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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 COMMENTS
 REGARDING THE COURT'S
 DRAFT SPECIAL VERDICT FORM**

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

1 At the Court's request, Oracle America, Inc. ("Oracle") provides the following comments
2 on the Court's draft special verdict form distributed on April 25, 2012. As portions of this verdict
3 form depend on the Court's jury instructions (including the definitions of "implementation,"
4 "documentation," and "work as a whole"), Oracle wishes to reserve further comments until after
5 the jury instructions have been circulated.

6 **I. API "PACKAGES"**

7 For clarity and accuracy, Oracle suggests adding the term "packages" after "APIs" in
8 questions 1 ("37 API *packages*"), 1.A (same), 2 (same), 2.A ("API *package* implementation"),
9 and 2.C ("individual API *package*"). As established through witness testimony, the "37 Java
10 APIs" asserted in this case are most accurately described as "packages," each of which contain
11 numerous sub-elements. Dr. Reinhold, Chief Java Architect at Oracle, explained: "Packages are
12 the highest level concept. Packages can contain classes and interfaces." (RT at 593:8-10.) As an
13 example, Dr. Reinhold described the "java.nio.channels package" (one of the 37 in this case) and
14 its constituent parts, including classes, interfaces, methods, and fields, organized in a hierarchical
15 structure. (RT at 593:14-597:8.) The term "API package" properly conveys the multi-element
16 nature of the 37 copied works.

17 Because some witnesses have used "API" to refer to a single method within a package
18 (RT at 1770:16-24 (Bornstein) (describing "max API")), the jury may misunderstand the term "37
19 APIs" to mean only 37 methods (or other sub-elements), rather than 37 "packages" of elements.
20 For these reasons, Oracle proposes that the "37 APIs" be referred to as "API packages."

21 **II. QUESTIONS ON VICARIOUS AND CONTRIBUTORY INFRINGEMENT**

22 In addition to Oracle's claim against Google for direct copyright infringement, Oracle also
23 asserts claims for vicarious and contributory infringement by virtue of Google's distribution of
24 infringing Android software to third parties. Oracle has presented evidence establishing that third
25 parties have installed the infringing Android software (including the 37 Java API packages) on
26 their devices. This evidence includes, *inter alia*, (1) the testimony of Rafael Camargo, Senior
27 Director at device-maker Motorola Mobility, who testified that Android software is installed on
28 Motorola's Droid and other devices (RT at 1047:21-24; TX 1064); and (2) the testimony of

1 Daniel Morrill, Google's Technical Program Manager for Android Compatibility, who testified
 2 that OEMs including Motorola, Samsung, HTC, and LG all make certified Android-compatible
 3 devices, which by definition include implementations of the 37 Java API packages. (RT at
 4 1016:6-1017:16.)

5 The Court's draft verdict form does not include questions covering Oracle's indirect
 6 infringement claims. Oracle proposes adding the following questions to the verdict form:

7 *4. If you found in Questions 1, 2, or 3 that Google copied Oracle's works and that the*
 8 *copying was not excused as "fair use" or de minimis, then answer the following*
 9 *questions:*

10 *(a) Has Oracle proven that third-party mobile device manufacturers or end-users*
 11 *infringed Oracle's copyrights by copying or using Android software?*

12 *(b) (If you answered "yes" to 4(a)) Has Oracle proven that Google intentionally*
 13 *induced or materially contributed to the third-party infringement you found in*
 14 *Question No. 4(a)?*

15 *(c) (If you answered "yes" to 4(a)) Has Oracle proven that Google vicariously*
 16 *infringed Oracle's copyrights as a result of the third-party infringement you found*
 17 *in Question No. 4(a)?*

18 **III. THE JURY SHOULD BE INSTRUCTED ON DERIVATIVE WORKS**

19 The Court's draft verdict form omits the question from the Court's earlier version
 20 regarding derivative works. If the issue of liability for derivative works is not presented in the
 21 verdict form, the jury should at least be instructed regarding derivative works. Google is arguing
 22 that it "transformed" the work under the doctrine of fair use. Jurors may incorrectly assume that
 23 Google's derivative works are fair use transformations if not instructed that infringement includes
 24 derivative works.

25 The Copyright Act separately protects the copyright owner's exclusive rights to "prepare
 26 derivative works based upon the copyrighted work." 17 U.S.C. § 106(2). A "derivative work" is:

27 a work based upon one or more preexisting works, such as a
 28 translation, musical arrangement, dramatization fictionalization,
 motion picture version, sound recording, art reproduction,

1 abridgement, condensation, or any other form in which a work may
2 be *recast, transformed, or adapted*. A work consisting of editorial
3 revisions, annotations, elaborations, or other modifications which,
4 as a whole, represent an original work of authorship, is a
5 “derivative work.”

