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UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF CALIFORNIA  
SAN FRANCISCO DIVISION

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11 ORACLE AMERICA, INC.

CASE NO. CV 10-03561 WHA (DMR)

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Plaintiff,

**STIPULATION AND ~~PROPOSED~~  
ORDER REGARDING ORACLE  
AMERICA, INC.'S FIRST  
AFFIRMATIVE DEFENSE –  
ASSIGNOR ESTOPPEL**

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v.

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GOOGLE INC.

Judge: Honorable William H. Alsup

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Defendant.

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**STIPULATION**

WHEREAS, Oracle in its Amended Complaint alleged that “Android (including without limitation the Dalvik VM and the Android software development kit) and devices that operate Android infringe one or more claims of each of United States Patents Nos. 6,125,447; 6,192,476; 5,966,702; 7,426,720; RE38,104; 6,910,205” (Dkt. No. 36);

WHEREAS, Google in its Answer to Oracle’s Amended Complaint and Amended Counterclaims alleged the invalidity of the seven patents-in-suit (Dkt. No. 51);

WHEREAS, Oracle in its Answer to Google’s Amended Counterclaims alleged that the doctrine of assignor estoppel barred Google’s assertion of invalidity based on Google’s employment of and being in privity with some of the inventors of the seven patents-in-suit (Dkt. No. 60);

WHEREAS, Google filed a précis letter seeking leave of the Court to file a motion for partial summary judgment on Oracle America, Inc.’s First Affirmative Defense of assignor estoppel (Dkt. No. 309);

WHEREAS, evidence obtained in discovery taken to date shows that Google employs or has employed James Gosling, named inventor of U.S. Reissue Patent No. RE38,104; Frank Yellin, a named inventor of U.S. Patent No. 6,061,520; and Lars Bak and Robert Greisemer, named inventors of U.S. Patent No. 6,910,205;

WHEREAS, based on evidence obtained in discovery taken to date, it appears that none of James Gosling, Frank Yellin, Lars Bak, and Robert Greisemer are an executive, officer, or substantial shareholder of Google and that none provided substantial “knowledge and assistance to develop any aspects of the accused Dalvik Virtual Machine or of the Android SDK that allegedly infringe the patents that those inventors assigned to Sun,” as Google wrote in its précis letter;

WHEREAS, Google argued in its précis letter that “[a]ssignor estoppel would be appropriate only if Google’s alleged infringement depended upon the engineers’ knowledge and assistance;”

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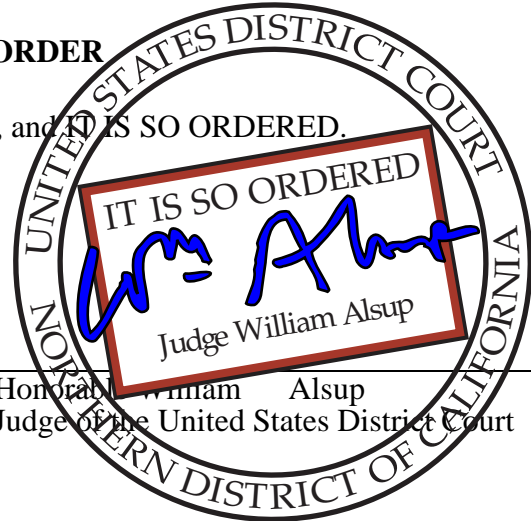
WHEREAS, the Court granted Google leave to file a motion for partial summary judgment on plaintiff’s affirmative defense of assignor estoppel, but also noted that “Plaintiff’s counsel remain free to negotiate a stipulated resolution of this issue.” (Dkt. No. 325.)

**NOW THEREFORE THE PARTIES HEREBY STIPULATE AND AGREE** that:

1. Oracle’s First Affirmative Defense (Assignor Estoppel) as against Google Inc. shall be dismissed with prejudice.

**ORDER**

The foregoing stipulation is approved, and **IT IS SO ORDERED.**



Date: September 6, 2011.

Honorable William Alsup  
Judge of the United States District Court

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Dated: September 2, 2011

MORRISON & FOERSTER LLP

By: /s/ Marc David Peters

MORRISON & FOERSTER LLP  
MICHAEL A. JACOBS (Bar No. 111664)  
mjacobs@mofo.com  
MARC DAVID PETERS (Bar No. 211725)  
mdpeters@mofo.com  
DANIEL P. MUINO (Bar No. 209624)  
dmuino@mofo.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.

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Dated: September 2, 2011

KEKER & VAN NEST LLP

By: /s/ Matthias Kamber

KEKER & VAN NEST LLP  
ROBERT A. VAN NEST (SBN 84065)  
rvannest@kvn.com  
CHRISTA M. ANDERSON (SBN184325)  
canderson@kvn.com  
710 Sansome Street  
San Francisco, CA 94111-1704  
Telephone: (415) 391-5400  
Facsimile: (415) 397-7188

KING & SPALDING LLP  
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

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

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

*Attorneys for Defendant*  
GOOGLE INC.

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**ATTESTATION**

I, Matthias Kamber, am the ECF User whose ID and password are being used to file this STIPULATION AND [PROPOSED] ORDER REGARDING ORACLE AMERICA, INC.'S FIRST AFFIRMATIVE DEFENSE – ASSIGNOR ESTOPPEL. In compliance with General Order 45, X.B., I hereby attest that Marc David Peters and Matthias Kamber have concurred in this filing.

Date: September 2, 2011

/s/ Matthias Kamber