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14 Attorneys for Defendant
GOOGLE INC.

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

18
19 ORACLE AMERICA, INC.

20 Plaintiff,

21 v.

22 GOOGLE INC.

23 Defendant.

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

Honorable Judge William Alsup

Hearing Date: October 13, 2011

Hearing Time: 8:00 a.m.

**DEFENDANT GOOGLE INC.'S SECOND
MOTION TO STRIKE PORTIONS OF
THE MITCHELL PATENT REPORT**

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1 PLEASE TAKE NOTICE that on October 13, 2011 at 8:00 a.m., or as soon thereafter as
2 counsel may be heard, Defendant Google Inc. (“Google”) will, and hereby does, respectfully
3 move to strike portions of the Expert Reports of John C. Mitchell Regarding Patent Infringement
4 (the “Mitchell Report,” Ex. A; “Mitchell Reply Report,” Ex. B). This Motion is based on the
5 following memorandum of points and authorities in support, the Declaration of Brian C. Banner
6 (“Banner Decl.”) and accompanying exhibits, the entire record in this matter and on such
7 evidence as may be presented at a hearing on this motion.

8 INTRODUCTION

9 In accordance with the Court’s Order granting leave to file an additional motion to strike
10 (Dkt. No. 464 at 8), Google raises herein additional critiques of the Mitchell Report, and in other
11 instances, critiques of Dr. Mitchell’s *Reply* report. In presenting the critiques below, Google is
12 mindful of the stated rationale in the Court’s Order and only identifies issues that align with that
13 guidance. This motion starts with Critique “D” to avoid overlapping with critiques A-C in the
14 first motion.

15 **CRITIQUE D – To Demonstrate Infringement of the ‘720 patent, the Mitchell Report Adds 16 New Theories Regarding Android’s Use of The Functions *vfork()* and *clone()***

17 Oracle’s infringement contentions (“ICs”) allege that Android infringes asserted claims
18 of the ‘720 patent by way of the *fork()* cloning mechanism in the Linux kernel (a software layer
19 beneath the Dalvik VM). (*See* Ex. C, Oracle’s claim chart on the ‘720 patent at 15-17). In
20 connection with asserted claim 1 of the ‘720 patent, Dr. Mitchell relies on this theory and claims
21 that “[t]he Linux fork executed by Android provides the ‘copy-on-write process cloning
22 mechanism’ in its *fork()* system call.” (Ex. A at ¶ 606.) Dr. Mitchell then adds that “Linux
23 provides **additional** ‘process cloning mechanisms’ in its *vfork()* and *clone()* system calls” and
24 even quotes a book that explains the distinctions between the “*fork()*, *vfork()*, and *clone()* System
25 Calls.” (*Id.* (emphasis added).)

26 Neither of the *vfork()* and *clone()* mechanisms were ever identified in Oracle’s ICs. Like
27 the TreeMap theory in Google’s first motion, these are new theories that Oracle failed to disclose
28 previously. They qualify as a new theory because Oracle is **not** asserting that *vfork()* or *clone()*

1 are part of its *fork()* theory, of a more detailed explanation thereof. Rather, Oracle is asserting
2 that these mechanisms can be used **instead** of the *fork()* theory in its ICs.

3 This distinction is of particular importance in regard to asserted claim 6. Whereas
4 Oracle's ICs for claim 6 identify only the *fork()* mechanism as meeting various claim elements
5 (Ex. C at 34-35), Dr. Mitchell's report does **not** rely on *fork()* and instead relies exclusively on
6 the *clone()* mechanism. (See Ex. A at ¶¶ 622-627.) Dr. Mitchell identifies a feature of *clone()*
7 called the "CLONE_VM flag" (*id.* at ¶ 624) and explains that when the "CLONE_VM flag" is
8 not set, the *clone()* mechanism allegedly infringes claim 6. (See *id.* at ¶¶ 624, 627.)

9 It is firmly established that a plaintiff cannot introduce infringement theories that were
10 not disclosed in its ICs. See *O2 Micro Intern. Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d
11 1355, 1366 n.12 (Fed. Cir. 2006) (citing *Nova Measuring Instruments Ltd. v. Nanometrics, Inc.*,
12 417 F. Supp. 2d 1121, 1123 (N.D. Cal. 2006) ("The [patent local] rules are designed to require
13 parties to crystallize their theories of the case early in the litigation *and to adhere to those*
14 *theories once they have been disclosed.*" (emphasis added))).

15 Accordingly, Google respectfully requests that the Court strike from the Mitchell Report
16 the relevant portion of ¶ 606 and all of ¶¶ 622-627 because they improperly refer to and rely
17 upon the *vfork()* and *clone()* mechanisms that were not identified in Oracle's ICs.

