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AMERICA CORP. and Counterdefendants  
12 INFINEON TECHNOLOGIES AG, INFINEON TECHNOLOGIES  
HOLDING NORTH AMERICA INC. and INFINEON  
13 TECHNOLOGIES RICHMOND, LP

14  
15 UNITED STATES DISTRICT COURT  
16 NORTHERN DISTRICT OF CALIFORNIA  
17 SAN JOSE DIVISION  
18

19 INFINEON TECHNOLOGIES NORTH  
20 AMERICA CORP.,

21 Plaintiff,

22 v.

23 MOSAID TECHNOLOGIES  
24 INCORPORATED,

25 Defendant.

26 AND RELATED COUNTERCLAIMS.  
27  
28

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

**REPLY AND ANSWER TO MOSAID'S  
SECOND AMENDED COUNTERCLAIMS  
AND RELATED COUNTER-  
COUNTERCLAIM**

**DEMAND FOR JURY TRIAL**

1 Plaintiff and Counterdefendant Infineon Technologies North America Corp. hereby replies to  
2 the second amended Counterclaims of Defendant Mosaid Technologies Incorporated (“Mosaid”). In  
3 addition, Counterdefendants Infineon Technologies AG, Infineon Technologies Holding North  
4 America Inc. and Infineon Technologies Richmond, LP hereby answer the second amended  
5 Counterclaims of Defendant Mosaid. For the purposes of this reply and answer, Plaintiff and  
6 Counterdefendants are collectively referred to as “Infineon.” Plaintiff and Counterdefendants’  
7 allegations and responses are based on their own knowledge with respect to their own acts and on  
8 information and belief as to all other allegations and responses.

9 **COUNTERCLAIMS**

10 **PARTIES**

11 73. Infineon admits the allegations contained in Paragraph 73.

12 74. Infineon admits the first sentence and denies the second sentence in Paragraph 74.

13 75. Infineon admits the first sentence and denies the second sentence in Paragraph 75.

14 76. Infineon admits the first sentence and denies the second sentence in Paragraph 76.

15 77. Infineon denies that Infineon Technologies Richmond, LP is a Delaware corporation  
16 that maintains its principal place of business in Sandston, Virginia. Infineon denies that Infineon  
17 Technologies Richmond, LP is a wholly-owned subsidiary of Infineon Technologies AG. Infineon  
18 admits that Infineon Technologies North America Corp. is a general partner in Infineon Richmond  
19 LP.

20 78. This Paragraph contains a statement of Mosaid’s abbreviation choices to which no  
21 response is required, and on that basis any allegations in the Paragraph are denied.

22 79. Infineon admits that Infineon Technologies Richmond, LP manufactures DRAM  
23 semiconductor devices at a facility located in Sandston, Virginia. Except as specifically admitted  
24 herein, the allegations in Paragraph 79 are denied.

25 80. Infineon admits that Infineon Technologies AG purchases output from the facility in  
26 Sandston, Virginia. Infineon further admits that Infineon Technologies North America Corp. sells  
27 and offers to sell DRAM semiconductor memory devices in the United States, including the  
28

1 Northern District of California. Except as specifically admitted herein, the allegations of Paragraph  
2 80 are denied.

3 81. Infineon admits that Infineon Technologies North America Corp. sells, offers to sell,  
4 and imports into the United States DRAM semiconductor devices. Infineon admits that Infineon  
5 Technologies North America Corp.'s activities in selling and offering for sale such items include the  
6 Northern District of California. Infineon admits that Infineon Technologies Richmond, LP  
7 manufactures DRAM semiconductor devices at a facility located in Sandston, Virginia. Except as  
8 specifically admitted herein, the allegations in Paragraph 81 are denied.

9 82. All allegations in Paragraph 82 are denied.

### 10 **JURISDICTION**

11 83. Infineon admits that Mosaid's Counterclaims purport to assert claims arising under  
12 the patent laws of the United States, Title 35, United States Code. Infineon admits that this Court  
13 has jurisdiction over the subject matter of this action. To the extent Paragraph 83 contains any other  
14 or different allegations, they are denied.

15 84. Infineon admits that personal jurisdiction in this case exists only with respect to  
16 Infineon Technologies North America Corp., Infineon Technologies Richmond, LP, and Infineon  
17 Technologies Holding North America Inc. Except as specifically admitted herein, the allegations in  
18 Paragraph 84 are denied.

