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21 UNITED STATES DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA  
 22 OAKLAND DIVISION

23 ORACLE USA, INC., *et al.*,  
 24 Plaintiffs,  
 25 v.  
 26 SAP AG, *et al.*,  
 27 Defendants.

CASE NO. 07-CV-01658 PJH (EDL)

**NOTICE OF MOTION AND MOTION  
 PURSUANT TO 17 U.S.C. § 410(c) THAT  
 EVIDENTIARY PRESUMPTION APPLY  
 TO SIX COPYRIGHT REGISTRATIONS**

Date: September 29, 2010  
 Time: 9:00 am  
 Place: 3rd Floor, Courtroom 3  
 Judge: Hon. Phyllis J. Hamilton

Case No. 07-CV-01658 PJH (EDL)

NOTICE OF MOTION AND MOTION PURSUANT TO 17 U.S.C. § 410(c) THAT EVIDENTIARY PRESUMPTION APPLY TO SIX  
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1 **NOTICE OF MOTION AND MOTION**

2 PLEASE TAKE NOTICE THAT on September 29, 2010 at 9 a.m., or as soon thereafter  
3 as the matter may be heard, in the United States District Court, Northern District of California,  
4 located at 1301 Clay St., Oakland, CA, Courtroom 3, 3rd Floor, before the Hon. Phyllis J.  
5 Hamilton, Plaintiff Oracle International Corporation (“OIC” or “Oracle”) will move for a  
6 determination pursuant to 17 U.S.C. § 410(c) that the certificates of registration for the copyright  
7 registrations listed below be granted full evidentiary weight.<sup>1</sup> This motion is based on this notice  
8 of motion and motion, the accompanying memorandum of points and authorities, the  
9 accompanying declarations of Todd Adler, John Polito, Buffy Ransom, and Daniel Vardell, and  
10 upon such other matters presented to the Court at the time of the hearing.

11 **RELIEF SOUGHT**

12 17 U.S.C. § 410(c) gives the Court discretion to deem certain certificates of copyright  
13 registration as *prima facie* evidence of the facts they state. Oracle brings this motion to request  
14 that the Court exercise this discretion as to six of Oracle’s copyright registrations – the only six  
15 out of the 111 total asserted registrations that do not enjoy the automatic status of *prima facie*  
16 evidence under the statute.

17 **MEMORANDUM OF POINTS AND AUTHORITIES**

18 **I. INTRODUCTION**

19 Oracle brings this motion to streamline trial through the statutory discretion available to  
20 the Court pursuant to 17 U.S.C. § 410(c). The Court can and should exercise its discretion to  
21 determine that certain copyrights benefit from an evidentiary presumption of their validity and of  
22 the truth of the facts contained in their certificates of registration. The practical effect of  
23 exercising that discretion here would be to avoid the need for introducing uncontroversial, but  
24 tedious and time-consuming, evidence at trial.

25 \_\_\_\_\_  
26 <sup>1</sup> The parties’ Joint Stipulation and [Proposed] Order Changing Time, Dkt. 763, requesting that  
27 the Court permit this motion to be heard during the Pretrial Conference on September 30, 2010,  
28 at 9 a.m., was still pending at time of filing.

1 Oracle asserts 111 registered copyrights. Of these, 105 benefit from an automatic  
2 evidentiary presumption pursuant to 17 U.S.C. § 410(c) because they were registered within five  
3 years of the publication date of the underlying work. This presumption means that the  
4 copyrights are presumed valid, and the facts stated in their certificates of registration are  
5 presumed true. These facts include such matters as who authored and owns each work. As an  
6 example, the presumption is important because ownership is an element of Oracle’s copyright  
7 claim and the presumption means the registration itself constitutes *prima facie* evidence proving  
8 that element.

9 Six of the 111 copyrights at issue were not registered within five years of first  
10 publication; Oracle registered them for purposes of this litigation after it discovered Defendants  
11 were copying Oracle’s software. There is no other material difference between these six and  
12 many other registrations for versions of the same software that do benefit from the automatic  
13 statutory presumption.

14 For the six that do not enjoy the automatic presumption, Oracle could take the time at  
15 trial to prove the facts their certificates of registration reflect (such as Oracle’s ownership of  
16 them). However, in light of the strong evidence corroborating these facts, it makes little sense to  
17 take up the Court’s and jury’s time and bog down the trial in this fashion. Precisely for this  
18 reason, the Copyright Act grants the Court discretion to extend the evidentiary presumption that  
19 already applies automatically to the other 105 of Oracle copyrights to the remaining six.<sup>2</sup>

20 The six copyrights at issue are for three versions of JD Edwards software and three  
21 versions of Siebel software, as follows:

22 Registration Number	Registration Date	Title of the work.	Date of Publication
23 TX 6-541-029	4/26/2007	Initial release of JD Edwards World A7.3	6/3/1996

24 \_\_\_\_\_  
25 <sup>2</sup> Oracle sought Defendants’ stipulation to the relief sought in this motion multiple times, starting  
26 on July 2, 2010. *See* Joint Pretrial Statement, Dkt. 745 at 4:22-5:10, 5:13 (discussing Oracle’s  
27 repeated efforts to reach a stipulation); Exhibit A to Joint Pretrial Statement, Dkt. 745-1, ¶¶ 13-  
28 16 (proposing stipulated facts regarding authorship, ownership, and copyrightable subject  
matter). Despite offering no evidence to rebut the facts Oracle seeks to establish here through  
the statutory procedure, Defendants would not stipulate. *See* Dkt. 745 at 5:10-12.

