

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

KEKER & VAN NEST LLP
ROBERT A. VAN NEST - #84065
rvannest@kvn.com
CHRISTA M. ANDERSON - #184325
canderson@kvn.com
633 Battery Street
San Francisco, CA 94111-1809
Telephone: 415.391.5400
Facsimile: 415.397.7188

KING & SPALDING LLP
DONALD F. ZIMMER, JR. - #112279
fzimmer@kslaw.com
CHERYL A. SABNIS - #224323
csabnis@kslaw.com
101 Second St., Suite 2300
San Francisco, CA 94105
Tel: 415.318.1200
Fax: 415.318.1300

KING & SPALDING LLP
SCOTT T. WEINGAERTNER (*Pro Hac Vice*)
sweingaertner@kslaw.com
ROBERT F. PERRY
rperry@kslaw.com
BRUCE W. BABER (*Pro Hac Vice*)
1185 Avenue of the Americas
New York, NY 10036
Tel: 212.556.2100
Fax: 212.556.2222

IAN C. BALLON - #141819
ballon@gtlaw.com
HEATHER MEEKER - #172148
meekerh@gtlaw.com
GREENBERG TRAUIG, LLP
1900 University Avenue
East Palo Alto, CA 94303
Tel: 650.328.8500
Fax: 650.328-8508

Attorneys for Defendant
GOOGLE INC.

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. 3
TO PRECLUDE GOOGLE FROM
OFFERING EVIDENCE OR ARGUMENT
THAT THIRD-PARTY OEMS CHANGED
INFRINGEMENT COMPONENTS OF
ANDROID**

Judge: Hon. William Alsup

Date Comp. Filed: October 27, 2010

Trial Date: October 31, 2011

1 accused Dalvik Virtual Machine.¹ (*Id.* at 44:7-12; 77:25-78:4.) Google showed all its cards and
2 hid nothing.

3 Having been aware of this issue since early in discovery, Oracle could (and should) have
4 obtained the HTC and Samsung versions of Android source code via subpoena, or taken
5 depositions of HTC and Samsung employees regarding their modifications to Android code.
6 Oracle did neither. It appears that Oracle did not even bother to purchase the accused devices at
7 the outset of the case to determine how they operate. As a result, Oracle simply failed to – and
8 indeed *declined to* – collect any reliable evidence that the accused third party devices contain and
9 execute the accused Android code.

10 ***II. Oracle Bears The Burden to Proof***

11 It is not Google’s burden to prove that the accused devices do not utilize the allegedly
12 infringing Android source code, rather, it is *Oracle’s burden* to prove that each accused device
13 utilizes the allegedly infringing code. *See DSU Medical Corp. v. JMS Co., Ltd.*, 471 F.3d 1293,
14 1303 (Fed. Cir. 2006) (“the patentee always has the burden to show direct infringement *for each*
15 *instance of indirect infringement.*” (emphasis added, citations omitted); *Fujitsu Ltd. v. Belkin*
16 *Intern., Inc.*, --- F. Supp. 2d ----, 2011 WL 1196417 (N.D. Cal. 2011) (“As with induced
17 infringement, a plaintiff must also show direct infringement by a third party in order to succeed
18 on a claim of contributory infringement.” (citing *Anton/Bauer, Inc. v. PAG, Ltd.*, 329 F.3d 1343,
19 1349 (Fed. Cir. 2003) (holding that the plaintiff must prove that the end users directly infringed
20 its patent in order to succeed on its claim of contributory infringement))).

21 Oracle largely failed to provide infringement contentions, expert reports or any other
22 evidence to support all of its indirect infringement allegations. For example, Oracle’s expert
23 report on patent infringement only addresses indirect infringement allegations with respect to just
24 three of the devices identified in Oracle’s infringement contentions (the HTC Nexus One, HTC
25 Nexus S, and Samsung Captivate). (*See* Mullen Decl. Ex. 4, Mitchell Report at ¶ 195; Mullen

26 ¹ Oracle’s suggestion that Google should have inserted Mr. Brady’s testimony into its
27 interrogatory response (Motion at 4) is entirely without merit, as Rule 26(e) explicitly provides
28 that a party need not supplement interrogatory responses with information otherwise made
known to the other party during the discovery process. Oracle certainly did not insert of all its

1 Decl. Ex. 5, ICs at § I.B.) Thus, Oracle has no evidence (to present at trial) of indirect
2 infringement with respect to any other devices. And even with respect to the three devices
3 addressed in Oracle’s expert report, the expert based his opinions upon unreliable circumstantial
4 evidence and presumptions that have been challenged in Google’s expert rebuttal reports.²