18 **CRITIQUE E – The Mitchell Report Improperly Adds A New “mBS Mobile” Infringement**
19 **Theory for the ‘476 Patent**

20 Oracle's ICs for the '476 Patent generally allege that certain API libraries within
21 Android's operating system provide the security functionality claimed in the '476 Patent. But an
22 introductory section of the Mitchell Report that precedes his detailed infringement analyses
23 appears to offer a very different theory of infringement. In particular, Dr. Mitchell identifies a
24 third party Android application called "mBS Mobile" and notes that "mBS Mobile is shipped
25 with the Java Security Manager turned on and a default security policy..." (Ex. A at ¶¶ 70, 77.)¹

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27 ¹ Paragraph 70 of Dr. Mitchell's Report appears to relate to the '447 patent, which is no longer asserted in this case.
28 However, paragraph 70 is an exact copy of paragraph 77, which appears to relate to the presently-asserted '476
patent. Because neither paragraph mentions either patent by name, Google moves to strike both paragraphs so that it
is clear that the mBS Mobile product may not be offered as evidence of infringement of the '476 patent.

1 Dr. Mitchell appears to be arguing that, instead of the security functionality being entirely
 2 provided by *Android's* source code, a foreign, third party application could theoretically be
 3 installed on an Android device and provide its own security functionality that interacts with
 4 Android code to practice the '476 Patent.² While Google cannot guess at what Oracle attempts
 5 to achieve here, it knows that there was no mention of mBS Mobile anywhere in Oracle's ICs.
 6 Thus, Dr. Mitchell should be precluded from offering any infringement theories in connection
 7 with the mBS Mobile product. For example, if Oracle contends mBS Mobile is relevant for
 8 indirect infringement, it should have been disclosed pursuant to Patent L.R. 3-1(d). *See*
 9 *generally Bender v. Advanced Micro Devices, Inc.*, No. 09-cv-01152, 2010 U.S. Dist. LEXIS
 10 89957 at *9 (N.D. Cal. July 29, 2010) ("plaintiff must identify each accused product and link it
 11 to a representative product [claim chart] in order to provide [the defendant] with fair notice of the
 12 specific products which are accused in this lawsuit.")

13 Accordingly, Google respectfully requests that paragraph 70 and 77 be stricken from the
 14 Mitchell Report, or alternatively, Dr. Mitchell be precluded from offering any infringement
 15 theories based on mBS Mobile.

16 **CRITIQUE F – The Mitchell Reply Report Adds a New Infringement Theory Regarding**
 17 **the '476 Patent**

18 Oracle's ICs allege that asserted claims of the '476 Patent are met, in part, by execution
 19 of the SecurityManager class (which has been disabled in Android). (*See* Ex. D, Oracle's claim
 20 chart on the '476 patent at 5, 20-21 (use of SecurityManager) and 74-76 (asserted claims 13-15).)
 21 Dr. Mitchell similarly identifies execution of the SecurityManager class as meeting Claim 10,
 22 "element B" of the '476 patent. (*See* Ex. A at ¶¶ 734-36; 763.)

23 A new theory appearing for the first time in Dr. Mitchell's *Reply* Report posits that, for
 24 the '476 patent, "[e]ven if the SecurityManager is *disabled*, the Java security framework may still
 25 be used . . ." (*See* Ex. B at ¶ 115 (emphasis added).) Although Dr. Mitchell is vague on the
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27
 28 ² It doesn't help that many of the web links cited in these paragraphs by Dr. Mitchell no longer work.

1 details, he is essentially offering a new infringement theory that departs from Oracle's earlier
2 allegations in that it does not require execution of the SecurityManager class.

3 Just because Oracle's existing infringement theories have not been borne out does not
4 give it a license to posit new theories, after discovery, in a reply report. The entirety of
5 paragraph 115 of the Reply report should be stricken because it represents a new infringement
6 theory that was never previously disclosed by Oracle. *See Nova*, 417 F. Supp. 2d at 1123 ("The
7 [patent local] rules are designed to require parties to crystallize their theories of the case early in
8 the litigation *and to adhere to those theories once they have been disclosed.*" (emphasis added)).
9 Furthermore, paragraph 115 of the Reply report should be stricken because the Court specifically
10 instructed the parties that "[r]epley reports must be limited to true rebuttal and should be very
11 brief. They should not add new material that should have been placed in the opening report..."
12 Case Management Order, Dkt. No. 56 at ¶ 8.

