

1 Brett M. Schuman (SBN 189247)
2 *BSchuman@goodwinlaw.com*
3 **GOODWIN PROCTER LLP**
4 Three Embarcadero Center
5 San Francisco, CA 94111-4003
6 Tel.: (415) 733-6000
7 Fax.: (415) 677-9041

8 Attorney for Defendant Envisage Technologies, LLC

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UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

ORACLE AMERICA, INC., a Delaware corporation and ORACLE INTERNATIONAL CORPORATION, a California corporation,

Plaintiffs,

v.

ENVISAGE TECHNOLOGIES, LLC, a Delaware limited liability company,

Defendant.

Case No. 3:21-cv-03540-JCS

ANSWER AND COUNTERCLAIM TO COMPLAINT FOR COPYRIGHT INFRINGEMENT

DEMAND FOR JURY TRIAL

Judge: Hon. Joseph C. Spero
Courtroom: F – 15th Floor

1 Defendant Envisage Technologies, LLC (“Envisage”) asserts the following answers,
2 affirmative defenses, and counterclaims to the complaint of Oracle America, Inc., and Oracle
3 International Corp. (collectively, “Oracle”). Envisage’s responses expressly reserve all rights to
4 file dispositive motions addressed to some or all of the claims asserted in the Complaint.
5 Envisage provides this Answer based on a reasonable inquiry and its knowledge to date.
6 Investigations into the matters that are subject of this Complaint are ongoing. Envisage’s
7 responses below follow the numbering of the paragraphs of the Complaint. For the avoidance of
8 doubt, any allegation not expressly admitted herein by Envisage is denied.

9 **PARTIES**

10 1. Envisage lacks knowledge or information sufficient to form a belief as to the truth
11 of the remaining allegations in this paragraph, and on that basis deny these allegations.

12 2. Envisage lacks knowledge or information sufficient to form a belief as to the truth
13 of the allegations in this paragraph, and on that basis deny these allegations.

14 3. Envisage admits that it is incorporated under the laws of the State of Delaware and
15 has its headquarters and principle place of business at 101 West Kirkwood Avenue, Suite 200,
16 Bloomington, Indiana 47407. Envisage further admits that it conducts business operations and
17 has customers located in the United States, including within the Northern District of California.
18 Otherwise denied.

19 **JURISDICTION AND VENUE**

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21 4. Paragraph 4 states a legal conclusion to which no response is required. To the
22 extent a response is required, Envisage admits that the Complaint purports to assert an action for
23 copyright infringement under the Federal Copyright Act and that the Court would have subject
24 matter jurisdiction over this action under 28 U.S.C. §§ 1331 and 1338, if Oracle establishes that it
25 holds valid copyright registrations for the works asserted.
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2 5. Paragraph 5 states a legal conclusion to which no response is required. To the
3 extent a response is required, for the limited purpose of this case, Envisage does not contest that
4 this Court has personal jurisdiction over Envisage.

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6 6. Envisage admits that it offers and licenses its software products and services in the
7 United States, the State of California, and the Northern District of California. Otherwise denied.

8 7. Paragraph 7 states a legal conclusion to which no response is required. To the
9 extent a response is required, Envisage does not contest that venue is proper in this district.
10 Otherwise denied. Envisage reserves its right to seek transfer of venue under 28 U.S.C. § 1404(a)

11 **INTRADISTRICT ASSIGNMENT**

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13 8. Paragraph 8 states a legal conclusion to which no response is required. Envisage
14 admits that the Complaint purports to assert an action arising under the copyright laws of the
15 United States. Envisage does not contest that this is an Intellectual Property Action properly
16 assigned on a district-wide basis under Civil Local Rule 3-2(c). Otherwise denied.

17 **BACKGROUND**

18 **A. Oracle's Industry-Leading Software**

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20 9. Envisage lacks knowledge or information sufficient to form a belief as to the truth
21 of the allegations in this paragraph, and on that basis deny the allegations.

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23 10. Envisage lacks knowledge or information sufficient to form a belief as to the truth
24 of the allegations in this paragraph, and on that basis deny the allegations.

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26 11. Envisage lacks knowledge or information sufficient to form a belief as to the truth
27 of the allegations in this paragraph, and on that basis deny the allegations.

1 12. Envisage admits that Oracle Database may be deployed in cloud-based IT
2 environments and on-premises data centers. Envisage lacks knowledge or information sufficient
3 to form a belief as to the truth of the remaining allegations in this paragraph, and on that basis
4 deny the allegations.

