

Exhibit L

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

22 ORACLE USA, INC., et al.,

23 Plaintiffs,

24 v.

25 SAP AG, et al.,

26 Defendants.

Case No. 07-CV-1658 PJH (EDL)

**DEFENDANTS' REPLY IN SUPPORT
OF THEIR MOTION TO COMPEL
DISCOVERY RELEVANT TO
PLAINTIFFS' COPYRIGHT CLAIMS**

Date: May 19, 2009

Time: 2:00 pm

Courtroom: E, 15th Floor

Judge: Hon. Elizabeth D. Laporte

1 Nimmer, §7.16[B][2][c]. The first condition is that the owner of the derivative work must own
2 the preexisting work as well. *Id.*; see also *Xoom, Inc. v. Imageline, Inc.*, 323 F.3d 279, 284 (4th
3 Cir. 2003) (“because Imageline owned copyright in SuperBundle and Master Gallery and in the
4 underlying works of each, its registration of SuperBundle and Master Gallery was sufficient to
5 permit an infringement action on the underlying parts, whether they be new or preexisting.”);
6 *Streetwise Maps, Inc. v. VanDam, Inc.*, 159 F.3d 739, 747 (2d Cir. 1998) (“because Streetwise is
7 the owner of the copyright of both the derivative and pre-existing work, the registration certificate
8 relating to the derivative work ... will suffice to permit it to maintain an action for
9 infringement...of the pre-existing work.”).²

10 The second condition is that the derivative work must include *all the features* of the
11 underlying work on which the infringement claim is based. Nimmer, § 7.16[B][2][c], n.105.7
12 (“The assumption is that the derivative work that is registered embodies all the features of the
13 underlying work on which suit is premised.”); see also *Streetwise Maps*, 159 F.3d at 746-47
14 (derivative and underlying street maps identical except for the addition of new subway and bus
15 notations in the derivative map); *Apple Computer*, 35 F.3d at 1440 (noting that the derivative
16 work was “not incrementally different” from the underlying work in any respect material to the
17 infringement claim).³

18 If there is a “disconnect,” as Nimmer puts it, between the underlying work and the
19 material incorporated into the derivative work, then the answer to whether suit can proceed is
20 “no.” Nimmer, § 7.16[B][2][c], n.105.7. Nimmer likens this situation to one in which it is the
21 underlying work, not the derivative work, that is registered. *Id.* In that circumstance, a claim for

22 ² See also *Apple Computer, Inc. v. Microsoft Corp.*, 35 F.3d 1435, 1447 (9th Cir. 1994)
23 (permitting Apple to sue for copying of material that appears in both the derivative and
24 underlying work “[b]ecause Apple owns the copyrights in both ...”); *Richmond Homes Mgmt,*
25 *Inc. v. Raintree, Inc.*, 862 F.Supp. 1517, 1526 (W.D. Va. 1994) (permitting suit based on the
26 derivative work registration based on evidence that plaintiff owned the preexisting work as well);
27 *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 775 F.Supp. 544, 555-57 (E.D.N.Y. 1991) (as owner of
28 both the underlying and new material, plaintiff’s registration of the derivative work was sufficient
to permit it to maintain an action for infringement of the underlying material).

³ See also *Xoom*, 323 F.3d at 281 (finding that all of the underlying clip art was contained
in the derivative works at issue); *Richmond Homes*, 862 F.Supp. at 1521 (“The floor plans of the
[preexisting work and derivative work] are essentially the same ...”); *Computer Assocs.*, 775
F.Supp. at 555-56 (noting that the unregistered underlying work (ADAPTER) was contained
within the registered derivative work).

1 infringement of the new material in the derivative work would require belated registration of the
 2 derivative work. This would cure the jurisdictional defect but prevent the recovery of heightened
 3 remedies such as statutory damages or attorneys' fees. *Id.* at § 7.16[B][2][b].

4 Simply put, either of the following scenarios limits the scope of a plaintiff's copyright
 5 claim and/or available remedies: (1) the allegedly infringed portions of the preexisting work are
 6 not part of the derivative work at issue in the case; or (2) the allegedly infringed portions of a late-
 7 registered derivative work do not include the material from the timely registered preexisting
 8 work. Both of these scenarios are relevant here.⁴

9 **2. The cases Oracle cites confirm that the requested discovery is both**
 10 **relevant and necessary.**

11 The purpose of the requested discovery is to obtain facts relevant to the two preconditions
 12 discussed above, *i.e.* facts regarding the chain of title, content, and registration status of the
 13 preexisting works:

14 6. For each of the Registered Works registered as a derivative work,
 15 identification of the author, current owner, any previous owners, content, creation
 16 date, publication date, and copyright registration number (if applicable), of the
 pre-existing works from which those Registered Works are derived.⁵

17 None of the cases cited by Oracle suggests that this discovery should be denied. On the
 18 contrary, each case was decided at trial or on summary judgment based on an evidentiary
 19 showing that both preconditions had been met. *See, e.g., Computer Assocs.*, 775 F.Supp. at 556
 20 (appeal following trial, finding that “[i]f there were evidence that the ADAPTER code had been
 21 placed in the public domain, or were owned by someone other than CA, Altai’s argument that the
 22 derivative nature of the registration did not extend to the ADAPTER code would be compelling.
 23 However, there is no such evidence. On the contrary, the undisputed evidence establishes that

24 _____
 25 ⁴ Thirty-five of the derivative works at issue here were registered belatedly and thus do
 not qualify for remedies such as statutory damages and attorneys' fees. Wallace Decl., Exh. A
 (identifying the thirty-five Registered Works not registered until 2007).

26 ⁵ As discussed in Defendants' opening brief, Defendants initially requested a Rule
 27 30(b)(6) deposition on this topic but agreed, at Oracle's request, to a supplemental interrogatory
 response instead (Interrogatory No. 13). Mot. at 4-5. Defendants plan to pursue a Rule 30(b)(6)
 28 deposition on the related topic of identification of new material in each derivative work upon
 resolution of this motion. *Id.* at 6, n.4.