### 19 **COUNT I** 20 **INFRINGEMENT OF U.S. PATENT NO. 5,214,602**

21 85. Mosaid's Counterclaim Paragraph 85 improperly incorporates by reference  
22 allegations of Paragraphs 71-72. Paragraphs 71 and 72 are "DEFENSES" included in Mosaid's  
23 Answer and Counterclaims. Paragraph 85 incorporates by reference other paragraphs of Mosaid's  
24 Answer and Counterclaims and does not contain any additional independent factual allegations.  
25 Infineon incorporates by reference the responses to Paragraphs 73-84 as though fully set forth  
26 herein. Except as specifically admitted, the allegations in Paragraph 85 are denied.

27 86. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
28 5,214,602 ("the '602 patent"), that a copy of the '602 patent is attached as Exhibit 1, and that Mosaid

1 has alleged that it is the owner of the '602 patent. Except as specifically admitted, the allegations in  
2 Paragraph 86 are denied.

3 87. All allegations in Paragraph 87 are denied.

4 88. Infineon admits that Mosaid has made accusations of infringement of the '602 patent.  
5 To the extent Paragraph 88 contains any other or different allegations, they are denied.

6 89. Infineon admits that the named counterdefendants have not entered into a license  
7 agreement with Mosaid regarding the '602 patent. Except as specifically admitted, the allegations in  
8 Paragraph 89 are denied.

9 90. All allegations in Paragraph 90 are denied.

10 91. All allegations in Paragraph 91 are denied.

11 92. All allegations in Paragraph 92 are denied.

12 93. All allegations in Paragraph 93 are denied.

13 **COUNT II**  
14 **INFRINGEMENT OF U.S. PATENT NO. 5,751,643**

15 94. Mosaid's Counterclaim Paragraph 94 improperly incorporates by reference  
16 allegations of Paragraphs 71–72. Paragraphs 71 and 72 are “DEFENSES” included in Mosaid's  
17 Answer and Counterclaims. Paragraph 94 incorporates by reference other paragraphs of Mosaid's  
18 Answer and Counterclaims and does not contain any additional independent factual allegations.  
19 Infineon incorporates by reference the responses to Paragraphs 73–93 as though fully set forth  
20 herein. Except as specifically admitted, the allegations in Paragraph 94 are denied.

21 95. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
22 5,751,643 (“the '643 patent”), that a copy of the '643 patent is attached as Exhibit 2, and that Mosaid  
23 has alleged that it is the owner of the '643 patent. Except as specifically admitted, the allegations in  
24 Paragraph 95 are denied.

25 96. All allegations in Paragraph 96 are denied.

26 97. Infineon admits that Mosaid has made accusations of infringement of the '643 patent.  
27 To the extent Paragraph 97 contains any other or different allegations, they are denied.

1 98. Infineon admits that the named counterdefendants have not entered into a license  
2 agreement with Mosaid regarding the '643 patent. To the extent that Paragraph 98 contains any  
3 other or different allegations, they are denied.

4 99. All allegations in Paragraph 99 are denied.

5 100. All allegations in Paragraph 100 are denied.

6 101. All allegations in Paragraph 101 are denied.

7 102. All allegations in Paragraph 102 are denied.

8 **COUNT III**  
9 **INFRINGEMENT OF U.S. PATENT NO. 5,822,253**

10 103. Mosaid's Counterclaim Paragraph 103 improperly incorporates by reference  
11 allegations of Paragraphs 71–72. Paragraphs 71 and 72 are “DEFENSES” included in Mosaid's  
12 Answer and Counterclaims. Paragraph 103 incorporates by reference other paragraphs of Mosaid's  
13 Answer and Counterclaims and does not contain any additional independent factual allegations.  
14 Infineon incorporates by reference the responses to Paragraphs 73–102 as though fully set forth  
15 herein. Except as specifically admitted, the allegations in Paragraph 103 are denied.

16 104. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
17 5,822,253 (“the '253 patent”), that a copy of the '253 patent is attached as Exhibit 3, and that Mosaid  
18 has alleged that it is the owner of the '253 patent. Except as specifically admitted, the allegations in  
19 Paragraph 104 are denied.

20 105. All allegations in Paragraph 105 are denied.

21 106. Infineon admits that Mosaid has made accusations of infringement of the '253 patent.  
22 To the extent that Paragraph 106 contains any other or different allegations, they are denied.