5 13. Envisage admits that Oracle Database can be licensed in different editions,
6 including a Standard Edition 2 and an Enterprise Edition. Envisage lacks knowledge or
7 information sufficient to form a belief as to the truth of the remaining allegations in this
8 paragraph, and on that basis deny the allegations.

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10 14. Envisage lacks knowledge or information sufficient to form a belief as to the truth
11 of the allegations in this paragraph, and on that basis deny the allegations.

12 15. Envisage lacks knowledge or information sufficient to form a belief as to the truth
13 of the allegations in this paragraph, and on that basis deny the allegations.

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15 **B. Envisage’s Unauthorized Use of Oracle Database**

16 16. Envisage admits that it develops software directed to the needs of public safety
17 leaders, including its Acadis Readiness Suite. Otherwise denied.

18 17. Envisage admits that its Acadis Readiness Suite software is hosted on Amazon
19 Web Services (“AWS”) for some of Envisage’s customers.

20
21 18. Envisage admits that it purchased a perpetual license and support services for
22 Oracle Database Standard Edition 1 in 2006. Otherwise denied.

23 19. Envisage admits that its customers include federal, state, and local government
24 entities. Envisage admits that Exhibit E appears to be a copy of the landing page for Envisage’s
25 website as of May 7, 2021. To the extent paragraph 19 purports to characterize, summarize, and
26 quote from Exhibit E, Envisage states that the document speaks for itself. Otherwise denied.

1 20. Envisage admits that it deploys its Acadis Readiness Suite Software for some of its
2 customers on Amazon Relational Database Service (“Amazon RDS”). Envisage further admits
3 that Amazon RDS allows companies to operate a relational database in the cloud using Oracle
4 Database, among other database options. Otherwise, denied.

5 21. Envisage admits that Exhibit F appears to be a copy of the AWS terms and
6 conditions published at <https://aws.amazon.com/service-terms/> as of May 7, 2021. To the extent
7 paragraph 5 purports to characterize, summarize, and quote from Exhibit F, Envisage states that
8 the document speaks for itself. Otherwise denied.

9 22. Envisage denies that it has at most a license only to Oracle Database SE1.
10 Envisage lacks knowledge or information sufficient to form a belief as to the truth of the
11 remaining allegations in this paragraph, and on that basis deny the allegations.

12 23. Envisage admits that Exhibit H appears to be a web-archive copy of the Envisage
13 webpage <https://www.envisagenow.com/acadis/it-security> as of January 16, 2021. To the extent
14 paragraph 23 purports to characterize, summarize, and quote from Exhibit H, Envisage states that
15 the document speaks for itself. Envisage admits that Exhibit I appears to be a copy of a contract
16 between Envisage and the General Services Administration, effective January 4, 2021. To the
17 extent paragraph 23 purports to characterize, summarize, and quote from Exhibit I, Envisage
18 states that the document speaks for itself. Envisage admits that Exhibit J appears to be an Acadis
19 Architecture and Security document that was available at [https://info.acadis.com/wp-](https://info.acadis.com/wp-content/uploads/2019/11/Envisage-AcadisCutSheets-Framework.pdf)
20 [content/uploads/2019/11/Envisage AcadisCutSheets-Framework.pdf](https://info.acadis.com/wp-content/uploads/2019/11/Envisage-AcadisCutSheets-Framework.pdf) as of May 7, 2021. To the
21 extent paragraph 23 purports to characterize, summarize, and quote from Exhibit J, Envisage
22 states that the document speaks for itself. Envisage admits that Exhibit K appears to be a copy of
23 a Statement of Work by Envisage Technologies, dated January 15, 2021. To the extent paragraph
24 23 purports to characterize, summarize, and quote from Exhibit K, Envisage states that the
25 document speaks for itself. Envisage admits that Exhibit L appears to be a copy of Envisage’s
26 service contract award with the State of Nebraska, dated December 12, 2019. To the extent
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1 paragraph 23 purports to characterize, summarize, and quote from Exhibit L, Envisage states that
2 the document speaks for itself. Envisage admits that Exhibit M appears to be a copy of
3 Envisage's technical proposal submission to the State of West Virginia, Military Affairs and
4 Public Safety Division of Criminal Justice, dated June 24, 2011. To the extent paragraph 23
5 purports to characterize, summarize, and quote from Exhibit M, Envisage states that the
6 document speaks for itself. Otherwise denied.