5 **III. Google Is Entitled To Challenge Oracle’s Arguments**

6 Google does not challenge the case law cited in Oracle’s Motion and agrees that parties
7 are generally not permitted to show up at trial with new information that was not disclosed
8 during discovery. But the issue here is very different because Oracle wants to show up at trial
9 without evidence of indirect infringement, offer up whatever argument it can muster (however
10 questionable), and then preclude Google from challenging any of Oracle’s positions so it can
11 evade its burden of proof. Oracle does not dispute the fact that third parties modify Android’s
12 source code before installing it in their devices. And *neither* party knows what particular
13 changes were made to the Android code before it was installed in the accused third party devices.

14 Simply based on the fact that Google does not know exactly how third parties have
15 modified the accused portions of Android source code, Oracle asks the Court to now preclude
16 Google “from offering any argument or evidence at trial that OEMs made changes to the
17 infringing components of the Android code installed on their devices.” (Motion at 5.) Oracle’s
18 position is untenable. Indeed, under this logic, Oracle should be equally barred from offering
19 any argument or evidence at trial that OEMs *use* Google’s version of allegedly infringing
20 Android code because Oracle has failed to present *any* evidence that third parties *did not* modify
21 those portions of code. Moreover, if Oracle’s position was indeed the law, every defendant that
22 denies knowledge of indirect patent infringement would be precluded from presenting a defense
23 at trial.

24 _____
employees’ deposition testimony into its own interrogatory responses.

25 ² Google also notes that the goal of Oracle’s Motion seems altogether pointless. According to
26 the Supreme Court in *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S.Ct. 2060, 2068-69 (2011),
27 a plaintiff must show that the alleged infringer had knowledge of the patent at issue and
28 knowledge that the third party product infringed on that patent to prove a claim for contributory
infringement (35 U.S.C. § 271(b)) or inducement (§ 271(c)). Oracle has no evidence for either
requirement, and its motion clearly recognizes as much with respect to the latter.

1 **IV. A Motion in Limine is Inappropriate for the Relief Oracle Seeks**

2 If Oracle’s position is that Google has no facts or evidence to counter its indirect
3 infringement claims, the proper approach would have been to move for summary judgment, not
4 raise it as a motion in limine. *See* Order (Dkt. No. 384) (The motions *in limine* must be directed
5 at excluding specific items of evidence; categorical motions and disguised summary judgment
6 motions are highly disfavored”); *see also* *Carpenter v. Forest Meadows Owners Ass’n*, No. 09-
7 cv-01918, 2011 U.S. Dist. LEXIS 82295 at *2 (E.D. Cal. July 26, 2011) (citing *C & E Services,*
8 *Inc. v. Ashland Inc.*, 539 F. Supp. 2d 316, 323 (D. D.C. 2008) (a motion in limine should not be
9 used as a substitute for a motion for summary judgment)). Oracle’s requested relief is
10 inappropriate because “a motion in limine should **not** be used to resolve factual disputes or
11 weigh evidence.” *Id.* (quoting *C & E Services*, 539 F. Supp. 2d at 323).

12 Motions in limine are generally intended for excluding *inadmissible* or *prejudicial*
13 evidence before it is actually offered at trial. *See* *Luce v. United States*, 469 U.S. 38, 40 n. 2
14 (1984); *see also* *Brodit v. Cabra*, 350 F.3d 985, 1004–05 (9th Cir. 2003). Oracle does not argue
15 that any particular Google argument or evidence is *inadmissible* or *prejudicial*, and in regard to
16 other disputes, “[c]ourts have recognized that it is almost always better situated during the actual
17 trial to assess the value and utility of evidence.” *Carpenter*, 2011 U.S. Dist. LEXIS 82295 at *1
18 (citing cases).

19 * * *

20 To the extent that Oracle presents its case based on conclusory expert opinions,
21 presumptions and speculations, Google should be fully entitled to challenge that house of cards
22 at trial, and Oracle has no legal basis to preclude Google from doing so. In filing this motion,
23 Oracle concedes that it has a serious evidentiary issue with respect to its indirect infringement
24 case, namely as a result of its fatal failure to obtain sufficient third party evidence during
25 discovery. Oracle’s Motion is simply a desperate attempt to prevent Google from pointing out
26 these glaring deficiencies at trial and should be denied.

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: October 4, 2011

Respectfully submitted,
KEKER & VAN NEST LLP

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