23 107. Infineon admits that the named counterdefendants have not entered into a license  
24 agreement with Mosaid regarding the '253 patent. To the extent that Paragraph 107 contains any  
25 other or different allegations, they are denied.

26 108. All allegations in Paragraph 108 are denied.

27 109. All allegations in Paragraph 109 are denied.

28 110. All allegations in Paragraph 110 are denied.

1 111. All allegations in Paragraph 111 are denied.

2 **COUNT IV**  
3 **INFRINGEMENT OF U.S. PATENT NO. 6,278,640 B1**

4 112. Mosaid's Counterclaim Paragraph 112 improperly incorporates by reference  
5 allegations of Paragraphs 71–72. Paragraphs 71 and 72 are “DEFENSES” included in Mosaid's  
6 Answer and Counterclaims. Paragraph 112 incorporates by reference other paragraphs of Mosaid's  
7 Answer and Counterclaims and does not contain any additional independent factual allegations.  
8 Infineon incorporates by reference the responses to Paragraphs 73–111 as though fully set forth  
9 herein. Except as specifically admitted, the allegations in Paragraph 112 are denied.

10 113. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
11 6,278,640 B1 (“the '640 patent”), that a copy of the '640 patent is attached as Exhibit 4, and that  
12 Mosaid has alleged that it is the owner of the '640 patent. Except as specifically admitted, the  
13 allegations in Paragraph 113 are denied.

14 114. All allegations in Paragraph 114 are denied.

15 115. Infineon admits that Mosaid has made accusations of infringement of the '640 patent.  
16 To the extent that Paragraph 115 contains any other or different allegations, they are denied.

17 116. Infineon admits that the named counterdefendants have not entered into a license  
18 agreement with Mosaid regarding the '640 patent. To the extent that Paragraph 116 contains any  
19 other or different allegations, they are denied.

20 117. All allegations in Paragraph 117 are denied.

21 118. All allegations in Paragraph 118 are denied.

22 119. All allegations in Paragraph 119 are denied.

23 120. All allegations in Paragraph 120 are denied.

24 **COUNT V**  
25 **INFRINGEMENT OF U.S. PATENT NO. 5,828,620**

26 121. Mosaid's Counterclaim Paragraph 121 improperly incorporates by reference  
27 allegations of Paragraphs 71–72. Paragraphs 71 and 72 are “DEFENSES” included in Mosaid's  
28 Answer and Counterclaims. Paragraph 121 incorporates by reference other paragraphs of Mosaid's

1 Answer and Counterclaims and does not contain any additional independent factual allegations.  
2 Infineon incorporates by reference the responses to Paragraphs 73-120 as though fully set forth  
3 herein. Except as specifically admitted, the allegations in Paragraph 121 are denied.

4 122. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
5 5,828,620 (“the ’620 patent”), that a copy of the ’620 patent is attached as Exhibit 5, and that Mosaid  
6 has alleged that it is the owner of the ’620 patent. Except as specifically admitted, the allegations in  
7 Paragraph 122 are denied.

8 123. All allegations in Paragraph 123 are denied.

9 124. Infineon admits that Mosaid has made accusations of infringement of the ’620 patent.  
10 To the extent that Paragraph 124 contains any other or different allegations, they are denied.

11 125. Infineon admits that the named counterdefendants have not entered into a license  
12 agreement with Mosaid regarding the ’620 patent. To the extent that Paragraph 125 contains any  
13 other or different allegations, they are denied.

14 126. All allegations in Paragraph 126 are denied.

15 127. All allegations in Paragraph 127 are denied.

16 128. All allegations in Paragraph 128 are denied.

17 129. All allegations in Paragraph 129 are denied.

18 **COUNT VI**  
19 **INFRINGEMENT OF U.S. PATENT NO. 6,055,201**

20 130. Mosaid’s Counterclaim Paragraph 130 improperly incorporates by reference  
21 allegations of Paragraphs 71–72. Paragraphs 71 and 72 are “DEFENSES” included in Mosaid’s  
22 Answer and Counterclaims. Paragraph 130 incorporates by reference other paragraphs of Mosaid’s  
23 Answer and Counterclaims and does not contain any additional independent factual allegations.  
24 Infineon incorporates by reference the responses to Paragraphs 73–129 as though fully set forth  
25 herein. Except as specifically admitted, the allegations in Paragraph 130 are denied.