Registration Number	Registration Date	Title of the work.	Date of Publication
TX 6-541-047	4/26/2007	Initial release of JD Edwards World A8.1	10/1/1997
TX 6-541-033	4/26/2007	Initial release of JD Edwards EnterpriseOne XE	9/18/2000
TX 6-941-989	6/29/2009	Siebel 6.3 Initial Release and Documentation	12/15/2000
TX 6-941-988	6/29/2009	Siebel 7.0.5 Initial Release and Documentation	11/15/2001
TX 6-941-990	6/29/2009	Siebel 7.5.2 Initial Release and Documentation	9/4/2002

For all time periods relevant to this motion, J.D. Edwards & Co. (“J.D. Edwards”) and Siebel Systems, Inc. (“SSI”), were renowned enterprise software companies. These two companies created and updated the enterprise software reflected by the six registrations above, and licensed that software to customers around the globe. Declaration of Buffy B. Ransom in Support of Plaintiffs’ Motion Pursuant to 17 U.S.C. § 410(c) (“Ransom Decl.”), ¶ 2; Declaration of Daniel A. Vardell in Support of Plaintiffs’ Motion Pursuant to 17 U.S.C. § 410(c) (“Vardell Decl.”), ¶ 2; *see also* Joint Pretrial Statement, Dkt. 745 at 16 (stating as an undisputed fact that Siebel Systems, Inc., “developed, owned, and licensed certain intellectual property, including copyrighted enterprise software programs.”).

It is undisputed that, when Oracle acquired both entities, all of their intellectual property was transferred, in the case of J.D. Edwards, or licensed, in the case of SSI, to plaintiff Oracle International Corporation. *See* Defs. Cross-Mot. for Partial Summary Judgment, Dkt. 670, at 3:16-20 (“On March 1, 2005, these PeopleSoft and JDE entities [that owned the copyrights before March 1, 2005] transferred the copyrights to OIC . . . .”); Order re Mots. For Partial Summary Judgment, Dkt. 762, at 5:11-13 (finding that the March 1, 2005 transfer of copyrights took place); Joint Pretrial Statement, Dkt. 745, at 15:13-15 (stating as an undisputed fact that “Siebel Systems, Inc. provided OIC with an exclusive license to its copyrights and other intellectual property, including rights to enforce intellectual property rights, effective March 1, 2006.”); *see also* Declaration of Todd E. Adler in Support of Plaintiffs’ Motion Pursuant to 17 U.S.C. § 410(c) (“Adler Decl.”), ¶ 4 & Ex. A at 1-2 and 4 (showing assignment of J.D. Edwards World and J.D. Edwards EnterpriseOne copyrights to Oracle and exclusive licensing of Siebel copyrights to Oracle); *id.* at 6-19 (excerpting relevant agreements).

1 In this Motion, Oracle presents evidence more than sufficient for the Court to apply the  
2 presumption under § 410(c) that J.D. Edwards authored and owned J.D. Edwards World A7.3,  
3 J.D. Edwards World A8.1, and J.D. Edwards EnterpriseOne XE, and that SSI authored and  
4 owned Siebel 6.3, Siebel 7.0.5 and Siebel 7.5.2.

5 **II. THE EVIDENTIARY PRESUMPTION APPLIES TO TIMELY REGISTERED**  
6 **WORKS AND CAN APPLY TO LATE-REGISTERED WORKS**

7 **A. The Presumption Applies Automatically to Virtually All of Oracle’s**  
8 **Copyrights**

9 Under the Copyright Act of 1976, as amended (the “Copyright Act”), “if a copyright  
10 holder secures a registration certificate within five years after first publication, the certificate will  
11 constitute prima facie evidence of both the validity of the copyright and the facts stated in the  
12 certificate.” *Cosmetic Ideas, Inc. v. IAC/InteractiveCorp*, 606 F.3d 612, 619 (9th Cir. 2010)  
(citing 17 U.S.C. § 410(c)).

