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 SAMSUNG SEMICONDUCTOR, INC., SAMSUNG AUSTIN SEMICONDUCTOR, LLC,
 16 SAMSUNG ELECTRONICS AMERICA, INC., and SAMSUNG TELECOMMUNICATIONS
 17 AMERICA, LLC

18 UNITED STATES DISTRICT COURT
 19 NORTHERN DISTRICT OF CALIFORNIA
 20 SAN FRANCISCO DIVISION

21
 22 ADVANCED MICRO DEVICES, INC., et al.,
 23 Plaintiffs and Counterdefendants,
 24 v.
 25 SAMSUNG ELECTRONICS CO., LTD., et al.,
 26 Defendants and Counterclaimants.
 27

CASE NO. 3:08-CV-0986-SI

**ANSWER AND COUNTERCLAIMS OF
 DEFENDANT AND
 COUNTERCLAIMANT SAMSUNG
 TELECOMMUNICATIONS AMERICA,
 LLC
 DEMAND FOR JURY TRIAL**

1 Defendant and Counterclaimant Samsung Telecommunications America, LLC (“STA”), by
2 and through its counsel, answers the First Amended Complaint for Patent Infringement
3 (“Complaint”) filed by Plaintiffs and Counterdefendants Advanced Micro Devices, Inc. (“AMD”)
4 and ATI Technologies, ULC (“ATI”) (collectively, “Plaintiffs and Counterdefendants”) as follows:

5 **INTRODUCTION**

6 STA admits that Plaintiffs and Counterdefendants have filed this suit for patent
7 infringement against STA and six related entities, asserting U.S. Patent No. 5,545,592 (“the ‘592
8 patent”), U.S. Patent No. 4,737,830 (“the ‘830 patent”), U.S. Patent No. 5,248,893 (“the ‘893
9 patent”), U.S. Patent No. 5,559,990 (“the ‘990 patent”), U.S. Patent No. 5,377,200 (“the ‘200
10 patent”), U.S. Patent No. 5,623,434 (“the ‘434 patent”), and U.S. Patent No. 6,784,879 (“the ‘879
11 patent”) (collectively, “the AMD patents”). STA is without knowledge or information sufficient to
12 form a belief as to the ownership of the AMD patents and on that basis, denies the allegation as to
13 ownership. Plaintiffs and Counterdefendants’ allegation regarding what the AMD patents
14 “generally cover” states a legal conclusion to which STA is not required to respond. Except as
15 expressly admitted, STA denies the allegations in the Introduction.

16 **THE PARTIES**

- 17 1. STA admits the allegations of paragraph 1 of the Complaint.
18 2. STA admits the allegations of paragraph 2 of the Complaint.
19 3. STA admits the allegations of paragraph 3 of the Complaint.
20 4. STA denies that Samsung Semiconductor, Inc. (“SSI”) is a subsidiary of SEC; SSI is
21 a subsidiary of Samsung Electronics America, Inc. (“SEA”). STA admits the remaining allegations
22 of paragraph 4 of the Complaint.
23 5. STA admits the allegations of paragraph 5 of the Complaint.
24 6. STA admits the allegations of paragraph 6 of the Complaint.
25 7. The ZIP code for 1301 East Lookout Drive, Richardson, Texas is 75082. STA
26 denies that STA is a subsidiary of SEC; STA is a subsidiary of SEA. STA admits the remaining
27 allegations of paragraph 7 of the Complaint.
28 8. STA admits the allegations of paragraph 8 of the Complaint.

1 9. STA admits the allegations of paragraph 9 of the Complaint.

2 **JURISDICTION**

3 10. STA admits that Plaintiffs and Counterdefendants purport to bring an action for
4 patent infringement. The remaining allegations of paragraph 10 of the Complaint state legal
5 conclusions, and STA is not required to, and does not, admit or deny such allegations.

6 11. STA admits that SSI maintains a place of business at 3655 North First Street, San
7 Jose, California 95134. STA denies that Defendants and Counterclaimants have committed acts of
8 patent infringement. To the extent that the remaining allegations of paragraph 11 of the Complaint
9 state legal conclusions, STA is not required to, and does not, admit or deny such allegations. To the
10 extent not expressly admitted, STA denies the allegations of paragraph 11 of the Complaint.

