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 SAMSUNG SEMICONDUCTOR, INC., SAMSUNG AUSTIN SEMICONDUCTOR, LLC,
 16 SAMSUNG ELECTRONICS AMERICA, INC., SAMSUNG TELECOMMUNICATIONS
 AMERICA, LLC, SAMSUNG TECHWIN CO., LTD., and SAMSUNG OPTO-ELECTRONICS
 17 AMERICA, INC.

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

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
 OPTO-ELECTRONICS AMERICA,
 INC.
 DEMAND FOR JURY TRIAL**

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

5 **INTRODUCTION**

6 SOA admits that Plaintiffs and Counterdefendants have filed this suit for patent
7 infringement against SOA 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”). SOA 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 SOA is not required to respond. Except as
15 expressly admitted, SOA denies the allegations in the Introduction.

16 **THE PARTIES**

- 17 1. SOA admits the allegations of paragraph 1 of the Complaint.
18 2. SOA admits the allegations of paragraph 2 of the Complaint.
19 3. SOA admits the allegations of paragraph 3 of the Complaint.
20 4. SOA is without sufficient information to admit or deny the allegations of paragraph
21 4 of the Complaint and on that basis denies them.
22 5. SOA is without sufficient information to admit or deny the allegations of paragraph
23 5 of the Complaint and on that basis denies them.
24 6. SOA is without sufficient information to admit or deny the allegations of paragraph
25 6 of the Complaint and on that basis denies them.
26 7. SOA is without sufficient information to admit or deny the allegations of paragraph
27 7 of the Complaint and on that basis denies them.
28 8. SOA admits the allegations of paragraph 8 of the Complaint.

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

2 **JURISDICTION**

3 10. SOA 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 SOA is not required to, and does not, admit or deny such allegations.

6 11. SOA denies that Defendants and Counterclaimants have committed acts of patent
7 infringement. To the extent that the remaining allegations of paragraph 11 of the Complaint state
8 legal conclusions, SOA is not required to, and does not, admit or deny such allegations. To the
9 extent the remaining allegations of paragraph 11 of the Complaint do not state legal allegations,
10 SOA is without sufficient information to admit or deny such allegations and on that basis denies
11 them.

12 **VENUE**

13 12. SOA denies that SSI has committed acts of patent infringement. To the extent that
14 the remaining allegations of paragraph 12 of the Complaint state legal conclusions, SOA is not
15 required to, and does not, admit or deny such allegations. To the extent the remaining allegations
16 of paragraph 12 of the Complaint do not state legal conclusions, SOA is without sufficient
17 information to admit or deny such allegations and on that basis denies them.

18 **INTRADISTRICT ASSIGNMENT**

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

22 **FACTUAL BACKGROUND**

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

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

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

3 (b) SOA denies that the '830 patent was duly and legally issued. SOA 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, SOA is not
7 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
8 SOA denies the allegations of paragraph 14(b) of the Complaint.

9 (c) SOA denies that the '893 patent was duly and legally issued. SOA 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, SOA is not
13 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
14 SOA denies the allegations of paragraph 14(c) of the Complaint.

15 (d) SOA denies that the '990 patent was duly and legally issued. SOA 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, SOA is not
19 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
20 SOA denies the allegations of paragraph 14(d) of the Complaint.

21 (e) SOA denies that the '200 patent was duly and legally issued. SOA 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, SOA is not
25 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
26 SOA denies the allegations of paragraph 14(e) of the Complaint.

27 (f) SOA denies that the '434 patent was duly and legally issued. SOA 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 SOA denies the allegations of paragraph 14(f) of the Complaint.

5 (g) SOA denies that the '879 patent was duly and legally issued. SOA 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, SOA is not
9 required to, and does not, admit or deny such allegations. To the extent not expressly admitted,
10 SOA denies the allegations of paragraph 14(g) of the Complaint.

11 15. SOA 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, SOA is not required to, and does not, admit or deny such allegations. SOA denies that
14 SOA had prior actual notice of the '592 patent no later than April 2006. SOA denies that SOA had
15 prior actual notice of the '830 patent no later than March 31, 2003. SOA is without knowledge or
16 information sufficient to form a belief as to when Defendants other than SOA 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. SOA denies the allegations of paragraph 17 of the Complaint and each of its
20 subparts.

