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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. 3:10-cv-03561 WHA

**GOOGLE INC.'S COMMENTS ON THE
COURT'S PROPOSED CHARGE TO THE
JURY**

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

1 **I. INTRODUCTION**

2 Pursuant to the Court’s request, Google Inc. (“Google”) hereby identifies its three most
3 pressing concerns with the Court’s Proposed Charge to the Jury [Dkt. No. 994]. First, instruction
4 28, which concerns fair use, inadequately explains the factors in the fair use test. Second,
5 instruction 19, which concerns alleged infringement of the structure, sequence, and organization
6 of the compilable code for the 37 API packages, does not instruct the jury to determine substantial
7 similarity. Third, instruction 30, concerning the work as a whole, is incorrect both in that it
8 identifies a different work as a whole for different questions, and in that it fails to identify the
9 registered work, the J2SE platform, as the work as a whole. Google further objects to the extent
10 that the Court did not adopt Google’s proposed jury instructions.

11 **II. ARGUMENT**

12 **A. Instruction 28 – Fair Use**

13 Google objects to the Court’s instruction 28 concerning fair use because it does not give
14 the jury sufficient background to understand the fair use factors. In addition to some smaller
15 changes that Google will raise at the charging conference, Google has four specific objections:

16 *First*, the jury should be instructed that the statutory factors are non-exclusive.

17 Specifically, Google requests that, after listing the four factors, the Court add this further
18 sentence: **“You may consider whatever additional factors you believe are appropriate, on
19 the facts of this case, to assist in your determination of whether Google’s use is a fair use.”**

20 Section 107 of the Copyright Act states that the factors to be considered “include” the four
21 statutory factors. 17 U.S.C. § 107. But the “factors enumerated in the statute in the section are
22 not meant to be exclusive: ‘[S]ince the doctrine is an equitable rule of reason, no generally
23 applicable definition is possible, and each case raising the question must be decided on its own
24 facts.’” *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539, 560 (1985)
25 (quoting H.R. Rep. No. 94-1476, at 65 (1976)). Instead, “Section 107 requires a case-by-case
26 determination whether a particular use is fair” *Id.*; *see also* 17 U.S.C. § 101 (“The terms
27 ‘including’ and ‘such as’ are illustrative and not limitative.”).

28 *Second*, the jury should be instructed that the fair use factors must be weighed together,

1 with no single factor being treated as dispositive. Specifically, Google requests that after the
2 “additional factors” sentence discussed above, the Court add these further sentences: **“All of the**
3 **fair use factors must be weighed together. No single factor compels a conclusion of fair use**
4 **or no fair use.”** The Supreme Court has held that the factors cannot “be treated in isolation, one
5 from another.” *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 578 (1994). “All are to be
6 explored, and the results weighed together, in light of the purposes of copyright.” *Id.* (citing
7 Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1110-11 (1990)).

8 *Third*, the Court should instruct the jury that the first factor is “The purpose and character
9 of the use, including whether such use is of commercial nature or is for nonprofit educational
10 purposes, **and including whether such work is transformative (meaning that it adds**
11 **something new, with a further purpose or different character, altering the original with new**
12 **expression, meaning, or message).”** This is based on the Supreme Court’s explanation in
13 *Campbell*:

14 The central purpose of this investigation [i.e. the first factor investigation] is to
15 see, in Justice Story’s words, whether the new work merely “supersede[s] the
16 objects” of the original creation, or instead adds something new, with a further
17 purpose or different character, altering the first with new expression, meaning, or
18 message; it asks, in other words, whether and to what extent the new work is
19 “transformative.”

20 510 U.S. at 579 (citations omitted).

21 *Fourth*, as to the second fair use factor, the Court should instruct the jury that it should
22 consider the “nature of the copyrighted work, **including whether the work is fictional or mostly**
23 **functional or factual.”** This explanation is drawn from the Ninth Circuit’s discussion of this
24 factor in *Sega Enters. Ltd. v. Accolade, Inc.*:

25 The second statutory factor, the nature of the copyrighted work, reflects the fact
26 that not all copyrighted works are entitled to the same level of protection. The
27 protection established by the Copyright Act for original works of authorship does
28 not extend to the ideas underlying a work or to the functional or factual aspects of
the work. To the extent that a work is functional or factual, it may be copied, as
may those expressive elements of the work that “must necessarily be used as
incident to” expression of the underlying ideas, functional concepts, or facts.