13 Of Oracle’s 111 copyrights in suit, certificates for 105 were secured within five years of  
14 the first publication of the underlying work, and receive the presumption of validity by statute.  
15 17 U.S.C. § 410(c). Thus, by operation of 17 U.S.C. § 410(c), these 105 certificates of  
16 registration constitute *prima facie* evidence as to the validity of the copyrights. This includes  
17 facts such as the originality of the registered works and the copyrightability of the subject matter.  
18 *Id.*; see also *Dream Games of Arizona v. PC Onsite*, 561 F.3d 983, 987 & n.2 (“A certificate of  
19 registration raises the presumption of copyright validity and ownership.”); *Religious Tech. Ctr. v.*  
20 *Netcom On-Line Comm’n Svcs., Inc.*, 923 F. Supp. 1231, 1241 (N.D. Cal. 1995) (observing that  
21 the presumption of validity extends to both originality and copyrightability). In addition, the  
22 statements in these 105 certificates concerning authorship, ownership, work-for-hire, and prior  
23 written assignment are presumed true. See, e.g., *Micro Star v. Formgen, Inc.*, 154 F.3d 1107,  
24 1109-10 (9th Cir. 1998) (ownership); *Langman Fabrics v. Graff Californiawear, Inc.*, 160 F.3d  
25 106, 111 (2d. Cir. 1998) (work-for-hire status); *Warren v. Fox Family Worldwide, Inc.*, 171 F.  
26 Supp. 2d 1057, 1066 (C.D. Cal. 2001) (work-for-hire status), *aff’d*, 328 F.3d 1136 (9th Cir.  
27 2003); *Severin Montres, Ltd., v. Yidah Watch Co.*, 997 F. Supp. 1262, 1264 (C.D. Cal. 1997)  
28 (authorship; ownership via written assignment), *aff’d*, 165 F.3d 917 (9th Cir.1998).



1 Defendants can only rebut the presumption with extrinsic evidence. *See, e.g., S.O.S.,*  
2 *Inc. v. Payday, Inc.*, 882 F.2d 1081, 1086-88 (9th Cir. 1989) (finding that challenges to  
3 statements regarding derivative work and authorship status in a copyright registration, absent  
4 evidence, were insufficient to rebut the presumption).

5 **B. The Court Has Discretion to Grant the Evidentiary Presumption to Late-**  
6 **Registered Works**

7 Courts in this circuit, and elsewhere, have granted the presumption to works registered  
8 more than five years after first publication when provided sufficient evidence of creation or  
9 ownership of the late-registered works. 17 U.S.C. § 410(c). By way of example, this evidence  
10 may include an assignment of copyright rights, proof the alleged infringer had contractual notice  
11 of asserted copyright restrictions, or direct evidence of authorship. *See, e.g., Lanard Toys Ltd. v.*  
12 *Novelty, Inc.*, 511 F. Supp. 2d 1020, 1031 (C.D. Cal. 2007) (reviewing “detailed design  
13 drawings . . . [and] an assignment of copyright rights” in exercising its discretion with respect to  
14 late-registered works pursuant to 17 U.S.C. § 410(c)); *Asset Mktg. Sys. Ins. Servs., LLC v.*  
15 *McLaughlin*, No. 06cv1176, 2007 WL 2406894 at \*5, (S.D. Cal. Aug. 20, 2007) (granting the  
16 full evidentiary presumption to a late-registered work where the alleged infringer had contractual  
17 notice of restrictions on reproduction and where the registered work displayed a copyright  
18 notice); *Religious Tech. Ctr.*, 923 F. Supp. at 1242 (granting “strong weight” after review of  
19 evidence of assignment of copyrights and of renewal terms for the late-registered works); *see*  
20 *also* 5 Patry on Copyright (2010) § 17:109 at 17-300 (“Courts have granted a certificate of prima  
21 facie status for registrations beyond the five-year period where there appeared to be little reason  
22 to call the validity of the facts in the certificate into question.”) (footnote omitted).

23 **III. THE COURT SHOULD GRANT THE EVIDENTIARY PRESUMPTION OF**  
24 **VALIDITY SET FORTH IN § 410(c) TO SIX REGISTRATIONS**

25 For four reasons, the Court should streamline the trial and extend the full evidentiary  
26 presumption of validity to the three J.D. Edwards copyrights and the three Siebel copyrights at  
27 issue in this Motion.

28

1 First, the evidence establishes that J.D. Edwards and Siebel developed and licensed (and  
2 Oracle continues to release) the World, EnterpriseOne and Siebel product lines, including these  
3 particular versions. This evidence consists of the software itself, related documentation, and  
4 related certificates of registration that are entitled by statute to the presumption of validity. In  
5 addition, the representative source code submitted to the Copyright Office as deposit material for  
6 each of the six registrations contains a copyright notice stating that J.D. Edwards or Siebel,  
7 respectively, was the copyright owner for that work. (Parts A.1 and B.1, below)

8 Second, relevant inter-entity agreements corroborate additional information on the  
9 certificates of registration. (Parts A.2 and B.2, below)

10 Third, at both J.D. Edwards and Siebel, senior management were the “creative  
11 masterminds” who made the development decisions for these large and complex software  
12 products, leaving the implementation of those decisions to the discretion of the development  
13 teams and individual developers. In addition, each company required its employees and  
14 contractors to agree that their individual contributions were works for hire. Each required  
15 developers to assign the rights to any contributions to their corporate employer. (Parts A.3 and  
16 B.3, below)