11 **VENUE**

12 12. STA denies that SSI has committed acts of patent infringement. STA admits that
13 SSI has a place of business in this District. To the extent that the remaining allegations of
14 paragraph 12 of the Complaint state legal conclusions, STA is not required to, and does not, admit
15 or deny such allegations. To the extent not expressly admitted, STA denies the allegations of
16 paragraph 12 of the Complaint.

17 **INTRADISTRICT ASSIGNMENT**

18 13. STA admits that Plaintiffs and Counterdefendants purport to bring an action for
19 patent infringement. The remaining allegations of paragraph 13 of the Complaint state a legal
20 conclusion which STA is not required to, and does not, admit or deny.

21 **FACTUAL BACKGROUND**

22 14. STA is without knowledge or information to form a belief as to the truth of the
23 allegations of paragraph 14 of the Complaint and, on that basis, denies them.

24 (a) STA denies that the '592 patent was duly and legally issued. STA admits that the
25 face of the '592 patent indicates that it issued from an application filed on February 24, 1995 and
26 that the purported inventor listed on the face of the patent is John A. Iacononi. To the extent the
27 remaining allegations of paragraph 14(a) of the Complaint state legal conclusions, STA is not

1 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
2 STA denies the allegations of paragraph 14(a) of the Complaint.

3 (b) STA denies that the '830 patent was duly and legally issued. STA admits that the
4 face of the '830 patent indicates that it issued from an application filed on January 8, 1986 and that
5 one of the purported inventors listed on the face of the patent is Bharat D. Patel. To the extent the
6 remaining allegations of paragraph 14(b) of the Complaint state legal conclusions, STA is not
7 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
8 STA denies the allegations of paragraph 14(b) of the Complaint.

9 (c) STA denies that the '893 patent was duly and legally issued. STA admits that the
10 face of the '893 patent indicates that it issued from an application filed on January 5, 1993 and that
11 the purported inventor listed on the face of the patent is Shinichi Sakamoto. To the extent the
12 remaining allegations of paragraph 14(c) of the Complaint state legal conclusions, STA is not
13 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
14 STA denies the allegations of paragraph 14(c) of the Complaint.

15 (d) STA denies that the '990 patent was duly and legally issued. STA admits that the
16 face of the '990 patent indicates that it issued from an application filed on September 24, 1996 and
17 that one of the purported inventors listed on the face of the patent is Pearl P. Cheng. To the extent
18 the remaining allegations of paragraph 14(d) of the Complaint state legal conclusions, STA is not
19 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
20 STA denies the allegations of paragraph 14(d) of the Complaint.

21 (e) STA denies that the '200 patent was duly and legally issued. STA admits that the
22 face of the '200 patent indicates that it issued from an application filed on August 27, 1992 and that
23 the purported inventor listed on the face of the patent is Michael D. Pedneau. To the extent the
24 remaining allegations of paragraph 14(e) of the Complaint state legal conclusions, STA is not
25 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
26 STA denies the allegations of paragraph 14(e) of the Complaint.

27 (f) STA denies that the '434 patent was duly and legally issued. STA admits that the
28 face of the '434 patent indicates that it issued from an application filed on July 27, 1994, and that

1 the purported inventor listed on the face of the patent is Stephen C. Purcell. To the extend the
2 remaining allegations of paragraph 14(f) of the Complaint state legal conclusions, SEC is not
3 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
4 STA denies the allegations of paragraph 14(f) of the Complaint.

5 (g) STA denies that the '879 patent was duly and legally issued. STA admits that the
6 face of the '879 patent indicates that it issued from an application filed on July 14, 1997 and that
7 the purported inventor listed on the face of the patent is Stephen Jonathan Orr. To the extent the
8 remaining allegations of paragraph 14(g) of the Complaint state legal conclusions, STA is not
9 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
10 STA denies the allegations of paragraph 14(g) of the Complaint.

11 15. STA denies the allegations of paragraph 15 of the Complaint.

