Lotus Reply in Support of Petition for Writ of Certiorari

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und Dienstleistungs-GmbH

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IBM Japan GB Solution Co., Ltd.

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IBM South Africa (Pty) Ltd.

IBM Unternehmensberatung GmbH

ICG Informationssysteme Consulting und

Betriebs-Gesellshaft GmbH

ID Centeret Hj.

ID Centeret Hjorring

IDG Informationsverarbeitung und

Dienstleistungen GmbH

Industria Per IL Software S.p.A.

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IPN Informatica per Il Negozio S.r.l.

ISD Informationssysteme und Dienstleistungs GmbH

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Prodstar Production Software

Prodstar S.A.

Progipart, S.A.

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Service Plus Ltd.

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Societe Civile Immobiliere Monge

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Borland's Brief fails to confront the central issue presented by this case:whether, and to what extent, the Congressional mandate extending copyright protection to computer programs protects expressive elements of user interfaces, as well as programming code. It then distorts the pertinent case law in an effort to show that the First Circuit's unprecedented use of Section 102(b) to deny protection to such expressive elements does not conflict with the law of other circuits. Borland concedes that a uniform, national answer to these questions is of vital importance to the software industry (Borland Br. at 24), but it fails to demonstrate that the First Circuit has provided any usable answer, much less one that has nationwide acceptance.

1. Borland's position rests upon three false premises.

First, Borland repeatedly mischaracterizes the nature of Lotus' claims and the scope of the district court's holdings. Lotus did not claim, and the district court did not rule, that Lotus' copyrights gave it a monopoly on the use of any individual menu command such as "COPY," "MOVE," or "PRINT." See Borland Br. at 1, 5 & 8. Rather, the issue at all times has been the copyrightability of the Lotus 1-2-3 menu tree or command hierarchy taken as a whole--a collection of 469 different menu commands, organized and sequentially arranged into more than 50 different menus. This distinction is critical. It is, in fact, the structure and arrangement of the entire 1-2-3 menu hierarchy that Borland copied in its products and that the district court found to contain sufficient original expression to be copyrightable. Pet. App. at 86a-89a. Borland's focus upon individual commands is a classic example of what Professor Nimmer called the fallacy of reductio ad absurdum: if the first word of a work is not protectable, standing alone, and the second is not, and so on, then the entire work must be unprotected. [1] Yet, as is true for any literary work, it is the combination and arrangement of the individual words in the 1-2-3 menus as a whole that give them their context, meaning, and communicative power--and that make them copyrightable.

Second, Borland misdescribes the Lotus 1-2-3 user interface in an attempt to reinforce the First Circuit's erroneous analogy comparing the words displayed in the 1-2-3 menus to the buttons on a machine. See Pet. App. at 18a-19a. It is simply untrue that a 1-2-3 user can instruct the program to perform an operation by typing out a menu command, such as "PRINT," as Borland represents. Borland Br. at 8. Neither are the words "used as buttons to operate a program." Id. at 13. Rather, the words serve to explain to users what their available command choices are at a given point in the operation of the program, and to identify the keystrokes that will communicate those choices to the program.[2] It is the keystrokes-- not the words appearing on the screen--that cause the program to take any action. Indeed, Lotus could have designed a user interface that did not display such information to the user (Pet. App. at 286a-288a); users could have been forced, for example, to remember the permissible keystrokes and to rely upon printed documentation for any necessary reminders. That this table of contents conveniently appears on the screen instead should not transform the character of those words from their fundamentally informative purpose into the equivalent of a mechanical device.

Recognition of this distinction also provides the appropriate perspective from which to consider Borland's argument that the 1-2-3 menu command hierarchy should be protected, if at all, under patent rather than copyright law. Borland Br. at 25-26. According to Borland, copyright in a computer program covers only its code, and "perhaps" the "detailed 'structure'" of its code. Id. at 26. That is, in Borland's view, copyright properly protects the digital notations that operate within the machine causing it to function, but not the English words that appear on the screen to assist a person in using the program, because the latter (but not the former) is a "method of operation." Id. at 18-19. Thus, according to Borland, an arrangement of words conveying information to human beings must be protected by patent, while machine-level communication is covered by copyright. Far from restoring "the overall intellectual property protection framework established by Congress," as Borland claims (id. at 25), this proposal would turn it on its head.

