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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

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

Case No. 3:10-cv-03651 WHA  
  
**GOOGLE'S OBJECTIONS TO FINAL  
CHARGE TO THE JURY (PHASE TWO)**  
  
Dept.: Courtroom 8, 19<sup>th</sup> Floor  
Judge: Hon. William Alsup

1 **I. INTRODUCTION**

2 Google offers these objections to, and comments on, the Court’s Final Charge to the Jury  
3 (Phase Two). *See* ECF Nos. 1121, 1121-1. Google also preserves all prior objections made to the  
4 jury instructions and verdict form. *See* RT 3652-3704 (transcript of charging conference).

5 **II. OBJECTIONS TO THE FINAL CHARGE**

6 **A. Instruction 8**

7 Google had suggested at the charging conference that the Court include on its special  
8 verdict form the phones that are accused by Oracle of infringement. *See* RT 3699:3-13. The  
9 Court has not adopted that suggestion in its proposed special verdict form. Google believes that  
10 the jury should be informed in some fashion of the phones that are actually in this case, and  
11 therefore proposes a new sentence to add to instruction 8, following the sentence “The products  
12 that allegedly infringe the asserted patents are certain Android mobile devices and software and  
13 the Android Software Development Kit (“SDK”).” The proposed new sentence would read “The  
14 specific Android mobile devices accused in this case are the Nexus One, the Nexus S, the HTC  
15 EVO 4G, the HTC Droid Incredible, the HTC G2, the Motorola Droid, and the Samsung  
16 Captivate.”

17 **B. Instruction 14**

18 Google objects to the Court’s inclusion in its jury instructions the statement that  
19 “[d]istributing or offering a product for free constitutes a use or sale.” That instruction is not  
20 supported by the case law. A sale requires transfer of a product for a price, not for free. *See*  
21 *PharmaStem Therapeutics, Inc. v. Viacell, Inc.*, 491 F.3d 1342, 1359 (Fed. Cir. 2007). Use of a  
22 product requires that a product be put into service, not merely displayed or distributed. *See*  
23 *Medical Sol’ns, Inc. v. C Change Surgical LLC*, 541 F.3d 1136, 1141 (Fed. Cir. 2008). For these  
24 reasons, as well as for those stated in Google’s Memorandum re Jury Instructions (ECF No. 535)  
25 at 33-35, Google objects to the inclusion of this sentence.

26 **C. Instructions 19 and 20**

27 Google objects to the inclusion in these two instructions of language suggesting that  
28 mobile service providers are potential direct infringers of the claims of the patents-in-suit. At the

1 charging conference, Google pointed out that Oracle had developed no evidence during trial  
2 suggesting that mobile service providers were direct infringers. *See* RT 3677-78. Google  
3 therefore objects to inclusion of “mobile service providers” in either of these instructions.

4 **D. Instruction 21**

5 Google objects to the inclusion of language stating that the jury could find Google liable  
6 for inducing infringement if it “knew or should have known of the asserted patent.” At the  
7 charging conference, counsel for Oracle stated that both parties had proposed such language in  
8 their instructions. RT 3679:23-24. In fact, Google had proposed such language for the third  
9 prong of the test, that is, “knew or should have known that its actions would cause direct  
10 infringement by another.” ECF No. 535 at 115. The Model Patent Jury Instructions for the  
11 Northern District of California, as revised November 3, 2011 (after the parties had submitted their  
12 original proposals on jury instructions), also support Google’s position here. Specifically, Model  
13 Instruction 3.9 does not include a “knew or should have known” standard in any of the three  
14 enumerated elements, and notes that an accused infringer “cannot be liable for inducement unless  
15 it actually believed it was highly probable its actions would encourage infringement of a patent  
16 and took intentional acts to avoid learning the truth.” The focus of imputed knowledge there is on  
17 the actions taken, not on knowledge of the patent. Accordingly, Google objects to inclusion of  
18 the “knew or should have known” language in the second prong of the test (page 8, line 21). That  
19 language should be “knew of the asserted patent.” Google would not object to inclusion of the  
20 “knew or should have known” language in the third prong of the test (page 8, line 22).

21 **E. Instruction 23**

22 Google objects the Court’s inclusion of an instruction on so-called “willful blindness.” As  
23 explained at the charging conference, *see* RT 3682-3692, there are insufficient facts in the record  
24 to support a jury finding that Google was willfully blind as to the patents-in-suit. The facts that  
25 Oracle has adduced come nowhere near the standard set by *Global-Tech Appliances, Inc. v. SEB*  
26 *S.A.*, 131 S. Ct. 2060 (2011). Instead, this case is similar to *Apeldyn Corp. v. AU Optronics*  
27 *Corp.*, No. 08-CV-568-SLR, 2011 U.S. Dist. LEXIS 134759 (D. Del. Nov. 15, 2011), where the  
28 court granted summary judgment of no indirect infringement because the underlying facts were

1 insufficient to support a conclusion that the accused infringer had been willfully blind. None of  
2 the cases cited by Oracle support a finding of willful blindness on facts of this sort. Google  
3 further objects to this instruction to the extent that it does not clearly state that Google's state of  
4 mind must have exceeded negligence or deliberate indifference, and that the actions it took to  
5 avoid learning of any relevant facts must have been active, not passive. *See Global-Tech*; N.D.  
6 Cal. Model Patent Jury Instruction 3.9 ("It is not enough that [accused infringer] was merely  
7 indifferent to the possibility that it might encourage infringement of a patent. Nor is it enough  
8 that [accused infringer] took a risk that was substantial and unjustified."); ECF No. 1120  
9 (requesting such language); ECF No. 1078 (explaining why willful blindness not met by facts of  
10 case); ECF No. 535 at 42-43 (containing original briefing on the issue).

11 **III. POTENTIAL REVISIONS TO THE FINAL CHARGE**

12 **A. Instruction 8**

13 Google suggests that the phrase "asserted patents" on page 4, line 11 be changed to  
14 "asserted claims," which was defined in the previous sentence. The term "asserted patents" is not  
15 otherwise defined in the instructions, and the current phrasing may cause jury confusion as to  
16 whether they could find infringement of non-asserted claims of the asserted patents.

17 **B. Instruction 14**

18 For the same reasons set forth in III.A, Google suggests changing the phrase "a claim of  
19 the asserted patents," which is found on page 6, line 14, to "an asserted claim."

20 Google further suggests that the phrase "you must compare that the accused product,"  
21 found at page 6, line 20, contains a typo and should be "you must compare the accused product."

22 Finally, Google suggests that the word "requirement," found on page 6, lines 21 and 24,  
23 be changed to "limitation," the term that is used in instruction 13, on page 6, line 7.

24 Dated: May 13, 2012

KEKER & VAN NEST LLP

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

27 Attorneys for Defendant  
28 GOOGLE INC.