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GOOGLE INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.,

Plaintiff,

v.

GOOGLE INC.,

Defendant.

Case No. 3:10-cv-03561 WHA

**GOOGLE INC.'S BRIEF IN OPPOSITION
TO ORACLE MOTION TO PRECLUDE
OWNERSHIP CHALLENGE**

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

1 Oracle’s “motion to preclude Google from disputing ownership” is an attempt by Oracle
2 to avoid the consequences of its failure to prove basic elements of its case, to blame Google for
3 that failure, and to segregate out for special treatment an issue that has already been joined in the
4 parties’ motions for judgment as a matter of law under Rule 50. The motion is not only
5 procedurally improper, it is also misguided as a matter of law. Oracle confuses “ownership” of
6 the copyrights at issue with the legal question of *the scope of Oracle’s rights*.

7 ARGUMENT AND CITATION OF AUTHORITIES

8 Oracle’s theory of copyright infringement has changed multiple times during this
9 litigation. At different times, Oracle has characterized the works in which it claims copyrights as
10 “collective works,” as “compilations,” as “derivative works,” or as free-standing works that are
11 part of the larger wholes that are the subject of its registrations. Oracle has also characterized its
12 claims based on the API packages as being claims of infringement of the “selection, arrangement
13 and structure” of the packages (Oracle Statement of Copyright Issues, Dkt. 899) and the
14 “structure, sequence and organization” of the packages (Oracle Proposed Findings and
15 Conclusions, Dkt. 902)—and neither of those articulations was advanced in the proposed pretrial
16 order. *See* Joint Proposed Pretrial Order, Dkt. 525.

17 Each of these characterizations has different consequences under the Copyright Act, and
18 each imposes on Oracle different burdens with respect to what it needed to prove at trial.
19 Selection, coordination, and arrangement are relevant to a copyright claim in a compilation, as
20 defined in 17 USC § 101. That section sets forth the *statutory* basis for protection. Structure,
21 sequence and organization, on the other hand, is a judicially created theory of infringement of
22 computer programs. Regardless of the theory Oracle is advancing, however, Oracle needed to
23 prove the contents of the complete works¹ that are the subject of its registrations and its

24 ¹ Google’s JMOL motion challenged the sufficiency of Oracle’s proof of the work as a whole,
25 based on Google’s assumption that Oracle was relying on TX 1076, the disc that Oracle
26 introduced on the last day of trial, as containing the complete work as a whole. Oracle has since
27 clarified that it does not rely on TX 1076, and relies instead on TX 623—which does contain, in
28 source code form, all of the files on which Oracle bases its claims. Google therefore does not
believe that there is any longer a live issue regarding whether Oracle proved the contents of the
version 5.0 work as a whole, and accepts that TX 623 should be treated as the work that is the
subject of the registrations for version 5.0.

1 ownership of any individual portions of those works on which it chose to base its infringement
2 allegations.

3 Under the plain language of 17 U.S.C. § 103(b), Oracle’s copyrights extend only to the
4 “material contributed by the author of such work, as distinguished from the preexisting material
5 employed in the work.” The copyrights therefore only extend to any materials included in the
6 works that were authored by Sun (or Sun employees).² The copyrights do not extend to any
7 preexisting materials created by other authors, and Oracle’s copyrights in the complete works do
8 not “imply any exclusive right in the preexisting material.” 17 U.S.C. § 103(b).

9 This issue of the scope of the copyrights owned by Oracle has become important because
10 of the unprecedented way Oracle advanced its infringement claims at trial. Oracle argued—and
11 the Court agreed for purposes of submitting Oracle’s claims to the jury—that small portions of
12 the entire works should be treated as individual “works” for purposes of its claims. Google has
13 objected to this approach, and has consistently argued that the “work as a whole” for infringement
14 purposes can and must be the entire work that is the subject of the registrations, and not a subset
15 or individual file contained in the larger work.

16 Oracle’s approach is contrary to both Oracle’s registrations and to the way infringement
17 claims are generally tried; it is as if Tolstoy argued that his copyright rights in *War & Peace* were
18 violated by copying a dozen sentences from the novel because those sentences were individual
19 works. Oracle argued, for example, that the individual files from which it claims code or
20 comments were copied should be considered the “work as a whole” for purposes of its claims
21 based on those materials. Oracle also argued that only the API packages were the appropriate
22 “work as a whole” for purposes of its “structure, sequence and organization” claims and its claims
23 based on the documentation or specifications of the API packages. This approach hopelessly
24 confuses ownership with infringement analysis, since “structure, sequence and organization” is
25 relevant, if at all, only at the infringement stage. The “structure, sequence and organization” of a

26 ² Under Ninth Circuit law, this includes portions of the works that were included in earlier
27 versions of the works. *See Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1447-48 (9th
28 Cir. 1994).

