

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

[Counsel Signatures Appear at the End]

**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

Honorable Judge William Alsup

**JOINT MEMORANDUM REGARDING
THE COURT'S TENTATIVE CASE PLAN**

1 Plaintiff Oracle America, Inc. ("Oracle") and Defendant Google Inc. ("Google") present
2 their views on the Court's May 11, 2011 Notice re Tentative Case Plan. As directed, the parties
3 engaged in a meet and confer, during which the parties reached agreement on some points and
4 remain in disagreement on others. This memorandum summarizes these points of agreement and
5 outstanding disputes.

6 **I. Agreed Points**

- 7 1. The current fact discovery cut-off remains in effect, and the parties shall conduct
8 discovery and file motions with the assigned Magistrate-Judge accordingly.
- 9 2. By June 1, 2011, Oracle shall narrow its patent infringement case to no more than 50
10 asserted claims.
- 11 3. By June 15, 2011, Google shall narrow its invalidity case to no more than six grounds
12 of invalidity per asserted claim. A reference or set of references setting forth an
13 anticipation or obviousness theory shall be counted by "chart" pursuant to Patent
14 L.R. 3-3(c) (*i.e.*, anticipation by a reference shall be counted as one ground for
15 purposes of this paragraph; references setting forth an obviousness combination shall
16 be counted as another ground). Other grounds shall be counted by stated legal theory,
17 e.g., "enablement," "lack of written description," "improper broadening."
- 18 4. The Court will entertain a summary judgment motion by Google on the copyright
19 issue, and Oracle may seek the Court's leave to file a summary judgment motion on
20 copyright issues as well. Briefing on copyright issues will adhere to the following
21 schedule:
 - 22 a. Opening brief(s) on August 1, 2011;
 - 23 b. Opposition brief(s) on August 19, 2011; and
 - 24 c. Reply briefs on August 29, 2011.
- 25 5. Other summary judgment motions will be entertained only upon obtaining leave
26 pursuant to the Court's previous order to that effect.
- 27 6. The trial remains set to begin on October 31. The trial, addressing all issues, will last
28 for three weeks.

1 **II. Disputed Issues**

2 The parties could not reach agreement on the following issues:

3 **A. Final Number of Claims and Defenses for Trial**

4 7a. Oracle's proposal: By September 1, 2011, or no later than 15 days after a ruling
5 on any pending patent-related summary judgment motions allowed pursuant to
6 paragraph 5 above, whichever is later, Oracle shall narrow its patent infringement
7 case to no more than 21 asserted claims. By no later than 15 days after Oracle's
8 narrowing of claims pursuant to this paragraph, Google shall narrow its invalidity
9 case to no more than four grounds of invalidity per claim. In the alternative,
10 Oracle proposes that any narrowing of claims to be asserted at trial be addressed
11 by the parties in papers submitted in connection with the final pre-trial
12 conference. Oracle opposes any other approach to narrowing its asserted claim on
13 the grounds set forth in its response to the Court's May 4, 2011 Order.

14 7b. Google's proposal: Google believes that the Court's initial plan for narrowing the
15 claims makes the case more manageable for the Court and the jury, and is the best
16 use of judicial resources. Google proposed a compromise of 10 to 14 claims to be
17 asserted by Oracle (upon which the parties could not reach agreement) and
18 believes the Court has the authority to limit the number of claims asserted to one
19 claim per patent without depriving Oracle of due process in asserting its claims.
20 *See In re Katz Interactive Call Processing Patent Lit.*, Case No. 2009-1450 et al.,
21 97 U.S.P.Q.2d 1737, 1744-45, 2011 WL 607381, *4, (Fed. Cir. Feb. 18, 2011)
22 (rejecting plaintiff's argument that district court's narrowing of claims for trial
23 violated due process). Google otherwise agrees that no later than 15 days after
24 Oracle's narrowing of claims pursuant to this paragraph, Google shall narrow its
25 invalidity case to no more than four grounds of invalidity per claim.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

B. Stay Pending Resolution of Reexamination Proceedings

8a. Oracle's proposal: Pursuant to the Court's May 11, 2011 Notice re Tentative Case Plan, no stay will be granted pending reexamination. Oracle will bear the risk of subsequent adverse events in reexamination pursuant to applicable law.

8b. Google's proposal: To the extent that Oracle intends to assert a large number of claims at trial, resulting in a complicated and extremely burdensome trial, Google defers to the Court's discretion to grant a stay pending reexamination. In the event that there is no stay, Oracle will take the risk that claims selected for trial will be cancelled or modified during re-examination

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

FILER'S ATTESTATION

I, Michael A. Jacobs, am the ECF user whose identification and password are being used to file this JOINT MEMORANDUM REGARDING THE COURT'S TENTATIVE CASE PLAN. In compliance with General Order 45.X.B, I hereby attest that Scott T. Weingaertner concurs in this filing.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

DATED: May 18, 2011

MORRISON & FOERSTER LLP

By: /s/ Michael A. Jacobs

MICHAEL A. JACOBS (Bar No. 111664)
mjacobs@mofoc.com
MARC DAVID PETERS (Bar No. 211725)
mdpeters@mofoc.com
DANIEL P. MUINO (Bar No. 209624)
dmuino@mofoc.com
755 Page Mill Road
Palo Alto, CA 94304-1018
Telephone: (650) 813-5600
Facsimile: (650) 494-0792

BOIES, SCHILLER & FLEXNER LLP
DAVID BOIES (Admitted Pro Hac Vice)
dboies@bsflp.com
333 Main Street
Armonk, NY 10504
Telephone: (914) 749-8200
Facsimile: (914) 749-8300
STEVEN C. HOLTZMAN (Bar No. 144177)
sholtzman@bsflp.com
1999 Harrison St., Suite 900
Oakland, CA 94612
Telephone: (510) 874-1000
Facsimile: (510) 874-1460

ORACLE CORPORATION
DORIAN DALEY (Bar No. 129049)
dorian.daley@oracle.com
DEBORAH K. MILLER (Bar No. 95527)
deborah.miller@oracle.com
MATTHEW M. SARBORARIA (Bar No. 211600)
matthew.sarboraria@oracle.com
500 Oracle Parkway
Redwood City, CA 94065
Telephone: (650) 506-5200
Facsimile: (650) 506-7114

Attorneys for Plaintiff
ORACLE AMERICA, INC.

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

KING & SPALDING LLP

By: /s/ Scott T. Weingaertner

SCOTT T. WEINGAERTNER (*Pro Hac Vice*)
sweingaertner@kslaw.com
ROBERT F. PERRY
rperry@kslaw.com
BRUCE W. BABER (*Pro Hac Vice*)
bbaber@kslaw.com
1185 Avenue of the Americas
New York, NY 10036-4003
Telephone: (212) 556-2100
Facsimile: (212) 556-2222

DONALD F. ZIMMER, JR. (SBN 112279)
fzimmer@kslaw.com
CHERYL A. SABNIS (SBN 224323)
csabnis@kslaw.com
KING & SPALDING LLP
101 Second Street – Suite 2300
San Francisco, CA 94105
Telephone: (415) 318-1200
Facsimile: (415) 318-1300

IAN C. BALLON (SBN 141819)
ballon@gtlaw.com
HEATHER MEEKER (SBN 172148)
meekerh@gtlaw.com
GREENBERG TRAUIG, LLP
1900 University Avenue
East Palo Alto, CA 94303
Telephone: (650) 328-8500
Facsimile: (650) 328-8508

Attorneys for Defendant
GOOGLE INC.