

1 MORRISON & FOERSTER LLP  
MICHAEL A. JACOBS (Bar No. 111664)  
2 mjacobs@mofo.com  
MARC DAVID PETERS (Bar No. 211725)  
3 mdpeters@mofo.com  
755 Page Mill Road  
4 Palo Alto, CA 94304-1018  
Telephone: (650) 813-5600 / Facsimile: (650) 494-0792  
5

6 BOIES, SCHILLER & FLEXNER LLP  
DAVID BOIES (Admitted *Pro Hac Vice*)  
dboies@bsflp.com  
7 333 Main Street  
Armonk, NY 10504  
8 Telephone: (914) 749-8200 / Facsimile: (914) 749-8300  
STEVEN C. HOLTZMAN (Bar No. 144177)  
9 sholtzman@bsflp.com  
1999 Harrison St., Suite 900  
10 Oakland, CA 94612  
Telephone: (510) 874-1000 / Facsimile: (510) 874-1460  
11

12 ORACLE CORPORATION  
DORIAN DALEY (Bar No. 129049)  
dorian.daley@oracle.com  
13 DEBORAH K. MILLER (Bar No. 95527)  
deborah.miller@oracle.com  
14 MATTHEW M. SARBORARIA (Bar No. 211600)  
matthew.sarboraria@oracle.com  
15 500 Oracle Parkway  
Redwood City, CA 94065  
16 Telephone: (650) 506-5200 / Facsimile: (650) 506-7114

17 *Attorneys for Plaintiff*  
ORACLE AMERICA, INC.  
18

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.  
27

Case No. 3:10-cv-03561-WHA

Honorable Judge William H. Alsup

**ORACLE AMERICA, INC.'S REPLY  
TO DEFENDANT GOOGLE INC.'S  
ANSWER TO COMPLAINT FOR  
PATENT AND COPYRIGHT  
INFRINGEMENT AND  
COUNTERCLAIMS**

**JURY TRIAL DEMANDED**

1 **ORACLE AMERICA, INC.’S REPLY TO DEFENDANT GOOGLE INC.’S**

2 **AMENDED COUNTERCLAIMS**

3 Plaintiff Oracle America, Inc. (“Oracle”) responds to each of the numbered paragraphs of  
4 the counterclaims of Defendant Google Inc., as set forth in its Answer to Plaintiff’s Amended  
5 Complaint for Patent and Copyright Infringement and Amended Counterclaims, as follows:

6 **GENERAL ALLEGATIONS**

7 1. Answering Paragraph 1, Oracle admits, on information and belief, that Google is a  
8 corporation organized and existing under the laws of the State of Delaware, with its principal place  
9 of business at 1600 Amphitheatre Parkway, Mountain View, California 94043.

10 2. Answering Paragraph 2, Oracle admits that Oracle is a corporation organized and  
11 existing under the laws of the State of Delaware, with its principal place of business at 500 Oracle  
12 Parkway, Redwood City, California 94065. Oracle admits that Oracle Corporation is a corporation  
13 organized and existing under the laws of the State of Delaware, with its principal place of business  
14 at 500 Oracle Parkway, Redwood City, California 94065. Oracle is a direct subsidiary of Oracle  
15 Systems Corporation, not of Oracle Corporation.

16 **JURISDICTION AND VENUE**

17 3. Paragraph 3 contains conclusions of law to which no response is required.

18 4. Paragraph 4 contains conclusions of law to which no response is required.

19 **FACTUAL BACKGROUND ALLEGATIONS**

20 **A. The Java Platform and Programming Language**

21 5. Answering Paragraph 1, Oracle admits that the Java platform includes the Java  
22 programming language and a runtime environment. Oracle admits that Sun Microsystems, Inc.  
23 (“Sun”) developed the Java platform in the 1990s. Oracle denies any remaining allegations of  
24 Paragraph 1.

