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12
13 UNITED STATES DISTRICT COURT
14 NORTHERN DISTRICT OF CALIFORNIA
15 SAN FRANCISCO DIVISION

16 ADVANCED MICRO DEVICES, INC.,
17 et al.,

18 Plaintiffs,

19 v.

20 SAMSUNG ELECTRONICS CO., LTD.,
21 et al.,

22 Defendants.

Case No. CV-08-0986-SI

**AMD'S NOTICE OF MOTION AND
MOTION FOR JUDGMENT ON THE
PLEADINGS OF NO INEQUITABLE
CONDUCT RELATING TO U.S.
PATENT NO. 5,545,592;
MEMORANDUM OF POINTS AND
AUTHORITIES IN SUPPORT
THEREOF**

**[PROPOSED] ORDER [FILED
CONCURRENTLY HEREWITH]**

Date: February 5, 2010
Time: 9:00 a.m.
Location: 19th Floor, Courtroom 10
Judge: Hon. Susan Y. Illston

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NOTICE OF MOTION AND MOTION

TO SAMSUNG ELECTRONICS CO., LTD.; SAMSUNG SEMICONDUCTOR, INC.; SAMSUNG AUSTIN SEMICONDUCTOR, LLC; SAMSUNG ELECTRONICS AMERICA, INC.; SAMSUNG TELECOMMUNICATIONS AMERICA, LLC; and SAMSUNG DIGITAL IMAGING CO., LTD. (collectively referred to as “Samsung” or “Defendants”), AND THEIR COUNSEL OF RECORD:

PLEASE TAKE NOTICE that on February 5, 2010 at 9:00 a.m., or as soon thereafter as the matter may be heard before the Honorable Judge Illston, United States Court House, San Francisco, California, Plaintiffs ADVANCED MICRO DEVICES, INC. and ATI TECHNOLOGIES, ULC (collectively “AMD”) will move and hereby do move pursuant to Federal Rules of Civil Procedure 9(b) and 12(c) for an order granting judgment on the pleadings as to the inequitable conduct defenses and claims asserted by Samsung (Dkt. #236, ¶¶77-89, 158-171; Dkt. ##237-241, ¶¶77-89, 123-136 and; Dkt. #242, ¶¶77-89, 122-135) against U.S. Patent No. 5,545,592 (“Iacoponi ’592 patent”). This motion is brought on the grounds that Samsung has failed to plead its inequitable conduct allegations as to the Iacoponi ’592 patent with sufficient particularity to state a claim for relief. Alternatively, the Court may choose to resolve this issue pursuant to N.D. Cal. Civil Local Rule 7.9 through reconsideration of its previous Order (Dkt. #234) allowing Samsung’s Motion for Leave to Amend to assert inequitable conduct claims and defenses due to “a change of law occurring after the time of such order” in light of *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312 (Fed. Cir. 2009).

This motion is based upon this Notice of Motion and Motion, the attached Memorandum of Points and Authorities, the papers and pleadings on file in this action, and such other and further evidence as may subsequently be presented to the Court.

1 **MEMORANDUM OF POINTS AND AUTHORITIES**

2 **I. Introduction**

3 In light of the “heightened pleading requirement” set forth in the Federal Circuit’s
 4 recent decision in *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1316 (Fed. Cir.
 5 2009), judgment on the pleadings is warranted on Samsung’s claims and defenses that
 6 John Iacoponi, the inventor of U.S. Patent No. 5,545,592 (“the Iacoponi ’592 patent”)
 7 engaged in inequitable conduct by withholding sixty-four references (“Alleged
 8 Inequitable Conduct References”) from the U.S. Patent and Trademark Office (“PTO”).
 9 Samsung has failed to comply with the requirements for pleading inequitable conduct
 10 stated in *Exergen*. Specifically, Samsung failed to properly plead each of the following:

- 11 1. The specific Iacoponi ’592 patent claims and limitations in those
 12 claims to which the sixty-four Alleged Inequitable Conduct
 13 References are relevant;
- 14 2. The location in each of the Alleged Inequitable Conduct References
 15 of the allegedly material information withheld from the PTO;
- 16 3. The claim limitations or combination of claim limitations from the
 17 Iacoponi ’592 patent that are disclosed in the Alleged Inequitable
 18 Conduct References, but are missing from the Iacoponi ’592 patent
 19 art of record.

