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 15 GOOGLE INC.

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

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

Case No. 3:10-cv-03561-WHA
 Honorable Judge William Alsup
**DEFENDANT GOOGLE INC.’S
 STATEMENT ON THE COURT’S
 TENTATIVE CLAIM CONSTRUCTION
 ORDER**

25 Pursuant to the Court’s Tentative Claim-Construction Order and Request for Critique
 26 (Dkt. 128) (“Order”), Defendant Google Inc. (“Google”) hereby submits this Statement on the
 27 Court’s Tentative Claim Construction Order. At the outset, Google wishes to make clear that it
 28 agrees with much of this Court’s reasoning and considers many of the claim constructions to be

1 favorable. To the extent that this Court’s claim constructions differ from Google’s, Google
2 continues to believe that its proposed claim constructions were correct and that this Court should
3 adopt them for reasons previously stated. Pursuant to the Court’s invitation, Google hereby
4 submits the following limited critique of the Court’s tentative constructions:
5

6 **I. Reduced Class File**

7 The Court’s construction that a “reduced class file” is “what remains after one or more
8 duplicated elements have been removed from a class file” is consistent with the idea behind
9 Google’s proffered construction – i.e., the structure of the original “class file” that is not affected
10 by the “reduction” is preserved in the resulting “reduced class file.” Referring to the class file
11 depicted in Figure 3 of the patent (*see* Tentative Order at 9), Google understands that under the
12 Court’s construction, any non-reduced structures of the depicted class file will remain intact or
13 unmodified in the resulting “reduced class file.”

14 With respect to what it means to be “reduced” in this context, Google agrees with the
15 Court’s analysis “that reduced class files are obtained by removing one or more duplicated
16 elements from a plurality of class files that contain the same element or elements.” (Tentative
17 Order at 11.)
18

19 **II. The Play Executing Step**

20 Google has no critique of the Court’s construction, recognizing the Court’s power under
21 *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1354 (Fed. Cir. 2003), to correct claims
22 even when they may be perceived as sloppily drafted. However, Google reserves its objection to
23 the validity of these claims as presently construed. Should either of the two affected claims
24 persist through trial, Google reserves the right to challenge these claims under 35 U.S.C. § 101,
25 § 112, ¶ 1, and § 112, ¶ 4. Briefly, claims 3 and 4 (which are dependent on claim 1) embody a
26 contradiction by calling for the performance (or execution) of actions required by the byte code,
27 while claim 1 explicitly recites that the byte code is not executed. Accordingly, these claims not
28 only are indefinite, but also lack utility under 35 U.S.C. § 101 because they are inoperable. In
addition, the limitations in claims 3 and 4 do not further limit claim 1 – since carrying out steps
of execution does not limit the antecedent requirement that the method be “without execution” –

1 in violation of 35 U.S.C. § 112, ¶ 4. Finally, a method that requires performance of execution
2 steps, while at the same time also forbidding them, does not find support in the specification of
3 the ‘520 patent under 35 U.S.C. § 112, ¶ 1.

4 **III. Intermediate Form Object Code**

5 Google has no critique of the Court’s tentative construction, separate from the reasons
6 urging the Court to adopt its proposed construction.

7 Contrary to Oracle’s assertions, the tentative construction does not dispense with
8 Google’s prior art references. Moreover, Google reserves its objections on the issue of whether
9 an “intermediate representation” is or can be executable.

10 **IV. Symbolic [data / field] Reference**

11 Google has no critique of the Court’s tentative construction of “symbolic reference.” We
12 also note that the Court’s understanding of the term “numeric reference” is consistent with
13 Google’s understanding and supports Google’s non-infringement position relating to certain
14 claims of the ‘104 patent. Google expects that this additional guidance by the Court may aid the
15 process of reducing the number of claims asserted at trial.

16 **V. Resolve / Resolving**

17 Google has no critique of the Court’s tentative construction. The tentative construction
18 clarifies that the “resolving” steps of the ‘104 patent claims are not novel. As counsel for Oracle
19 admitted during the *Markman* hearing, this “resolving” – i.e., “at least determining a numerical
20 memory-location reference that corresponds to the symbolic reference” – reads on the prior art.
21 *See* April 20, 2011 Transcript at 69:11-15 (“**THE COURT:** But you still agree that the red,
22 highlighted language there -- that was in the prior art? **MR. JACOBS:** Resolving symbolic
23 references in instructions by determining numerical references? **THE COURT:** Yes. **MR.**
JACOBS: On a stand-alone, basis? Yes.”).

24 **VI. Computer Readable Medium (and Related Terms)**

25 Although Google respectfully submits, and believes that Oracle agrees, that these terms
26 by their nature transcend the subject matter of the individual patents and are susceptible to a
27 consistent construction, Google appreciates the Court’s view that the parties’ agreement to
28 construe all of these terms as one term may not be appropriate in light of the differing technology
and filing dates of the respective patents. These claim terms were originally identified for

1 construction by Oracle, in order to avoid subject matter invalidity. However, at least for the
2 patents where the term “computer readable medium” is expressly defined, no construction should
3 be necessary. To the extent any such “computer readable medium” claims remain in the case
4 after the asserted claims are dropped according to a process the Court may order, Google would
5 seek the Court’s leave, at an appropriate time, to move for summary judgment of invalidity of the
6 “computer readable medium” claims under 35 U.S.C. § 101.

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