25 6. Answering Paragraph 2, Oracle admits that the Java programming language has syntax  
26 similar to C++, an existing object-oriented language. Oracle admits that the Java platform  
27 implemented a technique wherein programs written in the Java programming language can be  
28 compiled into intermediate instructions called “bytecode” to be executed on a computer that

1 implements a Java “virtual machine.” Oracle admits that the virtual machine can be a program that  
2 receives and executes the bytecode on the particular computer upon which the virtual machine is  
3 running. Oracle admits that so long as there is a Java virtual machine available for a given  
4 computer system, any program compiled from the Java programming language into Java bytecode  
5 could theoretically run on the Java virtual machine for that computer. Oracle admits that Sun’s  
6 Java bytecode instructions are stack-oriented, which is supported by Sun’s Java virtual machines,  
7 where data and parameters can be loaded onto data structures in the computer’s memory called  
8 “stacks” and instructions can then be executed using the data and parameters from the stack. Oracle  
9 denies any remaining allegations of Paragraph 2.

10         7. Answering Paragraph 3, Oracle admits that the Java platform includes many different  
11 components, including utilities to assist with the development of source code written in the Java  
12 programming language, a Java compiler that compiles Java programming language source code to  
13 Java bytecode, a Java runtime environment including Java virtual machines written to operate on a  
14 number of different computer platforms, and a set of extensive class libraries that can be accessed  
15 and reused by Java platform applications and can be used to perform software functions, such as  
16 writing to files or sorting data. Oracle denies any remaining allegations of Paragraph 3.

17         8. Answering Paragraph 4, Oracle admits that Sun developed and distributed the Java  
18 Standard Edition (“Java SE”) and other editions of the Java platform. Oracle admits that Java  
19 platform editions may typically include a development environment, a Java compiler, Java virtual  
20 machine, a set of class libraries, and documentation. Oracle admits that Java platform editions may  
21 provide a different set of class libraries based on the types of applications and environment at which  
22 an edition is targeted. Oracle denies any remaining allegations of Paragraph 4.

23         9. Answering Paragraph 5, Oracle admits that Sun released some source code for Java SE  
24 and other editions in 2006 and 2007 subject to the terms of the GNU Public License, version 2  
25 (“GPLv2”). Oracle denies any remaining allegations of Paragraph 5.

26         10. Answering Paragraph 6, Oracle admits that Sun published its copyrighted Java  
27 specifications and offered licenses to them under certain conditions. For example, in the case of the  
28 Java 2 Platform, Standard Edition, Sun permitted developers to create “clean room”

1 implementations of Sun's Java specifications provided that they comply with all applicable license  
2 requirements, including requirements that they (i) include a complete implementation of the current  
3 version of the specification without subsetting or supersetting; (ii) implement all the interfaces and  
4 functionality of the required packages of the Java 2 Platform, Standard Edition, as defined by Sun,  
5 without subsetting or supersetting; (iii) do not add any additional packages, classes, or interfaces to  
6 the java.\* or javax.\* packages or their subpackages; (iv) pass all test suites relating to the most  
7 recent published version of the specification of the Java 2 Platform, Standard Edition, that are  
8 available from Sun (the Technology Compatibility Kits) six (6) months prior to any beta release of  
9 the clean room implementation or upgrade thereto; (v) do not derive from Sun source code or  
10 binary materials; and (vi) do not include any Sun source code or binary materials without an  
11 appropriate and separate license from Sun. Google is not in compliance with these license  
12 conditions. Developers were well aware that Sun's specification license requires compatibility  
13 testing using Sun's TCKs, which were and are available free of charge to qualifying universities,  
14 colleges, not-for-profit organizations, and individuals (*see* <http://java.sun.com/scholarship/>). Oracle  
15 lacks sufficient knowledge or information to admit or deny the remainder of the allegations of  
16 Paragraph 6, and, on that basis, denies them.

17         11. Answering Paragraph 7, Oracle admits that the Apache Software Foundation  
18 ("Apache") requested a TCK to verify Apache Harmony's compatibility with Java in August 2006  
19 and that Sun included field of use restrictions in the TCK license. Oracle admits that Apache wrote  
20 an open letter in April 2007 requesting a TCK license without field of use restrictions, and that Sun  
21 declined to withdraw the field of use restrictions. Oracle denies any remaining allegations of  
22 Paragraph 7.

