
Defendants-Appellees-Cross Appellants.**

**Appeal from the United States District Court
for the Northern District of California**

**BRIEF AMICUS CURIAE OF
AMERICAN COMMITTEE FOR INTEROPERABLE SYSTEMS**

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**INTEREST OF AMICUS CURIAE
AND SUMMARY OF ARGUMENT**

The American Committee for Interoperable Systems ("ACIS") is an informal organization of companies that develop innovative software and hardware products that interoperate with computer systems developed by other companies.¹ Every member of ACIS believes that computer programs deserve effective intellectual property protection to give developers sufficient incentive to create new computer programs. At the same time, the members of ACIS are concerned that the improper extension of copyright law will impede innovation and inhibit fair competition in the computer industry. ACIS seeks the application of legal standards that will effectuate copyright law's fundamental

¹ ACIS members include Accolade, Inc., Advanced Micro Devices, Inc., Amdahl Corporation, AT&T Global Information Solutions, Broderbund Software, Inc., Bull HN Information Systems, Inc., Chips and Technologies, Inc., Clearpoint Research Corporation, Color Dreams, Inc., Comdisco, Inc., Emulex Corporation, Forecross Corporation, The Fortel Group, Fujitsu Systems Business of America, Inc., Informix Corporation, Integrated Documents Applications Corp., ICTV, Johnson-Laird, Inc., Kapor Enterprises, Inc., Landmark Systems Corporation, LCS/Telegraphics, New York Systems Exchange, Inc., Communications Corporation, Phoenix Technologies, Ltd., Plimoth Research Inc., Seagate Technology, Inc., Software Association of Oregon, Software Entrepreneurs Forum, Storage Technology Corporation, Sun Microsystems, Inc., Tandem Computers, Inc., 3Com Corporation, Western Digital Corporation, and Zenith Data Systems Corporation. (The Software Association of Oregon consists of 430 software development firms, firms in associated industries, and individuals professionally involved in software development. The Software Entrepreneurs Forum consists of over 1,000 software entrepreneurs and developers.)

aims by ensuring authors "the right to their original expression," but also encouraging competitors "to build freely upon the ideas and information conveyed by a [copyrighted] work." Feist Publications, Inc. v. Rural Tel. Serv. Co., 499 U.S. 340, 350 (1991).

The computer products developed by ACIS companies can achieve interoperability only if they can conform to the internal software interface standards established by other vendors. For this reason, ACIS strongly agrees with the District Court's recognition of the importance of standards to the computer industry, and its refusal to extend copyright protection to such standards. In its brief, however, Apple Computer, Inc. ("Apple") challenges the District Court's conclusion that copyright does not protect standardized elements. If this Court adopts Apple's position on this ruling, ACIS members and competitive conditions in the computer industry will suffer.

This amicus brief demonstrates that Apple bases its position on an unduly narrow interpretation of copyright's scenes a faire doctrine.² Apple's interpretation runs contrary to this Court's recent decision in Sega

2 Under the scenes a faire doctrine, courts "deny protection to those expressions that are standard, stock or common to a particular topic or that necessarily follow from a common theme or setting." Gates Rubber Co. v. Bando Chemical, Inc., 9 F.3d 823, 838 (10th Cir. 1993) (citations excluded).

Enterprises, Ltd. v. Accolade, Inc., 977 F.2d 1510 (9th Cir. 1992) and to scholarly authority.

Notwithstanding its disagreement with Apple on this point of law, ACIS takes no position on the ultimate issue of whether Microsoft Corporation and Hewlett-Packard Company infringed Apple's copyright in its graphical user interface ("GUI"). Additionally, neither ACIS nor its members have a direct financial interest in the outcome of this litigation.