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

22 **RESPONSE TO FIRST CLAIM FOR RELIEF**

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

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

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

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

1 outlining how Defendants' products specifically infringed claims of the '592 patent. SOA denies
2 that Plaintiffs demanded that SOA license the '592 patent. SOA is without knowledge or
3 information sufficient to form a belief as to when Defendants other than SOA 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. SOA incorporates by reference its above responses to paragraphs 1 through 22 of the
8 Complaint as if specifically set forth herein.

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

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

11 26. SOA denies that SOA had actual notice of the '830 patent since at least as early as
12 March 31, 2003. SOA denies that AMD presented SOA with a detailed PowerPoint presentation
13 outlining how Defendants' products specifically infringed claims of the '830 patent. SOA denies
14 that Plaintiffs demanded that SOA license the '830 patent. SOA is without knowledge or
15 information sufficient to form a belief as to when Defendants other than SOA 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. SOA incorporates by reference its above responses to paragraphs 1 through 26 of the
20 Complaint as if specifically set forth herein.

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

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

23 **RESPONSE TO FOURTH CLAIM FOR RELIEF**

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

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

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

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RESPONSE TO FIFTH CLAIM FOR RELIEF

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

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

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

RESPONSE TO SIXTH CLAIM FOR RELIEF

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

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

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

RESPONSE TO SEVENTH CLAIM FOR RELIEF

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

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

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

RESPONSE TO PRAYER FOR RELIEF

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

AFFIRMATIVE DEFENSES

42. By alleging the matters set forth below as affirmative defenses, SOA does not thereby allege or admit that SOA 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, SOA alleges as follows:

FIRST AFFIRMATIVE DEFENSE

(Non-Infringement of the '592 patent)

44. SOA 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. SOA 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. SOA 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. SOA 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. SOA 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. SOA 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. SOA 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' and Counterdefendants' 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. SOA is a New Jersey corporation with its principal place of business at 40 Seaview
4 Drive, Secaucus, New Jersey 07094.

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. SOA'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. SOA 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, and on
24 May 1, 2008, Plaintiffs and Counterdefendants filed their First Amended Complaint adding
25 allegations that SOA infringes the AMD patents.

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

1 71. SOA has not and is not now infringing, contributorily infringing, or inducing
2 infringement of any of the AMD patents.

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

5 **SECOND CLAIM FOR RELIEF**

6 **(Declaratory Judgment of Invalidity)**

7 73. SOA repeats and realleges each and every allegation set forth in paragraphs 62
8 through 72 as if fully set forth herein.

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

12 75. On February 18, 2008, Plaintiffs and Counterdefendants filed this lawsuit, and on
13 May 1, 2008, Plaintiffs and Counterdefendants filed their First Amended Complaint adding
14 allegations that SOA infringes the AMD patents.

15 76. A justiciable controversy exists between SOA on the one hand and Plaintiffs and
16 Counterdefendants on the other hand concerning the infringement and validity of the AMD patents.

17 77. Each claim of the AMD patents is invalid for failure to comply with the conditions
18 and requirements of patentability set forth in the patent statutes, including 35 U.S.C. §§ 101, 102,
19 103, and/or 112.

20 78. SOA is entitled to a declaratory judgment that the AMD patents are invalid.

21 **PRAAYER FOR RELIEF**

22 Wherefore SOA prays for judgment and relief as follows:

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

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

28 c. That the Court grant SOA declaratory judgment that the AMD patents are invalid;

1 d. That the Court adjudge this to be an “exceptional case” and award SEC attorneys’
2 fees pursuant to 35 U.S.C. § 285.

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

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

5 **DEMAND FOR JURY TRIAL**

6 SOA demands a jury trial on all issues that may be so tried.

7
8 DATED: July 16, 2008

HELLER EHRMAN LLP

9
10 /s/Robert T. Haslam

11 ROBERT T. HASLAM

Attorneys for Defendant and Counterclaimant

12 SAMSUNG OPTO-ELECTRONICS

13 AMERICA, INC.