Third, Borland depicts the 1-2-3 menu command hierarchy as distinct from the computer program that generates it, drawing a bright line between a "computer program" (which it defines as consisting only of programming code) and any informational content that the same code is designed to display. Id. at 17.[3] Borland's entire legal analysis rests upon this distinction, which it purports to draw from the definition of a "computer program" found in Section 101 of the Copyright Act. 17 U.S.C. 101. That definition--"a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result"--contains, on its face, no limitation that restricts its applicability to programming code. The 1-2-3 menu commands fit the statutory definition equally well, as they express a set of instructions to be used in a computer to produce particular results.[4] Certainly from the perspective of a typical user any suggestion that the user interface is not an integral part of the computer program seems absurd.[5]

2. Borland's argument also reveals a basic misperception of the role of the Section 101 definitions in the overall scheme of the Copyright Act. The definitions neither delimit the bounds of copyrightable subject matter, nor specify the scope of protection afforded to copyrightable works. That is the purpose of Section 102(a), with its illustrative but not limitative list of the types of works eligible for copyright, and of the limitations found in Section 102(b). It is no more accurate to employ the definition of a "computer program" in Section 101 as a basis for precluding protection for menus that a program displays, than to use the statutory definition of a "motion picture"--defined as a "series of related images which, when shown in succession, impart an impression of motion" (17 U.S.C. 101)--to preclude protection for a motion picture's plot, dialogue, or characters, all of which plainly are copyrightable and covered by the copyright in the motion picture itself.

Borland agrees that Section 102(b) is "the legislative embodiment of the idea/expression dichotomy," which supplies the "'line' between copyrightable and uncopyrightable subject matter." Borland Br. at 18 (emphasis in original). But the First Circuit disregarded the district court's finding that the 1-2-3 menu hierarchy contains expression separable from its underlying idea. Pet. App. at 17a. Beyond its misplaced reliance on the definition of a "computer program" in Section 101, Borland proffers no reason why the 1-2-3 menu command hierarchy can be considered an unprotected "method of operation" that would

not, under the First Circuit's reasoning, also preclude copyright protection for computer programs generally. The uncertainty confronting the software industry in the wake of the First Circuit's decision is both genuine and profound, and Borland's Brief does nothing to obviate the need for this Court's resolution of the issue.

3. Borland misreads the pertinent decisions from other circuits to argue that the First Circuit's decision presents no conflict.

a. Borland inaccurately portrays the Fifth Circuit's denial of a petition for rehearing en banc in Engineering Dynamics Inc. v. Structural Software Inc., 26 F.3d 1335 (5th Cir. 1994), pet. for reh'g en banc denied, 46 F.3d 408 (5th Cir. 1995), as retreating from its earlier opinion extending copyright protection to a computer program's user interface. Borland Br. at 23. In seeking rehearing of the Fifth Circuit's decision, the defendant Structural Software and its amici argued--as do Borland and many of the same amici in this case--that the court erroneously had based its original decision solely upon the existence of alternatives to plaintiff's choice of input formats. The Fifth Circuit rejected that characterization of its rationale as "overly simplistic" (46 F.3d at 409), observing that its conclusion rested upon many facts, including a finding that the plaintiff's user interface reflected a sufficient degree of creativity to qualify as original expression under this Court's ruling in Feist Publications, Inc. v. Rural Telephone Serv. Co., 499 U.S. 340, 358 (1991). Engineering Dynamics, 46 F.3d at 409. The court neither modified nor withdrew any of its previous rulings on copyrightability, including its reliance on Judge Keeton's decisions below. To the contrary, the Fifth Circuit reaffirmed its direction to the district court to apply the abstraction-filtration-comparison test to determine the precise scope of protection in plaintiff's user interface, in particular by identifying elements that were functionally dictated. Id. at 410.

