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 14 GOOGLE INC.

15 UNITED STATES DISTRICT COURT  
 16 NORTHERN DISTRICT OF CALIFORNIA  
 17 SAN FRANCISCO DIVISION

18 ORACLE AMERICA, INC.,  
 19 Plaintiff,  
 20 v.  
 21 GOOGLE INC.,  
 22 Defendant.

Case No. 3:10-cv-03561 WHA

**GOOGLE INC.'S NOTICE OF MOTION,  
 MOTION, AND MEMORANDUM OF  
 POINTS AND AUTHORITIES IN  
 SUPPORT OF ITS MOTION FOR A NEW  
 TRIAL ON ORACLE'S CLAIM THAT  
 GOOGLE IS LIABLE FOR  
 INFRINGEMENT OF ORACLE'S  
 COPYRIGHT ON THE STRUCTURE,  
 SEQUENCE AND ORGANIZATION OF  
 THE COMPILABLE CODE FOR THE 37  
 JAVA API PACKAGES**

Dept.: Courtroom 8, 19<sup>th</sup> Floor  
 Judge: Hon. William Alsup

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**NOTICE OF MOTION AND MOTION**

PLEASE TAKE NOTICE that pursuant to Fed. R. Civ. P. 59<sup>1</sup> Defendant Google Inc. (“Google”) will, and hereby does, respectfully move for a new trial on Oracle’s claim that Google is liable for infringement of Oracle’s copyright on the structure, sequence and organization of the compilable code for the 37 Java API packages. This Motion is based on the attached memorandum of points and authorities as well as the entire record in this matter.

Dated: May 8, 2012

KEKER & VAN NEST LLP

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

Attorneys for Defendant  
GOOGLE INC.

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<sup>1</sup> Google files this Rule 59 motion, directed to the issue of the effect of the jury’s inability to reach a unanimous decision on question 1B, pursuant to the court’s direction. RT 2890:1-6. Google reserves the right to file a further Rule 59 motion within the time allowed by the Rule on all grounds supported by the record.

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3 **MEMORANDUM OF POINTS AND AUTHORITIES**

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17 **I. INTRODUCTION**

Question 1 of the Special Verdict Form provided to the jury in this case included two sub-questions regarding Google’s alleged liability for copyright infringement based on the structure, sequence and organization of the compilable code in the 37 Java API packages. First, the jury was asked in question 1A: “Has Oracle proven that Google has infringed the overall structure, sequence and organization of copyrighted works?” Second, the jury was asked in question 1B: “Has Google proven that its use of the overall structure, sequence and organization constituted ‘fair use’?” Dkt. No. 1089. Although the jury concluded that Oracle had proven that Google infringed the overall structure, sequence and organization of the copyrighted works, the jury did not reach a unanimous verdict as to whether Google had proven the affirmative defense of fair use. Under settled Supreme Court and Ninth Circuit law, the jury’s failure to reach a verdict concerning both halves of this indivisible question requires a new trial concerning both questions. To accept the infringement verdict as binding on the parties and retry only fair use would violate both the unanimity requirement and the Reexamination Clause of the Seventh Amendment.

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28 **II. ARGUMENT**

The Seventh Amendment requires that, for suits at common law, “the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise re-examined in any Court of the United States, than according to the rules of the common law.” U.S. Const. Amend VII. Thus under the Seventh Amendment’s Reexamination Clause, a court cannot hold a partial retrial unless the issue to be retried is sufficiently “distinct and separable” from the issues decided by the first jury. *Gasoline Products Co. v. Champlin Refining Co.*, 283 U.S. 494, 500 (1931). Furthermore, the Seventh Amendment requires that jury verdicts in federal court be unanimous. *Murray v. Laborers Union Local No. 324*, 55 F.3d 1445, 1451 (9th Cir. 1995) (“The Seventh Amendment requires jury verdicts in federal civil cases to be unanimous.”); *see also* Fed. R. Civ. P. 48(b) (“Unless the parties stipulate otherwise, the verdict must be unanimous.”). Although this does not mean that the jury must agree to every factual issue that underlies a verdict, it does mean

1 that civil juries must be unanimous on all the “ultimate issues of a given case,” as well as the  
2 “final verdict itself.” *Jazzabi v. Allstate Insurance Co.*, 278 F.3d 979, 985 (9th Cir. 2002).

3 Based on these principles, and consistent with Supreme Court and Ninth and Federal  
4 Circuit law, the Court should declare a mistrial on both the infringement and fair use questions  
5 relating to Google’s alleged liability for copyright infringement based on the structure, sequence,  
6 and organization of the compilable code for the 37 Java API packages. Declaring a mistrial only  
7 as to the fair use question would violate the Seventh Amendment—both by threatening Google  
8 with a non-unanimous verdict on liability, and by having determination of the same factual  
9 question, or indivisible factual questions, made by two different juries.