20 These deficiencies are individually fatal to Samsung’s allegations of inequitable
 21 conduct. Aside from these deficiencies, Samsung’s pleading fails to give rise to a
 22 reasonable inference that Mr. Iacoponi was aware of the alleged material information
 23 contained in the Alleged Inequitable Conduct References, and fails to provide the
 24 underlying facts from which a court could reasonably infer that John Iacoponi acted with
 25 specific intent to deceive the PTO.

26 Pleading the above information is required. *Exergen*, 575 F.3d at 1328-30.
 27 Without such pleading requirements, inequitable conduct would become “‘a magic
 28 incantation to be asserted against every patentee’ and its ‘allegation established upon a

1 mere showing that art or information having some degree of materiality was not
 2 disclosed.” *Id.* at 1331 (citation omitted). Samsung has failed in its First Amended
 3 Answer and Counterclaims to plead its inequitable conduct allegations with sufficient
 4 particularity to state a claim upon which relief can be granted and its claims and defenses
 5 (Dkt. #236, ¶¶77-89, 158-171; Dkt. ##237-241, ¶¶77-89, 123-136 and; Dkt. #242, ¶¶77-
 6 89, 122-135) should be dismissed.

7 **II. Relevant Facts And Procedural History**

8 On March 11, 2009, Samsung filed a Motion for Leave To Amend Answers and
 9 Counterclaims to allege that the inventor of the '592 patent, John Iacoponi, engaged in
 10 inequitable conduct by withholding from the PTO during prosecution sixty-four
 11 references distributed at conferences. (Dkt. #120 at 5-6). AMD opposed Samsung's
 12 Motion for Leave to Amend as futile because Samsung failed to state a claim upon which
 13 relief can be granted and failed to plead inequitable conduct with particularity. (Dkt.
 14 #201). AMD argued that Samsung had failed to plead inequitable conduct with sufficient
 15 particularity because Samsung did not specify how each of its Alleged Inequitable
 16 Conduct References was material and non-cumulative, failed to properly allege actual
 17 knowledge of the sixty-four conference papers, and failed to properly allege how an
 18 inference of intent to deceive was warranted. (*Id.* at 10-13).

19 The Court granted Samsung's Motion for Leave to Amend. (Dkt. #234). As to
 20 AMD's arguments, the Court determined that Samsung's explanation of the materiality of
 21 its sixty-four Alleged Inequitable Conduct References was sufficient because “[r]equiring
 22 it to provide allegations about each of the dozens of abstracts cited in its answer would
 23 conflict with the requirement that pleadings be ‘simple, concise, and direct.’ Fed. R. Civ.
 24 P. 8(d)(1).” (*Id.*). The Court also found that Samsung's allegations of intent to deceive
 25 were sufficient because “[i]t is possible that at a later stage in this proceeding, Samsung
 26 could establish that these facts warrant an inference of intent to deceive.” (*Id.* at 6). Upon
 27 the Court's Order, Samsung filed its First Amended Answer and Counterclaims. (Dkt.
 28 ##236-242). AMD replied to Samsung's First Amended Answer and Counterclaims.

1 (Dkt. ##244-246). AMD now files its Motion for Judgment on the Pleadings of No
2 Inequitable Conduct as to U.S. Patent No. 5,559,990 pursuant to Fed. R. Civ. P. 12(c) and
3 9(b). In the alternative, the Court may choose to resolve this issue pursuant to N.D. Cal.
4 Civil Local Rule 7.9 through reconsideration of its previous Order (Dkt. #234) allowing
5 Samsung's Motion for Leave to Amend to assert inequitable conduct claims and defenses
6 due to "a change of law occurring after the time of such order" in light of *Exergen*, 575
7 F.3d 1312.

