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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. CV 10-03561 WHA

**ORACLE AMERICA, INC.'S
 MOTION IN LIMINE NO. 1 TO
 EXCLUDE EVIDENCE OR
 ARGUMENT REGARDING
 PATENT REEXAMINATIONS**

Dept.: Courtroom 8, 19th Floor
 Judge: Honorable William H. Alsup

Oracle moves the Court to preclude Google from introducing any evidence or argument regarding the pending, non-final reexaminations of six of the patents-in-suit. The existence and status of these non-final proceedings is irrelevant to the matters in this case. Any reference to them at trial would be highly prejudicial and is likely to create juror confusion. Under Rule 403, the Court should preclude Google from offering any evidence or argument regarding these non-final patent reexaminations.

I. REEXAMINATIONS OF THE PATENTS-IN-SUIT

In early 2011, Google filed requests for reexamination of each of the patents-in-suit. In March and April 2011, the PTO ordered reexaminations for all of the patents. The PTO subsequently issued office actions for all but the '104 patent.

For the '520 patent, the claims that Oracle is asserting against Google in this case were all confirmed patentable over the cited prior art. That proceeding is now concluded, except for the issuance of the reexamination certificate. For the other six patents, the reexaminations are still pending: (1) no office action has yet issued for the '104 patent; (2) the '447, '476, and '702 *ex parte* reexaminations are awaiting further office actions from the PTO, following Oracle's responses filed in those actions; (3) the '720 *inter partes* reexamination is awaiting a further office action following responses from both Oracle and Google; and (4) the '205 *inter partes* reexamination is awaiting Oracle's response to the PTO's office action. The chart below summarizes the current status of these reexaminations:

Patent No. (type of reexam)	Reexam Ordered	Office Action Issued	Oracle Response Due / Filed	Google Response Due / Filed	Asserted Claims Currently Rejected	Asserted Claims Allowed	Status
6,125,447 (ex parte)	3/23/11	6/29/11	8/29/11	n/a	All (10, 11)		Non-final; awaiting second PTO office action
6,192,476 (ex parte)	3/23/11	6/16/11	9/16/11	n/a	All (13, 14, 15)		Non-final; awaiting second PTO office action
5,966,702 (ex parte)	3/23/11	6/6/11	9/6/11	n/a	All (1, 6, 7, 12, 13, 15, 16)		Non-final; awaiting second PTO office action

1	7,426,720 (inter partes)	4/18/11	5/5/11	7/5/11	8/4/11	All (1, 4, 6, 10, 13, 19, 21, 22)	Non-final; awaiting second PTO office action
2							
3	RE38,104 (ex parte)	3/28/11	pending				Non-final; awaiting PTO office action
4							
5	6,910,205 (inter partes)	4/14/11	8/19/11	10/19/11	11/18/11	All (1, 2, 3)	Non-final; Oracle to respond to office action
6							
7	6,061,520 (ex parte)	3/23/11	6/23/11	8/24/11	n/a	All (1, 4, 8, 12, 14, 20)	Final; reexam certificate to issue
8							
9							

10 **II. ARGUMENT**

11 **A. The Non-Final Reexaminations Of The Patents-in-Suit Have No
12 Probative Value**

13 Federal courts have routinely relied on Federal Rule Evidence 403 to exclude evidence at
14 trial regarding co-pending, non-final reexaminations of the patents at issue, on the grounds that
15 such reexamination proceedings are not probative of patent invalidity and are highly likely to
16 confuse the jury. *See, e.g., SRI Int'l Inc. v. Internet Sec. Sys., Inc.*, 647 F. Supp. 2d 323, 356 (D.
17 Del. 2009) (“Absent unusual circumstances . . . non-final decisions made during reexamination
18 are not binding, moreover, they are more prejudicial (considering the overwhelming possibility of
19 jury confusion) than probative of validity”); *i4i Ltd. P’ship v. Microsoft Corp.*, 670 F. Supp. 2d
20 568, 583 (E.D. Tex. 2009) (“As explained elsewhere in this opinion, the simple fact that a
21 reexamination decision has been made by the PTO is not evidence probative of any element
22 regarding any claim of invalidity. . . . Even if it were, the evidence was substantially more
23 prejudicial than probative”); *Amphenol T & M Antennas, Inc. v. Centurion Int’l, Inc.*, No. 00 C
24 4298, 2002 U.S. Dist. LEXIS 822, at *5 (N.D. Ill. 2002).

25 A non-final patent reexamination proceeding, of course, is not probative of invalidity or
26 unpatentability. *Procter & Gamble Co. v. Kraft Foods Global, Inc.*, 549 F.3d 842, 848 (Fed. Cir.
27 2008) (“As this court has observed, a requestor’s burden to show that a reexamination order
28 should issue from the PTO is unrelated to a defendant’s burden to prove invalidity by clear and

1 convincing evidence at trial.”) (citation omitted); *Hoechst Celanese Corp. v. BP Chems., Ltd.*, 78
2 F.3d 1575, 1584 (Fed. Cir. 1996) (“[T]he grant by the examiner of a request for reexamination is
3 not probative of unpatentability”); *Volterra Semiconductor Corp. v. Primarion, Inc.*, No. C-08-
4 05129 JCS, 2011 U.S. Dist. LEXIS 49574, at *24 (N.D. Cal. Mar. 8, 2011) (“With respect to the
5 PTO Initial Office Actions and reexamination orders, ... preliminary decisions and actions by the
6 PTO in the course of a reexamination proceeding are not probative of invalidity”). When office
7 actions and party responses are still pending, any interim rejections of patent claims are not
8 indicative of an ultimate finding of invalidity. *Id.*