10 **A. The Seventh Amendment’s unanimity requirement mandates a new trial for**  
11 **both infringement and fair use.**

12 Twice in recent years, in *Jazzabi* and *United States v. Southwell*, 432 F.3d 1050 (9th Cir.  
13 2005), the Ninth Circuit has clearly held that a defendant has a right to a unanimous verdict on  
14 *liability*. Where liability depends on both acceptance of all elements of a plaintiff’s claim and  
15 rejection of a defendant’s affirmative defense, the jury must decide unanimously *both* that  
16 plaintiff has proven all claim elements *and* that defendant has failed to make out its affirmative  
17 defense. *Jazzabi*, 278 F.3d at 984. In other words, a hung jury on an affirmative defense is  
18 necessarily a hung jury on that entire liability claim because if the claim elements are submitted  
19 to a different jury than the affirmative defense, no jury has unanimously decided liability. Under  
20 the holdings of these cases, a new trial is necessary on both infringement and fair use.

21 In *Jazzabi*, the plaintiff’s house burned down, after which his insurer, Allstate, rejected his  
22 fire insurance claim. Allstate admitted it had not paid out on the policy, but raised the affirmative  
23 defense that Jazzabi had burned down his own house. *Jazzabi*, 278 F.3d at 980-81. After the jury  
24 began deliberations, it asked the court whether it could find Allstate liable even if it did not  
25 unanimously reject Allstate’s affirmative defense that Jazzabi started the fire. *Id.* at 981. The  
26 court instructed the jury that it should find Allstate liable so long as it did not unanimously *agree*  
27 *with* Allstate’s affirmative defense—in other words, even if the jury did not unanimously *reject*  
28 that defense. *Id.*

1           The Ninth Circuit reversed, holding that a defendant cannot be held liable until the jury  
2 both unanimously accepts plaintiff’s proof on the claim elements and unanimously rejects the  
3 defendant’s proof on its affirmative defense. *Id.* 985. The court held that “elements and  
4 affirmative defenses are co-equal components of the jury’s liability determination: Liability  
5 cannot be established until after the jurors unanimously agree that the elements are satisfied *and*  
6 they unanimously reject the affirmative defenses.” *Id.* at 984 (emphasis in original). Moreover,  
7 this result was not just good practice, it was required by the Seventh Amendment’s unanimity  
8 requirement. The court noted that “civil juries must ‘render unanimous verdicts on the ultimate  
9 issues of a given case’” as well as the “final verdict itself.” *Id.* at 985 (quoting *McKoy v. North*  
10 *Carolina*, 494 U.S. 433, 449 (1990) (Blackmun, J., concurring)). To allow a jury split on an  
11 affirmative defense to impose liability “defeats the intent and rationale underlying the mandate  
12 that jury verdicts be unanimous, because *liability might attach even though the jury had not*  
13 *unanimously agreed that a basis for liability exists.*” *Id.* (emphasis added). The Ninth Circuit  
14 held that the Seventh Amendment’s unanimity requirement was implicated and barred a partial  
15 verdict even though the elements of Jazzabi’s claim for breach of contract and Allstate’s defense  
16 that Jazzabi had committed arson were factually independent of one another.

17           When it revisited the issue in *Southwell*, the Ninth Circuit was even clearer in extending  
18 *Jazzabi* to the criminal context. *Southwell* was charged with arson and pled the affirmative  
19 defense of insanity. Relying on *Jazzabi*, the Ninth Circuit concluded that in order to convict  
20 *Southwell*, the jury had to unanimously conclude both that *Southwell* was guilty of the crime, and  
21 that he was not insane. “***Since a jury verdict must be unanimous, a jury united as to guilt but***  
22 ***divided as to an affirmative defense (such as insanity) is necessarily a hung jury.***” 432 F.3d at  
23 1055 (emphasis added). Again, the Ninth Circuit so held even though the elements of the crime  
24 of arson and the affirmative defense of insanity do not overlap.

25           Under *Jazzabi* and *Southwell*, Google has a Seventh Amendment right to be found liable  
26 only if a jury unanimously concludes *both* that Google’s conduct was infringing, *and* that it was  
27 not fair use. Conducting a second trial concerning only fair use would deprive Google of that  
28 right. This jury did not unanimously reject Google’s fair use defense. And, if a subsequent jury

1 were given only the question of fair use, there would be no way to know whether that jury would  
2 unanimously conclude that Google’s conduct was infringing, because the second jury would  
3 never have had to consider that question. Thus no jury would have “unanimously agreed that a  
4 basis for liability exists” because no jury would have “unanimously agree[d] that the elements are  
5 satisfied *and* . . . unanimously reject[ed] the affirmative defenses.” *Jazzabi*, 278 F.3d at 984-85.  
6 The Court must therefore hold a new trial as to both infringement and fair use.

