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IN THE UNITED STATES DISTRICT COURT  
FOR THE NORTHERN DISTRICT OF CALIFORNIA

ORACLE AMERICA, INC.,  
Plaintiff,

v.

GOOGLE INC.,  
Defendant.

No. C 10-03561 WHA

**ORDER PARTIALLY  
GRANTING AND  
PARTIALLY DENYING  
MOTION TO SUPPLEMENT  
INVALIDITY CONTENTIONS  
AND VACATING HEARING**

**INTRODUCTION**

In this patent and copyright infringement action involving features of Java and Android, defendant moves for leave to supplement its invalidity contentions. For the following reasons, the motion is largely **DENIED**.

**STATEMENT**

Oracle America, Inc. filed this action in August 2010, accusing Google Inc. of infringing 132 claims of seven patents, as well as various copyrights. Pursuant to Patent Local Rule 3-3, defendant Google served its patent invalidity contentions in January 2011. Google’s contentions included a variety of claim charts, which are required by the local rules for “each alleged item of prior art,” as well as a 22-page list of more than 500 additional references for which no claim charts were provided (Peters Decl. ¶ 1). Pat. Loc. R. 3-3(c). In February and March, Google filed reexamination requests with the United States Patent and Trademark Office concerning all seven patents at issue in this action (Dkt. No. 223 at 1).

1 The first step toward streamlining this gargantuan case for trial was jointly planned for  
2 early June (Dkt. Nos. 144, 147). On June 1, Oracle narrowed its patent case to fifty asserted  
3 patent claims, and two weeks later Google narrowed its invalidity defenses to six grounds per  
4 patent claim. Google now seeks leave to supplement its invalidity contentions with new defenses  
5 relating to the patent claims that remain in the action. The claims and technology at issue have  
6 been described in previous orders (Dkt. Nos. 137, 230). This order follows full briefing.

7 **ANALYSIS**

8 Amendment of invalidity contentions “may be made only by order of the Court upon a  
9 timely showing of good cause.” Pat. Loc. R. 3-6. With one exception, Google has not shown  
10 good cause for amending its invalidity contentions at this late date. Google asserts that the  
11 invalidity defenses it seeks to add “are among its strongest in the case” (Br. 1). Google, however,  
12 did not submit its proposed amendments or explain why its new invalidity theories are supposedly  
13 so strong. The parties did not brief the strength of Google’s new invalidity theories. It is  
14 therefore impossible to determine whether Google’s proposed supplements are meritorious or  
15 futile. Google argues that the strength of its new defenses is “demonstrated by the by the fact that  
16 Google elected them on June 15” (Reply Br. 8). This reasoning is circular. The June 15 deadline  
17 required Google to narrow its invalidity case to six grounds for each of the fifty patent claims  
18 chosen by Oracle — *a total of three hundred invalidity theories*. It is possible that Google simply  
19 did not have that many good invalidity theories and is now trying to fill in with whatever it can  
20 belatedly cobble together. Google has not carried its burden of showing otherwise.

21 Moreover, for purposes of Rule 3-6, “‘good cause’ requires a showing of diligence,” and  
22 “[t]he burden is on the movant to establish diligence rather than on the opposing party to establish  
23 a lack of diligence.” *O2 Micro Int’l Ltd. v. Monolithic Power Sys., Inc.*, 467 F.3d 1355, 1366  
24 (Fed. Cir. 2006) (discussing the validity and meaning of Patent Local Rule 3-6 of the Northern  
25 District of California). Google has not carried its burden of establishing diligence as to the vast  
26 majority of its proposed amendments. With limited exceptions, fact discovery has closed, and  
27 expert discovery is underway. The claims and defenses at issue have been significantly narrowed  
28 in reliance on the parties’ infringement and invalidity contentions. The final pretrial conference

1 and jury trial are only two months away. This action is well advanced, and Google now seeks  
2 leave to bring an entire fleet of new invalidity defenses into the fray. Good cause has not been  
3 shown for allowing such a dramatic maneuver at this late date. Only one category of amendments  
4 will be allowed.

