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

15
16
17 INFINEON TECHNOLOGIES NORTH
AMERICA CORP.,

18 Plaintiff,

19 v.

20 MOSAID TECHNOLOGIES
21 INCORPORATED,

22 Defendant.

Civil Action No. C 02-5772 JF (RS)

**INFINEON TECHNOLOGIES AG'S
ANSWER TO COUNTERCLAIM OF
MOSAID TECHNOLOGIES
INCORPORATED**

23 (Caption continued on the next page)
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1 MOSAID TECHNOLOGIES
2 INCORPORATED,
3
4 Counterclaimant,
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6 v.
7
8 INFINEON TECHNOLOGIES NORTH
9 AMERICA CORP., INFINEON
10 TECHNOLOGIES AG, INFINEON
11 TECHNOLOGIES HOLDING NORTH
12 AMERICA CORP., and INFINEON
13 TECHNOLOGIES RICHMOND LP,
14
15 Counterdefendants.

16 **ANSWER OF INFINEON TECHNOLOGIES AG**

17 Counterdefendant Infineon Technologies AG (“Infineon AG”) hereby answers the
18 Counterclaims of Defendant Mosaid Technologies Incorporated (“Mosaid”). Infineon AG’s
19 allegations and responses are based on its own knowledge with respect to its own acts, and on
20 information and belief as to all other allegations and responses.

21 **PARTIES**

22 77. Infineon AG admits the allegations contained in Paragraph 77.

23 78. Infineon AG admits the first sentence and denies the second sentence of Paragraph
24 78.

25 79. Infineon AG admits the first sentence and denies the second sentence of Paragraph
26 79.

27 80. Infineon AG admits the first sentence and denies the second sentence of Paragraph
28 80.

81. Infineon AG denies that Infineon Technologies Richmond, LP is a Delaware corporation that maintains its principal place of business in Sandston, Virginia. Infineon AG denies that Infineon Technologies Richmond, LP is a wholly-owned subsidiary of Infineon AG. Infineon AG admits that Infineon Technologies North America Corp. is a general partner in Infineon Richmond LP. Except as specifically admitted herein, the allegations of Paragraph 81 are denied.

1 **COUNT I**

2 **INFRINGEMENT OF U.S. PATENT NO. 5,214,602**

3 89. Mosaid's Counterclaim Paragraph 89 improperly incorporates by reference
4 allegations of Paragraphs 75–76 and 89. Paragraphs 75 and 76 are "DEFENSES" included in
5 Mosaid's Answer and Counterclaims. Paragraph 89 incorporates by reference other paragraphs of
6 Mosaid's Answer and Counterclaims and does not contain any additional independent factual
7 allegations. Paragraph 89, as phrased, is incorporating by reference its incorporation by reference.
8 Infineon AG incorporates by reference the responses to Paragraphs 77–88 as though fully set forth
9 herein. Except as specifically admitted, the allegations of Paragraph 89 are denied.

10 90. Infineon AG admits that Mosaid is the listed assignee for United States Patent No.
11 5,214,602 ("the '602 patent"), that a copy of the '602 patent is attached as Exhibit 1, and that Mosaid
12 has alleged that it is the owner of the '602 patent. Except as specifically admitted, the allegations in
13 Paragraph 90 are denied.

14 91. All allegations in Paragraph 91 are denied.

15 92. Infineon AG admits that Mosaid has made accusations of infringement of the '602
16 patent. To the extent Paragraph 92 contains any other or different allegations, they are denied.

17 93. Infineon AG admits that the named counterdefendants have not entered into a license
18 agreement with Mosaid regarding the '602 patent. Except as specifically admitted, the allegations of
19 Paragraph 93 are denied.

20 94. All allegations in Paragraph 94 are denied.

21 95. All allegations in Paragraph 95 are denied.

22 96. All allegations in Paragraph 96 are denied.

23 97. All allegations in Paragraph 97 are denied.

24 **COUNT II**

25 **INFRINGEMENT OF U.S. PATENT NO. 5,751,643**

26 98. Mosaid's Counterclaim Paragraph 98 improperly incorporates by reference
27 allegations of Paragraphs 75–76. Paragraphs 75 and 76 are "DEFENSES" included in Mosaid's
28 Answer and Counterclaims. Paragraph 98 incorporates by reference other paragraphs of Mosaid's

1 Answer and Counterclaims and does not contain any additional independent factual allegations.
2 Infineon AG incorporates by reference the responses to Paragraphs 77–97 as though fully set forth
3 herein. Except as specifically admitted, the allegations of Paragraph 98 are denied.

4 99. Infineon AG admits that Mosaid is the listed assignee for United States Patent No.
5 5,751,643 (“the ’643 patent”), that a copy of the ’643 patent is attached as Exhibit 2, and that Mosaid
6 has alleged that it is the owner of the ’643 patent. Except as specifically admitted, the allegations in
7 Paragraph 99 are denied.

8 100. All allegations in Paragraph 100 are denied.