ARGUMENT

I. THE SCENES A FAIRE DOCTRINE WITHHOLDS COPYRIGHT PROTECTION FROM PROGRAM ELEMENTS THAT HAVE BECOME INDUSTRY STANDARDS

Relying on the scenes a faire doctrine, the District Court below refused to extend copyright protection to arguably protectable program elements that had become de facto standards.³ Apple in its brief argues that this

3 In accordance with Brown Bag Software v. Symantec Corp., 960 F.2d 1465 (9th Cir. 1992), the District Court analytically dissected Apple's GUI. This Court's analytical dissection methodology is similar in substance to the Second Circuit's "abstraction-filtration-comparison" methodology. See Computer Associates Int'l., Inc. v. Altai, Inc., 982 F.2d 693, 706 (2d Cir. 1992). Given: (1) the similarity between "analytic dissection" and "abstraction-filtration-comparison"; (2) this Court's endorsement of the Second Circuit's methodology, see Sega Enterprises, Ltd. v. Accolade, Inc., 977 F.2d 1510, 1525 (9th Cir. 1992); (3) the highly functional nature of most screen displays; and (4) the confusion which may result from employing differently labelled methodologies for the infringement analysis of different aspects of a computer program, this Court should rule that "abstraction-filtration-comparison" is as appropriate a methodology for screen display cases as for cases involving the underlying computer programs. See Autoskill v. NESS, 994 F.2d 1476, 1490 (10th Cir.), cert. denied, 114 S. Ct. 307 (1993).

"ruling was a radical misuse of the 'scenes a faire' doctrine (which logically must be confined to what was common at the time a plaintiff's work was created, not extended to what later was emulated)" Apple Brief at 30.

On this narrow point, Apple is plainly wrong. Limiting the scenes a faire doctrine in the manner Apple suggests would prevent its application to situations where one work, or a handful of works by the same author, establishes a genre.⁴ During the course of writing a novel which begins a genre, the author feels few constraints limiting her range of expression. Subsequent authors can

4 There are numerous examples of such situations. Sir Walter Scott's Ivanhoe spawned the Medieval adventure novel with knights in shining armor saving damsels in distress. Buffalo Bill Cody's stories and performances engendered the Cowboy and Indian stereotypes of Western fiction, Raymond Chandler popularized the hard boiled detective, and "Superman" led to the ever-expanding pantheon of super heroes. These literary genres and stock characters were translated into film, which created its own genres. King Kong has inspired scores of monster movies, while Bruce Lee's martial arts movies are emulated by the likes of Steven Seagal and Jean-Claude Van Damme. Similarly, every season television producers derive new shows from Dragnet, Perry Mason, I Love Lucy, The Honeymooners, Marcus Welby, M.D., and Dallas. On a higher plane, Arnold Schoenberg's revolutionary twelve tone technique was adopted by many of his contemporaries, and led to the development of Serialism. Proceeding from the sublime to the ridiculous, the runaway popularity of the children's book Where's Waldo has led to such books as The Hunt for Helen, Searching for Susie, and Looking for Lisa. To be sure, each of these trailblazing works, as with all works of human creativity, draws on previous works. Nonetheless, each of these works by virtue of its popularity defined a genre, and all subsequent works within that genre derive from that archetypal work.

participate in that genre, however, only if they are free to borrow from the first novel those elements that define the genre. So long as constraints on the range of expression exist at the time the subsequent authors create their work, the constrained expression is non-infringing, regardless of whether those constraints existed at the time of the creation of the first work. And if this is true with respect to traditional copyrightable works, it is a fortiori the case with respect to utilitarian works such as computer programs.⁵

Apple suggests that the case law supports its parsimonious interpretation of the scenes a faire doctrine. Apple Brief at 30-31 & n.33. Not surprisingly, Apple neglects to cite this Court's recent decision in Sega v. Accolade, which reached this precise issue. When explaining that computer programs contain "logical, structural, and visual display elements that are dictated by . . . compatibility requirements and industry demands," the Sega Court quotes with approval the following statement from the Report of the National Commission on New Technological Uses of Copyrighted Works ("CONTU"): "[w]hen specific instructions, even though previously copyrighted, are the

