Exhibit J

Robert A. Mittelstaedt (SBN 060359)
Jason McDonell (SBN 115084)
Elaine Wallace (SBN 197882)
JONES DAY
555 California Street, 26th Floor
San Francisco, CA 94104
Telephone: (415) 626-3939
Facsimile: (415) 875-5700
ramittelstaedt@jonesday.com
jmcdonell@jonesday.com
ewallace@jonesday.com

Tharan Gregory Lanier (SBN 138784)
Jane L. Froyd (SBN 220776)
JONES DAY
1755 Embarcadero Road
Palo Alto, CA 94303
Telephone: (650) 739-3939
Facsimile: (650) 739-3900
tglanier@jonesday.com
jfroyd@jonesday.com

Scott W. Cowan (Admitted *Pro Hac Vice*)
Joshua L. Fuchs (Admitted *Pro Hac Vice*)
JONES DAY
717 Texas, Suite 3300
Houston, TX 77002
Telephone: (832) 239-3939
Facsimile: (832) 239-3600
swcowan@jonesday.com
jlfuchs@jonesday.com

Attorneys for Defendants
SAP AG, SAP AMERICA, INC., and
TOMORROWNOW, INC.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

SAN FRANCISCO DIVISION

ORACLE USA, INC., et al.,	Case No. 07-CV-1658 PJH (EDL)
Plaintiffs,	**DEFENDANTS' MOTION TO COMPEL DISCOVERY RELEVANT TO PLAINTIFFS' COPYRIGHT CLAIMS**
v.	
SAP AG, et al.,	
Defendants.	Date: May 19, 2009 Time: TBD Courtroom: E, 15th Floor Judge: Hon. Elizabeth D. Laporte

1   **NOTICE OF MOTION**

2   **PLEASE TAKE NOTICE** that on May 19, 2009, at a time to be determined by the

3   Court, in Courtroom E, 15th Floor, 450 Golden Gate Avenue, San Francisco, defendants SAP

4   AG, SAP America, Inc., and TomorrowNow, Inc. ("Defendants") will move the Court for an

5   order compelling plaintiffs Oracle USA, Inc., Oracle International Corporation, and Oracle

6   EMEA Ltd ("Oracle" or "Plaintiffs") to produce the documents and information described below.

7   This motion is based on the Notice of Motion, Motion, and Memorandum of Points and

8   Authorities incorporated herein, and on the accompanying Declaration of Elaine Wallace.

9   **RELIEF REQUESTED**

10   Defendants seek an order compelling Oracle, by May 29, 2009 to:

11   1.   Produce a complete copy of all software and other materials purportedly covered

12   by the copyright registrations it alleges were infringed (along with software license activation

13   codes sufficient to allow Defendants access to the software), or, in the alternative, provide written

14   confirmation that its copyright infringement claims exclude the materials not produced;

15   2.   Supplement its response to Interrogatory No. 13 to specifically identify the

16   preexisting material for each derivative work, and, to the extent that Oracle is permitted to rely on

17   the Customer Connection databases pursuant to Rule 33(d) in its response, to: (a) provide

18   whatever technical assistance is required to ensure that Defendants can access and use them; and

19   (b) identify the specific locations where the responsive information can be found for each

20   derivative work;

21   3.   (a) Produce all remaining nonprivileged documents in its possession, custody, or

22   control relating to the acquisition, assignment, or transfer of the registered works, and any

23   preexisting materials upon which they are based, including documents relating to PeopleSoft,

24   Inc.'s ("PeopleSoft") acquisition of technology developed by The Vantive Corporation

25   ("Vantive"), Red Pepper Software Company ("Red Pepper Software"), and Distinction Software,

26   Inc. ("Distinction Software");

27   (b) Confirm in writing that it has produced all materials described in 3(a) above

28   located after a diligent search of all locations at which such materials might plausibly exist; and

SFI-607080v1

- 1 -

DEFS.' COPYRIGHT MOT. TO COMPEL
Case No. 07-CV-1658 PJH(EDL)

1   (c) Produce all documents on which it intends to rely to meet its burden of proving

2   copyrightability and ownership for three Registered Works to which no presumption of validity

3   applies.