23         12. Answering Paragraph 8, Oracle admits that the Java Community Process<sup>SM</sup>  
24 "Executive Committee Meeting Summary for 4-5 December, 2007," accessible via  
25 <http://jcp.org/aboutJava/communityprocess/summaries/2007/December07-summary.html>, reported  
26 that "Oracle" proposed Resolution 1 as follows:  
27  
28

1 “It is the sense of the Executive Committee that the JCP become an open  
2 independent vendor-neutral Standards Organization where all members  
participate on a level playing field with the following characteristics:

- 3 • members fund development and management expenses  
4 • a legal entity with by-laws, governing body, membership, etc.  
5 • a new, simplified IPR Policy that permits the broadest number of  
implementations  
6 • stringent compatibility requirements  
7 • dedicated to promoting the Java programming model

8 Furthermore, the EC shall put a plan in place to make such transition as  
soon as practical with minimal disruption to the Java Community.”

9 Oracle admits that the same reported that Resolution 1 was seconded by BEA. Oracle admits that  
10 Oracle Corporation’s intent to acquire BEA Systems, Inc. was announced in October 2007 and  
completed in April 2008. Oracle denies any remaining allegations of Paragraph 8.

11 13. Answering Paragraph 9, Oracle admits that the Java Community Process<sup>SM</sup>  
12 “Executive Committee Meeting Minutes for 7 April, 2009,” accessible via  
13 <http://jcp.org/aboutJava/communityprocess/summaries/2009/April09-public-minutes.html>, reported  
14 that:

15 “Following the February 2009 EC meeting, the following motion for  
16 electronic (email) voting was proposed by Apache Software Foundation  
and seconded by Intel Corp.

17 “TCK licenses must not be used to discriminate against or restrict  
18 compatible implementations of Java specifications by including field of  
19 use restrictions on the tested implementations or otherwise. Licenses  
20 containing such limitations do not meet the requirements of the JSPA, the  
agreement under which the JCP operates, and violate the expectations of  
the Java community that JCP specs can be openly implemented.”

21 Oracle admits that the same reported that “Oracle” voted “yes.” Oracle denies any remaining  
22 allegations of Paragraph 9.

23 14. Answering Paragraph 10, Oracle admits that Oracle Corporation announced in April  
24 of 2009 that Oracle would be acquiring Sun. Oracle’s announcement is accessible via  
25 <http://www.oracle.com/us/corporate/press/018363>. Oracle admits that Sun was subsequently  
26 renamed “Oracle America, Inc.” Oracle denies any remaining allegations of Paragraph 10.

1 **B. The Open Handset Alliance and Development of the Android Platform**

2 15. Answering Paragraph 11, Oracle lacks sufficient knowledge or information to admit  
3 or deny the allegations of Paragraph 11, and, on that basis, denies them.

4 16. Answering Paragraph 12, Oracle lacks sufficient knowledge or information to admit  
5 or deny the allegations of Paragraph 12, and, on that basis, denies them.

6 17. Answering Paragraph 13, Oracle lacks sufficient knowledge or information to admit  
7 or deny the allegations of Paragraph 13, and, on that basis, denies them.

8 18. Answering Paragraph 14, Oracle lacks sufficient knowledge or information to admit  
9 or deny the allegations of Paragraph 14, and, on that basis, denies them.

10 19. Answering Paragraph 15, Oracle lacks sufficient knowledge or information to admit  
11 or deny the allegations of Paragraph 15, and, on that basis, denies them.

12 20. Answering Paragraph 16, Oracle lacks sufficient knowledge or information to admit  
13 or deny the allegations of Paragraph 16, and, on that basis, denies them.

14 21. Answering Paragraph 17, Oracle lacks sufficient knowledge or information to admit  
15 or deny the allegations of Paragraph 17, and, on that basis, denies them.

16 **C. Android and the Java Programming Language**

17 22. Answering Paragraph 18, Oracle lacks sufficient knowledge or information to admit  
18 or deny the allegations of Paragraph 18, and, on that basis, denies them.

19 23. Answering Paragraph 19, Oracle lacks sufficient knowledge or information to admit  
20 or deny the allegations of Paragraph 19, and, on that basis, denies them.

21 24. Answering Paragraph 20, Oracle lacks sufficient knowledge or information to admit  
22 or deny the allegations of Paragraph 20, and, on that basis, denies them.

23 25. Answering Paragraph 21, Oracle admits that Jonathan Schwartz's blog, accessible via  
24 [http://blogs.sun.com/jonathan/entry/congratulations\\_google](http://blogs.sun.com/jonathan/entry/congratulations_google), includes an entry dated November  
25 2007 that includes the quoted passage. Oracle lacks sufficient knowledge or information to admit  
26 or deny the remaining allegations of Paragraph 21, and, on that basis, denies them.

