

1 MORRISON & FOERSTER LLP
 MICHAEL A. JACOBS (Bar No. 111664)
 2 mjacobs@mofo.com
 KENNETH A. KUWAYTI (Bar No. 145384)
 3 kkuwayti@mofo.com
 MARC DAVID PETERS (Bar No. 211725)
 4 mdpeters@mofo.com
 DANIEL P. MUINO (Bar No. 209624)
 5 dmuino@mofo.com
 755 Page Mill Road, Palo Alto, CA 94304-1018
 6 Telephone: (650) 813-5600 / Facsimile: (650) 494-0792

7 BOIES, SCHILLER & FLEXNER LLP
 DAVID BOIES (Admitted *Pro Hac Vice*)
 8 dboies@bsflp.com
 333 Main Street, Armonk, NY 10504
 9 Telephone: (914) 749-8200 / Facsimile: (914) 749-8300
 STEVEN C. HOLTZMAN (Bar No. 144177)
 10 sholtzman@bsflp.com
 1999 Harrison St., Suite 900, Oakland, CA 94612
 11 Telephone: (510) 874-1000 / Facsimile: (510) 874-1460

12 ORACLE CORPORATION
 DORIAN DALEY (Bar No. 129049)
 13 dorian.daley@oracle.com
 DEBORAH K. MILLER (Bar No. 95527)
 14 deborah.miller@oracle.com
 MATTHEW M. SARBORARIA (Bar No. 211600)
 15 matthew.sarboraria@oracle.com
 500 Oracle Parkway, Redwood City, CA 94065
 16 Telephone: (650) 506-5200 / Facsimile: (650) 506-7114

17 *Attorneys for Plaintiff*
 ORACLE AMERICA, INC.

19 UNITED STATES DISTRICT COURT
 20 NORTHERN DISTRICT OF CALIFORNIA
 21 SAN FRANCISCO DIVISION

22 ORACLE AMERICA, INC.
 23 Plaintiff,
 24 v.
 25 GOOGLE INC.
 26 Defendant.

Case No. CV 10-03561 WHA

**ORACLE’S OBJECTIONS TO THE
 COURT’S FINAL CHARGE TO THE
 JURY AND SPECIAL VERDICT
 FORM (PHASE ONE)**

Dept.: Courtroom 8, 19th Floor
 Judge: Honorable William H. Alsup

1 Oracle submits these additional objections to the Court's Notice of Final Charge to the
2 Jury (Phase One) and Special Verdict Form (ECF No. 1012). Oracle preserves all prior
3 objections made to the jury instructions and verdict form, including those made at the charging
4 conference on Friday, April 27 and in briefs filed with the Court before and after that charging
5 conference addressing proposed jury instructions.

6 **I. ORACLE'S OBJECTIONS TO THE FINAL CHARGE**

7 **A. Instruction No. 16 (Infringement definition)**

8 Oracle was agreeable to the proposed change to Instruction No. 16 at the charging
9 conference, but notes that with this change, the complete set of jury instructions as revised now
10 lacks a clear and affirmative definition of infringement. That definition used to be contained in
11 Instruction No. 16. (*See* ECF. No. 994 ("As stated, the owner of a copyright has the exclusive
12 right to make copies of all of [sic] part of the copyrighted work. If someone else does so without
13 consent from the owner, then there is infringement (except in certain circumstances I will
14 describe below.")) It has now been removed, and the revised instruction substitutes in a
15 reference to the affirmative defenses of fair use and *de minimis*. Given that Google's affirmative
16 defenses of fair use and *de minimis* defenses are mentioned or explained in 10 of the 18
17 substantive instructions (*see* Jury Instr. Nos. 13, 16, 19, 21, 22, 24, 26, 27, 28, 30), the jury should
18 be provided with at least one clear definition of infringement, either in this instruction or
19 elsewhere.

