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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 MOTION FOR CLARIFICATION REGARDING '702 PATENT** Dept.: Courtroom 8, 19th Floor Judge: Honorable William H. Alsup

Oracle America, Inc. ("Oracle") requests guidance from the Court regarding the inclusion of the '702 patent in the patent infringement phase of the trial.

In response to the Court's request for "a candid discussion of the impact these [reexamination] rejections will have on the shape of trial," Oracle made the following commitment:

> Accordingly, if the case goes to trial this spring, Oracle will withdraw from the litigation with prejudice each claim of the '720, '205, and '702 patents asserted against Google that remains rejected at the time of trial, and proceed with the copyright case, the '520 patent, the '104 patent, and any asserted claims of the other three patents that are confirmed by the PTO.

(ECF No. 777 at 2.) Oracle also stated that it had "substantial arguments supporting reconsideration, raising a credible prospect that one or more of the rejections will be reversed by the examiners." (*Id.*) It was for this reason that Oracle made its withdrawal conditional.

That prospect has come to pass. As the Court and the parties now know, on April 19 the PTO reversed its earlier decisions and confirmed the patentability of all the claims of the '702 patent in re-examination, which include all the claims that Oracle accuses Google of infringing. Google's prediction that Oracle would be "unlikely to overcome the examiners' rejections" (ECF No. 779 at 2) was wrong. Google's invalidity contentions have been weighed and found wanting, on a standard much more favorable to Google than what Google faces at trial. A reexamination certificate confirming the asserted claims will issue in due course—Google is not permitted to appeal the PTO's decision in the *ex parte* reexamination.

The Court has twice commented on Oracle's conditional withdrawal in written orders. On March 13, 2012, the Court wrote:

> In reliance on Oracle's withdrawal with prejudice of the '720, '205, and '702 patents, given the final rejections by the PTO examiner, and having twice admonished counsel to reserve mid-April to mid-June 2012 for the trial of this case, this order now sets April 16 as the first day of trial, which will be devoted to jury selection and opening statements. The trial shall continue day to day on the trifurcated plan previously set and on the daily 7:30 a.m. to one p.m. schedule previously set, with the trial expected to run about eight weeks.

(ECF No. 786 at 1.) Two days later, the Court wrote:

> Another three [patents] rejected by the PTO examiner were withdrawn if the trial is held before the administrative appeals are completed, a withdrawal whose effect will be considered below. Therefore, there is a strong possibility that only the

> ’104 and ’520 patents will be asserted at trial, and this order will only address issues pertaining to these two patents, without prejudice to revisiting objections specific to the withdrawn patents if they later arise.

(ECF No. 796 at 1.)

The Court trifurcated the trial in its January 4, 2012 Final Pretrial Order (ECF No. 675). Phase Two, which has not yet begun, “will be directed to all patent liability and defense issues, including any generalized defenses.” (*Id.* at 3.) Phase One, which is underway, “will be directed to all liability and defenses for all copyright claims but not for any other issues.” (*Id.* at 2.)

Because the patent infringement phase of the trial has not begun, Oracle does not regard the ’702 patent as yet withdrawn and intends to assert the ’702 patent in Phase Two. The evidence shows that Google has significantly benefited from its use of the ’702 patent. Testing shows that Android application files are between 1.45 and 3.33 times smaller than they would be if the patented technology were not used, which results in a variety of additional performance benefits. (*See* Summary and Report of Noel Poore (TX669) at 13.) An injunction against Google’s continued infringement is warranted, particularly because the ’702 patent does not expire until October 2017.

Not to allow the ’702 patent to go forward would deprive Oracle of a significant intellectual property right. Google would not be unfairly prejudiced by including it, because the parties have prepared for and anticipated this moment. Both Oracle and Google kept their ’702-related exhibits on the trial exhibit list. (When considering whether and what exhibits could be dropped, Google asked if Oracle had indeed dropped the ’702 patent with prejudice. Oracle said “no.”) No additional experts will need to appear. Oracle’s experts Profs. Mitchell and Goldberg are appearing for other patents, as is Google’s ’702 noninfringement expert Prof. Parr. (We assume Google will withdraw its failed ’702 invalidity theories as it did for the ’520 patent.)

Oracle brings this motion for clarification because the Court has characterized Oracle’s conditional withdrawal differently at different times. Accordingly, Oracle respectfully requests that the Court confirm that Oracle may proceed to try infringement of the ’702 patent in Phase Two in light of the PTO’s recent confirmation of all asserted claims.

Dated: April 24, 2011

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