6 17 U.S.C. § 101 (emphasis added). Thus, creation of a work that “recast[s], transform[s], or
7 adapt[s]” a copyrighted work is the basis for a finding of infringement even in the absence of
8 actual copying. *See, e.g., Apple, Inc. v. Psystar Corp.*, 673 F. Supp. 2d 931, 938-39 (N.D. Cal.
9 2009) (finding that modifications to software to enable Mac OS X to run on a non-Apple
10 computer constituted infringing, derivative work: “[d]eletions, modifications, and additions to
11 software result in an infringing derivative work”); *Dun & Bradstreet Software Servs., Inc. v.*
12 *Grace Consulting, Inc.*, 307 F.3d 197, 208 (3rd Cir. 2002) (concluding that defendant’s
13 modification of a copy of plaintiff’s software, including fixing bugs and adding features, created
14 an infringing derivative work); *Midway Mfg. Co. v. Artic Int’l, Inc.*, 704 F.2d 1009, 1013-14 (7th
15 Cir. 1983) (finding defendant’s addition of circuit boards creating a speeded-up video game was a
16 derivative work); *SAS Inst., Inc. v. S & H Computer Sys., Inc.*, 605 F. Supp. 816, 831 (M.D. Tenn.
17 1985) (finding defendant’s duplication and conversion of software that would run on an IBM
18 computer to run on a VAX computer constituted a derivative work).

19 Here, ample evidence shows that Google created infringing, derivative works using
20 Oracle’s copyrighted Java API specifications and implementations:

21 1. Former Google engineer Bob Lee testified that Google looked at the Java API
22 specifications and transformed them into Android source code. (RT at 982:22-983:12.) Mr. Lee,
23 who was the core library lead for the Android team, admitted that he consulted the Java API
24 specifications available on Sun’s website to make sure that the Android code for the
25 corresponding core libraries would be consistent with those specifications. (*Id.*)

26 2. The jury heard testimony from Professor Mitchell that Google used a decompiler to
27 create Android source code derived from the Java bytecode, a process that would not have been
28 possible in a clean room implementation. (RT at 1257:14-1258:6 (“one of [the Java] class files
29 that are widely distributed was used to produce source code that’s in the Google library”);
30 1259:16-1260:7 (comparison of source code files shows “strong evidence that the Google code

1 was actually produced from the Oracle class file by a particular decompiler called JAD for Java
2 Decompiler”); 1260:8-1261:3 (analysis shows that “developers had access and used the Oracle
3 installation and copied from it . . . using a decompiler to produce source code”); 1261:14-1262:1.)
4 Google’s recasting of the bytecode into a different form created a derivative work.

5 This evidence could support a jury finding that Google created derivative works, in
6 addition to copying the API packages. In the absence of a derivative work instruction, the jury
7 may incorrectly assume that Google’s derivative works constitute “transformative use” under the
8 fair use doctrine. Google is arguing that Android is a “transformative use,” under the first of the
9 fair use statutory factors identified in recent case law. The word “transform” also appears in the
10 Ninth Circuit Model Jury Instruction on derivative use, as part of the definition for derivative
11 work. Ninth Circuit Manual of Model Jury Instruction No. 17.13 (2007). Acknowledging the
12 risk of juror confusion between transformative use under the fair use doctrine and the derivative
13 work doctrine, the Comment to Instruction No. 17.13 explains that “A derivative work is saved
14 from being an infringing work ‘only because the borrowed or copied material [in the derivative
15 work] was taken with the consent of the copyright owner of the prior work, or because the prior
16 work has entered the public domain.” *Id.* at Comment (citing *Micro Star v. Formgen*, 154 F.3d
17 1107, 1112 (9th Cir. 1998)).

18 Given this risk of juror confusion, the Court should instruct the jury on derivative works,
19 even if the issue is not included on the special verdict form. Both parties submitted jury
20 instructions on derivative works; in fact, of all the copyright instructions proposed, this
21 instruction was the closest to reaching full stipulation. (ECF No. 539, Joint Proposed Jury
22 Instructions at 45-47 (Instruction No. 14).)

23 **IV. THE JURY SHOULD BE INSTRUCTED THAT SELECTION AND**
24 **ARRANGEMENT OF NAMES WITHIN THE 37 JAVA API PACKAGES IS**
25 **PROTECTABLE**

26 During its opening statement and in proceedings before the Court, Google has repeatedly
27 referenced the Court’s earlier ruling that the individual names of Java API package elements
28 (“packages, classes, and methods”) are not protectable by copyright. (*See* ECF No. 433, 9/15/11
Order on Summ. J. at 7-8.) Omitted from these discussions is the fact that the Court specifically

1 left open “the possibility that the selection or arrangement of those names is subject to copyright
2 protection.” (*Id.* at 8.) The Court observed that “[c]opyright protection for the selection and
3 arrangement of elements within a work is a separate question from whether the elements
4 themselves are protected by copyright.” (*Id.*) See *Lamps Plus, Inc. v. Seattle Lighting Fixture*
5 *Co.*, 345 F.3d 1140, 1147 (9th Cir. 2003) (“a combination of unprotectable elements is eligible
6 for copyright protection only if those elements are numerous enough and their selection and
7 arrangement original enough that their combination constitutes an original work of authorship”).

8 The Court’s draft verdict form does not specify whether the selection and arrangement of
9 names can be considered by the jury in evaluating the “structure, sequence, and organization” of
10 the 37 Java API packages. Oracle does not propose modifications to the verdict form on this
11 issue. Oracle requests, however, that the Court instruct the jury that the selection and
12 arrangement of names within the Java API packages may be eligible for copyright protection (*see*
13 ECF No. 539, Oracle’s Proposed Jury Instruction No. 7).

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Dated: April 25, 2012

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By: /s/ Michael A. Jacobs

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ORACLE AMERICA, INC.