

Daily Journal

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TOP VERDICTS OF 2016

The largest and most significant verdicts and appellate reversals handed down in California in 2016

TOP DEFENSE VERDICTS

Oracle America Inc. v. Google Inc.

case INFO

Patent and copyright infringement

Northern District

U.S. District Judge William H. Alsup

Defense lawyers: Kecker, Van Nest & Peters LLP, Robert A. Van Nest, Christa M. Anderson, Daniel E. Purcell, Steven P. Ragland, Michael S. Kwun, Eugene M. Paige, Matthias A. Kamber, Kate E. Lazarus, Edward A. Bayley, Maya B. Karwande, Reid P. Mullen

Plaintiff lawyers: Orrick, Herrington & Sutcliffe LLP, Peter Bicks, Annette L. Hurst

Kecker, Van Nest & Peters LLP name partner Robert A. Van Nest won a blockbuster jury verdict for Alphabet Inc.-owned Google by persuading a federal panel in San Francisco that Google's inclusion of Oracle's Java programming code in its Android mobile operating system was fair use, not infringement, under copyright law.

To do it, Van Nest got jurors to distinguish between desktop and laptop computers, in which Oracle installs Java, and smartphones and tablets, where Google employs Android. Including parts of Java in Android to produce a separate product was a transformative reworking of Oracle's patented code, Van Nest argued — a key test for fair use that the jury agreed let Google off the hook for patent infringement.

The six-year conflict between the tech titans isn't over yet, because Oracle has again challenged the outcome at the U.S. Court of Appeals for the Federal Circuit. Its opening brief is due this month. Oracle claims Google wrongfully took elements of 37 Java application programming interfaces, known as APIs, to engineer Android without license from Sun Microsystems Inc., which Oracle bought in 2010.

It was the second trial in the high stakes case, and the appeal is the dispute's second trip to the



Sam Attal / Special to the Daily Journal

FROM TOP LEFT TO RIGHT, KECKER, VAN NEST & PETERS LLP OF COUNSEL MICHAEL S. KWUN, PARTNERS STEVEN P. RAGLAND, EUGENE M. PAIGE AND DANIEL E. PURCELL, ASSOCIATES KATE E. LAZARUS AND EDWARD A. BAYLEY, PARTNER MATTHIAS A. KAMBER. FROM BOTTOM LEFT TO RIGHT, ASSOCIATE MAYA B. KARWANDE AND PARTNERS ROBERT A. VAN NEST, CHRISTA M. ANDERSON AND REID P. MULLEN.

Federal Circuit. At the first trial in 2012, Van Nest defended Google on Oracle's patent and copyright claims and argued that the damage estimates were excessive. That jury delivered a unanimous verdict rejecting patent infringement. The circuit agreed, but returned the case to U.S. District Judge William H. Alsup for a new trial on the fair use issue, on which the jury had deadlocked. In May, the second jury unanimously favored Google's position.

Oddly, due to a quirk in procedural rules, Van Nest said, "even though there were no patent claims at issue in the [2016] trial, only copyright claims, the Federal Circuit will hear the appeal." Typically, the circuit hears only patent disputes. "That was a surprise even to Judge Alsup, who asked the parties to brief the issue. The reason is that patents were in dispute in the 2012 trial, so the Federal Circuit retains jurisdiction over the

second appeal."

Van Nest said his winning argument was that Java was created for different products: desktops and laptops. "Google used the APIs in new and different ways, and that was one of the big battlegrounds at trial. It was important that no one, including Oracle and Sun, had successfully used Java in smartphones. If it was that easy, it would have happened, and hence, the use by Google was transformative."

"The other key battleground was whether Android had harmed the market for Java — we argued there that Oracle failed to show any impact of Java revenues from Android."

Even so, the second win was no foregone conclusion, Van Nest said. "I was optimistic about the outcome, based on the evidence and the way the trial went. To say I was confident about the verdict would be an overstatement."

— John Roemer