17 Finally, equitable considerations strongly favor granting the presumption to the six  
18 registrations. (Part C, below)

19 Below, Oracle explains this evidence in detail as to each product line, starting with J.D.  
20 Edwards (Part A) and then Siebel (Part B). Because Defendants cannot provide evidence  
21 constituting a “persuasive challenge to the validity of the copyrights” at issue, the Court should  
22 extend the presumption to these six certificates of registration, even though they were registered  
23 more than five years after first publication. *See Religious Tech. Ctr.*, 923 F. Supp. at 1242;  
24 *Lifetime Homes, Inc. v. Residential Dev. Corp.*, 510 F. Supp. 2d 794, 801 (M.D. Fla. 2007)  
25 (extending the presumption of validity to a homebuilder’s certificate of registration where  
26 alleged infringing competitors neither presented evidence that the certificate was invalid nor  
27 successfully challenged the homebuilder’s ownership of the copyright).

28

1           **A.       The Court Should Apply the Presumption to the Three Late-Registered J.D.**  
2           **Edwards Works**

3           For the three J.D. Edwards copyrights in issue, the statements concerning ownership and  
4           authorship in the certificates of copyright registration are corroborated by extensive proof that  
5           J.D. Edwards developed and licensed the software (Part 1, below), by inter-entity agreements  
6           (Part 2, below), by the development process and employment agreements (Part 3, below), and by  
7           equitable considerations (Part C, below).

8                   **1.       J.D. Edwards Developed and Licensed the Software Before, During**  
9                   **and After the Relevant Time Periods**

10                           **a.       Copies of the J.D. Edwards Software**

11           Oracle has produced the J.D. Edwards software corresponding to the three J.D. Edwards  
12           works at issue in this motion:

- 13                   • J.D. Edwards World A7.3,  
14                   • J.D. Edwards World A8.1, and  
15                   • J.D. Edwards EnterpriseOne XE.

16           *See* Declaration of John Polito in Support of Plaintiffs’ Motion Pursuant to 17 U.S.C. § 410(c)  
17           (“Polito Decl.”), ¶ 16. Computer software is copyrightable subject matter under the Copyright  
18           Act. Thus, the certificates of registration for these works properly relate to copyrightable subject  
19           matter. *See Apple Computer, Inc. v. Formula Int’l, Inc.*, 725 F.2d 521, 524-25 (9th Cir. 1984);  
20           *see also* 17 U.S.C. § 101 (defining “computer program”). The software itself also states that J.D.  
21           Edwards owns it. Ransom Decl., ¶ 9.<sup>3</sup>

22                           **b.       Documentation and Release Notes for J.D. Edwards Software**

23           Software documentation is material, both printed and electronic, that instructs one in the  
24           use of software and explains its features. Release notes explain updated features and

25 \_\_\_\_\_  
26 <sup>3</sup> Evidence showing J.D. Edwards’ past *ownership* of the copyrights prior to the transfer  
27 corroborates J.D. Edwards’ *authorship*, because the author (including a work-for-hire employer)  
is the original owner of any copyrights. *See* 17 U.S.C. § 201(a)-(b).

1 functionality in new versions, among other things. *Cf. Netbula, LLC v. Storage Tech. Corp.*, No.  
2 C06-07391, 2008 WL 228036 (N.D. Cal. Jan. 18, 2008) at \*6 (treating facts in release notes for  
3 computer software as evidence of the software’s functionality). Oracle produced 18 years’ worth  
4 of J.D. Edwards software documentation and release notes, spanning from J.D. Edwards World  
5 A2.2 to A9.1, and from J.D. Edwards EnterpriseOne B7.3.3.1 (the version immediately  
6 preceding XE) through 8.12 (the most recent version at the time of filing).<sup>4</sup> See Polito Decl.,  
7 ¶¶ 5-7 & Exs. B-D (excerpting product documentation for J.D. Edwards World A7.3 (1996), J.D.  
8 Edwards EnterpriseOne 8.12 (2006), and J.D. Edwards World A9.1 (2007); *id.*, ¶ 8 & Ex. E  
9 (listing 39 pieces of product documentation from J.D. Edwards World A2.2 (1989) through J.D.  
10 Edwards EnterpriseOne XE (2000)); *see also* Ransom Decl., ¶ 6 (explaining EnterpriseOne  
11 version numbering scheme).

