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13 GOOGLE INC.

14 UNITED STATES DISTRICT COURT
15 NORTHERN DISTRICT OF CALIFORNIA
16 SAN FRANCISCO DIVISION

18 ORACLE AMERICA, INC.,
19
20 Plaintiff,
21 v.
22 GOOGLE INC.,
23 Defendant.

Case No. 3:10-cv-03561-WHA

**MOTION FOR PARTIAL SUMMARY
JUDGMENT AND/OR SUMMARY
ADJUDICATION RE: GOOGLE'S NON-
LIABILITY UNDER 35 U.S.C. § 271(f)**

Hearing Date: October 13, 2011
Time of Hearing: 8 a.m.
Judge: Hon. William Alsup

Date Comp. Filed: October 27, 2010
Trial Date: October 31, 2011

1 claim asserted in this action.

2 II. STATEMENT OF UNDISPUTED, MATERIAL FACTS

3 The undisputed facts supporting this motion are contained in the accompanying
4 Declaration of Patrick Brady. Mr. Brady is the Director of Google's Android Partner
5 Engineering Team (the "Partner Team").¹ Mr. Brady declares that the following facts are true:

- 6 • The Partner Team is responsible for Android partnerships with mobile handset and tablet-
7 computer manufacturers, silicon vendors, and mobile network operators.²
- 8 • In 2007, the Partner Team developed a process for sharing Android source code—
9 developed and open-sourced by Google and the Open Handset Alliance—with third
10 parties, including device manufacturers. Under this process, Google uploads and makes
11 available Android source code to foreign device manufacturers over the Internet via
12 source-code servers. **This is the only process that Google has used to make Android
13 source code available to foreign device manufacturers.³ Google has not made
14 Android source code available to foreign device manufacturers on any physical
15 medium.⁴**
- 16 • Also in 2007, the Partner Team developed a process for sharing Android binary code
17 with third parties, including device manufacturers. Under this process, Google uploads
18 Android binary code to servers and makes the binary code available to foreign device
19 manufacturers over the Internet. **This is the only process that Google has used to make
20 Android binary code available to foreign device manufacturers.⁵ Google has not
21 made Android binary code available to foreign device manufacturers on any**

22
23
24 ¹ Declaration of Patrick Brady in Support of Defendant Google Inc.'s Motion for Summary
25 Judgment and/or Summary Adjudication Re: Google's Non-Liability under 35 U.S.C. § 271(f)
26 ("Brady Decl."), ¶ 1. Mr. Brady also is Google's Rule 30(b)(6) designee in this action on
27 selected topics relating to Android, and was deposed in that capacity earlier this year. *Id.*, ¶ 1.

28 ² Brady Decl., ¶ 3.

³ Brady Decl., ¶ 4.

⁴ Brady Decl., ¶ 5.

⁵ Brady Decl., ¶ 6.

1 U.S.C. § 271(f)(1)).¹⁰ “Recognizing that § 271(f) is an exception to the general rule that our
 2 patent law does not apply extraterritorially,” the Supreme Court has “resist[ed] giving the
 3 language in which Congress cast § 271(f) an expansive interpretation.” *Microsoft*, 550 U.S. at
 4 442.

5 Adhering to its narrow reading of the section 271(f) exception, the Supreme Court held in
 6 *Microsoft* that a party does not infringe section 271(f) by supplying from the United States
 7 software that must be copied abroad by a foreign manufacturer before it can be loaded onto that
 8 manufacturer’s hardware. *See Microsoft*, 550 U.S. at 449-54. The Supreme Court reasoned that,
 9 “[b]ecause Microsoft does not export from the United States the copies actually installed, it does
 10 not ‘suppl[y] . . . from the United States’ ‘components’ of the relevant computers, and therefore
 11 is not liable under § 271(f) as currently written.” *Id.* at 442.

12 In *Microsoft*, AT&T alleged that Microsoft’s Windows operating system, when installed
 13 on a computer, enabled that computer to digitally encode and compress human speech in the
 14 manner claimed by AT&T’s patent. *Id.* at 441-42. Microsoft supplied Windows to foreign
 15 manufacturers by sending each of them a “master version . . . , either on a disk or via encrypted
 16 electronic transmission.” *Id.* at 445. The foreign manufacturer then used the master version to

17 ¹⁰ Section 271 (f) states:

18 (1) *Whoever* without authority *supplies* or causes to be supplied in
 19 or *from the United States all or a substantial portion of the*
 20 *components of a patented invention*, where such components are
 21 uncombined in whole or in part, *in such manner as to actively*
 22 *induce the combination of such components outside of the*
 23 *United States in a manner that would infringe* the patent if such
 24 combination occurred within the United States, *shall be liable as*
 25 *an infringer.*

26 (2) *Whoever* without authority *supplies* or causes to be supplied in
 27 or *from the United States any component of a patented invention*
 28 *that is especially made or especially adapted for use in the*
invention and not a staple article or commodity of commerce
 suitable for substantial noninfringing use, where such component
 is uncombined in whole or in part, *knowing that such component*
is so made or adapted and intending that such component will be
combined outside of the United States in a manner that would
infringe the patent if such combination occurred within the United
 States, *shall be liable as an infringer.*

Emphases added.

