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 ORACLE AMERICA, INC.

19 UNITED STATES DISTRICT COURT
 20 NORTHERN DISTRICT OF CALIFORNIA
 21 SAN FRANCISCO DIVISION

22 ORACLE AMERICA, INC.

23 Plaintiff,

24 v.

25 GOOGLE INC.

26 Defendant.

Case No. CV 10-03561 WHA

**ORACLE AMERICA'S NOTICE OF
 MOTION AND MOTION FOR
 ADMINISTRATIVE RELIEF TO
 DEEM FACTS ADMITTED BY
 GOOGLE**

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

1 **NOTICE OF MOTION**

2 PLEASE TAKE NOTICE THAT Oracle America, Inc. (“Oracle”) will, and hereby does,
3 respectfully move for administrative relief to deem the following facts admitted for purposes of
4 trial:

- 5 1. Google has admitted that the 37 Java APIs meet the threshold for originality required
6 by the Constitution.
- 7 2. Google has admitted that the Java programming language is distinct from the Java
8 APIs and class libraries.
- 9 3. Google has admitted that the only way to demonstrate compatibility with the Java
10 specification is by meeting all of the requirements of Sun’s Technology Compatibility
11 Kit (“TCK”) for a particular edition of Sun’s Java.
- 12 4. Google has admitted: TCKs were only available from Sun, initially not available as
13 open source, were provided solely at Sun’s discretion, and included several
14 restrictions, such as additional licensing terms and fees. In essence, although
15 developers were free to develop a competing Java virtual machine, they could not
16 openly obtain an important component needed to freely benefit from Sun’s purported
17 open-sourcing of Java.
- 18 5. Google has admitted: Although Sun offered to open source the TCK for Java SE, Sun
19 included field of use (“FOU”) restrictions that limited the circumstances under which
20 Apache Harmony users could use the software that the Apache Software Foundation
21 created. Sun refused the ASF’s request for a TCK license without FOU restrictions.

22 This Motion is based on the accompanying Memorandum of Points and Authorities, Declaration
23 of Marc D. Peters, and the entire record in this case.
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1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I. INTRODUCTION**

3 Based upon Google’s concessions, Oracle moves for an order to deem the following
4 admitted for purposes of trial:

- 5 1. Google has admitted that the 37 Java APIs meet the threshold for originality required
6 by the Constitution.
- 7 2. Google has admitted that the Java programming language is distinct from the Java
8 APIs and class libraries.
- 9 3. Google has admitted that the only way to demonstrate compatibility with the Java
10 specification is by meeting all of the requirements of Sun’s Technology Compatibility
11 Kit (“TCK”) for a particular edition of Sun’s Java.
- 12 4. Google has admitted: TCKs were only available from Sun, initially not available as
13 open source, were provided solely at Sun’s discretion, and included several
14 restrictions, such as additional licensing terms and fees. In essence, although
15 developers were free to develop a competing Java virtual machine, they could not
16 openly obtain an important component needed to freely benefit from Sun’s purported
17 open-sourcing of Java.
- 18 5. Google has admitted: Although Sun offered to open source the TCK for Java SE, Sun
19 included field of use (“FOU”) restrictions that limited the circumstances under which
20 Apache Harmony users could use the software that the Apache Software Foundation
21 created. Sun refused the ASF’s request for a TCK license without FOU restrictions.

22 As shown below, Google has conceded these points, clearly and unequivocally. Google should
23 now be bound by those concessions for purposes of trial.

24 **II. ARGUMENT**

25 **A. Google has admitted that the 37 Java APIs are original under the
26 Constitution.**

27 “Google has admitted that the 37 Java APIs meet the threshold for originality required by
28 the Constitution.” The Court should deem the underlined statement admitted. Google stated in
its March 23 Reply Copyright Liability Trial Brief:

The [API] packages as a whole, however, are not completely lacking in originality.
Thus, while reserving the right to present evidence that many aspects of the APIs are
unoriginal, Google does not dispute that the APIs as a whole meet the “extremely
low” threshold for originality required by the Constitution. *The jury therefore need
not be asked to address whether the APIs are original.*

(ECF No. 823 at 9 (emphasis added).)