12           These materials show that J.D. Edwards authored and owned J.D. Edwards World A7.3,  
13 J.D. Edwards World A8.1 and J.D. Edwards EnterpriseOne XE for two reasons. First, the  
14 documentation contains screenshots, feature lists, technical information, and other indicia for  
15 almost two decades of J.D. Edwards software products, at a level of detail that would be  
16 impossible to forge. *See, e.g.*, Polito Decl., ¶ 5 & Ex. B at ORCL00257003 and ORCL00257008  
17 (showing screenshots of J.D. Edwards World A7.3); *id.*, ¶ 9 & Ex. F (listing identification  
18 numbers and descriptions of all code changes made during the development of the three J.D.  
19 Edwards works at issue). This detailed record of documentation dating from 1989 through the  
20 creation of J.D. Edwards EnterpriseOne XE in 2000 is evidence that J.D. Edwards owned,  
21 supervised and controlled the software. *See Lanard Toys Ltd. v. Novelty, Inc.*, 511 F. Supp. at  
22 1031 (“The detailed design drawings submitted by plaintiffs under seal constitute sufficient  
23 evidence of Lanard Inc.’s ownership of the copyrights . . . at the time the copyright registrations  
24 to these toys were filed . . .”).

25

26

27 <sup>4</sup> The J.D. Edwards EnterpriseOne product line was created by rewriting J.D. Edwards World  
28 A7.3. Ransom Decl., ¶ 6.

1 Second, the documentation refers to the software at issue in this motion as J.D. Edwards  
2 software, consistent with a finding that J.D. Edwards authored this software. *See* Ransom Decl.,  
3 ¶ 9 (regular practice of J.D. Edwards to state, in the software code itself, in the documentation,  
4 and in the release notes that J.D. Edwards owned the software); *see, e.g.*, Polito Decl., ¶ 5 & Ex.  
5 B at ORCL00256981 (referring to “J.D. Edwards release A7.3” ); *id.* at ORCL00256984  
6 (forecasting the release of “A8.1 . . . in the next 12 to 18 months”); *id.* at ORCL00256983  
7 (referencing the OneWorld product line, which became EnterpriseOne).

8 This voluminous collection of documentation, alone, would establish that J.D. Edwards  
9 authored, and is the original owner of, J.D. Edwards World A7.3, J.D. Edwards World A8.1 and  
10 J.D. Edwards EnterpriseOne XE. 17 U.S.C. § 201(a) (“Copyright in a work protected under this  
11 title vests initially in the author or authors of the work.”); *id.* § 201(b) (employers are original  
12 authors of works made for hire). But there is far more.

13 **c. J.D. Edwards Copyright Registrations and Deposit Materials**

14 Copyrights in both *prior* and *later* versions of the same J.D. Edwards software at issue in  
15 this motion were timely registered with the Copyright Office.

16 *Prior:* In 1995, J.D. Edwards registered 19 modules of J.D. Edwards World A6.1 from  
17 1993 and 1994. Polito Decl., ¶ 17. These 19 registrations, which include statements about  
18 ownership and authorship, are entitled to the statutory presumption of validity because they were  
19 registered as unpublished works. *See Religious Tech. Ctr.*, 923 F. Supp. at 1242. The following  
20 year, J.D. Edwards rewrote its World software in a more modern programming language. The  
21 rewrite became known as the EnterpriseOne product. Ransom Decl., ¶ 6.

22 *Later:* Oracle’s 2007 registrations of J.D. Edwards World A9.1 and J.D. Edwards  
23 EnterpriseOne 8.0 through 8.12 are entitled to the automatic presumption, because the  
24 registrations were obtained within five years of first publication. Polito Decl., ¶¶ 17-19.

25 *At issue:* The late-registered J.D. Edwards works were published in 1996, 1997, and  
26 2000. *See* Adler Decl., ¶ 10 & Ex. B (attaching the certificates of registration for the late-  
27 registered J.D. Edwards copyrights). As a result, certificates of registration for versions of J.D.  
28 Edwards software entitled to the automatic presumption of validity both *pre-date* and *post-date*

1 the three late-registered J.D. Edwards registrations. This is compelling evidence that the  
2 certificates of registration for the intervening, late-registered J.D. Edwards versions should also  
3 be entitled to the presumption.

4 Oracle’s deposit materials for each of the J.D. Edwards copyrights at issue also contain  
5 copyright statements, listing J.D. Edwards as the owner of the copyright. *See* Polito Decl., ¶¶ 3-  
6 4 & Ex. A at 1-3 (attaching initial pages of deposit materials, with statements marked attributing  
7 ownership to J.D. Edwards & Company and J.D. Edwards World Source Co.).<sup>5</sup> This not only  
8 corroborates J.D. Edwards’ ownership and authorship, but also would have put any contributors  
9 who believed themselves to be joint authors on notice that they were in fact not joint authors,  
10 triggering the three-year statute of limitations. *See Zuill v. Shanahan*, 80 F.3d 1366, 1368, 1369,  
11 1371 (9th Cir. 1996) (holding that the statute of limitations on co-authorship claims begins to  
12 run, when “plain and express repudiation of co-authorship is communicated to the claimant,”  
13 including through distribution of a “printed copyright notice” stating sole authorship).