13 **CRITIQUE G – The Mitchell Reply Report Adds New Infringement Theories Regarding** 14 **the '520 Patent**

15 According to the infringement theory presented in Oracle's ICs, Android's dx tool
16 allegedly infringes the asserted claims of the '520 patent where it successfully creates a single
17 new instruction, referred to as a fill-array-data instruction, that replaces a less efficient series of
18 Java bytecode instructions for initializing individual elements of a static array. Specifically,
19 Oracle's ICs allege that the asserted claims are met when the dx tool calls the `parseNewarray()`
20 method to identify the static initialization of an array, and creates a single fill-array-data
21 instruction for initializing the static array. (*See* Ex. E, Oracle's claim chart on the '520 patent at
22 15-20 (pointing to the `parseNewarray()` method as satisfying "simulating execution" step), 20
23 (identifying slides 41-45 of the Dalvik Presentation as satisfying the "storing . . . an instruction"
24 step) and at 29-30 (showing the fill-array-data instruction in the dx tool output).) In his opening
25 Report, Dr. Mitchell relies upon this same theory of infringement for the '520 patent claims.
26 (*See, e.g.*, Ex. A at ¶¶ 524, 526, 541.)

27 In his Reply Report, Dr. Mitchell presents two new theories of infringement that were not
28 disclosed in Oracle's ICs. The first new theory posits that the dx tool can infringe the '520

1 patent claims by “creat[ing] (and stor[ing]) one *or more* instructions requesting the static
 2 initialization of the array.” (Ex. B at ¶ 92 (emphasis added).) This new theory departs from
 3 Oracle’s ICs, where Oracle’s infringement theory is limited to instances where the dx tool
 4 allegedly creates *a single* fill-array-data instruction for initializing a static array. (*See, e.g.*, Ex.
 5 A at ¶¶ 524, 526, 541.) In contrast, Dr. Mitchell’s new allegations of infringement now include
 6 instances where more than one instruction is created.

7 The second new theory presented for the first time in Dr. Mitchell’s Reply Report posits
 8 that an unsuccessful simulated execution can somehow infringe the ‘520 patent, meaning that the
 9 claimed step of “simulating execution” doesn’t need to identify a series of instructions for
 10 initializing individual elements of the array. Now, just translating the less efficient series of Java
 11 bytecode instructions for initializing individual elements of the array into a functionally identical
 12 series of Dalvik instructions is allegedly sufficient to infringe the ‘520 patent. Dr. Mitchell
 13 explains: “The claims do not require the simulating step to succeed in identification of the static
 14 initialization of the array in all cases,” and that code without the fill-array-data instruction “is
 15 evidence of infringement, because . . . [the resulting] instructions [are] fewer than the original
 16 number of bytecodes from the .class file.” (Ex. B at ¶ 92.)

17 This theory bears no resemblance to Oracle’s original theory, which required the creation
 18 of the new fill-array-data instruction. In its place, Dr. Mitchell’s new theory suggests that any
 19 translation of a Java bytecode array initialization sequence would infringe as long as the resulting
 20 code has fewer instructions than were present in the original Java .class file.

21 Dr. Mitchell’s attempt at introducing two new theories of infringement is improper.
 22 Accordingly, the “one or more instructions” phrase and the last three sentences of paragraph 92
 23 of the Reply report should be stricken. *See Nova*, 417 F. Supp. 2d at 1123 (“The [patent local]
 24 rules are designed to require parties to crystallize their theories of the case early in the litigation
 25 *and to adhere to those theories once they have been disclosed.*” (emphasis added)).

26 CONCLUSION

27 For the forgoing reasons, Google respectfully requests the Court grant the relief it deems
 28 appropriate, such as an order providing that:

- 1 (a) Oracle and its experts cannot refer to or rely upon new theories concerning the *vfork()*
2 and *clone()* mechanisms with respect to the '720 patent (*i.e.*, a portion of ¶ 606 and ¶¶
3 622-627);
- 4 (b) Oracle and its experts cannot refer to or rely upon any infringement theories based on
5 mBS Mobile with respect to the '476 Patent (*i.e.*, ¶¶ 70, 77);
- 6 (c) Oracle and its experts cannot refer to or rely upon any infringement theories for the
7 '476 Patent that do not require the SecurityManager (*i.e.*, Reply ¶ 115);
- 8 (d) Oracle and its experts cannot refer to or rely upon any infringement theories for the
9 '520 patent where static array initialization is performed by more than one instruction
10 (*i.e.*, Reply ¶ 92); and
- 11 (e) Oracle and its experts cannot refer to or rely upon any infringement theories for the
12 '520 patent that do not require the fill-array-data instruction (*i.e.*, Reply ¶ 92).

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1 DATED: September 29, 2011

KING & SPALDING, LLP

2 By: /s/ Scott T. Weingaertner /s/
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1 I hereby attest that Scott T. Weingaertner concurs in the e-filing of this
2 document.

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4 Dated: September 29, 2011

/s/ Cheryl A. Sabnis /s/
Cheryl A. Sabnis

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