5 **1. GOOGLE’S LACK OF DILIGENCE.**

6 Google waited several months after discovering most of its new defenses before it sought  
7 permission to move for leave to supplement its invalidity contentions. After permission to file a  
8 motion was granted in late June, Google waited another two and a half weeks to actually file its  
9 motion, and then filed a superceding amended version of the motion the following week. This  
10 delay suggests a lack of diligence. *See O2 Micro*, 467 F.3d at 1367 (upholding a district court’s  
11 finding of a lack of diligence where movant “waited almost three months . . . to serve its proposed  
12 amended contentions and two more weeks to formally move to amend”).

13 Google argues that it exercised “overall diligence” in light of the circumstances of this  
14 sprawling action (Reply Br. 4–7). Google’s delay in bringing the instant motion supposedly was  
15 motivated by a desire to conserve judicial and party resources (Br. 2):

16 Had Google filed this motion before Oracle narrowed its case and  
17 included *all* of the potential changes to its invalidity contentions,  
18 the resulting motion would have been several times larger than this  
19 one, and the bulk of it would have been mooted almost  
20 immediately by the parties’ narrowing decisions. The burden on  
21 the parties and the Court would have been even more severe had  
22 Google filed successive motions for each set of discoveries over  
23 the course of the spring and summer.

24 This argument is premised on the admission that “[b]oth parties have known since May that the  
25 scope of this case would soon be reduced by more than half” with the narrowing of claims and  
26 defenses planned for June (*ibid.*). True, Oracle asserted a large number of patent claims in its  
27 complaint, and narrowing was certainly in order. But this aspect of the action has no bearing on  
28 delay by Google before the narrowing plan went into effect, and it certainly does not justify  
subsequent delay.

Oracle’s selection of fifty out of its 132 asserted patent claims necessarily relied on the  
relative strength of the parties’ infringement and invalidity contentions as to each claim (Opp. 2).  
That some of the new theories were floated by Oracle before the June 1 narrowing deadline does

1 not eliminate all prejudice, contrary to Google (Reply Br. 1). Uncertainty remained as to whether  
2 Google would seek or receive permission to add any of those additional defenses to its official  
3 invalidity case. Indeed, by failing to move for leave to amend its contentions promptly after  
4 disclosing additional defenses, Google signaled an intention *not* to bring those defenses into this  
5 action. Google’s decision to wait until *after* Oracle was locked into its patent-claim selections to  
6 fortify its invalidity case with “defenses that it has now determined are among its strongest”  
7 amounts to sandbagging (Br. 1).

8 Google’s other excuses for its delay likewise fail. The time and effort demanded by  
9 discovery and other “competing case demands” does not justify neglecting to seek leave to amend  
10 invalidity contentions (Reply Br. 7). The failure of the parties to reach agreement regarding a  
11 stipulated supplementation was foreseeable. If Google was serious about amending its invalidity  
12 contentions, it should not have gambled for *months* on the possibility that a stipulation might be  
13 reached (*id.* at 6–7). Google generally did not exercise diligence in seeking to amend its  
14 invalidity contentions and has not shown good cause for allowing most of its proposed  
15 amendments at this eleventh hour. Each category of proposed amendments will be addressed  
16 in turn.

17 **2. OBVIOUSNESS THEORIES DIRECTED AT ’104 PATENT**  
18 **BASED ON RAU REFERENCE (CHARTS A-9 AND A-12).**

19 Google seeks to add claim charts A-9 and A-12 to its invalidity contentions directed at  
20 United States patent number RE38,104. These two new charts purport to disclose invalidating  
21 obviousness combinations based on an item of prior art Google calls “the *Rau* reference”  
22 (Br. 5–6). The *Rau* reference was included in Google’s January invalidity contentions but only in  
23 the list of additional references for which no claim charts were provided. The list did not specify  
24 the patents or claims to which Google contended the *Rau* reference applied (Peters Exh. 5 at 43).  
25 Google provided supplemental charts A-9 and A-12 “or their equivalent” to Oracle “on or before  
26 May 16, 2011.” Google explains that these two new defenses “respond to the Court’s Claim  
27 Construction Order, which rejected Google’s proposed claim constructions for both ‘intermediate  
28 form (object) code’ and ‘resolve’” (Br. 5–6).