26 131. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
27 6,055,201 (“the ’201 patent”), that a copy of the ’201 patent is attached as Exhibit 6, and that Mosaid  
28

1 has alleged that it is the owner of the '201 patent. Except as specifically admitted, the allegations in  
2 Paragraph 131 are denied.

3 132. All allegations in Paragraph 132 are denied.

4 133. Infineon admits that Mosaid has made accusations of infringement of the '201 patent.  
5 To the extent that Paragraph 133 contains any other or different allegations, they are denied.

6 134. Infineon admits that the named counterdefendants have not entered into a license  
7 agreement with Mosaid regarding the '201 patent. To the extent that Paragraph 134 contains any  
8 other or different allegations, they are denied.

9 135. All allegations in Paragraph 135 are denied.

10 136. All allegations in Paragraph 136 are denied.

11 137. All allegations in Paragraph 137 are denied.

12 138. All allegations in Paragraph 138 are denied.

13 **COUNT VII**  
14 **INFRINGEMENT OF U.S. PATENT NO. 6,236,581 B1**

15 139. Mosaid's Counterclaim Paragraph 139 improperly incorporates by reference  
16 allegations of Paragraphs 71–72. Paragraphs 71 and 72 are “DEFENSES” included in Mosaid's  
17 Answer and Counterclaims. Paragraph 139 incorporates by reference other paragraphs of Mosaid's  
18 Answer and Counterclaims and does not contain any additional independent factual allegations.  
19 Infineon incorporates by reference the responses to Paragraphs 73–138 as though fully set forth  
20 herein. Except as specifically admitted, the allegations in Paragraph 139 are denied.

21 140. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
22 6,236,581 (“the '581 patent”), that a copy of the patent is attached as Exhibit 7, and that Mosaid has  
23 alleged that it is the owner of the patent. Except as specifically admitted, the allegations in  
24 Paragraph 140 are denied.

25 141. All allegations in Paragraph 141 are denied.

26 142. Infineon admits that Mosaid has made accusations of infringement of the '581 patent.  
27 To the extent that Paragraph 142 contains any other or different allegations, they are denied.

1 143. Infineon admits that the named counterdefendants have not entered into a license  
2 agreement with Mosaid regarding the '581 patent. To the extent that Paragraph 143 contains any  
3 other or different allegations, they are denied.

4 144. All allegations in Paragraph 144 are denied.

5 145. All allegations in Paragraph 145 are denied.

6 146. All allegations in Paragraph 146 are denied.

7 147. All allegations in Paragraph 147 are denied.

8 **COUNT VIII**  
9 **INFRINGEMENT OF U.S. PATENT NO. 6,067,272**

10 148. Mosaid's Counterclaim Paragraph 148 improperly incorporates by reference  
11 allegations of Paragraphs 71–72. Paragraphs 71 and 72 are “DEFENSES” included in Mosaid's  
12 Answer and Counterclaims. Paragraph 148 incorporates by reference other paragraphs of Mosaid's  
13 Answer and Counterclaims and does not contain any additional independent factual allegations.  
14 Infineon incorporates by reference the responses to Paragraphs 73–147 as though fully set forth  
15 herein. Except as specifically admitted, the allegations in Paragraph 148 are denied.

16 149. Infineon admits that Mosaid is the listed assignee for United States Patent No.  
17 6,067,272 (“the '272 patent”), that a copy of the patent is attached as Exhibit 8, and that Mosaid has  
18 alleged that it is the owner of the patent. Except as specifically admitted, the allegations of  
19 Paragraph 149 are denied.

20 150. All allegations in Paragraph 150 are denied.

21 151. Infineon admits that Mosaid has made accusations of infringement of the '272 patent.  
22 To the extent that Paragraph 151 contains any other or different allegations, they are denied.

23 152. All allegations in Paragraph 152 are denied.

24 153. All allegations in Paragraph 153 are denied.

25 154. All allegations in Paragraph 154 are denied.

26 155. All allegations in Paragraph 155 are denied.

27 156. All allegations in Paragraph 156 are denied.

28 157. All allegations in Paragraph 157 are denied.