977 F.2d 1510, 1524 (9th Cir. 1992) (citing 17 U.S.C. § 102(b) and *Baker v. Selden*, 101 U.S. 99
(1879)).

1 **B. Instruction 19 -- Infringement**

2 Instruction 19, which concerns infringement of the structure, sequence, and organization
3 of the compilable code for the 37 API packages, does not instruct the jury to determine substantial
4 similarity. Google requests that after instructing the jury that “Google states that the elements it
5 has used are either not copyrightable in the first place,” that the Court insert a clause stating
6 Google’s position **“that Google’s work and Oracle’s work are not substantially similar when
7 compared as a whole”**. Google has additional, smaller changes to this instruction, which it will
8 raise at the charging conference.

9 **C. Instruction 30 – Work as a Whole**

10 The Court has identified four different works as a whole for different parts of the case.
11 Google objects to this formulation for several reasons. The Court should instead instruct the jury
12 that **“the work as a whole for all purposes is the entire J2SE platform.”**

13 *First*, there is no basis for using different works-as-a-whole for different questions.
14 Across the three questions that involve the “work as a whole” concept, the Court asks the jury to
15 apply four different works as a whole. This can only lead to confusion.

16 *Second*, as Google has argued previously, the work as a whole *for all purposes* is the
17 entire J2SE platform, the work that Sun registered with the copyright office. *See* Google’s April
18 22, 2012 Copyright Liability Trial Brief, Dkt. No. 955, at 5-12; Google’s April 25 Copyright
19 Brief, Dkt. No. 993, at 3-6. Indeed, not only is J2SE the sole work registered with the Copyright
20 Office, it is the sole work that was pled in Oracle’s Complaint in this case. Am. Compl., Dkt. No.
21 36, ¶ 39 (“Google’s Android infringes Oracle America’s copyrights *in the Java platform*”
22 (emphasis added)). As Google argued in its previous briefs, no case law exception applies to the
23 ordinary rule that the registered work is the “work as a whole” for all purposes—substantial
24 similarity, fair use, and de minimis.

25 *Third*, even assuming something smaller than J2SE *could* be considered the “work as a
26 whole,” the trial record does not support a smaller work (or multiple smaller works) *on the facts*
27 *of this case*. Oracle claims that it *does not allow* subsetting of the API libraries. RT 373:18-
28 374:9 (Kurian). Moreover, the APIs depend on each other and are interwoven. *See* RT 779:13-

1 780:18 (Bloch). There is *no* evidence in support of *any* work smaller than the work as a whole.

2 Allowing Oracle to argue for a jury verdict based on a work—or multiple works—smaller
3 than the entire J2SE platform as a whole would allow Oracle to improperly shift its definition of
4 the work as a whole in order to suit its individual claims as they have evolved. *See NXIVM Corp.*
5 *v. The Ross Institute*, 364 F.3d 471, 481 (2d Cir. 2004) (“If plaintiffs’ argument were accepted by
6 courts — and, not surprisingly, plaintiffs cite no authority to support it — the third factor could
7 depend ultimately on a plaintiff’s cleverness in obtaining copyright protection for the smallest
8 possible unit of what would otherwise be a series of such units intended as a unitary work.”).

9 If the Court adopts Google’s proposal, this would also require changing instruction 19 at
10 page 12, line 5 to remove the phrase “individually as 37 separate packages.”

11 **III. CONCLUSION**

12 Google respectfully requests that the Court adopt the changes to the proposed jury charge
13 set forth above. Consistent with the Court’s Order [Dkt. No. 994], Google reserves the remainder
14 of its objections to the proposed charge to the jury, and will raise those additional issues at the
15 charging conference.

16 Dated: April 26, 2012

KEKER & VAN NEST LLP

18 By: /s/ Robert A. Van Nest
19 ROBERT A. VAN NEST

20 Attorneys for Defendant
21 GOOGLE INC.