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ROBERT A. VAN NEST - #84065
rvannest@kvn.com
CHRISTA M. ANDERSON - #184325
canderson@kvn.com
KEKER & VAN NEST LLP
633 Battery Street
San Francisco, CA 94111-1704
Telephone: (415) 391-5400
Facsimile: (415) 397-7188

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

Attorneys for Defendant
GOOGLE INC.

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

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

**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

**GOOGLE’S OPPOSITION TO
ORACLE’S MOTION *IN LIMINE* NO. 2
TO EXCLUDE EVIDENCE OR
ARGUMENT THAT GOOGLE RELIED
ON LEGAL ADVICE IN MAKING ITS
DECISIONS TO DEVELOP AND
RELEASE ANDROID**

Judge: Hon. William Alsup

Date Comp. Filed: October 27, 2010

Trial Date: October 31, 2011

1 Oracle moves *in limine* for the Court to preclude Google from generally relying on advice
2 of counsel to rebut allegations of willful patent and copyright infringement and intent to induce
3 patent infringement, but then leaps to the conclusion that the Court should broadly exclude any
4 evidence or argument whatsoever that Google relied on *any* legal advice in deciding to develop
5 and release Android. Such a categorical request disregards the Court’s September 2, 2011 Order
6 Regarding Pretrial Filings (Dkt. No. 384), which unambiguously states that the parties’ motions
7 *in limine* “must be directed at excluding specific items of evidence; categorical motions and
8 disguised summary judgment motions are highly disfavored.” Regardless, Oracle’s motion far
9 exceeds requesting the exclusion of “specific items of evidence” relating to issues of willfulness
10 and inducement. Accordingly, Oracle’s Motion *In Limine* No. 2 should be denied.

11 **A. Oracle’s motion should be denied as moot because Google does not rely on an**
12 **advice-of-counsel defense with respect to willfulness or inducement**

13 At least with respect to its allegations of willfulness and inducement, Oracle’s Motion *In*
14 *Limine* No. 2 should be denied as moot. There is no evidence to suggest that Google even relies
15 on advice of counsel as a defense to willful patent infringement or inducing patent
16 infringement.¹ (And lest there be any confusion—Google does not.) Thus, there’s no related
17 evidence to exclude.

18 **B. Oracle seeks to expand Patent Local Rule 3-7 to exclude any evidence of any**
19 **advice of counsel related to the development of Android**

20 Oracle asks this Court not just to exclude evidence regarding advice of counsel to defend
21 a willfulness or inducement charge, but to exclude *all* evidence concerning *any* advice of
22 counsel. Specifically, Oracle relies on Patent L.R. 3-7, which provides for the production of any
23 written advice and documents and written summaries of any oral advice and related documents
24 *for which the attorney-client and work product protection have been waived*. But Oracle points
25 to no evidence for which it believes Google’s privilege assertions would have been waived on

26 _____
27 ¹ In fact, Google never had a reason to seek advice of counsel prior to July 209, 2010, as that was
28 the first time Oracle gave Google notice of those patents

1 account of potential reliance on advice of counsel to defend against the willfulness and
2 inducement charges.

3 To the contrary, the cases cited by Oracle provide no support for entirely and
4 categorically precluding Google from demonstrating that Google operated based on the advice of
5 counsel in connection with other issues—i.e., the general development of Android—having
6 nothing to do with Google’s rebuttal of Oracle’s willfulness and inducement allegations. Indeed,
7 even Oracle acknowledges that the cases that it cites solely relate to reliance on advice of counsel
8 with respect to issues of willfulness and/or inducement; they do not support such a blanket and
9 categorical exclusion of evidence related to advice of counsel generally.

10 **C. Conclusion**

11 In the face of the Court’s Order Regarding Pretrial Filings, which strongly discouraged
12 “categorical motions and disguised summary judgment motions,” Oracle has presented a motion
13 *in limine* that seeks to broadly preclude Google from presenting at trial an entire category of
14 evidence. Google has not relied on the advice of counsel as a defense to willfulness and
15 inducement because it is clear from the record that Google had no notice of the specific asserted
16 patents and no knowledge that its activities constituted infringement of the patents- and
17 copyrights-in-suit (for which it would have sought such advice) until just weeks before the
18 lawsuit. Oracle’s improper attempt to extend a moot point to categorically preclude Google’s
19 overall reliance on advice of counsel in the overall development of Android is unwarranted and
20 should be denied.

21
22 Dated: October 4, 2011

KEKER & VAN NEST LLP

23 By: s/ Robert A. Van Nest
24 ROBERT A. VAN NEST
25 Attorneys for Defendant
26 GOOGLE INC.
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