14 **2. The J.D. Edwards Inter-Entity Agreements Prove Authorship and**  
15 **Ownership**

16 Evidence that J.D. Edwards licensed or assigned copyrights for the same software also  
17 weighs in favor of extending the presumption under § 410(c) to the three late-registered versions.  
18 *See Religious Tech. Ctr.*, 923 F. Supp. at 1242 (holding that assignments of copyright rights are  
19 evidence of the assignor’s authorship and ownership of those rights). As demonstrated in  
20 documents filed with the Copyright Office, J.D. Edwards, named in the relevant deposit  
21 materials, assigned copyrights to Oracle International Corporation on March 1, 2005. *See* Order  
22

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23 <sup>5</sup> Oracle has produced documents and testimony to prove that the J.D. Edwards copyrights from  
24 the various J.D. Edwards entities legally transferred to OIC on March 1, 2005. Polito Decl.,  
25 ¶¶ 29-30 & Exs. Q-R (showing assignments, recorded with the Copyright Office, from J.D.  
26 Edwards & Co., LLC and J.D. Edwards World Source Co. to OIC); *id.* at ¶ 31 & Ex. S (showing  
27 merger of J.D. Edwards & Company into J.D. Edwards & Co., LLC); Adler Decl., ¶¶ 4-10, 12-  
28 13 & Ex. A at 1-2 (describing these transfers and confirming that they are consistent with the  
facts stated on the registrations); *See* Order re Mots. For Partial Summary Judgment, Dkt. 762, at  
5:3-20 (discussing various transfers of PeopleSoft and J.D. Edwards intellectual property rights  
and assets to OIC);

1 re Mots. For Partial Summary Judgment, Dkt. 762, at 5:3-20; *see also*, Joint Pretrial Statement at  
2 15:8-10 (stating as undisputed fact that “As part of Oracle’s acquisition of PeopleSoft, Inc.,  
3 ownership of certain PeopleSoft and J.D. Edwards copyrights and other intellectual property  
4 (with carve-outs related to J.D. Edwards) was transferred to OIC on March 1, 2005.”).

5        Though these transfers do not reference the three J.D. Edwards copyrights at issue  
6 (because they were not yet registered), these transfers are consistent with, and evidence of, J.D.  
7 Edwards’ authorship and ownership of the three J.D. Edwards copyrights at issue. The  
8 consistency between the evidence in these inter-entity agreements and the factual statements on  
9 authorship and ownership in the various copyright registrations independently supports a finding  
10 that the late-produced registrations are in fact accurate.

11                    **3.        The Relationship Between Employees and the Corporate Entity**  
12                    **Proves Ownership**

13        Oracle produced blank, form employment or contractor agreements from J.D. Edwards  
14 dated before (February 1996), in the midst of (March 1999 and June 2000) and after (April 2003)  
15 the development of the three versions of J.D. Edwards software at issue in this motion. Polito  
16 Decl., ¶¶ 22-24 & Exs. J-L. Each agreement required the employee or contractor both to  
17 acknowledge that his or her work was work for hire on behalf of J.D. Edwards and to assign any  
18 separate contributions to J.D. Edwards. *Id.* It was J.D. Edwards’ general practice to require  
19 employees and contractors to sign such agreements during the relevant time period. Ransom  
20 Decl., ¶ 8. The presence of these provisions suggests an intent to reserve authorship of J.D.  
21 Edwards software to the corporate entity, rather than to individual contributors. *See*  
22 *Aalmuhammed v. Lee*, 202 F.3d 1227, 1231-36 (9th Cir. 2000) (affirming denial of co-authorship  
23 to a consultant who substantially contributed material to a feature film, even assuming that the  
24 material was separately copyrightable, where consultant “lacked control over the work” and  
25 absent “objective manifestations of an intent to be coauthors”). Testimony regarding  
26 contemporaneous management of the development process confirms this understanding.  
27 Ransom Decl., ¶¶ 3-4.

28

1           Moreover, though sophisticated enterprise software requires the efforts of many  
2 individuals, it is the software company, not its employees or contractors, that author the resulting  
3 copyrighted software. That was true at J.D. Edwards. Ransom Decl., ¶¶ 5-7 (discussing the  
4 complexity of J.D. Edwards World A7.3, J.D. Edwards World A8.1 and J.D. Edwards  
5 EnterpriseOne XE and efforts to develop); *see also JustMed, Inc. v. Byce*, 600 F.3d 1118, 1121-  
6 22, 1125-28 (9th Cir. 2010) (affirming that a corporation and not an individual developer was the  
7 owner of copyrighted software, despite the developer having worked from home in a different  
8 state, having been paid and taxed as an independent contractor, and having changed the  
9 copyright statements in the software to attribute ownership to himself rather than the company).

10           In the Ninth Circuit, the question of whether individual contributors are deemed authors  
11 for copyright purposes depends upon the nature of the contribution, the “creative  
12 mastermind[ing]” of the entire work, and objective expressions of intent. *Aalmuhammed*, 202  
13 F.3d at 1234; *cf. Morrill v. The Smashing Pumpkins*, 157 F. Supp. 2d 1120, 1125-26 (C.D. Cal  
14 2001) (reviewing *Aalmuhammed* factors in evaluating authorship of a late-registered work  
15 pursuant to 17 U.S.C. § 410(c)).