8 **III. Applicable Law**

9 **A. Judgment On The Pleadings Standard**

10 This is a motion for judgment on the pleadings for failure to state a claim. A
11 defense of failure to state a claim upon which relief may be granted, typically raised
12 pursuant to Rule 12(b)(6), can be made after an answer has been filed by moving for
13 judgment on the pleadings pursuant to Rule 12(c). Fed. R. Civ. P. 12(h)(2). "Because the
14 motions are functionally identical, the same standard of review applicable to a Rule
15 12(b)(6) motion applies to a Rule 12(c) motion." *Chang v. Wells Fargo & Co.*, 2009 WL
16 2524406, at *4 (N.D. Cal. 2009). Judgment on the pleadings is appropriate when, taking
17 all the allegations in the non-moving party's pleadings as true, the moving party is entitled
18 to judgment as a matter of law. *Id.*

19 Of course, a non-moving party's allegations must be sufficiently pled before they
20 can be taken as true. *Vess v. Ciba-Geigy Corp. USA*, 317 F.3d 1097, 1107 (9th Cir. 2003).
21 To state a claim upon which relief can be granted, the party alleging inequitable conduct
22 must satisfy Fed. R. Civ. P. 9(b), which states that all allegations of fraud shall be stated
23 with particularity. *Exergen*, 575 F.3d at 1326. ("[I]nequitable conduct, while a broader
24 concept than fraud, must be pled with particularity' under Rule 9(b).") (citation omitted).
25 Insufficiently pled allegations of fraud contained in a pleading or claim should be
26 disregarded. *Vess*, 317 F.3d at 1105. The court should then examine the allegations that
27 remain to determine whether they state a claim for relief. *Id.* "If insufficiently pled
28 averments of fraud are disregarded, as they must be, in a complaint or claim grounded in

1 fraud, there is effectively nothing left of the complaint” and dismissal for failure to state a
 2 claim is warranted. *Id.* at 1107.

3 **B. The Requirements For Properly Pleading Inequitable Conduct**

4 After this Court’s Order of May 18th granting Samsung leave to amend, the
 5 Federal Circuit on August 4th clarified what is required to plead a claim of inequitable
 6 conduct with the particularity required by Rule 9(b). *Exergen*, 575 F.3d 1312. *Exergen*
 7 held that it is now necessary to “identify the specific who, what, when, where, and how of
 8 the material misrepresentation or omission committed before the PTO” when pleading
 9 inequitable conduct. *Id.* at 1328. Thus, according to *Exergen*, at the pleading stage, a
 10 properly pled inequitable conduct claim must identify:

- 11 1. *What* claims and claim limitations from the patent-in-suit each of the
 12 withheld references are relevant to; and
- 13 2. *Where* is the allegedly material information that was withheld from
 14 the PTO located in each of the withheld references; and
- 15 3. The claim limitations, or combination of claim limitations from the
 16 patent-in-suit, that are disclosed in the withheld references, but are
 17 missing from the art of record for the patent-in-suit. Such
 18 allegations are necessary to explain both “*why*” the withheld
 19 information is material and not cumulative, and “*how*” an examiner
 20 would have used this information in assessing the patentability of the
 21 claims.

22 *Id.* at 1328-30.

23 *Exergen* also required that, to plead the intent prong of inequitable conduct with
 24 sufficient particularity, the facts alleged must give rise to a reasonable inference of
 25 scienter. *Id.* at 1330. The pleading must include “underlying facts from which a court
 26 may reasonably infer that a specific individual (1) knew of the withheld material
 27 information or of the falsity of the material misrepresentation, and (2) withheld or
 28 misrepresented this information with a specific intent to deceive the PTO.” *Id.* at 1328-

1 29.

2 **IV. Samsung's Inequitable Conduct Allegations For The Iacoponi '592 Patent Fail**
 3 **To State A Claim Under *Exergen*, Rule 9(B) And Rule 12(C).**

4 Under the *Exergen* standard, Samsung's inequitable conduct pleading relating to
 5 the Iacoponi '592 patent is plainly deficient. Samsung fails to satisfy the materiality
 6 prong of the *Exergen* inequitable conduct pleading test because it fails to specify:

7 (1) what claims and claim limitations of the Iacoponi '592 patent are
 8 impacted by its allegations;

9 (2) where the allegedly material information is located within each of its
 10 Alleged Inequitable Conduct References; and

11 (3) the claim limitations, or combination of claim limitations, from the
 12 Iacoponi '592 patent that are disclosed in the Alleged Inequitable Conduct
 13 References, but are missing from the prior art of record for the Iacoponi
 14 '592 patent (the *why* and *how* of the materiality inquiry).

15 (*See* Dkt. #236, ¶¶77-89, 158-171; Dkt. ##237-241, ¶¶77-89, 123-136 and; Dkt. #242,
 16 ¶¶77-89, 122-135) (Samsung's inequitable conduct claims and defenses for the Iacoponi
 17 '592 patent).