4   **MEMORANDUM OF POINTS AND AUTHORITIES**

5   **I.   INTRODUCTION.**

6   More than two years after filing this lawsuit, Oracle still has not provided basic discovery

7   necessary to support its copyright claims. Oracle has failed to produce copies of almost half the

8   works identified in the complaint (the "Registered Works"), despite its agreement to produce

9   them and Judge Legge's order that it do so. Its failure (or inability) to produce this material is

10   critical not only to Defendants' ability to defend the case, but for the parties and the Court to

11   determine which Registered Works will remain in the litigation.

12   Oracle has also failed (or otherwise been unable) to identify the preexisting material on

13   which the derivative Registered Works are based. Derivative works comprise the majority of

14   works at issue in the case. Since a copyright in a derivative work extends only to new – as

15   opposed to preexisting – material, Oracle must either prove what is new (and provide related

16   discovery) or give up those claims.

17   Finally, Oracle still has not completed its production of documents relevant to proving

18   current ownership and chain of title for each of the Registered Works. Oracle's apparent inability

19   to provide this key information and locate relevant documents has been an ongoing problem that

20   has led to serial amendments of the complaint, including changing its roster of copyright

21   Plaintiffs. Oracle brought this case. Oracle controlled and controls its affiliates and the related

22   agreements. There is no excuse for Oracle's continued delay.

23   Oracle has resisted the discovery sought by this motion – and copyright discovery

24   generally – based on its erroneous view that the presumption of validity eliminates its discovery

25   obligations. However, the presumption of validity is immaterial to Oracle's obligation to produce

26   the information requested by this motion. A copyright plaintiff must support its claims, even

27   Oracle.

28

SFI-607080v1

- 2 -

DEFS.' COPYRIGHT MOT. TO COMPEL
Case No. 07-CV-1658 PJH(EDL)

1   **II.   RELEVANT FACTS.**

2   **A.   Oracle's Failure to Produce Copies of All Registered Works.**

3   Oracle alleges infringement of materials covered by eighty-three copyright registrations

4   (the "Registered Works"). TAC, ¶¶ 153-155; *see also* Wallace Decl., ¶ 1, Exh. A (Registrations

5   Summary).[1] Of the eighty-three Registered Works, fifty-six purportedly consist of software,

6   fifteen of software and user documentation, and twelve of user documentation alone. Wallace

7   Decl., ¶ 2. Nine of the Registered Works purportedly consist of "current development

8   environments" for various J.D. Edwards ("JDE") products. Wallace Decl., Exh. A.

9   On July 26, 2007, the first day of discovery, Defendants asked Oracle to produce a

10   complete copy of each Registered Work. Wallace Decl., ¶ 3, Exh. B (RFP No. 63). Oracle

11   largely agreed, but not as to the current development environments (*id*.), so Defendants moved to

12   compel in January 2008. Wallace Decl., ¶ 4. Oracle confirmed both in its response to

13   Defendants' motion and at the hearing with Judge Legge its agreement to produce a copy of each

14   Registered Work, except for the current development environments.[2] Wallace Decl., ¶ 5; *see also*

15   ¶ 7, Exh. C (2/13/08 Hearing Tr. at 134:18-143:23). Oracle argued that it should not be required

16   to produce copies of the allegedly infringed portions of the current development environments

17   because it would be duplicative of its production of other Registered Works. *Id.* Judge Legge

18   agreed and ordered production of Registered Works other than the current development

19   environments. Wallace Decl., Exh. D (2/22/08 Report and Recommendation), at 7-8. Judge

20   Legge further ordered Oracle to identify the specific Registered Works it contends were

21   infringed. *Id.*

22   More than a year later, Oracle still has not produced all of the Registered Works. In fact,

23   it has yet to produce thirty-one of them (not including the development environments discussed

24   above). *See* Wallace Decl., Exh. A. Defendants need a date certain by which Oracle must

25   produce the remaining Registered Works or, in the alternative, confirm that its infringement

26   [1] All references to "Wallace Decl." are to the accompanying Declaration of Elaine
Wallace.

27   [2] Oracle has identified additional Registered Works since the time of Defendants' motion
to compel and agreed in subsequent meet and confers to produce copies of those as well. Wallace

28   Decl. ¶ 6.

SFI-607080v1

DEFS.' COPYRIGHT MOT. TO COMPEL
Case No. 07-CV-1658 PJH(EDL)

1   claims do not include any of the Registered Works it has failed to produce.