16           At J.D. Edwards, senior management retained control over the features and functionality  
17 that would be developed in the software. Individual developers were then allowed discretion as  
18 to how to implement those features and functionality in the software. Ransom Decl., ¶ 4. In  
19 combination with the historical employment and engagement documents and related information,  
20 this evidence alone establishes that J.D. Edwards corporate entities, and not individual  
21 developers, were the original authors of the three versions of J.D. Edwards software. Combined  
22 with the clear and unequivocal evidence described above, there can be no doubt about corporate  
23 ownership.

24           **B.       The Court Should Apply the Presumption to the Three Late-Registered**  
25           **Siebel Works**

26           As with J.D. Edwards, for the three Siebel copyrights in issue, the statements concerning  
27 ownership and authorship in the certificates of copyright registration are corroborated by proof  
28 that Siebel developed and licensed the software (Part 1, below), by inter-entity agreements (Part



1 2, below), by the development process and employment agreements (Part 3, below), and by  
2 equitable considerations (Part C, below).<sup>6</sup>

3 **1. Siebel Developed and Licensed the Software Before, During and After**  
4 **the Relevant Time Periods.**

5 **a. Copies of the Siebel Software**

6 As with J.D. Edwards, Oracle has produced the Siebel software corresponding to the  
7 three Siebel works at issue in this motion:

- 8 • Siebel 6.3 Initial Release and Documentation,  
9 • Siebel 7.0.5 Initial Release and Documentation, and  
10 • Siebel 7.5.2 Initial Release and Documentation

11 *See* Polito Decl., ¶ 16. The certificates of registration thus properly relate to copyrightable  
12 subject matter. *See* Sec. III.A.1.a, above. The software itself states that Siebel owns it. Vardell  
13 Decl., ¶ 7.

14 **b. Documentation and Release Notes for Siebel Software**

15 Oracle has produced the entirety of its automated database containing Siebel  
16 documentation and related materials. Polito Decl., ¶¶ 16, 20. This database includes more than  
17 10 years of product documentation and release notes for Siebel software, including  
18 documentation for versions both before and after the three works at issue. Polito Decl., ¶¶ 12-15  
19 & Ex. I (attaching a summary of 208 pieces of Siebel documentation, spanning 10 years, from  
20 that database). This product documentation refers to the software at issue as being owned by  
21 Siebel. It also contains screenshots and technical details that only the author and owner of the  
22 relevant software could obtain. Polito Decl., ¶ 10 & Ex. G at 1-1 (“Siebel Systems is proud to  
23 introduce Siebel 2000 Version 6.3—the latest release of Siebel *e*Business Applications.”); *id.* at  
24 4-57 to 4-58 (step-by-step navigation instructions and screenshot); *id.*, ¶ 11 & Ex. H at  
25

26 \_\_\_\_\_  
27 <sup>6</sup> Evidence showing SSI’s *ownership* of the copyrights prior to the grant of exclusive license to  
28 OIC corroborates SSI’s *authorship*, because the author (including a work-for-hire employer) is  
the original owner of any copyrights. *See* 17 U.S.C. § 201(a)-(b).

1 ORCL00526442 to 445 (providing HTML source for implementation of a change request). As  
2 with J.D. Edwards, Oracle’s production of product documentation alone would establish  
3 ownership and authorship of the three versions of Siebel software at issue in this motion.  
4 Vardell Decl., ¶ 7 (Siebel’s regular practice was to state in the software, in related documentation  
5 and release notes and on the CDs it shipped that Siebel owned the software). But, again, there is  
6 far more.

7 **c. Siebel Copyright Registrations and Deposit Materials**

8 As with J.D. Edwards, every copyright for Siebel software, other than the three at issue in  
9 this motion, are entitled to the automatic statutory presumption of validity. *See* Polito Decl.,  
10 ¶¶ 20-21. Thus, the statements about authorship and ownership in the later registrations, which  
11 are presumed to be true, help establish the validity of identical statements in the three  
12 registrations for the works at issue in this motion. *See* Adler Decl., ¶ 11 & Ex. C (attaching the  
13 certificates of registration for the late-registered Siebel copyrights).

14 The deposit materials for the three Siebel works at issue, as with the J.D. Edwards works,  
15 each contain copyright formalities listing Siebel as the owner of the copyright. *See* Polito Decl.,  
16 ¶¶ 3-4 & Ex. A at 4-6 (attaching initial pages of deposit materials, with statements marked  
17 attributing ownership to Siebel Systems, Inc.). The Court can and should consider such  
18 statements in extending the presumption of validity to these three registrations, because  
19 copyright formalities put the reader on notice of a claim of copyright. *Cf. Asset Mktg.* at \*5  
20 (granting the full evidentiary presumption based, in part, on evidence that the alleged infringer  
21 should have been aware of the claim of copyright in the registered work).

