1 KEKER & VAN NEST LLP   KING & SPALDING LLP
   ROBERT A. VAN NEST - #84065   DONALD F. ZIMMER, JR. - #112279
2 rvannest@kvn.com   fzimmer@kslaw.com
   CHRISTA M. ANDERSON - #184325   CHERYL A. SABNIS - #224323
3 canderson@kvn.com   csabnis@kslaw.com
   MICHAEL S. KWUN - #198945   101 Second St., Suite 2300
4 mkwun@kvn.com   San Francisco, CA 94105
   633 Battery Street   Tel: 415.318.1200
5 San Francisco, CA 94111-1809   Fax: 415.318.1300
   Tel: 415.391.5400
6 Fax: 415.397.7188

7

8 KING & SPALDING LLP   IAN C. BALLON - #141819
   SCOTT T. WEINGAERTNER   ballon@gtlaw.com
9 (*Pro Hac Vice*)   HEATHER MEEKER - #172148
   sweingaertner@kslaw.com   meekerh@gtlaw.com
10 ROBERT F. PERRY   GREENBERG TRAURIG, LLP
   rperry@kslaw.com   1900 University Avenue
11 BRUCE W. BABER (*Pro Hac Vice*)   East Palo Alto, CA 94303
   1185 Avenue of the Americas   Tel: 650.328.8500
12 New York, NY 10036   Fax: 650.328.8508
   Tel: 212.556.2100
13 Fax: 212.556.2222

14 Attorneys for Defendant
   GOOGLE INC.
15

16

17   UNITED STATES DISTRICT COURT

18   NORTHERN DISTRICT OF CALIFORNIA

19   SAN FRANCISCO DIVISION

20 ORACLE AMERICA, INC.,   Case No. 3:10-CV-03561-WHA

21   Plaintiff,   **GOOGLE'S SUPPLEMENTAL
                                            COPYRIGHT LIABILITY TRIAL BRIEF
22   v.   PURSUANT TO MARCH 26, 2012 ORDER**

23 GOOGLE INC.,   Judge: Hon. William Alsup

24   Defendant.

25

26

27

28

GOOGLE'S SUPP. COPYRIGHT LIABILITY TRIAL BRIEF PURSUANT TO MARCH 26, 2012 ORDER
Case No. 3:10-CV-03561-WHA

640279.01

The Court has asked Google to address Oracle's contentions regarding an alleged field-of-use restriction and its purported applicability to the Apache Harmony project. As explained below, the Apache Software Foundation ("Apache") licenses Apache Harmony to the public without *any* field-of-use restrictions, and rejected Sun's attempt to impose such a limit on the use of Apache Harmony. Notwithstanding these facts, Sun has never sued Apache, and has never asserted that the use of the Apache Harmony libraries is conditioned on a field-of-use limitation. To the contrary, Jonathan Schwartz, Sun's CEO at the relevant times, has testified that Apache Harmony can be used for any purpose so long as the resulting product is not called "Java." There is no field-of-use restriction on the use of Apache Harmony. Oracle's field-of-use restriction argument is a red herring.

I. **The Apache Harmony project was launched in August 2005, and licensed without any field-of-use restrictions.**

In August 2005, Apache announced the Apache Harmony project, the goal of which was to create an open-source product compatible with J2SE. This project followed open-source efforts by other groups to achieve the same goal, such as GNU Classpath from the Free Software Foundation. Apache licenses Apache Harmony to the public for free under version 2 of the open source Apache License. This license does not have any field-of-use restrictions.[1]

II. **Apache never agreed to a field-of-use restriction, and Sun never objected to the use by Apache and others of the Java language APIs.**

Jonathan Schwartz, Sun's CEO from 2006 to 2010, testified that, absent a desire by Apache to call its Apache Harmony product "Java," Apache was free to offer its implementation of the Java language APIs for free, and others were free to use those implementations:

> Q. Were you generally familiar with how the Apache Harmony product worked?
>
> A. Yes.
>
> . . .
>
> Q. And based on your understanding, as long as users did not call their

---

[1] *See* Apache License, Version 2.0, *available at* http://www.apache.org/licenses/LICENSE-2.0.html. Version 2.0 of the General Public License, the open source license that governs use of GNU Classpath, similarly has no field-of-use restriction. *See* General Public License, Version 2.0, available at http://www.gnu.org/licenses/gpl-2.0.html.