9 101. Infineon AG admits that Mosaid has made accusations of infringement of the ’643
10 patent. To the extent Paragraph 101 contains any other or different allegations, they are denied.

11 102. Infineon AG admits that the named counterdefendants have not entered into a license
12 agreement with Mosaid regarding the ’643 patent. To the extent that Paragraph 102 contains any
13 other or different allegations, they are denied.

14 103. All allegations in Paragraph 103 are denied.

15 104. All allegations in Paragraph 104 are denied.

16 105. All allegations in Paragraph 105 are denied.

17 106. All allegations in Paragraph 106 are denied.

18 **COUNT III**

19 **INFRINGEMENT OF U.S. PATENT NO. 5,822,253**

20 107. Mosaid’s Counterclaim Paragraph 107 improperly incorporates by reference
21 allegations of Paragraphs 75–76. Paragraphs 75 and 76 are “DEFENSES” included in Mosaid’s
22 Answer and Counterclaims. Paragraph 107 incorporates by reference other paragraphs of Mosaid’s
23 Answer and Counterclaims and does not contain any additional independent factual allegations.
24 Infineon AG incorporates by reference the responses to Paragraphs 77–106 as though fully set forth
25 herein. Except as specifically admitted, the allegations of Paragraph 107 are denied.

26 108. Infineon AG admits that Mosaid is the listed assignee for United States Patent No.
27 5,822,253 (“the ’253 patent”), that a copy of the ’253 patent is attached as Exhibit 3, and that Mosaid
28

1 has alleged that it is the owner of the '253 patent. Except as specifically admitted, the allegations in
2 Paragraph 108 are denied.

3 109. All allegations in Paragraph 109 are denied.

4 110. Infineon AG admits that Mosaid has made accusations of infringement of the '253
5 patent. To the extent that Paragraph 110 contains any other or different allegations, they are denied.

6 111. Infineon AG admits that the named counterdefendants have not entered into a license
7 agreement with Mosaid regarding the '253 patent. To the extent that Paragraph 111 contains any
8 other or different allegations, they are denied.

9 112. All allegations in Paragraph 112 are denied.

10 113. All allegations in Paragraph 113 are denied.

11 114. All allegations in Paragraph 114 are denied.

12 115. All allegations in Paragraph 115 are denied.

13 **COUNT IV**

14 **INFRINGEMENT OF U.S. PATENT NO. 6,278,640 B1**

15 116. Mosaid's Counterclaim Paragraph 116 improperly incorporates by reference
16 allegations of Paragraphs 75–76. Paragraphs 75 and 76 are "DEFENSES" included in Mosaid's
17 Answer and Counterclaims. Paragraph 116 incorporates by reference other paragraphs of Mosaid's
18 Answer and Counterclaims and does not contain any additional independent factual allegations.
19 Infineon AG incorporates by reference the responses to Paragraphs 77–115 as though fully set forth
20 herein. Except as specifically admitted, the allegations of Paragraph 116 are denied.

21 117. Infineon AG admits that Mosaid is the listed assignee for United States Patent No.
22 6,278,640 B1 ("the '640 patent"), that a copy of the '640 patent is attached as Exhibit 4, and that
23 Mosaid has alleged that it is the owner of the '640 patent. Except as specifically admitted, the
24 allegations in Paragraph 117 are denied.

25 118. All allegations in Paragraph 118 are denied.

26 119. Infineon AG admits that Mosaid has made accusations of infringement of the '640
27 patent. To the extent that Paragraph 119 contains any other or different allegations, they are denied.

1 133. All allegations in Paragraph 133 are denied.

2 **COUNT VI**

3 **INFRINGEMENT OF U.S. PATENT NO. 6,055,201**

4 134. Mosaid's Counterclaim Paragraph 134 improperly incorporates by reference
5 allegations of Paragraphs 75–76. Paragraphs 75 and 76 are “DEFENSES” included in Mosaid's
6 Answer and Counterclaims. Paragraph 134 incorporates by reference other paragraphs of Mosaid's
7 Answer and Counterclaims and does not contain any additional independent factual allegations.
8 Infineon AG incorporates by reference the responses to Paragraphs 77–133 as though fully set forth
9 herein. Except as specifically admitted, the allegations of Paragraph 134 are denied.

10 135. Infineon AG admits that Mosaid is the listed assignee for United States Patent No.
11 6,055,201 (“the '201 patent”), that a copy of the '201 patent is attached as Exhibit 6, and that Mosaid
12 has alleged that it is the owner of the '201 patent. Except as specifically admitted, the allegations of
13 Paragraph 135 are denied.

14 136. All allegations in Paragraph 136 are denied.

15 137. Infineon AG admits that Mosaid has made accusations of infringement of the '201
16 patent. To the extent that Paragraph 137 contains any other or different allegations, they are denied.

17 138. Infineon AG admits that the named counterdefendants have not entered into a license
18 agreement with Mosaid regarding the '201 patent. To the extent that Paragraph 138 contains any
19 other or different allegations, they are denied.

