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18 TOMORROWNOW, INC.

19 UNITED STATES DISTRICT COURT  
20 NORTHERN DISTRICT OF CALIFORNIA  
21 OAKLAND DIVISION

22 ORACLE USA, INC., et al.,  
23 Plaintiffs,  
24 v.  
25 SAP AG, et al.,  
26 Defendants.

Case No. 07-CV-1658 PJH (EDL)

**DEFENDANTS' REPLY IN SUPPORT  
OF DEFENDANTS' CROSS MOTION  
FOR PARTIAL SUMMARY  
JUDGMENT**

Date: May 5, 2010  
Time: 9:00 a.m.  
Courtroom: 3, 3rd Floor  
Judge: Hon. Phyllis J. Hamilton

1 **I. THE RIGHT TO SUE FOR PRE-MARCH 1, 2005 INFRINGEMENT WAS NOT**  
 2 **PROPERLY TRANSFERRED TO OSC OR OIC**

3 There is but one, purely legal issue that decides Defendants' Cross Motion. As courts in  
 4 the Ninth Circuit have consistently held, *all* transfers of the right to sue for past copyright  
 5 infringement must be express. There is no exception in the merger context, and none of the  
 6 authority Plaintiffs cite supports a departure from this clear rule. Contrary to Plaintiffs' assertion,  
 7 this Court already addressed this issue when it held that the merger agreements at issue "do not  
 8 establish that the right to sue for copyright infringement was expressly transferred to OSC as a  
 9 consequence of the various mergers." D.I. 224 (12/15/08 Order) at 7. Because a transfer of  
 10 accrued claims for copyright infringement must be express and because the merger agreements at  
 11 issue never effected an express transfer to OSC, this Court's previous ruling compels the  
 12 conclusion that OSC never received such rights and could not have transferred those rights to OIC  
 13 (thereby mooting the purported July 2009 retroactive transfer from OSC to OIC of the accrued  
 14 causes of action). Accordingly, and because it is undisputed that OIC did not receive an express  
 15 transfer of these rights from the PeopleSoft and JDE entities who held them, OIC does not  
 16 possess these accrued claims and cannot sue for pre-March 1, 2005 infringement of the  
 17 PeopleSoft and JDE copyrights at issue.

18 **A. Plaintiffs Do Not Dispute that Accrued Claims for Copyright Infringement**  
 19 **Must Be Expressly Transferred, and Their Cited Authority Does Not Carve**  
 20 **Out Any Exception to this Rule in the Context of Corporate Transfers.**

21 As explained in Section II.B of Defendants' Cross Motion for Partial Summary Judgment,  
 22 transfers of accrued causes of action for copyright infringement must be express to be effective.  
 23 *See* D.I. 670 (Defs.' Cross Mot.) at 3; *see also, e.g., Co-opportunities, Inc. v. Nat'l Broad. Co.*,  
 24 510 F. Supp. 43, 46 (N.D. Cal. 1981); *Ed Brawley, Inc. v. Gaffney*, 399 F. Supp. 115, 116 (N.D.  
 25 Cal. 1975); *Lanard Toys Ltd. v. Novelty Inc.*, 511 F. Supp. 2d 1020, 1033 (C.D. Cal. 2007); *De*  
 26 *Silva Constr. Corp. v. Herralld*, 213 F. Supp. 184, 193 (M.D. Fla. 1962); D.I. 224 (12/15/08  
 27 Order) at 7. Contrary to Plaintiffs' assertions, courts in this Circuit have addressed this rule in  
 28 the context of corporate transfers and have required that transfers of accrued claims be express,  
 even between related companies. *See Co-opportunities*, 510 F. Supp. at 46 (holding that

1 transferring “all assets” of a sole proprietorship in exchange for stock in the resulting corporation  
2 did not effectuate a transfer of accrued infringement claims absent an express transfer); *Lanard*  
3 *Toys Ltd.*, 511 F. Supp. 2d at 1033 (barring recovery for claims predating assignment from  
4 related company, even though the assignment purported to transfer “all right, title, and interest,”  
5 because the assignment did not include an express transfer of accrued claims); *see also De Silva*  
6 *Constr. Corp.*, 213 F. Supp. at 193 (finding plaintiff corporation lacked standing to sue for  
7 copyright infringement that occurred when its predecessor corporation had owned the copyrights  
8 because the inter-company copyright assignments had not expressly transferred accrued claims).