18 As to the intent prong of the inequitable conduct test, Samsung fails to provide the
 19 underlying facts from which a court may reasonably infer:

20 (1) that John Iacoponi knew of the withheld material information contained
 21 in each of Samsung's Alleged Inequitable Conduct References; and

22 (2) that he withheld this information with a specific intent to deceive the
 23 PTO.

24 (*Id.*). In light of *Exergen*, Samsung has insufficiently pled its inequitable conduct
 25 allegations and therefore has failed to state a claim for inequitable conduct. Dismissal is
 26 required.

1 **A. Samsung Fails To Satisfy The Materiality Prong Of The Inequitable**
 2 **Conduct Test.**

3 **1. Samsung fails to identify what Iacoponi '592 patent claims, and**
 4 **what limitations in those claims, are impacted by its inequitable**
 5 **conduct allegations.**

6 To properly plead a claim of inequitable conduct, a defendant must specify what
 7 claims and claim limitations of the patent-in-suit are impacted by its allegations of
 8 inequitable conduct. In *Exergen*, the defendant's proposed pleading stated that an
 9 inequitable conduct reference "was material to the patentability . . . because it discloses a
 10 technique of scanning a radiation detector across a target to measure the maximum
 11 emitted radiation, and it is not cumulative to the information already of record ." *Exergen*,
 12 575 F.3d at 1325. A similar allegation was also made using a second inequitable conduct
 13 reference. *Id.* ("The '998 patent was material to the patentability of the '685 patent
 14 because it discloses a technique of swiping a radiation detector across a target, and it is
 15 not cumulative to the information already of record in the prosecution history of the '685
 16 patent."). *Id.* *Exergen* found both allegations to be deficient because the pleading "fails
 17 to identify which claims, and which limitations in those claims, the withheld references
 18 are relevant to." *Id.* at 1329.

19 Samsung's pleading is strikingly similar to the pleading rejected in *Exergen*.
 20 Samsung fails to identify the claims and claim limitations in the Iacoponi '592 patent that
 21 are impacted by its Alleged Inequitable Conduct References. Samsung merely alleges
 22 that "[n]umerous of the over one hundred technical abstracts distributed at each of the
 23 VMIC conferences between and including June of 1993 to June of 1996 were highly
 24 material to the patentability of the claims of the '592 patent in that they disclosed
 25 processes for forming nitrided contacts in semiconductor devices, including processes
 26 utilizing nitrogen ionized in a plasma." (*See, e.g.*, Dkt. #236, ¶83). This information,
 27 without any mention of the relevant claims or claim limitations, does not provide
 28 sufficient particularity to state a claim for relief under *Exergen*. *See* 575 F.3d at 1329.

1 **2. Samsung fails to identify where in its alleged inequitable conduct**
2 **references the material information is found.**

3 Under *Exergen*, a party asserting inequitable conduct cannot simply rely on a
4 general statement that a reference is material. The defendant in *Exergen* pled generally
5 that its inequitable conduct references, as a whole, were “material to the patentability of
6 the ’685 patent” without identifying the specific portions of the inequitable conduct
7 references that were material. *Id.* at 1326. *Exergen* found that the defendant’s statement
8 of materiality was not sufficiently particular to state a claim for inequitable conduct
9 because it fails “to identify . . . where in those references the material information is
10 found.” *Exergen*, 575 F.3d at 1329. A defendant must identify the specific portions of the
11 allegedly withheld references that it claims are material. *Id.*

12 Like the defendant’s pleading in *Exergen*, Samsung has failed to identify where the
13 material information is located in its Alleged Inequitable Conduct References. Samsung’s
14 pleading brusquely describes its sixty-four Alleged Inequitable Conduct References as
15 being “highly material” to the Iacoponi ’592 patent, but fails to identify the specific
16 portions of those references it alleges are material. (*See, e.g.*, Dkt. #236, ¶83). This type
17 of pleading falls short of the *Exergen* standard and fails to state a proper claim of
18 inequitable conduct.