1 **RELIEF**

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

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

6 **DEFENSES**

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

10 1. The Counterclaims fail to state a claim upon which relief can be granted.  
11 2. Lack of personal jurisdiction with respect to Infineon Technologies AG.  
12 3. Insufficiency of service of process on Infineon Technologies AG.  
13 4. Infineon incorporates by reference as though fully set forth herein the allegations  
14 from Infineon Technologies North America Corp.'s Complaint setting forth allegations of non-  
15 infringement of the asserted patents, invalidity of the asserted patents, and unenforceability of the  
16 asserted patents.

17 5. Infineon has not infringed any valid and enforceable claim of U.S. Patent Nos.  
18 5,214,602, 5,751,643, 5,822,253, 6,278,640, 5,828,620, 6,055,201, 6,236,581, and 6,067,272.

19 6. Each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253, 6,278,640, 5,828,620,  
20 6,055,201, 6,236,581, and 6,067,272 is invalid for failing to meet the conditions of patentability  
21 and/or otherwise comply with the requirements of 35 U.S.C. §§ 101 (due to lack of utility/  
22 operability), 102, 103 and/or 112.

23 7. Each of U.S. Patent Nos. 5,822,253, 5,828,620, 6,055,201, and 6,067,272 is invalid  
24 due to double patenting.

25 8. Each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253, 6,278,640, 5,828,620,  
26 6,055,201, and 6,236,581 is unenforceable due to laches and/or prosecution laches.



1 **FACTUAL BACKGROUND FOR COUNTER-COUNTERCLAIMS**

2 **JEDEC**

3 1. The JEDEC Solid State Technology Association (“JEDEC”) is a standards-setting  
4 body affiliated with the Electronic Industries Alliance (“EIA”), a trade association representing the  
5 electronics industry. EIA is a corporation organized under the laws of the State of Illinois. JEDEC  
6 promotes “the development and standardization of terms, definitions, product characterization, test  
7 methods, manufacturing support functions and mechanical standards for solid state products.”  
8 Standards are typically proposed, evaluated, and formalized in JEDEC committees and/or  
9 subcommittees and then presented for approval to the Board of Directors, which has final authority  
10 to approve or disapprove all proposed standards.

11 **JEDEC POLICIES AND PROCEDURES**

12 2. JEDEC requires that standardization programs must be “conducted under strict  
13 policies designed to promote and stimulate our free enterprise system and to make sure that laws for  
14 maintaining and preserving this system are vigorously followed” and “shall not be proposed for or  
15 indirectly result in. . .restricting competition, giving a competitive advantage to any manufacturer,  
16 [or] excluding competitors from the market.”

17 3. JEDEC also strives to avoid incorporating patented technologies into its published  
18 standards, or at a minimum to ensure that such technologies, if incorporated, will be licensed on  
19 royalty-free or otherwise reasonable and non-discriminatory terms.

20 4. JEDEC requires that its members disclose any patents, or pending patents, that relate  
21 to the standards-setting work undertaken by the organization.

22 5. At all times relevant herein, meetings of JEDEC’s committees and subcommittees  
23 were routinely opened with a statement by the chairperson underscoring the existence of such  
24 disclosure obligations.

25 6. This practice conforms with requirements set forth in the JEDEC Manual, which  
26 provides: “The chairperson of any JEDEC committee [expressly defined to include, among other  
27 things, subcommittees] must call to the attention of all those present the requirements contained in  
28 EIA Legal Guides, and the obligation of all participants to inform the meeting of any knowledge

1 they may have of any patents, or pending patents, that might be involved in the work they are  
2 undertaking.”

3 7. Since at least October 1993, the JEDEC Manual has required that no standard be  
4 drafted to include “patented items” - or “items and processes for which a patent has been applied” -  
5 unless (1) a well-supported technical justification for inclusion of the patented items exists; and (2)  
6 the patent holder provides express written assurance that that it will license the patented technology  
7 either “without compensation” or under “reasonable terms and conditions that are demonstrably free  
8 of any unfair discrimination.”

9 8. Since at least October 1993, the JEDEC Manual has also expressly provided that  
10 these disclosure and licensing obligations shall apply “with equal force” when JEDEC members,  
11 after a standard has been adopted, discover new information about existing patent rights - or  
12 otherwise obtain new patent rights - involving that standard.

13 9. In such situations, the JEDEC member must make the same disclosures and provide  
14 the same assurances as would be required if the member knew of such patent rights when the  
15 relevant standard was adopted.