22 **2. The Siebel Inter-Entity Agreements Prove Authorship and Ownership**

23 Oracle has produced documents and testimony that confirm the statements about  
24 authorship and ownership in the three Siebel registrations at issue. This evidence includes proof  
25 that Siebel licensed its copyrights as part of changes in ownership and authorship. Adler Decl.,  
26 ¶¶ 4-9, 11-12 & Ex. A at 4. Defendants agree. *See* Joint Pretrial Statement, Dkt. 745 at 15:13-15  
27 (stating as an undisputed fact that Siebel Systems, Inc., exclusively licensed its copyrights to  
28 OIC on March 1, 2006); *id.* at 22:22-25 (stating as an undisputed fact that “Since March 1, 2006,

1 OIC has held all exclusive rights under the Copyright Act for each registration described in rows  
2 104-108 of Table 1, save for [a carveout relating to EMEA]”); *id.* at 21-22, Table 1 (listing the  
3 three Siebel copyrights at issue in this motion in rows 104-106).

4 The consistency between the facts stated in the registrations for the three Siebel works at  
5 issue in this motion, the facts summarized in Mr. Adler’s declaration, and the undisputed facts in  
6 the Joint Pretrial Statement are more than sufficient evidence upon which the Court should grant  
7 the presumption of validity to the three Siebel copyrights at issue. *See Lanard Toys*, 511 F.  
8 Supp. 2d at 1031 & 1037 n.12 (finding ownership of late-registered works to have been  
9 established upon review of extrinsic evidence).

10 **3. The Relationship Between Employees and the Corporate Entity**  
11 **Proves Ownership**

12 Oracle also produced blank, form employment agreements from Siebel that pre-date,  
13 post-date and are contemporaneous with the development of the three versions of Siebel software  
14 at issue in this motion. Polito Decl., ¶¶ 25-28 & Exs. M-P. Again, each agreement included  
15 both an acknowledgment of the work-for-hire status of employee contributions, an agreement to  
16 assign copyrights, and assignment of copyrights from the employee to Siebel. *Id.* It was  
17 Siebel’s general practice to require that employees sign such agreements during the relevant time  
18 period. Vardell Decl., ¶ 6.

19 As with J.D. Edwards, the presence of these provisions suggests an intent to reserve  
20 authorship of Siebel software to the corporate entity, rather than to individual contributors  
21 Testimony regarding contemporaneous management of the development process confirms this  
22 understanding. Vardell Decl., ¶¶ 3-4. Indeed, as with J.D. Edwards, the development of Siebel  
23 software is a complex undertaking that requires the efforts of many employees, managers and  
24 corporate officers. Vardell Decl., ¶ 5. Senior management retained control over the features and  
25 functionality that would be developed in the software, but individual developers were then  
26 allowed discretion as to how to implement those features and functionality. Vardell Decl., ¶¶ 3-  
27 4. For the reasons and based on the authorities cited in Sec. III.A.3., above, this evidence alone  
28

1 establishes that the Siebel corporate entity, and not the individual developers, were the original  
2 authors of the three versions of Siebel software.

3 **C. For Both the J.D. Edwards and Siebel Works, Equity Supports the**  
4 **Presumption of Validity**

5 Though the discretion afforded to the Court is statutory in nature, the Court  
6 independently should consider that the equities heavily weigh in favor of exercising its discretion  
7 to apply the presumption of validity. Otherwise, Defendants would gain an advantage from their  
8 concealment of the illegal copying.

9 Because § 410(c) uses a fixed date range to determine whether to automatically grant the  
10 presumption of validity, the distinction in this case between copyrights entitled to the  
11 presumption by operation of statute and those to which the presumption applies at the Court's  
12 discretion is demonstrably unrelated to merit. Siebel did not register any of its copyrights before  
13 Oracle acquired Siebel. Adler Decl., ¶ 15. In fact, all copyright registrations for Siebel software  
14 have the same effective date, because the copyrights were registered after this case began. *Id.*  
15 Similarly, though J.D. Edwards did register some copyrights early in its corporate history, the  
16 copyrights in the majority of versions of J.D. Edwards software were also registered after this  
17 case began. Adler Decl., ¶ 14. The only reason that certain of the six copyrights at issue were  
18 registered outside the five-year period is because Defendants concealed their infringement until  
19 Oracle uncovered it in discovery. Extending the presumption to these six works would be an  
20 appropriate exercise of the Court's equitable authority, because it would prevent Defendants  
21 from benefiting from their admitted infringement. Order re Mots. For Partial Summary  
22 Judgment, Dkt. 762, at 24:6-9, 24:13-18 (ruling that Defendants were guilty of direct and indirect  
23 copyright infringement for certain registrations and time periods). It is also, we submit,  
24 indisputably warranted by the evidence.

25 **IV. CONCLUSION**

26 For all of the reasons stated above, Oracle International Corporation respectfully requests  
27 that the Court grant the full presumption of evidentiary validity pursuant to 17 U.S.C. § 410(c) to  
28 the six certificates of registration at issue in this motion.

1 DATED: August 19, 2010

BINGHAM McCUTCHEN LLP

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