27 26. Answering Paragraph 22, Oracle lacks sufficient knowledge or information to admit  
28 or deny the allegations of Paragraph 22, and, on that basis, denies them.

**E. Oracle's Amended Complaint**

27. Answering Paragraph 23, Oracle admits that Oracle asserts that Google infringes U.S. Reissue Patent No. RE38,104 (“the ’104 reissue patent”), and U.S. Patent Nos. 5,966,702 (“the ’702 patent”), 6,061,520 (“the ’520 patent”), 6,125,447 (“the ’447 patent”), 6,192,476 (“the ’476 patent”), 6,910,205 (“the ’205 patent”), and 7,426,720 (“the ’720 patent”) (collectively “the Patents-in-Suit”). Oracle admits that Oracle asserts that Google infringes and induces Android users and developers to infringe certain copyrights attached to Oracle’s Complaint as Exhibit H (“the Asserted Copyrights”). Oracle denies any remaining allegations of Paragraph 23.

28. Answering Paragraph 24, Oracle denies the allegations of Paragraph 24.

29. Answering Paragraph 25, Oracle admits that an actual case or controversy exists between Google and Oracle over the Patents-in-Suit. Oracle denies any remaining allegations of Paragraph 25.

**COUNT ONE****Declaratory Judgment of Non-Infringement of U.S. Reissue Patent No. RE 38,104**

30. Answering Paragraph 26, Oracle incorporates by reference its responses to the allegations of Paragraphs 1 through 25 of the Counterclaims.

31. Answering Paragraph 27, Oracle admits that an actual case or controversy exists between Google and Oracle as to whether the ’104 reissue patent is infringed by Google.

32. Answering Paragraph 28, Oracle denies the allegations of Paragraph 28.

33. Answering Paragraph 29, Oracle denies the allegations of Paragraph 29.

34. Answering Paragraph 30, Oracle admits that this case is exceptional and alleges that Oracle is entitled to an award of attorneys’ fees under 35 U.S.C. § 285. Oracle denies any remaining allegations of Paragraph 30.

**COUNT TWO****Declaratory Judgment of Invalidity of U.S. Reissue Patent No. RE 38,104**

35. Answering Paragraph 31, Oracle incorporates by reference its responses to the allegations of Paragraphs 1 through 30 of the Counterclaims.

1 36. Answering Paragraph 32, Oracle lacks sufficient knowledge or information to admit  
2 or deny the allegations of Paragraph 32, and, on that basis, denies them.

3 37. Answering Paragraph 33, Oracle denies the allegations of Paragraph 33.

4 38. Answering Paragraph 34, Oracle denies the allegations of Paragraph 34.

5 39. Answering Paragraph 35, Oracle denies the allegations of Paragraph 35.

6 40. Answering Paragraph 36, Oracle admits that this case is exceptional and alleges that  
7 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
8 remaining allegations of Paragraph 36.

9 **COUNT THREE**

10 **Declaratory Judgment of Non-Infringement of U.S. Patent No. 5,966,702**

11 41. Answering Paragraph 37, Oracle incorporates by reference its responses to the  
12 allegations of Paragraphs 1 through 36 of the Counterclaims.

13 42. Answering Paragraph 38, Oracle admits that an actual case or controversy exists  
14 between Google and Oracle as to whether the '702 patent is infringed by Google.

15 43. Answering Paragraph 39, Oracle denies the allegations of Paragraph 39.

16 44. Answering Paragraph 40, Oracle denies the allegations of Paragraph 40.

17 45. Answering Paragraph 41, Oracle admits that this case is exceptional and alleges that  
18 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
19 remaining allegations of Paragraph 41.

20 **COUNT FOUR**

21 **Declaratory Judgment of Invalidity of U.S. Patent No. 5,966,702**

22 46. Answering Paragraph 42, Oracle incorporates by reference its responses to the  
23 allegations of Paragraphs 1 through 41 of the Counterclaims.

24 47. Answering Paragraph 43, Oracle lacks sufficient knowledge or information to admit  
25 or deny the allegations of Paragraph 43, and, on that basis, denies them.

26 48. Answering Paragraph 44, Oracle denies the allegations of Paragraph 44.

27 49. Answering Paragraph 45, Oracle denies the allegations of Paragraph 45.