12 16. To the extent the allegations of paragraph 16 of the Complaint state legal
13 conclusions, STA is not required to, and does not, admit or deny such allegations. STA denies that
14 STA had prior actual notice of the '592 patent no later than April 2006. STA denies that STA had
15 prior actual notice of the '830 patent no later than March 31, 2003. STA is without knowledge or
16 information sufficient to form a belief as to when Defendants other than STA received actual notice
17 of the AMD patents and on that basis, denies the allegations as to actual notice of the AMD patents
18 to those other Defendants.

19 17. STA denies the allegations of paragraph 17 of the Complaint and each of its
20 subparts.

21 18. STA denies the allegations of paragraph 18 of the Complaint.

22 **RESPONSE TO FIRST CLAIM FOR RELIEF**

23 19. STA incorporates by reference its above responses to paragraphs 1 through 18 of the
24 Complaint as if specifically set forth herein.

25 20. STA denies the allegations of paragraph 20 of the Complaint.

26 21. STA denies the allegations of paragraph 21 of the Complaint.

27 22. STA denies that STA had actual notice of the '592 patent since at least as early as
28 April 2006. STA denies that AMD presented STA with a detailed PowerPoint presentation

1 outlining how Defendants' products specifically infringed claims of the '592 patent. STA denies
2 that Plaintiffs demanded that STA license the '592 patent. STA is without knowledge or
3 information sufficient to form a belief as to when Defendants other than STA received actual notice
4 of the '592 patent and on that basis, denies the allegations as to actual notice of the '592 patent to
5 those other Defendants.

6 **RESPONSE TO SECOND CLAIM FOR RELIEF**

7 23. STA incorporates by reference its above responses to paragraphs 1 through 22 of the
8 Complaint as if specifically set forth herein.

9 24. STA denies the allegations of paragraph 24 of the Complaint.

10 25. STA denies the allegations of paragraph 25 of the Complaint.

11 26. STA denies that STA had actual notice of the '830 patent since at least as early as
12 March 31, 2003. STA denies that AMD presented STA with a detailed PowerPoint presentation
13 outlining how Defendants' products specifically infringed claims of the '830 patent. STA denies
14 that Plaintiffs demanded that STA license the '830 patent. STA is without knowledge or
15 information sufficient to form a belief as to when Defendants other than STA received actual notice
16 of the '830 patent and on that basis, denies the allegations as to actual notice of the '830 patent to
17 those other Defendants.

18 **RESPONSE TO THIRD CLAIM FOR RELIEF**

19 27. STA incorporates by reference its above responses to paragraphs 1 through 26 of the
20 Complaint as if specifically set forth herein.

21 28. STA denies the allegations of paragraph 28 of the Complaint.

22 29. STA denies the allegations of paragraph 29 of the Complaint.

23 **RESPONSE TO FOURTH CLAIM FOR RELIEF**

24 30. STA incorporates by reference its above responses to paragraphs 1 through 29 of the
25 Complaint as if specifically set forth herein.

26 31. STA denies the allegations of paragraph 31 of the Complaint.

27 32. STA denies the allegations of paragraph 32 of the Complaint.

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RESPONSE TO FIFTH CLAIM FOR RELIEF

33. STA incorporates by reference its above responses to paragraphs 1 through 32 of the Complaint as if specifically set forth herein.

34. STA denies the allegations of paragraph 34 of the Complaint.

35. STA denies the allegations of paragraph 35 of the Complaint.

RESPONSE TO SIXTH CLAIM FOR RELIEF

36. STA incorporates by reference its above responses to paragraphs 1 through 35 of the Complaint as if specifically set forth herein.

37. STA denies the allegations of paragraph 37 of the Complaint.

38. STA denies the allegations of paragraph 38 of the Complaint.

RESPONSE TO SEVENTH CLAIM FOR RELIEF

39. STA incorporates by reference its above responses to paragraphs 1 through 38 of the Complaint as if specifically set forth herein.

40. STA denies the allegations of paragraph 40 of the Complaint.

41. STA denies the allegations of paragraph 41 of the Complaint.

RESPONSE TO PRAYER FOR RELIEF

STA denies that Plaintiffs and Counterdefendants are entitled to any relief whatsoever from STA , either as prayed or otherwise.

AFFIRMATIVE DEFENSES

42. By alleging the matters set forth below as affirmative defenses, STA does not thereby allege or admit that STA has the burden of proof with respect to any of said matters.