16 10. Thus, the policies, procedures, and practices existing within JEDEC throughout all  
17 times relevant herein have imposed upon JEDEC members the following basic duties concerning the  
18 disclosure of relevant patent-related information and the licensing of relevant patent rights:

19 (a) First, to the extent any JEDEC member held patents or pending patents that  
20 relate to the standard-setting work that JEDEC was undertaking, the member was required to  
21 disclose the relevant patents or pending patents.

22 (b) Second, in the event that technologies covered by a member’s known patents  
23 or pending patents were proposed for inclusion in a JEDEC standard, the member was required to  
24 state whether the technology would be made available either “without compensation” or under  
25 “reasonable terms and conditions that are demonstrably free of any unfair discrimination.” Absent  
26 the member’s agreement to one of these two conditions, the JEDEC rules would not allow the  
27 technology to be incorporated into a proposed standard.

## JEDEC WORK INVOLVING SDRAM STANDARDS

11. The JEDEC committee responsible for overseeing the development of standards relating to memory devices is known as the JC-42 Committee on Solid State Memories (“JC-42”), which has several subcommittees, including the JC-42.3 Subcommittee on RAM Devices (“JC-42.3”).

12. Beginning in or around 1990, JC-42.3 commenced work on standards relating to the design and architecture of synchronous DRAM, referred to within JC-42.3 as “SDRAM.” JEDEC members involved in the SDRAM-related work of JC-42.3 have over time included virtually all leading memory designers, manufacturers, and users, whether based in the U.S. or abroad.

13. During the 1990s, JEDEC issued several SDRAM-related standards, the first of which was published in November 1993 and was identified as Release 4 of the 21-C Standard. Later releases of the 21-C Standard followed with certain portions relating to SDRAM. In August 1999, JEDEC published a substantially augmented SDRAM standard - Release 9 of the 21-C Standard - which introduced a second generation of SDRAM that became known as “double data rate” or “DDR” SDRAM. A standard specific to DDR SDRAM requiring the use of a delayed lock loop (DLL) to resolve clock skew was released by JEDEC in June 2000. Further revisions were released in May 2002 and March 2003.

14. JEDEC adopted and published these standards through the following process:

(a) At regularly scheduled meetings of the JC-42.3 Subcommittee, which typically occurred on a quarterly basis - as well as affiliated committee and task group meetings, which were scheduled as needed - members were allowed to make presentations concerning specific concepts or technologies that they proposed for inclusion in a standard under development.

(b) Such presentations generally were accompanied by written materials, which, in addition to being shared with all members present at the meeting, were reproduced and attached to the official meeting minutes.

(c) Proposals were presented to the subcommittee membership for approval through a formal balloting process, pursuant to which written ballots were distributed and received by mail.

1 (d) Votes were then tabulated at the subsequent meeting of the subcommittee, at  
2 which time members voting “No” were required to explain their reasons for opposing the proposal.

3 (e) A two-thirds majority was required to pass a standards proposal.

4 15. Individual proposals, once approved by JC-42.3, were often held at the subcommittee  
5 level until a complete package of related proposals was ready to be forwarded to the Council for  
6 final ratification.

7 16. The JEDEC’s JC-42.3 Subcommittee’s work on SDRAM standards continues today,  
8 and a third-generation SDRAM standard, known as “DDR II,” which also includes the use of a DLL,  
9 is expected to be completed later this year.

#### 10 **MOSAID’S ’042 PATENT APPLICATION AND ITS PROGENY**

11 17. On October 6, 1994, Mosaid filed U.S. Patent Application 08/319,042 (“the ’042  
12 application”) with the USPTO - the first in a line of patent applications with claims that, on  
13 information and belief, are generally directed to the use of a DLL in an SDRAM. The ’042  
14 application issued as U.S. Patent No. 5,796,673 on August 18, 1998.

15 18. Mosaid filed multiple continuation applications from the original '042 application,  
16 which are outlined in the following chart:

Patent/ Published Application	Issue/ Publication Date	Application	Application Date
20030107944	June 12, 2003	10/348,062 Continuation of '217	January 17, 2003
20030090952	May 15, 2003	10/279,217 Continuation of 09/977,088	October 23, 2002
20020075747	June 20, 2002	09/977,088 Continuation of '274	October 12, 2001
6,314,052	November 6, 2001	09/761,274 Continuation of 09/392,088	January 16, 2001
6,205,083	March 20, 2001	09/392,088 Continuation of '095	September 8, 1999
6,067,272	May 23, 2000	08/996,095 Continuation of '042	December 22, 1997
5,796,673	August 18, 1998	08/319,042	October 6, 1994





1 33. Mosaid has sued Infineon for infringement of the '272 patent.