1 generate copies, and “[t]hose copies, not the master sent by Microsoft, [were] installed on the
2 foreign manufacturer’s computers.” *Id.*

3 The Supreme Court parsed the statute, noting that it “applies to the supply abroad of the
4 ‘components of a patented invention, where *such components* are uncombined in whole or in
5 part, in such manner as to actively induce the combination of *such components*.” *Id.* at 449
6 (emphases in original) (quoting 35 U.S.C. § 271(f)(1)). Congress’s use of the phrase “such
7 components” showed that “the *very components* supplied from the United States, and *not copies*
8 *thereof*, trigger § 271(f) liability when combined abroad to form the patented invention at issue.”
9 *Microsoft*, 550 U.S. at 453 (emphases added).

10 Applying this interpretation to the facts before it, the Supreme Court observed that
11 “Windows software—indeed any software detached from an activating medium—remains
12 uncombinable” “[u]ntil it is expressed as a computer-readable ‘copy,’ e.g., on a CD-ROM.” *Id.*
13 at 449. Prior to that time, “[i]t cannot be inserted into a CD-ROM drive or downloaded from the
14 Internet; it cannot be installed or executed on a computer. Abstract software code is an idea
15 without physical embodiment, and as such, it does not match § 271(f)’s categorization:
16 ‘components’ amenable to ‘combination.’” *Id.* It is the “extra step” of “encod[ing] software’s
17 instructions onto a medium that can be read by a computer” that “renders the software a usable,
18 combinable part of a computer.” *Id.* at 451. “Here,” however, “the copies of Windows actually
19 installed on the foreign computers were not themselves supplied from the United States. Indeed,
20 those copies did not exist until they were generated by third parties outside the United States.”
21 *Id.* at 453. “Without stretching § 271(f) beyond the text Congress composed, a copy made
22 entirely abroad does not fit the description ‘supplie[d] . . . from the United States.’” *Id.* at 454
23 n.15 (quoting 35 U.S.C. § 271(f)(1)).¹¹

24 Finally, the Supreme Court observed that “[a]ny doubt that Microsoft’s conduct falls
25 outside § 271(f)’s compass would be resolved by the presumption against [the]
26 extraterritoriality” of U.S. patent laws. *Microsoft*, 550 U.S. at 454. The Supreme Court’s

27 _____
28 ¹¹ The Court noted that its analysis, “while focusing on § 271(f)(1), is equally applicable to
§ 271(f)(2),” which “like [paragraph] (1), covers only a ‘component’ amenable to

1 holding in *Microsoft* “sent a clear message that the territorial limits of patents should not be
2 lightly breached.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 576 F.3d 1348, 1362 (Fed.
3 Cir. 2009), *cert. denied*, 130 S. Ct. 1088 (2010).

4 Applying the teachings of *Microsoft* to this case yields the straightforward conclusion
5 that Google cannot, as a matter of law, be held liable under § 271(f) for the conduct alleged by
6 Oracle. Android software—like Microsoft Windows and “any [other] software detached from an
7 activating medium”¹²—remains a mere “idea without physical embodiment”¹³ and not a
8 combinable “component” until it is “expressed as a computer-readable ‘copy.’” Google has only
9 one method of supplying Android software to foreign manufacturers of such devices: by making
10 the software available for download from certain servers.¹⁴ And downloading software from a
11 server necessarily copies it—otherwise it would disappear from the server after the first
12 download. Thus, foreign device manufacturers are required to copy Android software before
13 loading it onto the devices they manufacture.¹⁵

14 Accordingly, just as in *Microsoft*, “the copies of [Android] actually installed on” foreign-
15 made devices are “not themselves supplied from the United States. Indeed, those copies did not
16 exist until they were generated by third parties outside the United States.” *Microsoft*, 550 U.S. at
17 453. And “a copy made entirely abroad does not fit the description ‘supplie[d] . . . from the
18 United States.’” *Id.* at 454 n.15 (quoting 35 U.S.C. § 271(f)(1)).

19 Because foreign manufacturers must copy Android software before loading it onto their
20 devices, the copy that is “combined” with the foreign-made device is not supplied from the
21 United States by Google. Accordingly, § 271(f)’s narrow exception to the presumption against
22 extraterritoriality does not apply here, and Google cannot be held liable under that exception.
23 Accordingly, the Court should grant Google’s motion for summary judgment.

24 ‘combination.’” *Microsoft*, 550 U.S. at 454 n.16.

25 ¹² *Microsoft*, 550 U.S. at 449.

26 ¹³ *Id.*

27 ¹⁴ Brady Decl., ¶ 4.

28 ¹⁵ Brady Decl., ¶ 8.

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IV. CONCLUSION

For all the reasons stated above, the Court should grant partial summary judgment or adjudication that Google is not liable to Oracle under 35 U.S.C. § 271(f) with respect to any patent-infringement claim asserted in this action.

Dated: September 8, 2011

Respectfully submitted,

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