43. For its further and separate defense to Plaintiffs and Counterdefendants' Claims and each purported cause of action therein, STA alleges as follows:

FIRST AFFIRMATIVE DEFENSE

(Non-Infringement of the '592 patent)

44. STA has not and is not infringing, contributing to the infringement of, and/or inducing infringement of any valid, enforceable claim of the '592 patent.

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SECOND AFFIRMATIVE DEFENSE

(Non-Infringement of the '830 patent)

45. STA has not and is not infringing, contributing to the infringement of, and/or inducing infringement of any valid, enforceable claim of the '830 patent.

THIRD AFFIRMATIVE DEFENSE

(Non-Infringement of the '893 patent)

46. STA has not and is not infringing, contributing to the infringement of, and/or inducing infringement of any valid, enforceable claim of the '893 patent.

FOURTH AFFIRMATIVE DEFENSE

(Non-Infringement of the '990 patent)

47. STA has not and is not infringing, contributing to the infringement of, and/or inducing infringement of any valid, enforceable claim of the '990 patent.

FIFTH AFFIRMATIVE DEFENSE

(Non-Infringement of the '200 patent)

48. STA has not and is not infringing, contributing to the infringement of, and/or inducing infringement of any valid, enforceable claim of the '200 patent.

SIXTH AFFIRMATIVE DEFENSE

(Non-Infringement of the '434 patent)

49. STA has not and is not infringing, contributing to the infringement of, and/or inducing infringement of any valid, enforceable claim of the '434 patent.

SEVENTH AFFIRMATIVE DEFENSE

(Non-Infringement of the '879 patent)

50. STA has not and is not infringing, contributing to the infringement of, and/or inducing infringement of any valid, enforceable claim of the '879 patent.

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EIGHTH AFFIRMATIVE DEFENSE

(Invalidity of the '592 patent)

51. Each claim of the '592 patent is invalid for failure to meet the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

NINTH AFFIRMATIVE DEFENSE

(Invalidity of the '830 patent)

52. Each claim of the '830 patent is invalid for failure to meet the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

TENTH AFFIRMATIVE DEFENSE

(Invalidity of the '893 patent)

53. Each claim of the '893 patent is invalid for failure to meet the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

ELEVENTH AFFIRMATIVE DEFENSE

(Invalidity of the '990 patent)

54. Each claim of the '990 patent is invalid for failure to meet the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

TWELFTH AFFIRMATIVE DEFENSE

(Invalidity of the '200 patent)

55. Each claim of the '200 patent is invalid for failure to meet the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

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THIRTEENTH AFFIRMATIVE DEFENSE

(Invalidity of the '434 patent)

56. Each claim of the '434 patent is invalid for failure to meet the statutory and decisional requirements for patentability, including but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

FOURTEENTH AFFIRMATIVE DEFENSE

(Invalidity of the '879 patent)

57. Each claim of the '879 patent is invalid for failure to meet the statutory and decisional requirements for patentability, including, but not limited to, 35 U.S.C. §§ 101-103 and/or 112.

FIFTEENTH AFFIRMATIVE DEFENSE

(Statute of Limitations)

58. Recovery on Plaintiffs and Counterdefendants' Claims is barred, in whole or in part, by the applicable statute of limitations, 35 U.S.C. § 286.

SIXTEENTH AFFIRMATIVE DEFENSE

(Equitable Doctrines)

59. Plaintiffs and Counterdefendants' Claims are barred by the equitable doctrines of laches, estoppel, waiver, implied license, and/or unclean hands.

SEVENTEENTH AFFIRMATIVE DEFENSE

(Prosecution History Estoppel)

60. Plaintiffs' claims for relief are barred under the doctrine of prosecution history estoppel to the extent that plaintiffs allege infringement under the doctrine of equivalents.

EIGHTEENTH AFFIRMATIVE DEFENSE

(Res Judicata and Collateral Estoppel)

61. On information and belief, some or all of Plaintiffs' and Counterdefendants' claims are barred, in whole or in part, by the doctrines of res judicata and/or collateral estoppel.