In this case, Judge Keeton specifically found, after trial, that the 1-2-3 menu command hierarchy was not dictated by the functionality it allowed users to achieve, in addition to finding that numerous viable alternatives existed to that particular menu command hierarchy. Pet. App. at 89a, 93a & 130a. Under the Fifth Circuit's ruling in Engineering Dynamics, these findings would compel a conclusion of copyrightability. The First Circuit, in contrast, either ignored these findings or deemed them irrelevant to its analysis. Id. at 17a. The conflict is square. Indeed, Borland argued before the First Circuit that the Engineering Dynamics court erred when it "adopted" Judge Keeton's reasoning and held that a computer program's user interface is copyrightable.[7]

b. Borland fares no better in its attempt to depict the law of the Ninth Circuit as not in conflict with the First. Borland casually dismisses the Ninth Circuit's decision in Johnson Controls, Inc. v. Phoenix Control Systems, Inc., 886 F.2d 1173 (9th Cir. 1989), as "not pertinent here at all" (Borland Br. at 20), despite the court's explicit statement that:

[w]hether the non-literal components of a program, including the structure, sequence and organization and user interface, are protected depends on whether, on the particular facts of each case, the component in question qualifies as an expression of an idea or an idea itself. (Id. at 1175.)

Borland similarly mischaracterizes the Ninth Circuit's decision in Brown Bag Software v. Symantec Corp., 960 F.2d 1465 (9th Cir.), cert. denied sub nom. BB Asset Mgmt. Inc. v. Symantec Corp., U.S. , 113 S. Ct. 198 (1992). The district court did not hold "that the menus at issue were 'unprotectable by copyright'" (Borland Br. at 20), and neither did the Ninth Circuit. Borland refers to a portion of the district court's decision, as summarized by the Ninth Circuit, rejecting plaintiff's claim that its copyright protected certain functional "features" of the program, such as the ability to access files or to print. 960 F.2d at 1472.8 The district court carefully distinguished these unprotectable "features" from the "expression" in "the programs' respective opening menus," which it found were "not substantially similar". Id. at 1473. The Ninth Circuit recognized this distinction, affirming the district court's test for comparing "the expressions embodied" in the programs' menus. Id. at 1475. That the Ninth Circuit considered the menus to comprise protected expression is obvious throughout its analysis. They simply had not been copied in that case.

Borland faults Lotus for not discerning a different rule in the Ninth Circuit's earlier decision in Ashton-Tate Corp. v. Ross, 916 F.2d 516 (9th Cir. 1990). Lotus is not alone in concluding that this decision has no bearing upon the issues in this case. The First Circuit did not mention that case, and the Ninth Circuit omitted any such reference when it discussed the menus at issue in Brown Bag two years later. Contrary to Borland's assertion, the Ninth Circuit did not hold in Ross that "the menu commands of a spreadsheet software product were uncopyrightable" (Borland Br. at 20); that question was not before the court. Rather, the issue was whether Ross, having furnished a document consisting of "only a list of labels for user commands" that he "thought should be included" in a predecessor to the Ashton-Tate program,9 could claim to be a joint author of the program's eventual user interface. Ashton-Tate Corp. v. Ross, 728 F. Supp. 597, 602 (N.D. Cal. 1989). The Ninth Circuit's holding was that this handwritten list--not the program's menu commands and hierarchy--did not qualify for copyright protection, and thus Ross had no claim to joint authorship in the program. 916 F.2d at 522.10