2 34. Mosaid has alleged that Infineon infringes the '272 patent in both its Amended  
3 Answer and Counterclaims of May 30, 2003 and Second Amended Answer and Counterclaims of  
4 July 11, 2003.

5 35. Infineon has not infringed any valid and enforceable claim of the '272 patent, either  
6 literally or under the doctrine of equivalents, directly or indirectly.

7 36. The '272 patent is invalid because of its failure to meet the conditions of patentability  
8 and/or otherwise comply with the requirements of 35 U.S.C. §§ 101 (due to double patenting and a  
9 lack of utility and/or operability), 102, 103 and/or 112.

10 37. The '272 patent is unenforceable against Infineon due to equitable estoppel and/or  
11 Mosaid is barred from obtaining a license from Infineon under U.S. Patent No. 6,067,272 on  
12 anything more than reasonable terms and conditions that are demonstrably free of any unfair  
13 discrimination.

14 38. Infineon has an implied license to practice the claims of U.S. Patent No. 6,067,272.

15 39. A judicial declaration of noninfringement, invalidity, unenforceability, and license is  
16 necessary and appropriate in order to resolve this controversy.

17 **COUNT II**  
18 **BREACH OF CONTRACT**

19 40. Reply Paragraphs 73-77 and Counter Counterclaim Paragraphs 1 to 28 as set forth  
20 above are incorporated by reference as if set forth fully herein.

21 41. This Court has supplemental jurisdiction over this counterclaim pursuant to 28 U.S.C.  
22 § 1367.

23 42. Venue is proper in this judicial district under 28 U.S.C. § 1391.

24 43. Mosaid, Infineon, JEDEC and EIA are entities that have capacity to enter into  
25 contracts.

26 44. Mosaid regularly attended JEDEC meetings when it was a member of the  
27 organization and actively promoted the incorporation of DLL technology into the evolving SDRAM  
28 standard.

1 45. Mosaid's conduct at JEDEC during the SDRAM and DDR SDRAM standardization  
2 process included offered to license patents stemming from the '042 application, including the '272  
3 and '673 patents to JEDEC members, including Infineon.

4 46. As consideration for Mosaid's offer, members of JEDEC, including Infineon, agreed  
5 to include DLL technology in JEDEC SDRAM standards, including the DDR SDRAM standard.

6 47. Mosaid's conduct at JEDEC during the SDRAM and DDR SDRAM standardization  
7 process, including its statements that it would license patents stemming from its pending DLL patent  
8 and the '673 patent, gave rise to a contract between Mosaid and members of JEDEC and/or EIA  
9 (including Infineon) or, in the alternative, to a contract between Mosaid and JEDEC and/or EIA, to  
10 which members of JEDEC (including Infineon) are third party beneficiaries, that Mosaid would  
11 license the '272 patent without compensation or on fair, reasonable, and non-discriminatory terms.

12 48. Lawful objects of this contract include setting standards to govern memory chips and  
13 benefiting the members of JEDEC, including Mosaid and Infineon.

14 49. Mosaid has accused Infineon of infringing the '272 patent based on Infineon's  
15 manufacture and/or sale of DDR SDRAM standards-compliant products, and has offered to license  
16 Infineon under Mosaid's patent portfolio under unreasonable and/or unfairly discriminatory terms.

17 50. Mosaid has breached the contract, as a result of which, Infineon has incurred damages  
18 and will be further damaged in the future.

19 **COUNT III**  
20 **PROMISSORY ESTOPPEL**

21 51. Reply Paragraphs 73-77 and Counter Counterclaim Paragraphs 1 to 28 as set forth  
22 above are incorporated by reference as if set forth fully herein.

23 52. This Court has supplemental jurisdiction over this counterclaim pursuant to 28 U.S.C.  
24 § 1367.

25 53. Venue is proper in this judicial district under 28 U.S.C. § 1391.

26 54. Mosaid's overall conduct at JEDEC during the SDRAM and DDR SDRAM  
27 standardization process including its statements that it would license patents stemming from its  
28 pending DLL patent application and the '673 patent, constitutes a promise that Mosaid would license

1 the '272 patent to JEDEC members, including Infineon, either without compensation or under  
2 reasonable terms and conditions that are demonstrably free of any unfair discrimination.