1 **COUNTERCLAIMS**

2 **THE PARTIES**

3 62. STA is a Delaware limited liability company with its principal place of business at
4 1301 East Lookout Drive, Richardson, Texas, 75082.

5 63. On information and belief, AMD is a Delaware corporation with its principal offices
6 at One AMD Place, Sunnyvale, California 94085.

7 64. On information and belief, ATI is a subsidiary of AMD and is incorporated in
8 Alberta, Canada, with its principal place of business at 1 Commerce Valley Drive E, Markham,
9 Ontario, L3T 7X6, Canada.

10 **JURISDICTION AND VENUE**

11 65. STA's counterclaims do not require the presence of third parties over whom this
12 Court cannot acquire jurisdiction for adjudication. This Court has subject matter jurisdiction over
13 these counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

14 66. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b), 1391(c), 1391(d),
15 and 1400(b).

16 **FIRST CLAIM FOR RELIEF**

17 **(Declaratory Judgment of Non-Infringement)**

18 67. STA repeats and realleges each and every allegation set forth in paragraphs 62
19 through 66 as if fully set forth herein.

20 68. This Claim arises under the Federal Declaratory Relief Act and the Patent Laws of
21 the United States, and more particularly, under 28 U.S.C. §§ 2201 and 2202 and 35 U.S.C. § 1, *et*
22 *seq.*

23 69. On February 18, 2008, Plaintiffs and Counterdefendants filed this lawsuit, which
24 alleges that STA infringes the AMD patents.

25 70. A justiciable controversy exists between STA on the one hand and Plaintiffs and
26 Counterdefendants on the other hand concerning the infringement and validity of the AMD patents.

27 71. STA has not and is not now infringing, contributorily infringing, or inducing
28 infringement of any of the AMD patents.

1 72. STA is entitled to a declaratory judgment that it has not infringed and does not
2 infringe directly or indirectly, contributorily or by inducement, any of the AMD patents.

3 **SECOND CLAIM FOR RELIEF**

4 **(Declaratory Judgment of Invalidity)**

5 73. STA repeats and realleges each and every allegation set forth in paragraphs 62
6 through 72 as if fully set forth herein.

7 74. This Claim arises under the Federal Declaratory Relief Act and the Patent Laws of
8 the United States, and more particularly, under 28 U.S.C. §§ 2201 and 2202 and 35 U.S.C. § 1, *et*
9 *seq.*

10 75. On February 18, 2008, Plaintiffs and Counterdefendants filed this lawsuit, which
11 alleges that STA infringes the AMD patents.

12 76. A justiciable controversy exists between STA on the one hand and Plaintiffs and
13 Counterdefendants on the other hand concerning the infringement and validity of the AMD patents.

14 77. Each claim of the AMD patents is invalid for failure to comply with the conditions
15 and requirements of patentability set forth in the patent statutes, including 35 U.S.C. §§ 101, 102,
16 103, and/or 112.

17 78. STA is entitled to a declaratory judgment that the AMD patents are invalid.

18 **PRAYER FOR RELIEF**

19 Wherefore STA prays for judgment and relief as follows:

20 a. That Plaintiffs and Counterdefendants are not entitled to the relief prayed for in their
21 Complaint, or to any relief whatsoever; and that the Complaint be dismissed with prejudice;

22 b. That the Court grant STA declaratory judgment that the AMD patents have never
23 been, and are not now, infringed by STA or by any other person using STA's products, and that
24 STA has not induced infringement of or contributorily infringed the AMD patents;

25 c. That the Court grant STA declaratory judgment that the AMD patents are invalid;

26 d. That the Court adjudge this to be an "exceptional case" and award SEC attorneys'
27 fees pursuant to 35 U.S.C. § 285.

28 e. That STA be awarded its costs of suit pursuant to 35 U.S.C. § 284; and

1 f. That the Court order such other and further relief as the Court deems proper.

2 **DEMAND FOR JURY TRIAL**

3 STA demands a jury trial on all issues that may be so tried.

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5 DATED: May 15, 2008

HELLER EHRMAN LLP

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/s/Robert T. Haslam

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ROBERT T. HASLAM

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Attorneys for Defendant and Counterclaimant
SAMSUNG TELECOMMUNICATIONS
AMERICA, LLC

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