20 139. All allegations in Paragraph 139 are denied.

21 140. All allegations in Paragraph 140 are denied.

22 141. All allegations in Paragraph 141 are denied.

23 142. All allegations in Paragraph 142 are denied.

24 **COUNT VII**

25 **INFRINGEMENT OF U.S. PATENT NO. 6,236,581 B1**

26 143. Mosaid's Counterclaim Paragraph 143 improperly incorporates by reference
27 allegations of Paragraphs 75–76 and 143. Paragraphs 75 and 76 are “DEFENSES” included in
28 Mosaid's Answer and Counterclaims. Paragraph 143 incorporates by reference other paragraphs of

1 Mosaid's Answer and Counterclaims and does not contain any additional independent factual
2 allegations. Paragraph 143, as phrased, is incorporating by reference its incorporation by reference.
3 Infineon AG incorporates by reference the responses to Paragraphs 77–142 as though fully set forth
4 herein. Except as specifically admitted, the allegations of Paragraph 143 are denied.

5 144. Infineon AG admits that Mosaid is the listed assignee for United States Patent No.
6 6,236,581 (“the ’581 patent”), that a copy of the patent is attached as Exhibit 7, and that Mosaid has
7 alleged that it is the owner of the patent. Except as specifically admitted, the allegations of
8 Paragraph 144 are denied.

9 145. All allegations in Paragraph 145 are denied.

10 146. Infineon AG admits that Mosaid has made accusations of infringement of the ’581
11 patent. To the extent that Paragraph 146 contains any other or different allegations, they are denied.

12 147. Infineon AG admits that the named counterdefendants have not entered into a license
13 agreement with Mosaid regarding the ’581 patent. To the extent that Paragraph 147 contains any
14 other or different allegations, they are denied.

15 148. All allegations in Paragraph 148 are denied.

16 149. All allegations in Paragraph 149 are denied.

17 150. All allegations in Paragraph 150 are denied.

18 151. All allegations in Paragraph 151 are denied.

19 152. All allegations in Paragraph 152 are denied.

20 153. All allegations in Paragraph 153 are denied.

21 **RELIEF**

22 Infineon AG denies that Mosaid is entitled to any relief, either as requested in Mosaid's
23 Counterclaims or otherwise.

24 Infineon AG further denies each and every allegation contained in Mosaid's Counterclaims,
25 to which Infineon AG has not specifically responded, if any.

DEFENSES

Infineon AG alleges and asserts the following defenses in response to the allegations contained in Mosaid’s Counterclaims, undertaking the burden of proof only as to those defenses deemed affirmative defenses by law, regardless of how such defenses are denominated herein:

1. The Counterclaims fail to state a claim upon which relief can be granted.
2. Lack of personal jurisdiction with respect to Infineon AG.
3. Insufficiency of service of process on Infineon AG.
4. Infineon AG incorporates by reference as though fully set forth herein the allegations from Infineon Technologies North America Corp.’s original Complaint setting forth allegations of non-infringement of the asserted patents, invalidity of the asserted patents, and unenforceability of the asserted patents.
5. Infineon AG has not infringed any valid and enforceable claim of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253, 6,278,640, 5,828,620, 6,055,201 and 6,236,581.
6. Each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253, 6,278,640, 5,828,620, 6,055,201 and 6,236,581 is invalid for failing to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 101, 102, 103 and/or 112.
7. Each of U.S. Patent Nos. 5,822,253, 5,828,620 and 6,055,201 is invalid due to double patenting.
8. Each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253, 6,278,640, 5,828,620, 6,055,201 and 6,236,581 is unenforceable due to laches and/or prosecution laches.
9. Each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253, and 6,278,640 is unenforceable due to inequitable conduct in the procurement of those patents and/or related patents.
10. Mosaid’s claims for injunctive relief are barred in light of the fact that Mosaid has failed to meet the requirements for preliminary or permanent injunctive relief.
11. Mosaid’s claims are barred by estoppel, including the doctrine of prosecution history estoppel.

1 patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 101, 102, 103 and/or
2 112;

3 (f) That this Court hold that each of U.S. Patent Nos. 5,822,253, 5,828,620 and
4 6,055,201 is invalid under the doctrine of double patenting;

5 (g) That this Court hold that each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253,
6 6,278,640, 5,828,620, 6,055,201 and 6,236,581 is unenforceable due to laches and/or prosecution
7 laches.

8 (h) That this Court hold that each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253,
9 and 6,278,640 is unenforceable due to inequitable conduct in the procurement of those patents and/or
10 related patents;

11 (i) Awarding Infineon AG its costs and disbursements in this action, including
12 reasonable attorneys' fees; and

13 (j) Awarding Infineon AG such other and further relief as the Court deems just and
14 proper.

15 Dated: March 24, 2003

KIRKLAND & ELLIS

17 s/Eric R. Lamison

18 By: _____

Eric R. Lamison
Attorneys for Counterdefendant
INFINEON TECHNOLOGIES AG