3 55. JEDEC and its members, including Infineon, developed and adopted standards in  
4 justifiable reliance on Mosaid's promise. If Mosaid had disclosed to the JC-42.3 Subcommittee that  
5 it did not intend to comply with the JEDEC patent policy, that would have impacted the content of  
6 the SDRAM standards, the terms on which Mosaid would later be able to license any pertinent  
7 patent rights, and/or both.

8 56. Mosaid knew or reasonably should have known that JEDEC and its members,  
9 including Infineon, would rely on Mosaid's overall conduct during the SDRAM and DDR SDRAM  
10 standardization process.

11 57. Mosaid has breached its promise by accusing Infineon of infringing the '272 patent  
12 based on Infineon's manufacture and/or sale of DDR SDRAM standards-compliant products, and  
13 refusing to license Infineon under Mosaid's patent portfolio under fair, reasonable, and non-  
14 discriminatory terms.

15 58. Having invested many millions of dollars in developing the JEDEC-standardized  
16 DDR SDRAM products accused of infringing the '272 patent, Infineon has suffered material  
17 prejudice as a result of Mosaid's breach of its promise.

18 **PRAYER FOR RELIEF**

19 WHEREFORE, Infineon prays for relief against Mosaid as follows:

20 (a) That Mosaid take nothing by its Counterclaims;

21 (b) Judgment that personal jurisdiction in this case does not exist with respect to  
22 Infineon Technologies AG;

23 (c) Judgment that process was insufficiently served on Infineon Technologies AG;

24 (d) Judgment that Infineon has not infringed any valid and enforceable claim of U.S.  
25 Patent Nos. 5,214,602, 5,751,643, 5,822,253, 6,278,640, 5,828,620, 6,055,201, 6,236,581, and  
26 6,067,272;

27 (e) Judgment that each of U.S. Patent Nos. 5,214,602, 5,751,643, 5,822,253, 6,278,640,  
28 5,828,620, 6,055,201, 6,236,581, and 6,067,272 is invalid for failure to meet the conditions of

1 patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 101 (due to lack of  
2 utility/ operability), 102, 103 and/or 112;

3 (f) Judgment that each of U.S. Patent Nos. 5,822,253, 5,828,620, 6,055,201, and  
4 6,067,272 is invalid under the doctrine of double patenting.

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

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

10 (i) Judgment that Mosaid is barred from asserting any of the claims of U.S. Patent No.  
11 6,067,272 by equitable estoppel.

12 (j) Judgment that Mosaid's assertion of U.S. Patent No. 6,067,272 is a breach of contract  
13 between Mosaid and the members of JEDEC and/or EIA, including Infineon.

14 (k) Judgment that Infineon has an implied license to practice the claims of U.S. Patent  
15 No. 6,067,272.

16 (l) Judgment that promissory estoppel bars Mosaid from obtaining a license from  
17 Infineon on anything more than reasonable terms and conditions that are demonstrably free of any  
18 unfair discrimination.

19 (m) Judgment that Mosaid's claims for injunctive relief are barred in light of the fact that  
20 Mosaid has failed to meet the requirements for preliminary or permanent injunctive relief.

21 (n) Awarding Infineon damages due Mosaid's breach of contract.

22 (o) Awarding Infineon its costs and disbursements in this action, including reasonable  
23 attorneys' fees; and

1 (p) Awarding Infineon such other and further relief as the Court deems just and proper.

2 Dated: August 8, 2003

3 Respectfully submitted,

4 s/Thomas D. Pease

5 \_\_\_\_\_  
6 John M. Desmarais (*pro hac vice*)

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26 INFINEON TECHNOLOGIES AG, INFINEON

27 TECHNOLOGIES HOLDING NORTH AMERICA

28 INC., and INFINEON TECHNOLOGIES

RICHMOND, LP

1 **DEMAND FOR JURY TRIAL**

2 Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Plaintiff and  
3 Counterdefendant Infineon Technologies North America Corp. and Counterdefendants Infineon  
4 Technologies AG, Infineon Technologies Holding North America Inc. and Infineon Technologies  
5 Richmond, LP hereby demands a jury trial of all issues triable to a jury in this action.

6 Dated: August 8, 2003

7 Respectfully submitted,

8 s/Thomas D. Pease

9 \_\_\_\_\_  
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