1 **COUNT SEVEN**

2 **Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,125,447**

3 61. Answering Paragraph 57, Oracle incorporates by reference its responses to the  
4 allegations of Paragraphs 1 through 56 of the Counterclaims.

5 62. Answering Paragraph 58, Oracle admits that an actual case or controversy exists  
6 between Google and Oracle as to whether the '447 patent is infringed by Google.

7 63. Answering Paragraph 59, Oracle denies the allegations of Paragraph 59.

8 64. Answering Paragraph 60, Oracle denies the allegations of Paragraph 60.

9 65. Answering Paragraph 61, Oracle admits that this case is exceptional and alleges that  
10 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
11 remaining allegations of Paragraph 61.

12 **COUNT EIGHT**

13 **Declaratory Judgment of Invalidity of U.S. Patent No. 6,125,447**

14 66. Answering Paragraph 62, Oracle incorporates by reference its responses to the  
15 allegations of Paragraphs 1 through 61 of the Counterclaims.

16 67. Answering Paragraph 63, Oracle lacks sufficient knowledge or information to admit  
17 or deny the allegations of Paragraph 63, and, on that basis, denies them.

18 68. Answering Paragraph 64, Oracle denies the allegations of Paragraph 64.

19 69. Answering Paragraph 65, Oracle denies the allegations of Paragraph 65.

20 70. Answering Paragraph 66, Oracle admits that this case is exceptional and alleges that  
21 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
22 remaining allegations of Paragraph 66.

23 **COUNT NINE**

24 **Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,192,476**

25 71. Answering Paragraph 67, Oracle incorporates by reference its responses to the  
26 allegations of Paragraphs 1 through 66 of the Counterclaims.

27 72. Answering Paragraph 68, Oracle admits that an actual case or controversy exists  
28 between Google and Oracle as to whether the '476 patent is infringed by Google.

1 73. Answering Paragraph 69, Oracle denies the allegations of Paragraph 69.

2 74. Answering Paragraph 70, Oracle denies the allegations of Paragraph 70.

3 75. Answering Paragraph 71, Oracle admits that this case is exceptional and alleges that  
4 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
5 remaining allegations of Paragraph 71.

6 **COUNT TEN**

7 **Declaratory Judgment of Invalidity of U.S. Patent No. 6,192,476**

8 76. Answering Paragraph 72, Oracle incorporates by reference its responses to the  
9 allegations of Paragraphs 1 through 71 of the Counterclaims.

10 77. Answering Paragraph 73, Oracle lacks sufficient knowledge or information to admit  
11 or deny the allegations of Paragraph 73, and, on that basis, denies them.

12 78. Answering Paragraph 74, Oracle denies the allegations of Paragraph 74.

13 79. Answering Paragraph 75, Oracle denies the allegations of Paragraph 75.

14 80. Answering Paragraph 76, Oracle admits that this case is exceptional and alleges that  
15 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
16 remaining allegations of Paragraph 76.

17 **COUNT ELEVEN**

18 **Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,910,205**

19 81. Answering Paragraph 77, Oracle incorporates by reference its responses to the  
20 allegations of Paragraphs 1 through 76 of the Counterclaims.

21 82. Answering Paragraph 78, Oracle admits that an actual case or controversy exists  
22 between Google and Oracle as to whether the '205 patent is infringed by Google.

23 83. Answering Paragraph 79, Oracle denies the allegations of Paragraph 79.

24 84. Answering Paragraph 80, Oracle denies the allegations of Paragraph 80.

25 85. Answering Paragraph 81, Oracle admits that this case is exceptional and alleges that  
26 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
27 remaining allegations of Paragraph 81.

1 **COUNT TWELVE**

2 **Declaratory Judgment of Invalidity of U.S. Patent No. 6,910,205**

3 86. Answering Paragraph 82, Oracle incorporates by reference its responses to the  
4 allegations of Paragraphs 1 through 81 of the Counterclaims.

5 87. Answering Paragraph 83, Oracle lacks sufficient knowledge or information to admit  
6 or deny the allegations of Paragraph 83, and, on that basis, denies them.

7 88. Answering Paragraph 84, Oracle denies the allegations of Paragraph 84.

8 89. Answering Paragraph 85, Oracle denies the allegations of Paragraph 85.

