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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 OBJECTION TO  
 GOOGLE’S PROPOSED  
 INSTRUCTION ON THE  
 OBJECTIVE-SUBJECTIVE TEST**  
 Dept.: Courtroom 8, 19th Floor  
 Judge: Honorable William H. Alsup

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1 Oracle submits this last of three briefs objecting to instructions that were proposed for the  
2 first time at the charging conference on Friday, April 27.

3 **I. ORACLE OBJECTS TO GOOGLE’S PROPOSED INSTRUCTION ON**  
4 **THE OBJECTIVE SUBJECTIVE TEST**

5 At the charging conference on April 27, 2012, Google proposed for the first time the  
6 following jury instruction on the objective-subjective test (No. 26):

7 To determine whether the copyrighted work and the accused work  
8 are substantially similar, or if appropriate, virtually identical, you  
9 must compare the works as a whole. However, in comparing the  
10 works as a whole, you cannot consider similarity to unprotectable  
11 elements of Oracle’s works.

12 I have instructed you about the protectable and unprotectable  
13 elements of Oracle's works in instructions 17, 19 and 20.

14 (RT at 2401:23-2402:12.)

15 Oracle objects to this instruction on four grounds. First, it does not state that, the jurors’  
16 comparison should be made in relation to Oracle’s work as a whole, rather than to Android.  
17 Second, it does not explain that the qualitative significance of the work copied, though  
18 quantitatively small, may be enough to find substantial similarity. Third, this instruction does not  
19 explain that if the jury were to find direct evidence of copying, the jury need not analyze whether  
20 the works are substantially similar. Lastly, the instruction is confusing because it asks the jurors  
21 to cross-reference other jury instructions in order to be able to interpret this one.

22 **A. The Instructions Should Reflect that Google Is Liable for Copying**  
23 **Either a Quantitatively or a Qualitatively Significant Portion of**  
24 **Oracle’s Work, Regardless of the Size of the Portion of Android Not**  
25 **Accused**

26 Google’s proposed instruction is erroneous because the jury should compare the copied  
27 portion in relation to the plaintiff’s work as a whole, not the defendant’s work as a whole. To  
28 hold otherwise would be to “allow an unscrupulous defendant to copy large or qualitatively  
significant portions of another’s work and escape liability by burying them beneath non-  
infringing material in the defendant's own work, even where the average audience might  
recognize the appropriation.” *Newton v. Diamond*, 388 F.3d 1189, 1195 (9th Cir. 2004). “No  
plagiarist can excuse the wrong by showing how much of his work he did not pirate.” *Sheldon v.*

1 *Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936)). The Court suggested at the  
2 charging conference that it may include an instruction that addresses this point, and Oracle  
3 renews its request that the Court do so. Such an instruction is particularly important in this case,  
4 given that Google’s counsel has repeatedly emphasized all of the many different parts of Android  
5 that have nothing to do with this litigation or Oracle’s work as a whole.

6 Just as importantly, the substantiality of a taking “is measured by considering the  
7 qualitative and quantitative significance of the copied portion in relation to the plaintiff’s work as  
8 a whole.” *Newton*, 388 F.3d at 1193. Copying that is *either* quantitatively or qualitatively  
9 significant constitutes infringement. *See, e.g., Harper & Row Publishers, Inc. v. Nation*  
10 *Enters.*, 471 U.S. 539 (1985) (holding that copying of 300 words of quotation from unauthorized  
11 manuscript of Gerald Ford memoir was not fair use); *Mktg. Tech. Solutions, Inc. v. Medizine LLC*,  
12 No. 09 Civ. 8122 (LMM), 2010 U.S. Dist. LEXIS 50027, at \*10 (S.D.N.Y. May 18, 2010)  
13 (denying summary judgment where defendant copied 437 lines of source code out of plaintiff’s  
14 953,612-line program because “it performs a real function” in the plaintiff’s program). This  
15 should be stated explicitly in the instruction.

16 Google’s proposed instruction uses an incorrect frame of reference and fails to inform the  
17 jury that they should find infringement if Google copied even a quantitatively small, but  
18 qualitatively significant portion of Oracle’s work.

19 **B. Direct Evidence of Copying Obviates the Need to Analyze Whether the**  
20 **Works Are Substantially Similar.**

21 The objective-subjective test, as part of the greater substantial similarity analysis, is  
22 merely an alternative way to prove copying in the absence of direct evidence of copying. Where,  
23 as here, the jurors have heard evidence of direct copying, they should be instructed as follows:  
24 “Direct evidence of copying is sufficient to prove copying. Thus, where there is direct evidence  
25 of copying, you do not need to consider whether the works are substantially similar or virtually  
26 identical.” *See Range Road Music, Inc. v. East Coast Food, Inc.*, 668 F.3d 1148, 1154 (9th Cir.  
27 2012). In *Range Road*, the Ninth Circuit held that there is no need to prove similarity when there  
28 is evidence of direct copying as is the case here:

1 “Substantial similarity” is not an element of a claim of copyright  
2 infringement. Rather, it is a doctrine that helps courts adjudicate  
3 whether copying of the “constituent elements of the work that are  
4 original” actually occurred when an allegedly infringing work  
5 appropriates elements of an original without reproducing it *in toto*.

6 *Id* (citation omitted). (“[S]ubstantial similarity’ is irrelevant in a case like this one, in which the  
7 Music Companies produced evidence that the public performances entailed direct copying of  
8 copyrighted works.”). Google admits that it engaged in massive direct copying of the structure,  
9 sequence and organization of thousands of elements in the APIs for these 37 API packages.  
10 Oracle is not required to provide further evidence of substantial similarity.

11 **C. The Third Sentence Of This Instruction Is Confusing.**

12 The Court indicated at the charging conference that it was not inclined to include the third  
13 sentence of Google’s proposed instruction. Oracle agrees with this conclusion. In fact, to fully  
14 apply this instruction, the jurors would have to cross reference *five* other instructions (not just the  
15 three that Google has noted). The instructions that the jurors would need to refer to are: work as  
16 a whole (#30); ideas/expression (#17); structure, sequence, and organization (#19); names of files  
17 (#20); and substantial similarity/virtual identity (#25). For this reason, Oracle believes it would  
18 be better to eliminate this instruction entirely. It will only confuse the jury to add in an  
19 instruction that is potentially relevant to so many other instructions that have previously been  
20 explained.

21 **CONCLUSION**

22 For these reasons, the Court should not include Google’s proposed verdict question on the  
23 objective-subjective test. In the alternative, the Court should modify the instruction to correct for  
24 the errors discussed above.

25 Dated: April 29, 2012

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