7 24. Denied.

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9 **C. Oracle's Attempts to Settle the Licensing Dispute with Envisage**

10 25. Denied.

11 26. Envisage admits that it communicated with Oracle via e-mail on April 21, 2012.
12 To the extent paragraph 26 purports to characterize and summarize Envisage's e-mail, Envisage
13 states that the e-mail speaks for itself. Envisage admits that it currently continues to use Oracle
14 Database. Otherwise denied.

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16 27. Denied.

17
18 **FIRST CAUSE OF ACTION**

19 Copyright Infringement Under 17 U.S.C. §§ 101 et seq. and 17 U.S.C. §§ 501 et seq.

20 28. Envisage repeats and incorporates by reference each of its responses to paragraphs
21 1-27 of the Complaint as though fully set forth herein.

22 29. Denied.

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24 30. Envisage admits that Oracle International Corp. is listed as the copyright claimant
25 and Oracle America, Inc. is listed as the Author, employer for hirer, of the works listed in
26 paragraph 30. Envisage lacks knowledge or information sufficient to form a belief as to the truth
27 of the allegations in this paragraph, and on that basis deny the allegations.

1 31. Envisage lacks knowledge or information sufficient to form a belief as to the truth
2 of the allegations in this paragraph, and on that basis deny the allegations.

3 32. Denied.

4 33. Denied.

5 34. Denied.

6 35. Denied.

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9 **PRAYER FOR RELIEF**

10 Envisage respectfully request that the Court deny Oracle's prayers for relief A through F,
11 in their entirety and that Oracle take nothing from its Complaint.
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13 **DEMAND FOR JURY TRIAL**

14 Envisage joins in Oracle's request for a jury trial on all issues triable by jury.

15 **AFFIRMATIVE DEFENSES**

16 Without admitting any wrongful conduct, and without assuming any burden that Envisage
17 would not otherwise bear, Envisage asserts the following defenses to the Complaint,
18 incorporating by reference the foregoing answers and the allegations in the following
19 counterclaims as if fully set forth herein:
20

21 **FIRST DEFENSE**

22 Plaintiffs fail to state a claim against Defendant on which relief can be granted.

23 **SECOND DEFENSE**

24 Oracle's claims are barred for a lack of subject matter jurisdiction because it lacks valid
25 copyright registrations for the intellectual property rights asserted, or has not properly or timely
26 registered its works.
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THIRD DEFENSE

Oracle is not entitled to recover on its purported copyright claim because the asserted copyrights are invalid or unenforceable.

FOURTH DEFENSE

Oracle has authorized, implicitly, expressly or otherwise, Envisage’s allegedly infringing use of Oracle Database, and thus Oracle’s copyright infringement claims are barred by Oracle’s license, consent, and acquiescence to Envisage’s use.

FOURTH DEFENSE

Any alleged conduct by Envisage as set forth in the Complaint constitutes “fair use” pursuant to applicable copyright law.

FIFTH DEFENSE

Third party, Amazon Web Services, is liable for the alleged infringement and will be required to answer and indemnify.

SIXTH DEFENSE

Oracle’s claims are barred by the doctrine of copyright misuse.

SEVENTH DEFENSE

Oracle’s copyright claims are barred by the equitable doctrines of unclean hands, waiver, and/or estoppel.

EIGHTH DEFENSE

Oracle’s copyright claims are barred at least in part by the applicable statute of limitations.

NINTH DEFENSE

This case is subject to transfer under the doctrine of forum non conveniens under 28 U.S.C. § 1404(a).

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TENTH DEFENSE

Oracle’s claims are barred for failure to join Amazon Web Services as an indispensable party.

ELEVENTH DEFENSE

Any alleged copyright by Envisage is innocent and not willful, at least because Envisage relied in good faith on representations made by AWS regarding the scope of the license to Oracle Database provided under AWS’s “License Included” service model for Amazon RDS for Oracle.

TWELFTH DEFENSE

Any damages owed to Oracle should be off-set by the amount to which Oracle has been unjustly enriched at Envisage’s expense as a result of subscription fees paid by Envisage to AWS, and passed on to Oracle, based on Envisage’s reliance on AWS’s representations that the Oracle License provided by AWS for Amazon RDS was sufficient to cover Envisage’s Acadis offerings.