1 A claim construction different from that proposed by the moving party is a circumstance  
2 “that may, *absent undue prejudice to the non-moving party*, support a finding of good cause.”  
3 Pat. Loc. R. 3-6 (emphasis added). Here, however, the claim construction order issued on  
4 May 9, 2011. Google served claim charts applying the Rau reference to the ’104 patent shortly  
5 thereafter, but those charts were not part of Google’s invalidity contentions. Contentions may be  
6 amended “only by order of the Court upon a *timely* showing of good cause.” Pat. Loc. R. 3-6  
7 (emphasis added). Google did not seek leave to move to formally amend its invalidity  
8 contentions until a month after claim constructions were set, which was well *after* Oracle had  
9 narrowed its infringement case. Google did not file the instant motion until a month later still  
10 (Dkt. Nos. 181, 214). Google failed to exercise diligence in seeking to supplement its invalidity  
11 contentions with charts A-9 and A-12 following claim construction. Google’s untimely motion to  
12 do so now is **DENIED**.

13 **3. OBVIOUSNESS THEORIES DIRECTED AT ’104 PATENT**  
14 **BASED ON MULTIPLE REFERENCES (CHART A-10).**

15 Google also seeks to reinforce its defense against the ’104 patent by adding chart A-10,  
16 which purports to disclose an invalidating obviousness combination based on four prior art  
17 references discovered after Google served its invalidity contentions. Google served a claim chart  
18 based on two of the new references on May 16, and one of Google’s experts discovered the other  
19 two sometime thereafter (Br. 6–7).

20 The “*recent* discovery of material, prior art despite earlier diligent search” is another  
21 circumstance “that may, *absent undue prejudice to the non-moving party*, support a finding of  
22 good cause.” Pat. Loc. R. 3-6 (emphasis added). Again, however, Google delayed in seeking  
23 permission to supplement its invalidity contentions. Two of the references in chart A-10 were  
24 known to Google at least three months ago, and Google does not say when it discovered the other  
25 two. Google falls well short of showing that the four references in chart A-10 were discovered  
26 recently and that Google exercised diligence in seeking to add them to its invalidity contentions.  
27 Google’s motion to supplement its invalidity contentions with chart A-10 is **DENIED**.  
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**4. ANTICIPATION THEORIES DIRECTED AT '702 PATENT  
BASED ON JAVAOS REFERENCE (NOT CHARTED).**

With respect to United States patent number 5,966,702, Google requests carte blanche to supplement its invalidity contentions with anticipation theories based on Oracle's JavaOS product "after Oracle has produced all relevant documents and source code" (Br. 7). Google has not prepared any claim charts analyzing JavaOS in relation to the asserted patent claims. Google asserts that its delay in doing so was caused by "Oracle's own discovery abuse"; Google claims that "Oracle did not produce *any* JavaOS source code until May 2011, *and has still not produced* the JavaOS source code that predates the '702 patent [*sic*] by a year" (*ibid.*). Oracle disputes this statement, claiming that the JavaOS source code it produced in May included code that predated the '702 patent by more than a year (Opp. 6). In reply, Google states that it "gained additional evidence regarding the source code for that product just last Friday in a 30(b)(6) deposition of Oracle" (Reply Br. 7). Google, however, has not pointed to any indication that Oracle actually stonewalled against discovery regarding JavaOS.

At all events, the time for fact discovery has passed. Google had ample opportunity to request JavaOS source code from Oracle and to request discovery relief from the Court if Oracle was not forthcoming in its source code production. The parties raised a swarm of discovery disputes, but no source code production grievance was among them. Having failed to press for this discovery, Google may not now decry Oracle's supposed "untimely production of this highly relevant prior art evidence" (Br. 7). Google's motion to supplement its invalidity contentions with theories based on JavaOS is **DENIED**.

