

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

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

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

16 *Attorneys for Plaintiff*
ORACLE AMERICA, INC.

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

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

Case No. CV 10-03561 WHA

**ORACLE AMERICA, INC.’S
MOTION IN LIMINE NO. 2 TO
EXCLUDE EVIDENCE OR
ARGUMENT THAT GOOGLE
RELIED ON LEGAL ADVICE IN
MAKING ITS DECISIONS TO
DEVELOP AND RELEASE
ANDROID**

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

1 Oracle moves the Court to preclude Google from introducing any evidence or argument
2 that Google relied on advice of counsel in connection with its decisions to develop and release
3 Android. Google did not make the required disclosures under Patent L.R. 3-7 of documents
4 reflecting any legal advice upon which it intends to rely. That alone should preclude Google from
5 relying on advice of counsel to rebut allegations of willful patent infringement or intent to induce
6 infringement. Moreover, during discovery, Google routinely asserted privilege to prevent Oracle
7 from obtaining discovery on any legal advice Google may have received, with respect to both
8 patent and copyright issues. Accordingly, Google should also be precluded from invoking legal
9 advice as a defense to willful copyright infringement. For these reasons, the Court should
10 exclude any evidence or argument that Google relied on legal advice in deciding to develop and
11 release Android.

12 **I. GOOGLE’S ASSERTION OF PRIVILEGE OVER LEGAL ADVICE**

13 Google has invoked the attorney-client privilege to block all of Oracle’s discovery into
14 any legal advice Google received in connection with Android. First, Google did not produce any
15 documents relating to advice of counsel under Patent Local Rule 3-7. That rule requires “each
16 party relying upon advice of counsel as part of a patent-related claim or defense” to produce a
17 copy of “any written advice” and provide “a written summary of any oral advice” on which the
18 party intends to rely and for which it has waived the attorney-client privilege and work product
19 protection. Patent L.R. 3-7. Failure to comply with the rule means that the party may not rely on
20 advice of counsel as a defense.

21 Second, Google asserted privilege and withheld from production numerous documents
22 purportedly reflecting legal advice related to Android. Google’s privilege log contains many
23 entries identifying privileged legal opinions that have been withheld from Oracle. (Declaration of
24 Daniel P. Muino in Support of Oracle America, Inc.’s Motions *In Limine* Nos. 1 Through 5
25 (“Muino Decl.”), ¶ 5.) Indeed, Google systematically asserted privilege over any
26 communications regarding advice of Google’s counsel.

27 Third, Google instructed its witnesses not to answer questions regarding legal advice
28 pertaining to Android, based on the attorney-client privilege. For example, counsel instructed

1 Andy Rubin, Google's Senior Vice President of Mobile and co-founder of Android, not to answer
2 questions regarding legal advice pertaining to executive decisions on Android's release [REDACTED]

3 [REDACTED]
4 [REDACTED]
5 [REDACTED]
6 [REDACTED]
7 [REDACTED]
8 [REDACTED]
9 [REDACTED]

10 [REDACTED] Google's assertion of privilege prevented Oracle
11 from discovering the nature of any legal advice about this topic:

12
13 Q. BY MR. JACOBS: Have you interacted with the legal team over issues
14 associated with the release of Android that prevented it from giving you the legal
bit?

15 MS. ANDERSON: Objection. Instruct the witness not to answer on grounds of
16 privilege as phrased.

17 Q. BY MR. JACOBS: Has the legal team ever conveyed to you we have concerns
about a -- an Android release and we can't give you the legal bit?

18 MS. ANDERSON: Objection. Instruct the witness not to answer on the grounds
19 of attorney-client privilege as phrased.

20 MR. JACOBS: And for all those instructions, you're following your counsel's
instructions not to answer the question?

21 THE WITNESS: Yes, I am.

22
23 (Muino Decl. Exhibit E at 25:13-26:2 (July 27, 2011 Deposition Transcript of
Andrew Rubin).)

24 Google also asserted privilege over legal advice that Mr. Rubin received after this lawsuit was
25 filed:

26 Q. BY MR. JACOBS: So let me ask you this question with the intent of dividing
27 up possible privileged communications from non-privileged activities you may
28 have conducted. Have you actually reviewed what I'll refer to as the infringement

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contentions in this lawsuit? It's a very thick document in which Oracle sets forth the claims of the patents-in-suit and the accused functionality.

MS. ANDERSON: Objection. Instruct the witness not to answer on the grounds of attorney-client privilege to the extent responding would inherently disclose communications you had with counsel.

THE WITNESS: I'll take the instruction of my counsel.

Q. BY MR. JACOBS: Do you have a view, based on a review of the patents in the litigation, whether Android is bringing any of those patents?

MS. ANDERSON: Objection. Form. And also object to the extent the question is seeking to disclose communications with counsel, on that basis, I would instruct you not to answer on grounds of privilege, otherwise you may answer.

THE WITNESS: I will not answer based on the advice of my counsel.