9 Plaintiffs’ argument that the rule requiring an express transfer of the right to sue for  
10 copyright infringement does not apply in the merger context fails as a matter of law and logic.  
11 Plaintiffs rely on two Delaware cases and the Delaware Corporations Code for the proposition  
12 that in a merger all assets and claims transfer to the surviving corporation without the need to  
13 execute an express transfer of these assets and claims.<sup>1</sup> D.I. 700 (Pls.’ Reply) at 4. These cases,  
14 however, are inapplicable as neither discusses the mechanics of properly transferring accrued  
15 causes of action for copyright infringement; rather, they address whether former shareholders of  
16 a dissolved company have standing to pursue pending derivative claims against the merged  
17 corporations—a question not even remotely at issue here. *See Heit v. Tenneco, Inc.*, 319 F. Supp.  
18 884, 886 (D. Del. 1970); *Lewis v. Anderson*, 477 A.2d 1040, 1043 (Del. 1984). Conversely,  
19 cases in this Circuit are clear that accrued claims of copyright infringement, unlike other assets  
20 and claims, must be transferred expressly; a general transfer of all assets and liabilities is not  
21 enough. *See Co-opportunities*, 510 F. Supp. at 46-47. Plaintiffs cite no case law to the contrary.

22 Further, Plaintiffs’ assertion that copyright claims survive a merger despite failure to  
23 comply with statutory pre-requisites is not only irrelevant, it is not supported by the cases on

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24 <sup>1</sup> Plaintiffs also argue that Delaware corporations law is not preempted by the Copyright  
25 Act and thus it presumptively applies. However, Defendants’ Cross Motion does not raise this  
26 issue and the cases Plaintiffs cite are inapposite to the current motion. *U.S. v. Northrop Corp.*  
27 does not even support Plaintiffs’ position, as it applies federal common law, not state law, to fill  
28 in gaps in a federal statutory scheme. *See* 59 F.3d 953, 960 (9th Cir. 1995). In *Kamen v. Kemper*  
*Fin. Servs.*, the discussed presumption regarding proper application of state law is limited to those  
areas of law where states have special province—in *Kamen*, the allocation of governing power  
within a corporation. *See* 500 U.S. 90, 99 (1991). The issue at hand, in contrast, concerns  
ownership and transfer of copyrights, the province of federal law and statute.

1 which Plaintiffs rely. Specifically, Plaintiffs' reliance on *Forry, Inc. v. Neundorfer, Inc.*, 837  
2 F.2d 259 (6th Cir. 1988) is misplaced for two reasons. *Forry* is inapposite because it does not  
3 address the question relevant to resolving the present motion—the transfer of accrued claims—  
4 but only addresses the transfer of copyrights themselves. *See id.* at 262. Moreover, unlike here,  
5 the surviving entity of the merger in *Forry* owned the copyrights *before* the merger took place.  
6 *See id.* The *Forry* court merely found, unsurprisingly, that another company's merger into the  
7 copyright owner did not somehow effect a transfer of assets that the surviving entity already  
8 owned. *Id.* Such a holding is irrelevant to the present motion because it does not bear on the  
9 question of whether the dissolving PeopleSoft and JDE entities properly transferred accrued  
10 causes of action to OSC when they merged into it. Similarly, *Raffoler, Ltd. v. Peabody & Wright,*  
11 *Ltd.*, 671 F. Supp. 947 (E.D.N.Y. 1987) does not support departing from the rule requiring  
12 express transfers of accrued copyright infringement claims, as it also concerns the ownership of  
13 the copyrights themselves, as opposed to the existing claims for infringement. *Id.* at 952.