**5. THEORIES BASED ON REEXAMINATION SUBMISSIONS  
(EIGHT CHARTS DIRECTED AT FOUR PATENTS).**

Google also seeks to supplement its invalidity contentions with eight claim charts directed at four patents, all of which are based on prior art references that Google submitted to the United States Patent and Trademark Office when initiating the reexamination proceedings in February and March 2011. Specifically, Google seeks to add charts A-2 and A-3 directed at the '104 patent; charts C-8, C-9, and C-11 directed at United States patent number 7,426,720; charts D-5

1 and D-6 directed at United States patent number 6,061,520; and chart F-5 directed at United  
2 States patent number 6,125,447.

3 Google argues that Oracle “has been on notice of these invalidity defenses since at least  
4 early March” when Google submitted them to the USPTO and thereby disclosed them to Oracle  
5 (Br. 8). Not so. By failing to move for leave to amend its invalidity contentions promptly after  
6 initiating the reexaminations, Google telegraphed an intention *not* to assert those prior art  
7 references in this action. Google did not exercise diligence in seeking to supplement its invalidity  
8 contentions with charts A-2, A-3, C-8, C-9, C-11, D-5, D-6, and F-5 following its initiation of the  
9 reexamination proceedings. Google’s untimely motion to do so now is **DENIED**.

10 **6. PRINTED MATTER DEFENSE.**

11 Google “seeks to provide further elaboration of its invalidity defense based on the fact that  
12 the identified claims are non-statutory subject matter.” Google explains that it “originally  
13 identified that defense as one based on § 101,” but “has since learned that courts conduct what is  
14 in effect the same analysis under both § 101 and § 102.” Google did not submit a proposed  
15 “elaboration” or describe how its new understanding of the law would bear on amendment of its  
16 invalidity contentions. Google simply characterizes its proposed amendment as “essentially a  
17 question of law” and admits uncertainty as to whether such an amendment “is even necessary”  
18 (Br. 8–9). Google has not provided enough information about this proposed amendment to show  
19 what is being requested, much less to show good cause for granting the request. Google also has  
20 not shown why diligent legal research would not have revealed this issue sooner. Google’s  
21 motion for leave “to provide further elaboration” of its Section 101 invalidity contentions is  
22 **DENIED**. This is without prejudice to its argument (not yet ruled on) that such a point need not  
23 even be in a cart under the local rule.

24 **7. OBVIOUSNESS THEORIES DIRECTED AT ’205 PATENT BASED ON**  
25 **PREVIOUS ANTICIPATION CONTENTIONS (CHARTS E-9, E-10, AND E-11).**

26 Google seeks to add claim charts E-9, E-10, and E-11 to its invalidity contentions directed  
27 at United States patent number 6,910,205. These three charts purport to disclose invalidating  
28 obviousness combinations based on prior art references Google identified and charted  
individually in its January 2011 invalidity contentions as *anticipating* the ’205 patent. Google

1 explains that the new charts do not contain new material but rather reorganize components of  
2 claim charts that were disclosed as part of its January 2011 contentions (Br. 7–8). Oracle  
3 acknowledges that all four of the prior art references contained in these new charts were asserted  
4 and charted as anticipatory in Google’s January 2011 contentions (Opp. 7).

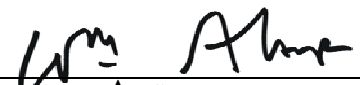
5 Each of the prior art references in charts E-9, E-10, and E-11 was charted in Google’s  
6 January 2011 contentions as required by Patent Local Rule 3-3(c). In this instance only, the  
7 Court will allow expansion to use the same references (and those references only) to prove up  
8 obviousness of the same claims. Google’s motion to supplement its invalidity contentions with  
9 charts E-9, E-10, and E-11 is **GRANTED**.

10 **CONCLUSION**

11 For the foregoing reasons, the motion by Google Inc. for leave to supplement its invalidity  
12 contentions is **GRANTED IN PART AND DENIED IN PART**. As to charts E-9, E-10, and E-11, the  
13 motion is **GRANTED**. As to all other proposed amendments, the motion is **DENIED**.

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15 **IT IS SO ORDERED.**

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17 Dated: August 8, 2011.

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20 WILLIAM ALSUP  
21 UNITED STATES DISTRICT JUDGE  
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