Q. BY MR. JACOBS: Have you asked anybody on your team to assist counsel in reviewing the allegations?

MS. ANDERSON: Objection. Instruct the witness not to answer on grounds of attorney-client privilege.

THE WITNESS: I'll take that advice.

Q. BY MR. JACOBS: Has anybody on your team assisted counsel in reviewing Oracle's patent infringement allegations?

MS. ANDERSON: Objection, and instruct the witness not to answer on the grounds of attorney-client privilege.

THE WITNESS: Again, I'll take that advice.

(*Id.* at 36:14-37:25.)

...

Q. BY MR. JACOBS: Did you get -- did you involve Google's counsel in review of the terms of click-through licenses at any point in the development of Android?

MS. ANDERSON: Objection. Instruct the witness not to answer on grounds of attorney-client privilege.

THE WITNESS: I'll take that advice, thank you.

(*Id.* at 109:12-20.)

1 Google also used privilege as a shield to prevent Oracle from discovering any legal advice
2 received by Google regarding the copyrightability of APIs:

3 Q. And in particular, I just have to ask this again: Did you consult with counsel
4 over your tenure at Google around the question of whether API's were
5 copyrightable as it related to Android?

6 MS. ANDERSON: Objection. Instruct the witness not to answer on the grounds
7 of attorney-client privilege.

8 THE WITNESS: I'll accept the advice of my attorney.
9 (*Id.* at 155:22-156:5.)

10 Google asserted privilege and instructed Daniel Bornstein, Google engineer and one of the
11 lead developers for Android, not to answer questions regarding whether or not he received advice
12 of counsel about what materials he could look at to develop Android. (Muino Decl. Exhibit F at
13 161:22-162:21 (May 16, 2011 Deposition Transcript of Daniel Bornstein).) Google's instruction
14 prevented discovery on this subject:

15 Q. At the time, referring to, say, in early 2007, what was the source of your
16 understanding that it was that you could use documentation to gain understanding
17 of the idea of an API?

18 A. I don't know specifically.

19 Q. At the time, did you have -- receive any advice of counsel about what
20 materials you could or could not look at to develop Android?

21 A. So I have had discussions with lawyers on and off throughout my career. I
22 don't know how much I can say about the content of those.

23 MR. BABER: Instruct the witness to not say anything about the content of
24 discussions.

25 THE WITNESS: Okay.

26 BY DR. PETERS:

27 Q. Did you see the -- were you ever advised by counsel that it was permissible to
28 use a Javadoc to develop Android?

MR. BABER: Object and instruct the witness not to answer the question on the
grounds of privilege.

BY DR. PETERS:

Q. Will you follow your counsel's instructions?

A. I will follow my counsel's instructions.

(*Id.*)

Further, Google asserted privilege in the deposition of Bob Lee, former Google engineer
in charge of developing Android's class libraries, and instructed him not to answer questions
regarding whether Google analyzed the implications of Sun's license dispute with Apache on the

1 release of Android. (Muino Decl. Exhibit G at 73:4-12 (August 3, 2011 Deposition Transcript of
2 Bob Lee).) Google's instruction prevented discovery on this subject:

3 Q. BY MR. PETERS: Did Google analyze whether or not the dispute between
4 Sun and Apache was any bar to its release of Android?

MR. PURCELL: Object to the form.

5 And to the extent you're aware of any analysis done by Google's lawyers or at the
6 instruction of Google's lawyers, I instruct you not to answer.

THE WITNESS: Okay. I'm not sure. I don't know.

(*Id.*)

7 Fourth, Google asserted privilege in many of its responses to Oracle's interrogatories. For
8 example, Google asserted privilege in its response to Interrogatory No. 2. (Muino Decl. Exhibit
9 H at 7-8 (Google's Response to Oracle's 1st Set of Interrogatories dated January 6, 2011).)
10 Oracle's Interrogatory No. 2 asks Google to "[i]dentify who at Google was and is responsible for
11 Android's compliance with the intellectual property rights of third parties and briefly describe
12 their roles in that regard." (*Id.*) Google asserted "attorney-client privilege, the work product
13 doctrine, and/or any other applicable privilege, immunity, or protection." (*Id.*) Further, it appears
14 that Google failed to identify anyone from the legal team, nor did Google describe "their roles" in
15 ensuring Android's compliance. Google's assertion of privilege over any legal advice it received
16 pertaining to Android has been consistent and complete.
17
18

19 **II. GOOGLE SHOULD BE PRECLUDED FROM INVOKING ADVICE OF**
20 **COUNSEL AS A DEFENSE**

21 Having failed to disclose the basis of any advice of counsel defense and having blocked
22 all discovery on this subject, Google should be precluded from arguing that it relied on legal
23 advice in connection with its decisions to develop and release Android.