14 Finally, Plaintiffs' argument that related companies need not make express transfers of the  
15 right to sue for accrued copyright claims is unpersuasive. *See* D.I. 700 (Pls.' Reply) at 5-6 (citing  
16 *Parfums Givenchy, Inc. v. C & C Beauty Sales, Inc.*, 832 F. Supp. 1378, 1384 (C.D. Cal. 1993)).  
17 Although the *Parfums* court held that, under the specific facts in question, the plaintiff's parent  
18 company had intended to transfer accrued claims for infringement to its subsidiary absent  
19 language expressly transferring those claims, a subsequent decision in the same district upheld the  
20 requirement that transfers of accrued copyright claims must be express, even between related  
21 companies. *See Lanard Toys*, 511 F. Supp. 2d at 1033. The *Co-opportunities* decision from the  
22 Northern District of California also upholds the requirement that a transfer of accrued  
23 infringement claims must be express. *Co-opportunities, Inc.*, 510 F. Supp. at 46-47. In sum, none  
24 of the authority cited by Plaintiffs counsels against the application of the rule requiring express  
25 transfers of accrued copyright infringement claims.

26 **B. The Undisputed Facts and This Court's Order Dismissing OSC's Copyright**  
27 **Infringement Claims Confirm that Pre-March 1, 2005 Copyright Claims**  
28 **Never Transferred to OSC or OIC.**

Contrary to Plaintiffs' assertions, although this Court did not address OIC's standing in its

1 December 15, 2008 Order on Defendants’ Motion to Dismiss, it did address an issue key to  
2 resolving this Cross Motion in Defendants’ favor. Specifically, in considering whether OSC was  
3 a proper copyright plaintiff, this Court held that the Oracle merger agreements at issue “do not  
4 establish that the right to sue for copyright infringement was expressly transferred to OSC as a  
5 consequence of the various mergers.”<sup>2</sup> D.I. 224 (12/15/08 Order) at 7.

6 Therefore, as explained in Section II.A of Defendants’ Cross Motion for Partial Summary  
7 Judgment, the undisputed facts demonstrate that certain PeopleSoft and JDE entities, not OIC,  
8 owned the PeopleSoft and JDE copyrights at issue in this case before March 1, 2005; thus, OIC  
9 may sue for pre-March 1, 2005 infringement only if it received a valid transfer of the right to  
10 pursue those claims. *See* D.I. 670 (Defs.’ Cross Mot.) at 2. However, none of the inter-company  
11 agreements at issue contain the required express transfer of any accrued copyright claims. *See id.*  
12 at 3-4. Therefore, no claims for infringement pre-dating the March 1, 2005 merger were  
13 properly transferred to OSC, and OSC could not have transferred those rights to OIC. Moreover,  
14 Plaintiffs do not dispute that the PeopleSoft and JDE entities that held the right to these claims  
15 did not transfer the claims to OIC and are themselves now dissolved (having dissolved on March  
16 1, 2005, well before the purported July 2009 retroactive transfer); therefore, they did not and can  
17 no longer transfer their rights to the accrued copyright claims. *Id.* at 2. Accordingly, OIC lacks  
18 standing to bring claims for pre-March 2005 copyright infringement.

## 19 **II. CONCLUSION**

20 This Court should grant Defendants’ Cross Motion for summary judgment of non-  
21 infringement and dismiss OIC’s pre-March 1, 2005 copyright infringement claims for all  
22 PeopleSoft and JDE copyright registrations asserted in this case, as well as deny Plaintiffs’  
23 Motion for Partial Summary Judgment with respect to those claims, because the undisputed facts  
24 show that the right to sue for pre-March 1, 2005 infringement of the asserted PeopleSoft or JDE

25 <sup>2</sup> Contrary to Plaintiffs’ characterization, Defendants have never “asserted that OIC may  
26 have received the right to pursue past claims.” D.I. 700 (Pls.’ Reply) at 4 n.1. Rather,  
27 Defendants argued in opposition to Plaintiffs’ motion for 1292(b) certification that “neither OSC  
28 nor any party has standing to sue for infringement prior to March 1, 2005,” and that “OIC cannot  
sue for infringement before March 2005.” D.I. 273 (Defs.’ Opp. to Pls.’ Mot. for Entry of Final  
Judgment) at 5. Moreover, the portion of Defendants’ brief cited by Plaintiffs merely  
acknowledges the position that *Plaintiffs* took in their motion. *See id.* at 10.

1 copyright registrations was never properly transferred to OIC.

2 Dated: April 21, 2010

JONES DAY

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By: /s/ Tharan Gregory Lanier

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Tharan Gregory Lanier

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Counsel for Defendants

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SAP AG, SAP AMERICA, INC., and  
TOMORROWNOW, INC.

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