20 **B. Instruction No. 17 (Ideas/Expression)**

21 With the exception of the last sentence of this instruction, Oracle objects to the inclusion
22 of an ideas/expression instruction on the grounds that such an instruction is confusing because it
23 is an issue of law for the Court to decide and that the Court's approach in the rest of the set of
24 instructions is to charge the jury with determining whether there was infringement and whether it
25 was excused, while reserving the issue of copyrightability for the Court. Since the jury will not
26 be deciding copyrightability, this instruction is unnecessary and invites the jury to deliberate over
27 whether the works at issue are protected by copyright.
28

1 Oracle does not object to the last sentence of this instruction, which needs to be delivered
2 to inform the jury that the structure, sequence and organization is copyrightable.

3 **C. Instruction No. 24 (Copying)**

4 Oracle objects to revised instruction 24 to the extent that it now states that Oracle has the
5 burden to prove that Google's copying was not *de minimis* in comparison to the work as a whole.
6 The instruction appears to be placing the burden on Oracle to show that copying of the APIs for
7 the 37 packages was not *de minimis*, but the Court has already stated that no reasonable jury
8 could find this. (*See* Tr. 1870 (No reasonable jury could find that the structure, sequence, and
9 organization is *deminimus*.”).) In addition, the burden of establishing a *de minimis* defense rests
10 with Google, not Oracle. *See, e.g., Merch. Transaction Sys., Inc. v. Nelcela, Inc.*, 2009 U.S. Dist.
11 LEXIS 25663, at *61 (D. Ariz. Mar. 17, 2009) (“Thus, Nelcela will not escape liability unless it
12 can show that the protectable elements in the Lexcel software constitute an insignificant
13 (quantitatively and qualitatively) portion or aspect of the Lexcel software.”).

14 Further, Oracle continues to object to the Court's use of the “virtual identity test” for
15 claims involving the API documentation. While the Court appears to be using this test to refer to
16 a comparison of the written description in the API documentation, Oracle notes that the term API
17 documentation is actually broadly defined in Instruction 18, to include “all content—including
18 English-language comments as well as method names and class names, declarations, definitions,
19 parameters, and organization—in the reference document for programmers.” (ECF No. 1012
20 ¶ 18.) Applying the virtual identity test to copying of this broad range of creative expression
21 would be incorrect if that is the Court's intent.

22 **D. Instruction No. 25**

23 This instruction was requested by Google at the charging conference. Oracle submitted a
24 brief objecting to the proposed instruction on Sunday, April 29, and incorporates that brief by
25 reference here. (*See* ECF No. 1010.) As described in more detail in that brief, this instruction
26 should not be given at all, but if it is delivered, the instruction is improper because: (1) the proper
27 frame of reference for the “work as a whole” should be Oracle's work, not Android; (2) the
28 instruction does not include the fact that the comparison to the work as a whole should be both

1 qualitative and quantitative, as even a quantitatively small amount of copying can have
2 significance; and (3) the instruction should explicitly state that there is no need to engage in the
3 substantial similarity analysis if there is evidence of direct copying of the kind Google has
4 admitted to here. (*See id.* at 1-3.)

5 **E. Instruction No. 26**

6 Oracle objects to the Court's inclusion of "transformative" in paragraph 1 of the
7 instruction, and to the definition of "transformative." Oracle objects further to the use of the term
8 "functional" in section 2. Both terms were proposed by Google and have the potential to mislead
9 the jury. Oracle filed a brief on April 29 setting forth its objections to the fair use instruction
10 provided by the Court at the charging conference on April 27. (ECF No. 1005.) Oracle
11 incorporates that brief by reference here.

12 Google's use is not transformative. Google copied the APIs for the 37 Java packages
13 nearly verbatim, and uses them in a competing product to attract Java developers. Google's claim
14 that Android's use of the APIs for the 37 Java packages is transformative because Android is a
15 smart phone is baseless. All Google has done is to take technology already present in one billion
16 mobile phones, copy it without modification, and use it for Android. Further, there was
17 uncontroverted evidence at trial that the Java APIs were already being used in Blackberry
18 smartphones manufactured by RIM, Sidekick/Hiptop smartphones manufactured by Danger, and
19 Nokia's Series 60 phones. (Tr. 959:20-23 (Swetland); 1585:21-23 (Rubin); 300:18-19 (Ellison);
20 383:6-9 (Kurian); 1102:3-9 (Cizek); 1922:22-25 (Gering).)