2   In light of the amount of time that has passed and discovery that has been done since

3   Judge Legge's order, and in light of Oracle's failure to produce copies of several JDE Registered

4   Works, Defendants have asked Oracle to confirm whether it has changed its position that

5   production of the JDE current development environments would be duplicative of other

6   productions. Wallace Decl., ¶ 9. Defendants have not yet received a response to that question.

7   *Id.* As discussed below, to the extent that Oracle fails to produce the materials upon which it

8   based its argument that production of the development environments would be duplicative,

9   Defendants seek an order from the Court requiring Oracle to produce the current development

10   environments.

11   **B.**   <u>**Oracle's Failure To Identify Preexisting Material In Its Derivative Works**</u>

12   <u>**Registrations**</u>**.**

13   Fifty-two of the eighty-three Registered Works are derivative works, *i.e.* works "based

14   upon one or more preexisting works." 17 U.S.C. § 101; *see also* Wallace Decl., Exh. A. The

15   majority of the registrations for these derivative works identify the preexisting material simply as

16   "previously published versions" of the registered work, or some variation of that language, with

17   no further detail as to which previous version(s), or portion(s) thereof, they include. *Id.* This is

18   true even with respect to Registered Works that purport to be the "initial" release of a product.

19   *Id.*

20   In June 2008, Defendants served a Rule 30(b)(6) deposition notice to Oracle requesting

21   testimony on the following topic:

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

24

25   Wallace Decl., Exh. E (Rule 30(b)(6) Notice), at 6. Oracle objected that this subject matter is

26   more appropriate for an interrogatory response. Wallace Decl., ¶ 11. Defendants agreed that

27   Oracle could supplement its response to Defendants' Interrogatory No. 13 in lieu of providing

28   deposition testimony, but reserved the right to seek deposition testimony should the response be

SFI-607080v1

DEFS.' COPYRIGHT MOT. TO COMPEL
Case No. 07-CV-1658 PJH(EDL)

1 It is important to distinguish between preexisting and new material because the copyright in a

2 derivative work covers only the new material. *See* Copyright Office Circular 41, at 2 ("The

3 copyright in a derivative work covers only the additions, changes, or other new material

4 appearing for the first time in the work. It does not extend to any preexisting material and does

5 not imply a copyright in that material."); *see also* 17 U.S.C. § 103(b). Thus, for example,

6 Oracle's alleged copyright in PeopleSoft 8 Student Administration Solutions (TX 5-431-289), or

7 PeopleSoft 8.8 Enterprise Performance Management (TX 5-993-616), or PeopleSoft Financials

8 7.5 (TX 4-792-574) does not extend to any material from the previously published versions upon

9 which these works are based.[8] Wallace Decl., Exh. A.

10 Oracle may argue (as it has consistently done for all aspects of copyright related

11 discovery) that it has no obligation to identify preexisting material because most (although not

12 all) of the Registered Works qualify for the presumption of validity. However, the presumption

13 of validity is immaterial to the derivative works question. Presumption or not, the scope of

14 Oracle's claim to a given derivative work cannot, as a matter of law, extend beyond the new

15 material contained in that work. *See* 17 U.S.C. § 103(b). Accordingly, Oracle's claim to any

16 version of software that is based on "previous versions" extends only to the new material in the

17 new version. It is thus critically important that Oracle specify for each version what material is

18 new and what was preexisting. This is particularly true for products for which only one version is

19 at issue in the case. The three products named above represent a few examples of Registered

20 Works that fall into this category. However, it is also true for products for which more than one

21 version is at issue, especially where the earliest release at issue in the case is registered as a

22 derivative work based on previous versions not at issue. Wallace Decl., Exh. A (the PeopleSoft

23 HRMS and PeopleTools product lines, for example).[9]

24

25 [8] These are just a few examples. The complete list of Oracle's fifty-two derivative work

26 registrations is attached as Exhibit A to the Wallace Declaration.

27 [9] Oracle's refusal to articulate a damages theory only compounds the derivative works
problem. If, as it has indicated, Oracle intends to pursue a royalty on a per fix or per object basis,
it becomes even more critical to delineate the exact scope of the material covered by each

28 registration.

SFI-607080v1

DEFS.' COPYRIGHT MOT. TO COMPEL
Case No. 07-CV-1658 PJH(EDL)

- 9 -