9 Nor are the non-final reexaminations relevant to rebutting the charges of willful
10 infringement and intent to induce infringement. The initiation of a reexamination proceeding
11 does not exculpate an infringer from a finding of willfulness. *Hoechst*, 78 F.3d at 1583-84
12 (finding that the grant of a request for reexamination is not dispositive of willfulness). Moreover,
13 even if the reexaminations were relevant to willfulness and intent, the prejudicial effect of
14 disclosing them to the jury would vastly outweigh any probative value. *See Presidio Components*
15 *Inc. v. Am. Tech. Ceramics Corp.*, No. 08-CV-335-IEG (NLS), 2009 U.S. Dist. LEXIS 106795, at
16 *5 (S.D. Cal. Nov. 13, 2009) (“[E]ven if the reexamination proceedings are somehow relevant on
17 the issues of obviousness or willfulness, they are nevertheless unfairly prejudicial”) (citation
18 omitted); Declaration of Daniel P. Muino in Support of Oracle America, Inc.’s Motions *In Limine*
19 Nos. 1 Through 5 (“Muino Decl.”), Exhibit A, *Realtime Data, LLC v. Packeteer, Inc.*, No. 6:08-
20 cv-144-LED-JDL, (E.D. Tex. Dec. 30, 2009), ECF No. 805 at 4 (“[A]lthough an ongoing
21 reexamination proceeding and the USPTO’s actions therein could be considered by the Court as a
22 factor in a willfulness determination at the summary judgment stage, during trial in a request for
23 judgments as a matter of law as to willful infringement, and/or post-verdict, it should not be
24 introduced before the jury due to the highly prejudicial effect the USPTO’s actions would have on
25 the jury”); Muino Decl. Exhibit B, *Intel Corp. v. Commonwealth Scientific & Indus. Research*
26 *Org.*, No. 6:06-cv-551 (E.D. Tex. Apr. 9, 2009), ECF No. 518 at 4 (“[W]ithout any conclusions
27 of the PTO to rely upon, evidence that the PTO is currently reexamining the patent may work to
28

1 unduly alleviate Defendants’ ‘clear and convincing’ burden for both invalidity and willfulness in
2 front of the jury”).

3 **B. Reference To The Non-Final Reexaminations At Trial Would Be**
4 **Highly Prejudicial And Likely To Confuse The Jury**

5 Any reference to the non-final reexaminations in front of the jury would be prejudicial to
6 Oracle, as it would create a high likelihood of confusing and misleading the jury regarding the
7 validity of the patents. *See Boston Scientific Corp. v. Cordis Corp.*, No. 10-315-SLR, 2011 U.S.
8 Dist. LEXIS 46210, at *1-2 (D. Del. Apr. 28, 2011) (“It is generally not the court’s practice to
9 admit the reexamination record as trial evidence. Rejections on reexamination are not binding,
10 and such evidence is almost always more prejudicial than probative.”). Oracle’s patents are
11 entitled to a presumption of validity and may only be invalidated based on clear and convincing
12 evidence. *See Microsoft Corp. v. i4i Ltd. P’ship*, 131 S. Ct. 2238 (2011) (applying the clear and
13 convincing standard to all prior art references regardless of their use in initial examination); *z4*
14 *Techs., Inc. v. Microsoft Corp.*, 507 F.3d 1340, 1354 (Fed. Cir. 2007) (invalidity must be shown
15 by clear and convincing evidence). The jury will be instructed on this standard. Informing the
16 jury that the PTO is reexamining the patents may cause jurors to erroneously conclude that the
17 patents are invalid or no longer entitled to a presumption of validity. *See Amphenol*, 2002 U.S.
18 Dist. LEXIS 822, at *5 (“[T]elling the jury that the patent has been called into question by the
19 Patent Office may significantly influence the jury’s application of the presumption of validity and
20 significantly prejudice [the patentee]. The prejudicial potential of this evidence far outweighs any
21 probative value it may have.”). Jurors may well mistake the PTO’s interim rejections of certain
22 patent claims as indicative of the government’s final position on the validity of those claims.

23 Moreover, if the jury were informed of the non-final reexaminations, the parties and the
24 Court would be obliged to explain the PTO’s reexamination procedures to the jury so as to
25 mitigate confusion. This may lead to disputes on how to characterize the reexamination process
26 and how to explain the substantive positions taken by the parties and the PTO in the
27 reexaminations. Such disruption will be avoided if references to the non-final reexaminations are
28 precluded.

1 In an analogous situation, this Court excluded argument regarding the prosecution
2 histories of certain trademark applications, including non-final Office Actions, in *Autodesk, Inc.*
3 *v. Dassault Systèmes Solidworks Corp.*, No. 3:08-cv-04397-WHA (N.D. Cal. Dec. 23, 2009),
4 ECF No. 209. (Muino Decl. Exhibit C.) In that case, Autodesk moved in limine to exclude
5 evidence or argument regarding these materials on the grounds that their introduction would be
6 prejudicial and likely to confuse the jury. (*Id.*) The Court precluded mention of the non-final
7 office actions and other prosecution filings during opening statements. (Muino Decl. Exhibit D,
8 *Autodesk*, ECF No. 240 at 52-53 (Dec. 31, 2009).)

9 **III. CONCLUSION**

10 The non-final reexaminations are not probative of invalidity or any other issues of
11 relevance to this case. Permitting their introduction creates a high risk of confusing and
12 misleading the jury. Pursuant to Federal Rule Evidence 403, Oracle requests that the Court
13 preclude Google from offering any argument or evidence at trial regarding the six non-final
14 reexaminations of the patents-in-suit.

15
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18
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