24 First, Patent L.R. 3-7 is perfectly clear that advice of counsel defenses are precluded if a
25 party fails to waive privilege and produce documents underlying the defense:

26 [E]ach party relying upon advice of counsel as part of a patent-related claim or
27 defense for any reason shall:
28

1 (a) Produce or make available for inspection and copying any written advice and
2 documents related thereto for which the attorney-client and work product
3 protection have been waived;

4 (b) Provide a written summary of any oral advice and produce or make available
5 for inspection and copying that summary and documents related thereto for which
6 the attorney-client and work product protection have been waived;

7 A party who does not comply with the requirements of this Patent L.R. 3-7 shall
8 not be permitted to rely on advice of counsel for any purpose absent a stipulation
9 of all parties or by order of the Court.

10 Patent L.R. 3-7. The rule is absolute – unless underlying documents and oral advice are
11 disclosed, invoking advice of counsel to rebut any patent-related claim (including willfulness and
12 intent to induce infringement) is precluded, absent a stipulation or leave of Court. *Protective*
13 *Optics, Inc. v. Panoptx, Inc.*, 488 F. Supp. 2d 922, 923 (N.D. Cal. 2007) (“a defendant who
14 wishes to escape charges of willful infringement may rely on the advice of his attorney, but he
15 must alert the other side of his intention to do so, and he must turn over (or identify in a privilege
16 log) all documents that relate to the attorney’s opinion. Failure to do so precludes use of the
17 attorney’s opinion as a defense.”) Google has not made the required disclosures under L.R. 3-7;
18 accordingly, it is precluded from offering an advice of counsel defense as a rebuttal to Oracle’s
19 allegations of willful patent infringement and intent to induce infringement.

20 Second, Ninth Circuit law is clear that legal advice as a defense to willful copyright
21 infringement must also be excluded if the party has invoked the attorney-client privilege to block
22 discovery on that advice. *See Columbia Pictures Indus., Inc. v. Krypton Broad. of Birmingham,*
23 *Inc.*, 259 F.3d 1186, 1196 (9th Cir. 2001) (affirming exclusion of legal advice as a defense to
24 willful copyright infringement, because defendant invoked privilege to block discovery on that
25 advice); *accord Chevron Corp. v. Pennzoil Co.*, 974 F.2d 1156, 1162 (9th Cir. 1992) (privilege
26 cannot be waived selectively and thus used as a sword and shield); *SNK Corp. of Am. v. Atlas*
27 *Dream Ent’t Co.*, 188 F.R.D. 566, 571 (N.D. Cal. 1999) (“[f]airness dictates that a party may not
28 use the attorney-client privilege as both a sword and a shield”).

29 In *Columbia Pictures*, the Ninth Circuit affirmed a trial court’s decision to exclude
30 evidence of defendant’s reliance on advice of counsel, because the defendant asserted privilege

1 over the same evidence during discovery. *Columbia*, 259 F.3d at 1196. Defendant in that case
2 sought to present evidence regarding advice of counsel to rebut an allegation of willful copyright
3 infringement. *Id.* However, defendant “refused to answer questions regarding his interactions
4 with counsel at his deposition.” *Id.* The district court granted plaintiff’s motion in limine to
5 exclude evidence relating to defendant’s advice of counsel. *Id.* Defendant offered “to make
6 himself available for deposition” on the subject of advice of counsel, but the district court rejected
7 this offer, stating that “[t]he Defendant cannot now, at the eleventh hour, make himself available
8 for a deposition.” *Id.* (quoting district court). The Ninth Circuit agreed that “refusing to answer
9 questions regarding relevant communications with counsel until the ‘eleventh hour’” was
10 sufficient ground for precluding testimony regarding the advice of counsel. *Id.*

11 Here, Google has used privilege as a shield. Google has systematically asserted attorney-
12 client privilege on all subjects relating to advice of counsel, whether pertaining to patents or
13 copyrights. Google routinely asserted privilege at depositions of its witnesses on subjects
14 regarding advice of counsel, including conversations surrounding the legal team’s analysis and
15 checking of a “legal bit” to approve an Android release, as well as post-complaint analysis of
16 Oracle’s claims of infringement.

17 For these reasons, any evidence or argument that Google relied on legal advice in
18 connection with its Android decisions should be excluded from trial. Google should be precluded
19 from presenting evidence or argument on both the substance of Google’s advice of counsel, as
20 well as the fact that Google obtained and relied on that advice.

21 III. CONCLUSION

22 Google used the attorney-client privilege to shield from discovery any evidence regarding
23 legal advice it received in connection with its Android decisions. Under Patent L.R. 3-7 and
24 Ninth Circuit law, Google is precluded from asserting any advice of counsel defense. Oracle
25 requests that the Court exclude any evidence or argument that Google relied upon legal advice in
26 making its decisions to develop and release Android.

1 Dated: September 24, 2011

MICHAEL A. JACOBS
MARC DAVID PETERS
DANIEL P. MUINO
MORRISON & FOERSTER LLP

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4 By: /s/ Daniel P. Muino

Attorneys for Plaintiff
ORACLE AMERICA, INC.

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