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17 *Attorneys for Plaintiff*
 ORACLE AMERICA, INC.

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

**SUPPLEMENTAL DECLARATION
 OF MARC DAVID PETERS IN
 SUPPORT OF ORACLE'S
 RESPONSIVE CLAIM
 CONSTRUCTION BRIEF**

Dept.: Courtroom 9, 19th Floor
 Judge: Honorable William H. Alsup
 Tutorial: April 6, 2011, 1:30 p.m.
 Hearing: April 20, 2011, 1:30 p.m.

1 I, Marc David Peters, declare as follows:

2 I am a partner at Morrison & Foerster LLP and am counsel of record to Plaintiff Oracle
3 America, Inc. I have personal knowledge of the matters set forth herein and, if called to testify,
4 could and would testify competently to the following.

5 1. On March 24, 2011, I performed searches of issued patents in the U.S. Patent and
6 Trademark Office online database. *See* U.S. Patent Full-Text Database Manual Search, available
7 at <http://patft.uspto.gov/netahtml/PTO/search-adv.htm>. My search criteria were:

- 8 • ((aclm/"computer-readable medium") andnot ("carrier wave" or "carrier waves"))
- 9 • (aclm/"computer-readable medium" and ("carrier wave" or "carrier waves"))
- 10 • (an/"sun microsystems")
- 11 • (an/"sun microsystems" and aclm/"computer-readable medium")
- 12 • ((an/"sun microsystems" and aclm/"computer-readable medium") andnot ("carrier
13 wave" or "carrier waves"))
- 14 • ((an/"sun microsystems" and aclm/"computer-readable medium") and ("carrier wave"
15 or "carrier waves"))

16 2. Here are the results of my searches:

17 3. There are 23,840 issued patents having “computer-readable medium” in the
18 claims, but do not have “carrier wave” anywhere in the specification. In contrast, there are 3,804
19 issued patents having “computer-readable medium” in the claims, which do have “carrier wave”
20 somewhere in the specification.

21 4. There are 7,615 patents issued to Sun Microsystems, of which 546 have
22 “computer-readable medium” in the claims.

23 5. There are 333 patents issued to Sun Microsystems having “computer-readable
24 medium” in the claims, but do not have “carrier wave” anywhere in the specification. In contrast,
25 there are 213 patents issued to Sun Microsystems having “computer-readable medium” in the
26 claims, which do have “carrier wave” somewhere in the specification.

27 6. Reading through the earliest-issued patents in the search results, I did not find a
28 patent application filed in 1996 that had both “computer-readable medium” in the claims and

1 “carrier wave” somewhere in the specification. U.S. Patent No. 5,953,522, which was filed in
2 July 1996, does not have “carrier wave” in the specification.

3 7. On March 29, 2011, I reviewed the file history for U.S. Patent No. 5,953,522. I
4 observed that the phrase “carrier wave” did not appear in the specification and claims as they
5 were originally filed on July 1, 1996. The phrase “carrier wave” did not appear in the prosecution
6 of the ’522 patent until it was added to the claims by an amendment in 1998. The amendment
7 was filed by a different attorney, at a different law firm, than the one who filed the specification
8 two years earlier. Attached hereto as Exhibit 9 is a true and correct copy of the original 1996
9 claims of the ’522 patent and of the 1998 amendment to the claims.

10 8. Attached hereto as Exhibit 10 is a true and correct copy of Section 2106 from the
11 MANUAL OF PATENT EXAMINING PROCEDURE, 8th Edition, dated August 2001. The relevant
12 portion on page 2100-14 is indicated.

13 9. Attached hereto as Exhibit 11 is a CDROM containing certified copies of the
14 patents-in suit and their file histories, including parent patents and their file histories. Present on
15 the disk are:

- 16 • True and correct certified copies of U.S. Patent No. RE38,104 and its parents
17 5,367,685 and RE36,204, and their respective file histories. These were produced to
18 Google with the Bates numbers OAGOOGL0000052131-52143,
19 OAGOOGL0000052194-52209, OAGOOGL0000052235-52253,
20 OAGOOGL0000113509-113600, OAGOOGL0000113789-114304, and
21 OAGOOGL0000102583-105959.
- 22 • A true and correct certified copy of U.S. Patent No. 5,966,702 and its file history.
23 These were produced to Google with the Bates numbers OAGOOGL0000052023-
24 52059 and OAGOOGL0000113601-113788.
- 25 • A true and correct certified copy of U.S. Patent No. 6,061,520 and its file history.
26 These were produced to Google with the Bates numbers OAGOOGL0000052097-
27 52109 and OAGOOGL0000112640-113099.

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- A true and correct certified copy of U.S. Patent No. 6,125,447 and its file history. These were produced to Google with the Bates numbers OAGOOGL0000052060-52077 and OAGOOGL0000111937-112639.
- A true and correct certified copy of U.S. Patent No. 6,192,476 and its file history. These were produced to Google with the Bates numbers OAGOOGL0000052078-52096 and OAGOOGL0000111357-111936.
- True and correct certified copies of U.S. Patent No. 6,910,205 and its parent 6,513,156, and their respective file histories. These were produced to Google with the Bates numbers OAGOOGL0000052144-52169, OAGOOGL0000052210-52234, OAGOOGL0000113100-113508, and OAGOOGL0000052602-52859.
- A true and correct certified copy of U.S. Patent No. 7,426,720 and its file history. These were produced to Google with the Bates numbers OAGOOGL0000052110-52130 and OAGOOGL0000052270-52424.

10. For the Court’s convenience, the chambers copy of Exhibit 11 is being provided in both disk and paper form. The disk contains the complete patents and file histories listed above. To conserve space and paper, certain prior art references that were submitted to the patent office (notably, a few complete textbooks totaling thousands of pages) were omitted from the paper copy.

I declare under penalty of perjury under the laws of the United States that to the best of my knowledge the foregoing is true and correct. Executed on March 31, 2011, in Palo Alto, California.

/s/ Marc David Peters
Marc David Peters