 c. Borland further errs by asserting that the Tenth Circuit "rejected" its decision in Autoskill, Inc. v. National Educational Support Systems, Inc., 994 F.2d 1476 (10th Cir.), cert. denied, 114 U.S. 307 (1993), five months later in Gates Rubber Co. v. Bando Chemical Indus., Ltd., 9 F.3d 823 (10th Cir. 1993). Borland Br. at 22. In Gates Rubber, the Tenth Circuit explicitly adopted the abstraction-filtration-comparison test "which we previously approved for use in the context of a preliminary injunction ruling in Autoskill," also citing with approval Judge Keeton's decision in Lotus Development Corp. v. Paperback Software Int'l, 740 F. Supp. 37 (D. Mass. 1990). Gates Rubber, 9 F.3d at 834. The court of appeals directed the district court to apply that test to determine the copyrightability of plaintiff's menus (id. at 843-44)--a senseless direction if the Tenth Circuit agreed with the First Circuit that menus are per se ineligible for copyright. Thus, under the law of the Tenth Circuit but not the First, menus may be protected to the extent they contain identifiably separable expression. This rule is wholly unaffected by the district court's subsequent factual finding that the menus at issue in Gates Rubber fell "towards the idea end of the idea-expression dichotomy" because the "universe of choices to accomplish [their] task is relatively small." Gates Rubber Co. v. Bando Chemical

Indus., Ltd., No. 92-S-136, slip. op. at 7 (D. Colo. filed June 12, 1995). In contrast, Judge Keeton in this case found that the possible "universe of choices" for a spreadsheet menu hierarchy providing the same functionality as in Lotus 1-2-3 was virtually unlimited (Pet. App. at 131a), although, as noted above, his decision did not rest upon that finding alone. Id. at 93a, 129a, 130a & 133a.

d. Borland also claims that the Second Circuit "pointedly rejected" Judge Keeton's Paperback analysis in Computer Assoc. Int'l, Inc. v. Altai, Inc., 982 F.2d 693 (2d Cir. 1992). Borland Br. at 4 (emphasis in original). In fact, the Second Circuit cited Paperback with approval in support of critical steps in its own reasoning no fewer than five times.11 Borland ignores these substantive citations in favor of the court's single reference in dicta concerning the potential policy implications of the Second Circuit's decision, leading to a conclusion that courts must apply, "in accordance with Congressional intent, long-standing principles of copyright law to computer programs." 982 F.2d at 712. It is precisely these "long-standing principles"--including the principle that Section 102(b) must be interpreted by applying the idea/expression dichotomy to each element of a copyrighted work for which protection is sought--that both the Second Circuit and the district court below espoused and followed, but the First Circuit ignored.

Borland accuses Judge Keeton of having rejected or ignored well-settled principles in order to achieve a "controversial extension of copyright law" in this case. Borland Br. at 3, 11. This is not correct. Faithful to the Congressional mandate, Judge Keeton applied traditional copyright doctrine to the task of defining the scope of protection available to computer programs--a new, high technology form of "literary work". He took as his guide the landmark decisions of Judge Learned Hand that have, for decades, instructed the courts in the proper use of the idea/expression dichotomy, the merger doctrine and other time-tested analytic tools to distinguish the protected from the unprotected elements of literary works. The result was an analysis that not only has influenced the tests subsequently adopted in decisions of the Second, Fifth, Ninth, and Tenth Circuits, as those courts have all acknowledged, but also has generated considerable favorable commentary in the academic community.12 Judge Keeton's conclusion that a computer program's menu command hierarchy is copyrightable where, as here, its original expression is separable from its underlying functionality, is consistent with decisions from across the land.13 The First Circuit is the first court to hold otherwise.

CONCLUSION

For these reasons and for the reasons set forth in the petition, the petition for a writ of certiorari should be granted.

Respectfully submitted,

Footnotes

1 Declaration of Melville B. Nimmer, dated November 15, 1984, at 14, appended to Anthony L. Clapes, Patrick Lynch and Mark R. Steinberg, Silicon Epics and Binary

Bards: Determining the Proper Scope of Copyright Protection for Computer Programs, 34 UCLA L. Rev. 1493, 1585, 1588-89 (1987). *(return to text)*

2 The permissible keystrokes include the first letters of the words appearing in a particular menu or the "ENTER" key, which will communicate the currently highlighted menu command. *(return to text)*

3 Contrary to Borland's suggestion (id.), the facts of this case prove this to be incorrect. The district court received in evidence the print-out of a particular file, stored internally in the Borland programs, in which every word from the 1-2-3 menus, arranged as in the 1-2-3 menu hierarchy, was spelled out. See Pet. App. at 34a-35a. *(return to text)*