RESERVATION OF DEFENSES

Envisage reserves all affirmative defenses under Rule 8(c) of the Federal Rules of Civil Procedures and any other defenses, at law or in equity, that may be available now or may become available in the future based on discovery or any other factual investigation in this case.

COUNTERCLAIMS

Counterclaim Plaintiff Envisage Technologies LLC (“Envisage”) alleges the following Counterclaims against Counterclaim Defendants Oracle America, Inc., and Oracle International Corporation (collectively, “Oracle”), incorporating by reference Envisage’s Answer to Oracle’s complaint as if fully set forth herein:

PARTIES

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2 1. Counterclaim Plaintiff Envisage Technologies, LLC (“Envisage”) is a corporation
3 organized under the laws of the State of Delaware with its headquarters and principal place of
4 business at 101 West Kirkwood Avenue, Suite 200, Bloomington, Indiana 47404.

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6 2. Upon information and belief, Counterclaim Defendant Oracle America, Inc.
7 (“Oracle America”) is a corporation organized under the laws of the State of Delaware with its
8 principal place of business at 500 Oracle Parkway, Redwood Shores, California 94065.

9 3. Upon information and belief, Oracle International Corporation (“Oracle
10 International”) is a corporation organized under the laws of the State of California with its
11 principal place of business at 500 Oracle Parkway, Redwood Shores, California 94065.

JURISDICTION AND VENUE

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14 4. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1338 and 1331.

15 5. This Court has personal jurisdiction, and venue is proper, because Counterclaim
16 Defendants have their principal place of business in Redwood Shores, California, and because
17 Counterclaim Defendants consented to jurisdiction by initiating this action.

FACTS

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19 6. Envisage is an Indiana-based technology company that developed the Acadis®
20 Readiness Suite (“Acadis”), a proprietary software system that allows public safety agencies at
21 federal, state, and local levels to securely store and deploy training, compliance, and certification
22 materials and information for their workforces and trainees.

23
24 7. As a software application, Acadis can operate on a variety of database systems.
25 One of these options is Oracle Database. In 2006, Envisage purchased a license to Oracle
26 Database Standard Edition 1 (“Database SE1”) for use in Envisage’s internal support, testing, and
27 training purposes.
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1 8. Historically, Envisage provided Acadis to its agency customers primarily “on
2 premises” as a software program that the customers hosted and maintained on their own
3 hardware. Under the “on premises” model, Acadis users were responsible for providing their
4 own necessary third-party software licenses, including any necessary license to Oracle Database.
5

6 9. Starting in 2019, Envisage began to offer Acadis to more customers as a “cloud-
7 based” software service through a secure web interface hosted on Envisage’s hardware. To
8 support the expansion of Envisage’s cloud-based hosting of Acadis, turned to the Amazon
9 Relational Database Service (“Amazon RDS”) provided by Amazon Web Services (“AWS”).

10 10. One of the primary reasons that Envisage decided to host Acadis using Amazon
11 RDS over its competitors was that AWS offered a “License Included” service model of “Amazon
12 RDS for Oracle.”

13 11. In describing the “License Included” service model on the AWS website, AWS
14 specially represented that “In the ‘License Included’ service model, you do not need separately
15 purchased Oracle licenses; the Oracle Database software has been licensed by AWS.” This
16 representation appears on AWS’s webpage titled “Amazon RDS for Oracle pricing,” available at
17 <https://aws.amazon.com/rds/oracle/pricing/> (last visited July 6, 2021), a true and correct copy of
18 which is attached hereto as **Exhibit 1**. The same unqualified representation also appeared at least
19 up until February 13, 2020 on the AWS webpage titled “Amazon RDS for Oracle FAQs,”
20 available at
21 <https://web.archive.org/web/20200213130823/https://aws.amazon.com/rds/oracle/faqs/> (last
22 visited July 6, 2021), a true copy of which is attached hereto as **Exhibit 2**.

23 12. Envisage relied on these representations on the AWS website in subscribing to
24 Amazon RDS for Oracle to host Acadis without purchasing additional Oracle licenses.
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1 13. Additionally, Envisage, in choosing to use Amazon RDS for Oracle, relied on
2 advice and representations made by AWS customer representatives during in-person “Well-
3 Architected Review” meetings offered by AWS in 2019 and 2020, during which the AWS and
4 Envisage representatives discussed the technical details of Envisage’s Acadis offerings, and
5 discussed ways to use AWS services most cost-effectively to meet Envisage’s needs.
6

7 14. Based on AWS’s representations and recommendations, Envisage subscribed to
8 the “License Included” service model for all instances of Amazon RDS for Oracle that Envisage
9 uses for Acadis.
10

11 15. On May 11, 2021, Oracle filed the Complaint in this case, alleging that Envisage
12 infringed Oracle’s copyrights by using Oracle Database without proper authorization.
13

14 **COUNT I – DECLARATORY JUDGMENT**
15 **(No Infringement of Oracle’s Copyrights)**

16 16. Envisage repeats and incorporates by reference each of paragraphs 1-15 of its
17 Counterclaims, and its Answer to Oracle’s Complaint.