1 work cannot be registered with the Copyright Office; the Copyright Office only registers claims
2 to copyright in a “work.”

3 Google has made plain multiple times that *Google does not contest Oracle’s ownership*
4 *of the copyrights on which Oracle is suing*. E.g., RT 1665:3-8; RT 1884:10-13; RT 1887:6-8.
5 That acknowledgement, however, does not dispose of the issue of the scope of those copyrights,
6 nor does it relieve Oracle of the need to prove (1) *that it has ownership rights over the individual*
7 *portions of the works it singled out for purposes of trying to prove its infringement claims*, and
8 (2) that Google’s copying of those portions (if proved) resulted in a material copying of the work
9 as registered. These two issues are very different. The first issue has become significant as a
10 result of the way in which Oracle has pursued its infringement claim—and has been briefed as
11 part of the parties’ JMOL motions under Rule 50 (as well as the parties’ proposed findings and
12 conclusions) and should be decided as part of those motions, to the extent necessary.

13 The only additional issues raised in Oracle’s motion are Oracle’s attempts to preclude
14 Google from challenging Oracle’s failure of proof. Oracle’s attempts rely on Google’s past briefs
15 and the pretrial order, and on a discussion with the Court regarding ownership during trial.
16 Neither provides a basis for excusing Oracle’s failure of proof.

17 Until Oracle put its evidence in at trial, Google did not expect that Oracle would fail to
18 introduce the necessary evidence to prove the extent of its rights under its registrations. Google
19 did not expect there to be a live issue of fact regarding Oracle’s rights, and there was no reason
20 for Google to propose either a jury instruction or verdict question relating to those facts or to brief
21 those issues prior to trial. See RT 2392:10-2394:19 (charge conference). These issues are issues
22 of law, for the Court to decide—and the parties so identified them in the pretrial order. See Joint
23 Proposed Pretrial Order, Dkt. 525 at 10 (issues of law 1 and 2). The pretrial order also identified
24 as potential fact issues to be addressed at trial the underlying facts relating to Oracle’s ownership
25 of any individual components of the works, in the event there was any dispute over what Oracle’s
26 proof established. See Dkt. 525 at 15 (issues 7-9).

27 Oracle, however, neglected entirely to prove or even attempt to prove that it owns, e.g.,
28

1 the individual files that it claims were copied or any of the individual API packages. As a result,
 2 Oracle's copyright rights as a matter of law under 17 U.S.C. § 103(b) extend only to the works as
 3 a whole and not any individual portions of the entire work. The pretrial order expressly identified
 4 and preserved these issues for trial, and Google has not waived its right to pursue them based on
 5 the lack of evidence from Oracle on these issues at trial.

6 Nor does the Court's colloquy during trial with counsel regarding ownership of the
 7 copyright claims preclude Google's arguments. Oracle's brief makes clear that Google's counsel
 8 said only that Google is not disputing ownership of the copyrights—which it is not. RT 713:19-
 9 25; *see also* RT 1884:10-1887:8. Moreover, Google is not raising any ownership issue as to the
 10 specific 37 API packages at issue, which was the concern Oracle's counsel raised at the start of
 11 the discussion with the Court. RT 713:11-15. During the same colloquy, Google's counsel made
 12 clear that Google was not agreeing with Oracle's argument that it had a "separate copyright on an
 13 API package," RT 714:13-22, and the Court observed at the conclusion of the discussion that
 14 "this is more complicated than what you're [Oracle's counsel] proposing. . . . I think there's an
 15 issue." RT 715:3-6.

16 Google's arguments are not barred, and have arisen as a direct result of Oracle's decision
 17 to take scissors to its works in order to manipulate the infringement analysis with respect to the
 18 individual files by seeking to have each of them treated as a mini-"work as a whole." Oracle's
 19 "motion to preclude" should be addressed as part of the parties' pending motions for judgment as
 20 a matter of law, in connection with which these issues have been both clarified and briefed by
 21 both parties.

22 Dated: May 8, 2012

KEKER & VAN NEST LLP

24 By: /s/ Robert A. Van Nest
 ROBERT A. VAN NEST

25 Attorneys for Defendant
 26 GOOGLE INC.