21 If the Court is going to deliver an instruction on transformative, Oracle requests that the
22 definition be revised as "meaning whether Google's use of copyrighted material was for a distinct
23 purpose unrelated to the function and purpose of Oracle's original material." *See, e.g., Kelly v.*
24 *Arriba Soft Corp.*, 336 F.3d 811 (9th Cir. 2003) (holding search engine operator's use of
25 "thumbnail" pictures of copyrighted images was "transformative" fair use, because it "served an
26 entirely different function" from plaintiff's original images). *See also* ECF No. 1005 at 4-8.

1 **F. Instruction No. 28 (*De Minimis*)**

2 Oracle objects that Instruction No. 28 improperly places the burden of proving the
3 affirmative defense of *de minimis* use on the plaintiff, Oracle. *See Merch. Transaction*, 2009 U.S.
4 Dist. LEXIS 25663, at *61.

5 Oracle also objects that this instruction should clearly state that the defense of *de minimis*
6 is only available to excuse Google’s use the 11 Java source and object code files copied verbatim,
7 and is not a defense to Google’s use of the structure, sequence, and organization of the
8 compilable code of the API packages or for the documentation of the API packages. Although
9 Oracle believes this to be the Court’s intent, the instruction currently makes no mention of this
10 important point.

11 **G. Instruction No. 29 (Works as a Whole)**

12 Oracle objects to this instruction to the extent that it may be read to suggest that the jury
13 should be comparing the structure sequence and organization of the 37 packages with all of the
14 compilable code in the 166 packages. The comparison should be to the structure, sequence and
15 organization of those packages. In addition, Oracle asks that the Court delete the italics from the
16 word “all.” *See* ECF No. 1012 ¶ 29(“. . . all of the compilable code associated with *all* of the 166
17 API packages (not just the 37). . .” and “documentation for *all* of the 166 API packages (not just
18 the 37)”) (emphasis in original) These italics were helpful in the former instruction to draw
19 a distinction between situations where the jury was being asked in the same instruction to
20 compare against all the APIs for all of the packages, as well as “*that individual API package*”
21 (ECF No. 994 ¶ 30) (emphasis in original). Now that the individual package comparison has
22 been removed, the italics are no longer required and place undue emphasis on this point.

23 **II. ORACLE’S OBJECTIONS TO THE FINAL SPECIAL VERDICT FORM**

24 **A. Special Verdict Form Question 3**

25 Oracle objects to Question 3 to the extent that it places the burden on Oracle to prove that
26 Google’s copying was not *de minimis*. As noted above, Google has the burden of establishing a
27 *de minimis* defense.
28

1 Oracle agrees with Google’s comment that this verdict form should be clarified to ensure
2 that it is clear to the jury what it is doing when it votes “Yes” or “No.” Oracle is willing to adopt
3 Google’s suggestion of placing a parenthetical stating “infringing” under “Yes” and a
4 parenthetical stating “not infringing” under “No.”

5 **B. Special Verdict Form Question 4**

6 Oracle objects to the Court’s inclusion of interrogatories relating to the equitable defenses
7 on the verdict form. Oracle filed a brief relating to this issue on April 29, which it incorporates
8 by reference here. (ECF No. 1004). Oracle is concerned that including these interrogatories will
9 improperly focus the jury on Google’s equitable defenses, which are for the Court to decide.
10 Oracle objects further that the interrogatories do not capture all the elements of the equitable
11 defenses. (*See id.* at 1-3.)

12 **CONCLUSION**

13 For all the above reasons, Oracle requests that the Court modify the final proposed
14 instructions in accordance with the objections described above.

15
16 Dated: April 30, 2012

MORRISON & FOERSTER LLP

17
18 By: /s/ Michael A. Jacobs

19 Michael A. Jacobs
20 Attorneys for Plaintiff
21 ORACLE AMERICA, INC.
22
23
24
25
26
27
28