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GOOGLE INC.

UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC.,  
  
Plaintiff,  
  
v.  
  
GOOGLE INC.,  
  
Defendant.

Case No. 3:10-cv-03561 WHA  
  
**MOTION IN LIMINE RE PETER  
KESSLER TESTIMONY RE ANDROID  
CODE MODIFICATIONS**  
  
Dept.: Courtroom 8, 19<sup>th</sup> Floor  
Judge: Hon. William Alsup

1 **I. INTRODUCTION**

2 Google moves to exclude testimony by Oracle engineer Peter Kessler regarding alleged  
3 use of the '104 patent in Android's Dalvik virtual machine source code and modifications that  
4 Oracle engineers allegedly made to source code. The issue is whether Mr. Kessler, who was  
5 never disclosed by Oracle as a witness who would provide opinion testimony, can provide such  
6 expert testimony on behalf of Oracle. He cannot, for at least three reasons. *First*, Oracle  
7 disclosed a different engineer, Mr. Vandette, to testify on the topic of Google's alleged use of the  
8 '104 patent and the steps he took to turn off the allegedly infringing features in Android. *Second*,  
9 the only testimony for which Oracle disclosed Mr. Kessler was *Oracle's*—not Google's—  
10 practice of the asserted claims of the patents in suit. *Third*, at deposition, Oracle blocked  
11 questioning regarding the very topic for which it now apparently intends to present Mr. Kessler,  
12 asserting privilege.

13 **II. ARGUMENT**

14 **A. Oracle disclosed Mr. Vandette—not Mr. Kessler—to testify about Google's**  
15 **use of the '104 patent and the steps taken to disable that functionality in the**  
16 **Dalvik source code.**

17 The demonstrative slides disclosed by Oracle to Google in connection with Mr. Kessler's  
18 testimony fall into two categories: (1) side-by-side comparisons of Android's Dalvik source code  
19 in modified and unmodified form; and (2) slides related to "Use of the '104 Patent in the Dalvik  
20 Sources" (as reflected in the titles). This does not square with Oracle's disclosures pursuant to  
21 Rule 26(a)(2)(C) of the Federal Rules of Civil Procedure. Those disclosures, dated July 29, 2011,  
22 include three Oracle employees designated to offer opinion testimony: Mssrs. Landau, Poore,  
23 and Vandette. Each is disclosed regarding Dalvik code modifications and benchmark  
24 performance testing related to particular patents. The disclosure for Mr. Vandette stated, in  
25 relevant part:

26 Mr. Vandette is a current employee of Oracle who may present testimony on the  
27 subject of performance benchmark analysis and testing. Mr. Vandette may testify  
28 about the performance benchmark analysis and testing he conducted to measure  
the benefits Android obtains from practicing United States Patent Nos. RE38,104  
("the '104 patent") and 6,910,205 ("the '205 patent"). Mr. Vandette may also  
testify about the performance benchmark analysis and testing he conducted to

1           measure the benefits Java SE Embedded obtains from practicing the '205 patent.  
2           *Mr. Vandette may also provide testimony regarding the ways in which Android*  
3           *practices the '104 and '205 patents, and the steps he took to turn off the patented*  
4           *features to measure the performance hits to Android.*

5 Oracle America, Inc.'s Disclosures Pursuant to Fed. R. Civ. P. 26(a)(2)(C) (July 29, 2011)  
6 (emphases added). In short, Oracle disclosed Mr. Vandette to testify about Android's alleged use  
7 of the '104 patent and the steps he allegedly took to modify the Android source code for his  
8 benchmark tests. And while Oracle supplemented its Rule 26(a)(2)(C) disclosure on February 7,  
9 2012, that supplemented disclosure only added Mr. Reinhold, not Mr. Kessler.

10           Based on the demonstrative slides, it seems Oracle wants to change horses. The problem  
11 is, Oracle never disclosed Mr. Kessler as an employee expert regarding Android's alleged use of  
12 the '104 patent and the steps he took to modify the Android source code for his benchmark tests.  
13 Because Mr. Kessler was not so disclosed—in contrast to Mr. Vandette, who was explicitly  
14 disclosed—Oracle should be precluded from eliciting from Mr. Kessler testimony regarding  
15 Android's alleged use of the '104 patent and the steps taken to modify the Android source code.

16           **B.     Mr. Kessler was only disclosed to testify about *Oracle's* use of the '104 patent.**

17           In addition to Oracle's failure to disclose Mr. Kessler as an employee expert to testify  
18 about Android's use of the '104 patent and the steps taken to modify the Android source code—  
19 and its actual disclosure of someone else on those topics—Oracle's witness list also failed to  
20 disclose Mr. Kessler regarding these topics. According to Oracle's witness list, "Mr. Kessler is  
21 an Oracle engineer. He may testify regarding *Oracle's* products that practice the asserted claims  
22 of the patents-in-suit." (Dkt. No. 525-2 at 8 (emphasis added).) He is not disclosed regarding  
23 *Google's* alleged use of the '104 patent or modifications to Android source code. As such, he  
24 should be precluded from testifying on those issues.

25           **C.     Oracle asserted privilege regarding the topics for which it now intends Mr.**  
26           **Kessler to testify.**

27           If the lack of proper disclosures are not sufficient grounds to exclude Mr. Kessler's  
28 proposed testimony, the fact that Oracle asserted privilege over the very topics for which Mr.  
Kessler is now being offered should be. As reflected in the demonstrative slides, the main topic

1 for which Oracle intends to use Mr. Kessler is “Use of the ’104 Patent in the Dalvik Sources.” In  
2 other words, alleged infringement of the ’104 patent by Android. But when asked whether he did  
3 an infringement analysis for the ’104 patent, Oracle limited the answer to a simple yes or no  
4 question.

5 Q. Have you ever done an infringement analysis on Android products for the  
6 ’104 patent?

7 Mr. Norton: You may answer that question a yes or no.

8 A: Yes.

9 *See* Kessler Dep. 71:13-17. Oracle would not even allow questioning as to the timing of this  
10 analysis, instructing the witness not to answer.

11 Q. When did you conduct these infringement analyses?

12 MR. NORTON: I’ll object and instruct the witness not to answer the question on  
13 grounds of attorney-client privilege and work product.

14 Q. Will you follow that instruction?

15 A. Yes, I will.

16 *Id.* at 73:5-12. Given its refusal to allow discovery into Mr. Kessler’s infringement analysis of  
17 the ’104 patent, Oracle cannot now offer Mr. Kessler to testify at trial regarding “Use of the ’104  
18 Patent in the Dalvik Sources.”

### 19 III. CONCLUSION

20 For the foregoing reasons, the Court should grant a motion *in limine* prohibiting Mr.  
21 Kessler from testifying regarding Android’s alleged practice of the ’104 patent and the steps  
22 taken to modify the Android source code.

23 Dated: May 6, 2012

24 KEKER & VAN NEST LLP

25 By: /s/ Robert A. Van Nest  
26 ROBERT A. VAN NEST

27 Attorneys for Defendant  
28 GOOGLE INC.