19 **3. Samsung fails to specify why the sixty-four Alleged Inequitable**
20 **Conduct References are non-cumulative and how an examiner**
21 **would have used the non-cumulative information in assessing the**
22 **patentability of the Iacoponi ’592 patent claims.**

23 A defendant’s inequitable conduct pleading must also allege facts that plausibly
24 suggest that its inequitable conduct references are non-cumulative. *Exergen* requires that
25 an inequitable conduct pleading must identify the claim limitations or combination of
26 claim limitations that are disclosed in the allegedly withheld references, but are missing
27 from the art of record. *Exergen*, 575 F.3d at 1329 (stating that the pleading fails to
28 “identify the particular claim limitations, or combination of claim limitations, that are

1 supposedly absent from the information of record”). This information is required to
 2 “explain both ‘why’ the withheld information is material and not cumulative, and ‘how’
 3 an examiner would have used this information in assessing the patentability of the
 4 claims.” *Id.* at 1329-30. *Exergen* held that the defendant’s pleading was deficient
 5 because it only stated that its inequitable conduct references were “not cumulative to the
 6 information already of record.” *Id.* at 1329.

7 Samsung’s pleading contains even less particularity than the defendant’s pleading
 8 rejected in *Exergen*. Where the defendant in *Exergen* at least made the allegation that its
 9 inequitable conduct references were not cumulative, Samsung fails to make such an
 10 allegation. Samsung’s pleading merely states in a conclusory manner that its sixty-four
 11 Alleged Inequitable Conduct References are “highly material” to the Iacoponi ’592 patent.
 12 (*See, e.g.*, Dkt. #236, ¶83). Samsung’s pleading does not identify the material information
 13 contained in any of its Alleged Inequitable Conduct References that is absent from the
 14 prior art of record for the Iacoponi ’592 patent. (*Id.*). Samsung also provides no
 15 explanation as to why the Alleged Inequitable Conduct References are not cumulative and
 16 how an examiner would have used those references. (*Id.*). This information is required at
 17 the pleading stage by *Exergen*. 575 F.3d at 1328-29.

18 **B. Samsung Fails To Satisfy The Intent Prong Of The Inequitable Conduct**
 19 **Test.**

20 Samsung’s allegations fail to include “underlying facts from which a court may
 21 reasonably infer that a specific individual (1) knew of the withheld material information
 22 or of the falsity of the material misrepresentation, and (2) withheld or misrepresented this
 23 information with a specific intent to deceive the PTO” as is required by *Exergen*. *Id.*¹

24
 25
 26 ¹ “Although ‘knowledge’ and ‘intent’ may be averred generally” under Rule 9(b), *Exergen*
 27 “requires that the pleadings allege sufficient underlying facts from which a court may
 28 reasonably infer that a party acted with the requisite state of mind.” 575 F.3d at 1327; *see also Ashcroft v. Iqbal*, 129 S.Ct. 1937, 1949 (2009).

1 **1. Samsung fails to properly allege that John Iacoponi was aware of**
 2 **the allegedly material information in the alleged inequitable**
 3 **conduct references.**

4 Samsung fails to provide underlying facts upon which a court could reasonably
 5 infer that John Iacoponi was aware of the allegedly withheld material information
 6 contained in Samsung's Alleged Inequitable Conduct References. According to *Exergen*,
 7 "one cannot assume that an individual, who generally knew that a reference existed, also
 8 knew of the specific material *information* contained in that reference." *Exergen*, 575 F.3d
 9 at 1330 (emphasis in original). Samsung merely alleges that Mr. Iacoponi was aware that
 10 the sixty-four references existed. (Dkt. # 236, ¶84) ("Mr. Iacoponi was aware of and
 11 retained copies of the VMIC materials distributed at the VMIC conferences he
 12 attended."). Samsung has not alleged that Mr. Iacoponi was aware of any specific
 13 material *information* contained in any of the sixty-four references.² Accordingly, as in
 14 *Exergen*, Samsung's pleading "does not allege facts that would support a reasonable
 15 inference that a relevant individual knew of the allegedly material information" contained
 16 in Samsung's references. *Exergen*, 575 F.3d at 1330.