18 17. This is an action for declaratory judgment under the Federal Declaratory Judgment
19 Act, 28 U.S.C. §§ 2201 and 2202.

20 18. There exists an actual controversy between Envisage and Oracle regarding
21 Envisage’s authorization to use Oracle Database software.

22 19. When Envisage provides Acadis to customers “on premises,” Envisage customers
23 are responsible for obtaining their own license from Oracle for any use of Oracle Database with
24 Acadis.

25 20. With respect to any use of Oracle Database in connection with instances of Acadis
26 provided by Envisage on Amazon RDS, Envisage reasonably relied on representations made by
27 AWS that its “License Included” service model for Amazon RDS for Oracle provided adequate
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1 licensing from Oracle without the need to purchase any additional licenses directly from Oracle
2 for use of Oracle Database.

3 21. Upon information and belief, Oracle authorized AWS to act on Oracle’s behalf in
4 licensing Oracle Database to AWS customers under the “License Included” service model for
5 Amazon RDS for Oracle.

6 22. Upon information and belief, Oracle did review and approve, or reasonably should
7 have reviewed and approved, all AWS representations regarding the license to Oracle Database
8 provided with AWS’s “License-Included” service model for Amazon RDS for Oracle.

9 23. Envisage therefore seeks a declaration that Envisage’s use of Oracle Database for
10 Acadis was implicitly or expressly authorized under the license to Oracle Database provided by
11 through the “License-Included” service model for Amazon RDS for Oracle.
12

13
14 **COUNT II – UNJUST ENRICHMENT**
15 **(Fees Paid for “License Included” Service Model)**

16 24. Envisage repeats and incorporates by reference each of paragraphs 1-23 of its
17 Counterclaims, and its Answer to Oracle’s Complaint.

18 25. In reliance on representations made by AWS that its “License Included” service
19 model for Amazon RDS for Oracle provided adequate licensing for Envisage’s use of Oracle
20 Database in connection with Oracle’s Acadis offerings, Envisage paid AWS a premium for the
21 “License Included” service model beyond the cost for the “Bring Your Own License” service
22 model for Amazon RDS for Oracle.

23 26. Upon information and belief, Oracle received a substantial portion of the premium
24 paid by Envisage to AWS for the “License Included” service model.

25 27. To the extent AWS’s representations were false with respect to the adequacy of the
26 Oracle Database license provided under the “License Included” service model for Envisage’s
27

1 Acadis offerings, Oracle has been unjustly enriched to Envisage’s detriment as a result of AWS’s
2 representations, and is entitled to restitution.

3 **DEMAND FOR RELIEF**

4 Wherefore, Envisage respectfully requests that this Court enter a Judgment as follows:

- 5 A. Granting a declaration that Envisage has not and does not infringe Oracle’s copyrights
- 6 by using Oracle Database;
- 7 B. Providing an accounting of licensing fees received by Oracle from payments made by
- 8 Envisage to AWS for Amazon RDS under the “License Included” service model;
- 9 C. Awarding Envisage’ costs and attorneys’ fees; and
- 10 D. Granting any such other and further relief as the Court deems just and proper.

11 Dated: July 6, 2021

12 Respectfully submitted,

13 GOODWIN PROCTER LLP

14 By: /s/ Brett Schuman

15 Brett Schuman

16 Attorney for Defendant

17 ENVISAGE TECHNOLOGIES, LLC

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CERTIFICATE OF SERVICE

I hereby certify that I electronically filed the foregoing with the Clerk of the Court for the United States District Court for the Northern District of California by using the CM/ECF system on July 6, 2021. I further certify that all participants in the case are registered CM/ECF users and that service will be accomplished by the CM/ECF system.

I certify under penalty of perjury that the foregoing is true and correct. Executed this 6th day of July 2021.

/s/ Brett Schuman
BRETT SCHUMAN