9 90. Answering Paragraph 86, Oracle admits that this case is exceptional and alleges that  
10 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
11 remaining allegations of Paragraph 86.

12 **COUNT THIRTEEN**

13 **Declaratory Judgment of Non-Infringement of U.S. Patent No. 7,426,720**

14 91. Answering Paragraph 87, Oracle incorporates by reference its responses to the  
15 allegations of Paragraphs 1 through 86 of the Counterclaims.

16 92. Answering Paragraph 88, Oracle admits that an actual case or controversy exists  
17 between Google and Oracle as to whether the '720 patent is infringed by Google.

18 93. Answering Paragraph 89, Oracle denies the allegations of Paragraph 89.

19 94. Answering Paragraph 90, Oracle denies the allegations of Paragraph 90.

20 95. Answering Paragraph 91, Oracle admits that this case is exceptional and alleges that  
21 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
22 remaining allegations of Paragraph 91.

23 **COUNT FOURTEEN**

24 **Declaratory Judgment of Invalidity of U.S. Patent No. 7,426,720**

25 96. Answering Paragraph 92, Oracle incorporates by reference its responses to the  
26 allegations of Paragraphs 1 through 91 of the Counterclaims.

27 97. Answering Paragraph 93, Oracle lacks sufficient knowledge or information to admit  
28 or deny the allegations of Paragraph 93, and, on that basis, denies them.

1 98. Answering Paragraph 94, Oracle denies the allegations of Paragraph 94.

2 99. Answering Paragraph 95, Oracle denies the allegations of Paragraph 95.

3 100. Answering Paragraph 96, Oracle admits that this case is exceptional and alleges that  
4 Oracle is entitled to an award of attorneys' fees under 35 U.S.C. § 285. Oracle denies any  
5 remaining allegations of Paragraph 96.

6 **COUNT FIFTEEN**

7 **Declaratory Judgment of Non-Infringement of the Asserted Copyrights**

8 101. Answering Paragraph 97, Oracle incorporates by reference its responses to the  
9 allegations of Paragraphs 1 through 96 of the Counterclaims.

10 102. Answering Paragraph 98, Oracle admits that an actual case or controversy exists  
11 between Google and Oracle as to whether the Asserted Copyrights are infringed by Google.

12 103. Answering Paragraph 99, Oracle denies the allegations of Paragraph 99.

13 104. Answering Paragraph 100, Oracle denies the allegations of Paragraph 100.

14 **PRAYER FOR RELIEF**

15 Oracle denies that Google is entitled to any of the relief for which it prays as to any cause  
16 of action, and specifically denies all allegations and prayers for relief contained in sub-paragraphs  
17 a-h of Google's Answer and Counterclaims.

18 **AFFIRMATIVE DEFENSES**

19 Without conceding that any of the following must be pled by way of affirmative defense or  
20 that Google does not have the burden of proving the issue as part of its affirmative case, Oracle  
21 pleads the following as affirmative defenses:

22 **FIRST AFFIRMATIVE DEFENSE**

23 **(Assignor Estoppel)**

24 Google asserts invalidity of each of the Patents-in-Suit through affirmative defenses and  
25 declaratory judgment counterclaims. Each of the inventors of the Patents-in-Suit assigned the  
26 patents to Sun (now Oracle) for good and valuable consideration. The doctrine of assignor estoppel  
27 bars Google from challenging the validity of any Patent-in-Suit naming an inventor with whom  
28 Google is in privity. Some of the named inventors joined Google and have developed software for

1 Google. Some may in the future. Google is in privity with these inventors and is barred from  
2 asserting invalidity of their patents. For example, on information and belief, Frank Yellin, co-  
3 inventor of the '520 patent, and Lars Bak and Robert Griesemer, co-inventors of the '205 patent,  
4 are presently employed by Google, and Google is in privity with them with respect to those patents.  
5 Google is therefore barred from challenging the validity of the '520 and '205 patents by the  
6 doctrine of assignor estoppel.

7  
8 **DEMAND FOR A JURY TRIAL**

9 Oracle America demands a jury trial for all issues so triable.

10 Dated: November 29, 2010

11 MICHAEL A. JACOBS  
12 MARC DAVID PETERS  
13 MORRISON & FOERSTER LLP

14 By: /s/ Marc David Peters

15 *Attorneys for Plaintiff*  
16 ORACLE AMERICA, INC.  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28