1 Google confirmed there is no dispute about the API's originality. Holding Google to its
2 concession now is appropriate. The parties have briefed copyright issues extensively. Google
3 made its concession deliberately. *See Leorna v. United States*, 105 F.3d 548, 551 n.2 (9th Cir.
4 1997) (holding statement in opening brief was binding admission); *Am. Title Ins. Co. v. Lacelaw*
5 *Corp.*, 861 F.2d 224, 227 (9th Cir. 1988) (adopting the holding of the Tenth Circuit that
6 statements contained in a party's trial brief "may be considered admissions of the party in the
7 discretion of the district court"); *Barnett v. Cnty. of Contra Costa*, No. C-04-4437-THE, 2007
8 U.S. Dist. LEXIS 8131, at *9-10 (N.D. Cal. Jan. 24, 2007) (holding party bound to statements
9 made in briefs). Google is resisting making the admission, claiming it did not agree to originality
10 of the 37 APIs at issue. However, because Google affirmatively stated that there was no need to
11 take the issue of originality to the jury, it cannot claim it was only making a partial concession
12 that does not dispose of this issue. The Court should hold Google to its admission by deeming
13 the issue of originality to have been conceded by Google in Oracle's favor.

14 **B. Google has admitted that the Java programming language is distinct from the**
15 **Java APIs and class libraries.**

16 "Google has admitted that the Java programming language is distinct from the Java APIs
17 and class libraries." The Court should deem the underlined statement admitted.

18 In the Court's April 11 Order (ECF No. 896), the Court identified a dispute between the
19 parties about whether the Java APIs and class libraries are part of or distinct from the Java
20 programming language. Oracle asks the Court to read to the jury Google's admissions on this
21 point and so has filed this "deemed-admitted" motion.

22 In its Amended Counterclaims, Google admitted and alleged that the Java programming
23 language is distinct from the class libraries. Google stated in the first paragraph that the Java
24 programming language is *distinct* from the Java runtime environment: "*While they are distinct*
25 *elements*, the term 'Java' is commonly used to refer to the programming language, the runtime
26 environment, as well as the platform." (Google Amended Counterclaims ¶ 1, ECF No. 51 at 13
27 (emphasis added).) Google stated in the third paragraph that the "Java runtime environment"
28 includes the Java class libraries:

1 Upon information and belief, the Java platform comprises many different
2 components, including utilities to assist with the development of source code written
3 in the Java programming language, a Java compiler that converts Java programming
4 language statements to Java bytecode, **a Java runtime environment consisting of**
5 Java virtual machines written to operate on a number of different computer platforms
6 and **a set of standard class libraries** that can be accessed and reused by Java platform
7 applications to perform common software functions, such as writing to files or sorting
8 data. (*Id.* ¶ 3 at 14 (emphasis added).)

9 Google's statements in its operative pleading are judicial admissions that conclusively
10 bind Google. "Factual assertions in pleadings and pretrial orders, unless amended, are considered
11 judicial admissions conclusively binding on the party who made them." *Am. Title*, 861 F.2d at
12 226; *see also Gradetech, Inc. v. Am. Emp'rs Grp.*, No. C 06-02991 WHA, 2006 U.S. Dist. LEXIS
13 47047, at *9 (N.D. Cal. June 29, 2006) (holding fact asserted in another complaint was judicial
14 admission).

15 Google's copyright expert confirmed that the language is different from the APIs and
16 class libraries. He stated that "'Java' may refer to three **very different** things: the Java
17 programming language, the Java Application Programming Interfaces (APIs), or software source
18 code that references and implements the APIs." (Astrachan Opening Expert Report, ECF
19 No. 262-1, at ¶ 7 (emphasis added); *see also id.* at ¶ 54 ("[D]ifferent programming languages can
20 be used to implement a particular API. In the case of Android, both the Java programming
21 language and the C programming language were used to create code to implement the APIs at
22 issue."))