⁵ See Computer Associates Int'l., Inc. v. Altai, Inc., 982 F.2d 693, 704, 711-12 (2d Cir. 1992); Sega Enterprises Ltd. v. Accolade, Inc., 977 F.2d 1510, 1524-26 (9th Cir. 1992). See also Copyright Protection: Has Look & Feel Crashed? 11 Cardozo Arts & Ent. L. J. 721, 732-33 (1993) (comments of the Honorable John M. Walker, Jr.).

only and essential means of accomplishing a given task, their later use by another will not amount to infringement." 977 F.2d at 1524 (citations omitted and emphasis supplied).⁶ In a footnote to this quotation, the Sega Court declined to protect the lines of Sega code constituting the "key" necessary to "unlock" the Sega console. Id. at n.7. Significantly, the Court withheld protection from the Sega "key" even though nothing constrained the range of Sega's expression when it initially designed its matching "lock" and "key." In other words, this Court has already found that otherwise protectable computer program elements lose their protected status if they subsequently become necessary for compatibility.

Professor Paul Goldstein of Stanford Law School acknowledges that the proposition that the scenes a faire doctrine applies "any time an otherwise copyrightable expression becomes a de facto standard is not free from practical difficulties." First, "the determination whether a particular form of expression has become a standard will rarely be . . . clear cut. . . ." Second, a rule "under which expression that is protectible one day becomes

⁶ See also Gates Rubber Co. v. Bando Chemical, Inc., 9 F.3d 823, 838 (10th Cir. 1993) (After defining scenes a faire, the Court explained that "[g]ranting copyright protection to the necessary incidents of an idea would effectively afford a monopoly to the first programmer to express those ideas." (emphasis supplied, citations omitted)).

unprotectible the next" may introduce instability into business planning. Professor Goldstein, however, believes these problems are readily surmounted:

[C]ourts have faced both these problems in the closely related context of trademark "genericide" under which an originally distinctive mark, such as "Aspirin" or "Thermos," enjoys trademark protection in its early years but, over time, loses its distinctiveness by becoming the product's descriptive, generic designation that competitors must be free to use if they are to be able to enter the market.

P. Goldstein, Copyright Principles, Law and Practice, 1993 Supplement at 17-18 (emphasis supplied).

Professor Goldstein adds that the case for holding standardized expression uncopyrightable is stronger than the case for holding generic marks unprotectible. While a generic mark may confuse a small percentage of consumers as to the source of the competitor's product, no consumer confusion will result from a competitor's use of expression that embodies a standard. Id. No one purchasing Microsoft's Windows thinks he is getting Apple's Macintosh.

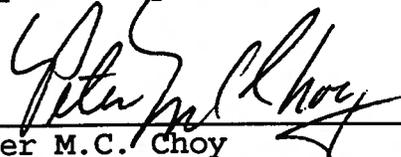
Apple asserts that withdrawing protection from a program element that the market has selected as a de facto standard amounts to a penalty on creativity; had the element been less attractive to the market, it would not have become a de facto standard. Apple's argument overlooks the fact that many elements of the Macintosh program remain protected, and Apple can enforce its rights against other

programmers who copy or paraphrase those elements. While Apple may not sell as many Macintosh programs as it would if it could monopolize the overlapping windows GUI, the copyright protection it receives allows it to profit from its research and development efforts, thereby giving it the incentive to develop more programs. The objectives of copyright, accordingly, are served. As Professor Goldstein writes, "[t]o give greater property rights than we needed to obtain the desired quantity and quality of works would impose costs on users without any countervailing benefits to society." 1 P. Goldstein, Copyright Principles, Law and Practice § 1.1 at 6.

II. CONCLUSION

For the foregoing reasons, this Court should affirm the District Court's ruling that the scenes a faire doctrine withdraws protection from computer program elements that have become standard features.

Respectfully submitted,



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CERTIFICATE OF SERVICE

This is to certify that on the 18th day of February, 1994, two true and correct copies of Brief Amicus Curiae of American Committee for Interoperable Systems and one true and correct copy of the corresponding Motion for Leave to File an Amicus Brief were sent via first class mail, postage prepaid, to the following:

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