4 The menu commands also fit the literal definition of a "literary work" found in the same section: "works, other than audiovisual works, expressed in words, numbers, or other verbal or numerical symbols or indicia, regardless of the nature of the material objects, such as books, periodicals, manuscripts, phonorecords, film, tapes, disks, or cards, in which they are embodied." 17 U.S.C. 101. *(return to text)*

5 Neither does the Copyright Office share Borland's view on this subject. In its amicus brief, the Copyright Office declared: "Menu screens are integral parts of computer programs, and they may or may not contain copyrightable expression." Brief Amicus Curiae on Behalf of the Register of Copyrights, at 5. Contrary to Borland's contention (Borland Br. at 4), this brief was not filed in the court of appeals, urging reversal, but in the district court, and in it the Copyright Office expressly declared that its "brief should not be taken as commenting on the copyrightability or scope of protection to be accorded the works at issue in this case, i.e., those relating to Lotus 1-2-3." Id. at 3. *(return to text)*

6 See Brief Amicus Curiae of Intellectual Property Owners in Support of Petitioner, at 9-10; Brief Amicus Curiae of Information Technology Industry Council in Support of the Petition for a Writ of Certiorari, at 3 & 10-11. *(return to text)*

7 Letter of Gary L. Reback, counsel of record for Borland, to Clerk of the Court for the First Circuit, dated September 27, 1994.*(return to text)*

8 In this case, Judge Keeton drew the same distinction, specifically finding that 1-2-3's "features" or functional capabilities comprise part of the unprotected "idea" underlying the 1-2-3 menu command hierarchy, rather than part of the protected expression. Pet. App. at 129a.*(return to text)*

9 Judge Keeton explicitly considered this and other facts in the course of distinguishing this case from Ross in his analysis (Pet. App. at 135a-36a), and did not disregard the Ross decision merely because it arose in another circuit, as Borland suggests. Borland Br. at 6.*(return to text)*

10 Among the reasons given by the district court for its conclusion was the fact that Ross "did not contribute in any manner" to the "implementation of his suggested commands"

in the program, and therefore had contributed only an "idea" rather than expression to the creation of the program's user interface. 728 F. Supp. at 602. Borland glides over this and other critical facts necessary to a proper understanding of the Ross decision by use of ellipsis (Borland Br. at 21), which omits, between the first six and last five words of the quote, five complete sentences and virtually all of the district court's explanation for its conclusion.*(return to text)*

11 Specifically, the Second Circuit cited Paperback for its exposition of the pertinent legislative history (982 F.2d at 702); for the principle that non-literal elements of computer programs, like other literary works, are protected by copyright (id. at 703); for the conclusion that the idea/expression distinction should be used to determine which aspects of computer programs are copyrightable (id. at 704); for its use of merger doctrine to address the question of substantial similarity "in the context of computer program structure" (id. at 709); and, explicitly agreeing with Judge Keeton's "approach," for the conclusion that merger is "an effective way to eliminate non-protectable expression contained in computer programs." (Id.)*(return to text)*

12 See, e.g., Jane C. Ginsburg, Four Reasons and a Paradox: The Manifest Superiority of Copyright Over Sui Generis Protection of Computer Software, 94 Colum. L. Rev. 2559, 2571 n. 68 (1994); Arthur R. Miller, Copyright Protection for Computer Programs, Databases and Computer-Generated Works: Is Anything New Since CONTU?, 106 Harv. L. Rev. 997 (1993); Robert D. Sprague, Multimedia: The Convergence of New Technologies and Traditional Copyright Issues, 71 Den. U.L. Rev. 635 (1994); Nicholas P. Terry, GUI Wars: The Windows Litigation and the Continuing Decline of "Look and Feel", 47 Ark. L. Rev. 93 (1994). *(return to text)*

13 See, e.g., Engineering Dynamics, 26 F.3d at 1343-44; Gates Rubber, 9 F.3d at 849; Brown Bag, 960 F.2d at 1475-76.*(return to text)*

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