23 The Court should hold these concessions against Google.

24 **C. Google has admitted that the only way to demonstrate compatibility with a
25 Java specification is through a Sun TCK.**

26 "Google has admitted that the only way to demonstrate compatibility with the Java
27 specification is by meeting all of the requirements of Sun's Technology Compatibility Kit
28 ("TCK") for a particular edition of Sun's Java." The Court should deem the underlined statement
admitted. In its Amended Counterclaims, Google admitted and alleged this exact point:

The only way to demonstrate compatibility with the Java specification is by meeting
all of the requirements of Sun's Technology Compatibility Kit ("TCK") for a
particular edition of Sun's Java.

(Google Amended Counterclaims ¶ 6, ECF No. 51 at 15.) Google's statements in its operative

1 pleading are judicial admissions that conclusively bind Google. *Am. Title*, 861 F.2d at 226; *see*
2 *also Gradetech*, 2006 U.S. Dist. LEXIS 47047, at *9.

3 **D. Google has admitted that TCKs were only available from Sun, and carried**
4 **additional license terms and fees.**

5 The Court should deem the underlined statement admitted by Google:

6 TCKs were only available from Sun, initially not available as open source, were
7 provided solely at Sun’s discretion, and included several restrictions, such as
8 additional licensing terms and fees. In essence, although developers were free to
9 develop a competing Java virtual machine, they could not openly obtain an important
10 component needed to freely benefit from Sun’s purported open-sourcing of Java.

11 In its Amended Counterclaims, Google admitted and alleged this exact point:

12 Importantly, however, TCKs were only available from Sun, initially were not
13 available as open source, were provided solely at Sun’s discretion, and included
14 several restrictions, such as additional licensing terms and fees. In essence, although
15 developers were free to develop a competing Java virtual machine, they could not
16 openly obtain an important component needed to freely benefit from Sun’s purported
17 open-sourcing of Java.

18 (Google Amended Counterclaims ¶ 6, ECF No. 51 at 15.) Google’s statements in its operative
19 pleading are judicial admissions that conclusively bind Google. *Am. Title*, 861 F.2d at 226; *see*
20 *also Gradetech*, 2006 U.S. Dist. LEXIS 47047, at *9.

21 **E. Google has admitted that Sun refused the Apache Software Foundation’s**
22 **request for a TCK license without field of use restrictions.**

23 The Court should deem the underlined statement admitted by Google:

24 Although Sun offered to open source the TCK for Java SE, Sun included field of use
25 (“FOU”) restrictions that limited the circumstances under which Apache Harmony
26 users could use the software that the Apache Software Foundation created. Sun
27 refused the ASF’s request for a TCK license without FOU restrictions.

28 In its Amended Counterclaims, Google admitted and alleged this same point:

For example, in August of 2006, the Apache Software Foundation (“ASF”), a not-for-profit corporation that provides organizational, legal, and financial support for open source software projects, attempted to obtain a TCK from Sun to verify Apache Harmony’s compatibility with Java. *Although Sun eventually offered to open source the TCK for Java SE, Sun included field of use (“FOU”) restrictions that limited the circumstances under which Apache Harmony users could use the software that the ASF created, such as preventing the TCK from being executed on mobile devices. In April of 2007, the ASF wrote an open letter to Sun asking for either a TCK license without FOU restrictions, or an explanation as to why Sun was “protect[ing] portions of Sun’s commercial Java business at the expense of ASF’s open software” and violating “Sun’s public promise that any Sun-led specification [such as Java] would be fully implementable and distributable as open source/free software.” However, Sun continued to refuse the ASF’s requests.*

1 (Google Amended Counterclaims ¶ 7, ECF No. 51 at 15-16 (emphasis added).) Google's
2 statements in its operative pleading are judicial admissions that conclusively bind Google. *Am.*
3 *Title*, 861 F.2d at 226; *see also Gradetech*, 2006 U.S. Dist. LEXIS 47047, at *9.

4 **III. CONCLUSION**

5 The Court should hold Google to its concessions and deem the above matters admitted.

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Dated: April 12, 2012

MORRISON & FOERSTER LLP

By: /s/ Michael A. Jacobs

Attorneys for Plaintiff
ORACLE AMERICA, INC.