17 **2. Samsung fails to allege facts from which a court may reasonably**
 18 **infer intent to deceive.**

19 To properly plead inequitable conduct in light of *Exergen*, Samsung must properly
 20 allege materiality and must also provide "underlying facts from which a court may
 21 reasonably infer that" John Iacoponi withheld information "with a specific intent to
 22 deceive the PTO." *Id.* at 1328-29. Samsung failed to plead the underlying facts from
 23 which an inference of deceptive intent can be made. Indeed, Samsung compounds its
 24

25 ² Nor can Samsung in good faith allege that John Iacoponi was aware of the allegedly
 26 material information contained in each of its sixty-four references. John Iacoponi's
 27 deposition testimony makes clear that he has never read the references. He testified that
 28 his practice was simply to put these materials "on a shelf, and if I was not forced to
 consolidate office space or clean up shelf space, leave them there." (Iacoponi Depo. Tr. at
 33:14-34:2 and 35:13-16).

1 failure to sufficiently plead the materiality of its sixty-four references by improperly
2 relying on this missing materiality as support for a finding of intent. Samsung's deceptive
3 intent allegations read as follows:

4 Upon information and belief, Mr. Iaconi withheld the materials
5 distributed at the VMIC conferences held between and including
6 June of 1993 to June of 1996, including the references listed in
7 paragraph 83 and the Iaconi paper, from the USPTO with an
8 intent to deceive the USPTO. Moreover, an inference of an intent to
9 deceive the USPTO is warranted, in light of: (a) *the high level of*
10 *materiality* of the materials presented at the 1993 to 1996 VMIC
11 conferences, including the references listed in paragraph 83; and/or
12 (b) the fact that the VMIC conference was well-known to those
13 working in the field of semiconductor interconnect technology;
14 and/or (c) *the large volume of highly material information*
15 distributed at the VMIC conferences between June of 1993 and June
16 of 1996; and/or (d) *the high level of materiality of the Iaconi*
17 *paper* and the fact that this paper was co-authored by the inventor
18 himself.

19 (Dkt. #236, ¶88) (emphasis added). Three of the four allegations offered to establish
20 deceptive intent relate solely to the supposed materiality of Samsung's Alleged
21 Inequitable Conduct References. (*Id.*). Samsung's allegation is insufficient. An
22 inference of deceptive intent cannot be based merely on an allegation of materiality. "The
23 required showings of materiality and intent are separate, and a showing of materiality
24 alone does not give rise to a presumption of intent to deceive." *Praxair, Inc. v. ATMI,*
25 *Inc.*, 543 F.3d 1306, 1313 (Fed. Cir. 2008). Thus, even if Samsung had properly pled
26 materiality, Samsung cannot rely solely on materiality to establish intent.

27 The only cognizable facts apart from materiality that are alleged by Samsung are
28 "the fact that the VMIC conference was well-known to those working in the field of

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semiconductor interconnect technology” and that John Iacoponi “co-authored” a paper of unspecified materiality. (Dkt. #236, ¶88). Neither of these facts can support an inference of deceptive intent because neither has anything to do with John Iacoponi’s state of mind. Put another way, even if Samsung establishes as fact that the VMIC conference is well known in the industry, it does not tend to show that John Iacoponi acted with specific intent to deceive the Patent and Trademark Office.

Samsung’s pleading fails to meet a threshold level of deceptive intent required to support an allegation of inequitable conduct. *Exergen*, 575 F.3d at 1331. Samsung’s generic assertion of sixty-four references of unknown materiality, unspecified portions of which allegedly apply to unspecified claims and claim limitations for unspecified reasons is precisely the “magic incantation to be asserted against every patentee . . .” rejected by *Exergen. Id.*

CONCLUSION

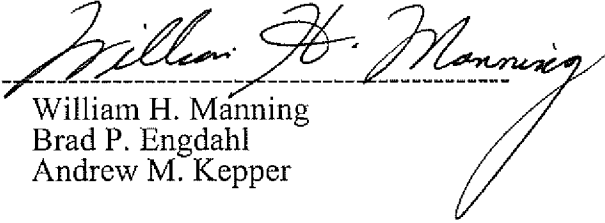
Because Samsung has failed to plead inequitable conduct for the Iacoponi ’592 patent with the particularity required to state a claim for relief under Rules 9(b) and 12(c), AMD respectfully requests judgment on the pleadings in its favor and dismissal of Samsung’s inequitable conduct allegations relating to the Iacoponi ’592 patent (Dkt. #236, ¶¶77-89, 158-171; Dkt. ##237-241, ¶¶77-89, 123-136 and; Dkt. #242, ¶¶77-89, 122-135).

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DATED: December 7, 2009

ROBINS, KAPLAN, MILLER & CIRESI L.L.P.

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