7 **B. The Seventh Amendment’s Re-Examination Clause mandates a new trial for**  
8 **infringement and fair use.**

9 Under the Seventh Amendment’s Re-Examination Clause, a partial retrial “may not  
10 properly be resorted to unless it clearly appears that the issue to be retried is so distinct and  
11 separable from the others that a trial of it alone may be had without injustice.” *Gasoline Products*  
12 *Co. v. Champlin Refining Co.*, 283 U.S. 494, 500 (1931); *see also* Moore’s Federal Practice –  
13 Civil § 59.14 (“A specific issue may be retried when it clearly appears that (1) the issue is  
14 sufficiently distinct and separable from the others and (2) the trial of that issue alone may be held  
15 without injustice.”). Here, accepting a partial verdict on infringement alone would be error for a  
16 separate reason not present in *Jazzabi* or *Southwell*—because the issues of infringement and fair  
17 use are sufficiently factually intertwined that a retrial of fair use cannot be had without also  
18 retrying infringement.

19 The clearest factual overlap with respect to the claim at issue here is between infringement  
20 and the third factor of the fair use analysis. In determining infringement, the jury must determine  
21 whether there are “substantial similarities” between the copyrighted work and the accused work.  
22 Final Charge to the Jury, Dkt. 1018 at 11-12. The third fair use factor asks the jury to determine  
23 an obviously similar question: the “amount and substantiality of the portion [of the copyrighted  
24 work] used in relation to the copyrighted work as a whole.” *Id.* at 13. The jury’s determination  
25 of whether there are “substantial similarities” between the copyrighted work and the accused  
26 work necessarily overlaps with the jury’s determination as to the “amount and substantiality” of  
27 the portion of the copyrighted work used in the accused work in relation to the copyrighted work  
28 as a whole. Thus if one jury is asked to decide infringement and a second jury is asked to decide

1 fair use, that second jury's fair use analysis would require it to re-examine the factual  
2 determinations made as part of the first jury's infringement analysis. This violates the Seventh  
3 Amendment. *See Allison v. Citgo Petroleum Corp.*, 151 F.3d 402, 423 n.21 (5th Cir. 1998).

4 The Federal Circuit reached a similar conclusion in the patent context in *Witco Chemical*  
5 *Corp. v. Peachtree Doors, Inc.*, 787 F.2d 1545 (Fed. Cir. 1986). In *Witco*, the defendants made  
6 non-infringement, invalidity, and unenforceability arguments regarding the allegedly-infringed  
7 patents. *Id.* at 1547. The jury found the patents valid and enforceable, but could not reach a  
8 unanimous verdict with regard to infringement. *Id.* The district court excused the jury for an  
9 indefinite period. Three weeks later defendants moved for a mistrial based on the hung jury. The  
10 district court recalled the same jury and gave them additional instructions, at which point they  
11 quickly found infringement. *Id.* The Federal Circuit reversed the infringement verdict based on  
12 coercion. *Id.* at 1548.

13 The Federal Circuit then had to decide whether to remand just the infringement verdict for  
14 retrial, or to remand the entire case. Relying on *Gasoline Products*, the court concluded that "it is  
15 inappropriate, in light of the evidence presented and arguments made at this trial, to have one jury  
16 return a verdict on the validity, enforceability and contract questions while leaving the  
17 infringement questions to a second jury." *Id.* at 1549. The court reasoned that "the arguments  
18 against infringement are indistinguishably woven with the factual underpinnings of the validity  
19 and enforceability determinations and the subject matter of the contract." *Id.* The court therefore  
20 vacated the entire judgment and remanded for a new trial. *Id.*

21 Other courts have similarly concluded that when two claims depend on common factual  
22 determinations, they must be tried together. In *Kuehne & Nagel v. Geosource*, 874 F.2d 283 (5th  
23 Cir. 1989), the court ordered a retrial on all claims even though it only reversed on one specific  
24 issue. It concluded that the "overlapping nature of the evidence in SGS' breach of contract claim  
25 against Geosource and Geosource's tortious interference claim against SGS makes us wary of  
26 retrying only Geosource's breach of contract and fraudulent inducement claims." *Id.* at 295.  
27 Retrial of all claims was necessary because "the new jury should be given the opportunity to view  
28 the dispute comprehensively." *Id.* (internal quotation marks and alterations omitted). In *Matter*

1 of *Rhone-Poulenc Rorer, Inc.*, 51 F.3d 1293 (7th Cir. 1995), the Seventh Circuit struck down a  
2 district court’s plan to have one jury decide the issue of negligence and then have a subsequent  
3 jury decide the issues of comparative negligence and proximate causation because “[b]oth issues  
4 overlap the issue of the defendants’ negligence.” *Id.* at 1303.

5 Because the “factual underpinnings” of infringement and fair use are “indistinguishably  
6 woven” together, the Court must hold a retrial as to both infringement and fair use. *Witco*, 787  
7 F.2d at 1549.

8 **III. CONCLUSION**

9 Holding a retrial solely on Google’s fair use defense (question 1B) without also retrying  
10 Oracle’s claim for infringement (question 1A) would violate Google’s Seventh Amendment rights  
11 under both the unanimity requirement and the Reexamination Clause. Google therefore requests  
12 that the Court declare a mistrial, and order a new trial, as to both infringement and fair use as to  
13 Oracle’s claim that Google is liable for infringement of its copyright on the structure, sequence,  
14 and organization of the 37 API packages.

15 Dated: May 8, 2012

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18 Attorneys for Defendant  
19 GOOGLE INC.