1

640279.01

products Java, they were free to use the source code that Apache Harmony made available?

A. Yes.

Schwartz Depo. at 49:11-50:10; *see also id* at 47:17-23 ("It's a free world. . . . If they called it Java, we would be involved. If they didn't call it Java, then they could call it a Linux phone, they could call it a free phone or an open phone, that's up to them."). However, "In order to call your product Java, and in order to feature to the marketplace that you were a Java phone or a Java device and to get that brand, you needed to pass that the—the TCKs, the Testing [sic] Compatibility Kits." *Id.* at 46:17-21.

Starting in August 2006, Apache attempted to obtain from Sun a license to the J2SE 5.0 technology compatibility kit ("TCK"). The license *to the TCK* (i.e. to the suite of compatibility tests) that Sun offered to Apache would have limited the use of Apache Harmony to certain fields of use. Apache, however, never agreed to such a limitation.

In May 2007, with no TCK license in place for Apache Harmony, Schwartz publicly stated, "there is no reason that Apache cannot ship Harmony today." Trial Ex. 2341; Schwartz Depo. at 51:15-22. According to Schwartz, however, Apache "wanted, in fact, to be able to call Harmony Java. And we held firm and said no, that's our core value. If you want to call it Java, you can pay, you know, the fee to go run the test and compatibility kits, and that enable you to tell your customers that you actually had a licensed Java runtime. But absent that statement, they, you know, couldn't say that, and they were frustrated by it." Schwartz Depo. at 52:16-23.

In June 2007, Apache wrote an open letter to Sun, requesting a TCK license without a field-of-use restriction. That same month, in an effort spearheaded by Oracle Corporation, twelve signatories, including a Google Engineering VP, urged Schwartz to grant Apache an unencumbered TCK license. *See* Trial Ex. 2347. Sun, however, refused. Because Apache was unwilling to agree any field-of-use restriction, it *did not license* the TCK. As a result, Apache *did not agree to—and never has agreed to—a field-of-use limitation for Apache Harmony.*

The lack of a TCK license, however, did not prevent others from using Apache Harmony:

Q. Now I take it they could already use the Apache Harmony code for free; correct?

2

640279.01

1   A. Yes.

2   Q. And they could put that in a commercial product and sell it?

3   A. Yes.

4   . . .

5   Q. The one thing they couldn't do was call it Sun [sic]?

6   A. They could not call it Java.

7 Schwartz Depo. at 83:15-84:7. Even without a TCK license, "[a]nybody else who wanted to go

8 create their own runtime, whether it was Apache Harmony or GNU Classpath, was free to do so;

9 they just couldn't call it Java." *Id.* at 182:2-5. Mr. Schwartz will testify that commercial

10 products from IBM and Hewlett-Packard used the Apache Harmony implementation of the Java

11 language APIs without objection from Sun.

12 **III.   There is no field-of-use restriction for Apache Harmony.**

13   The dispute between Apache and Sun was about branding, and the ability to say that

14 Apache Harmony is Java compatible. The end result was that Apache *did not agree* to a field-of-

15 use restriction. Notwithstanding Apache's refusal to limit the field of use for Apache Harmony,

16 Sun never sued Apache. In fact, Sun's CEO has testified that *anyone* can use the Apache

17 Harmony code (and thus its implementation of the Java language API specifications)—so long as

18 it does not call its product "Java."

19   Finally, Google in any event does not call Android "Java." Google has used the term

20 "Java" in its nominative, non-brand sense to describe, for example, how developers can use the

21 free and open Java programming language to write applications for the Android platform. That,

22 however, is not an attempt to brand the Android product "Java." Indeed, Oracle's complaint

23 does not include a trademark infringement count. Oracle's field-of-use restriction argument is

24 irrelevant and should be rejected.

25 Dated: March 27, 2012   KEKER & VAN NEST LLP

26   /s/ Robert A. Van Nest
                                                    By: ROBERT A. VAN NEST
27

28   Attorneys for Defendant
                                                          GOOGLE INC.

GOOGLE'S SUPP. COPYRIGHT LIABILITY TRIAL BRIEF PURSUANT TO MARCH 26, 2012 ORDER
Case No. 3:10-CV-03561-WHA

640279.01