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GOOGLE INC.

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'S SUPPLEMENTAL
COPYRIGHT LIABILITY TRIAL BRIEF
PURSUANT TO MARCH 26, 2012 ORDER**

Judge: Hon. William Alsup

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

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

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

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

20 Jonathan Schwartz, Sun’s CEO from 2006 to 2010, testified that, [REDACTED]
21 [REDACTED]
22 [REDACTED]
23 [REDACTED]
24 [REDACTED]
25 [REDACTED]
26 [REDACTED]

27 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
28 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>.

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[REDACTED]
[REDACTED]
[REDACTED]
Schwartz Depo. at 49:11-50:10; *see also id* at 47:17-23 [REDACTED]
[REDACTED]
[REDACTED]

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:

[REDACTED]
[REDACTED]

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[REDACTED]

Schwartz Depo. at 83:15-84:7. Even without a TCK license, “[a]nybody else who wanted to go create their own runtime, whether it was Apache Harmony or GNU Classpath, was free to do so; they just couldn’t call it Java.” *Id.* at 182:2-5. Mr. Schwartz will testify that commercial products from IBM and Hewlett-Packard used the Apache Harmony implementation of the Java language APIs without objection from Sun.

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

The dispute between Apache and Sun was about branding, and the ability to say that Apache Harmony is Java compatible. The end result was that Apache *did not agree* to a field-of-use restriction. Notwithstanding Apache’s refusal to limit the field of use for Apache Harmony, Sun never sued Apache. In fact, Sun’s CEO has testified that *anyone* can use the Apache Harmony code (and thus its implementation of the Java language API specifications)—so long as it does not call its product “Java.”

Finally, Google in any event does not call Android “Java.” Google has used the term “Java” in its nominative, non-brand sense to describe, for example, how developers can use the free and open Java programming language to write applications for the Android platform. That, however, is not an attempt to brand the Android product “Java.” Indeed, Oracle’s complaint does not include a trademark infringement count. Oracle’s field-of-use restriction argument is irrelevant and should be rejected.

Dated: March 27, 2012

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