

UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF NEW JERSEY

**MOSAID TECHNOLOGIES INCORPORATED,**

**Plaintiff,**

v.

**SAMSUNG ELECTRONICS CO., LTD.,  
SAMSUNG ELECTRONICS AMERICA, INC.,  
SAMSUNG SEMICONDUCTOR, INC., and  
SAMSUNG AUSTIN SEMICONDUCTOR, L.P.,**

**Defendants.**

01-CV-4340 (WJM)

**ORDER**

**INFINEON TECHNOLOGIES NORTH AMERICA  
CORP.,**

**Plaintiff,**

v.

**MOSAID TECHNOLOGIES INCORPORATED,**

**Defendant.**

03-CV-4698 (WJM)

**MOSAID TECHNOLOGIES INCORPORATED,**

**Counterclaimant,**

v.

**INFINEON TECHNOLOGIES NORTH AMERICA  
CORP., INFINEON TECHNOLOGIES AG,  
INFINEON TECHNOLOGIES HOLDING NORTH  
AMERICA CORP., and INFINEON  
TECHNOLOGIES RICHMOND LLP,**

**Counterdefendants.**

This matter having come before the Court on MOSAID Technologies Inc.'s ("MOSAID's") and Infineon Technologies North America Corp. *et al.*'s ("Infineon's") motions for summary judgment and MOSAID's motion to strike the Rebuttal Expert Report of Joseph C. McAlexander Regarding Non-Infringement of MOSAID Patents, and the Court having considered the parties' submissions and having heard oral argument, and for the reasons set forth in its accompanying Opinion, and for good cause shown,

**IT IS** on this 1<sup>st</sup> day of April 2005 hereby,

**ORDERED** that the parties' motions for summary judgment are **GRANTED-IN-PART** and **DENIED-IN-PART** as follows:

**Infringement**

1. Infineon does not directly infringe method claim 15 of U.S. Patent No. 5,751,643.
2. Infineon's accused products lack the "latching" limitation found in the asserted claims of the Lines U.S. Patent Nos. 5,822,253 (the "'253 patent'"), 5,751,643 (the "'643 patent'"), and 6,278,640 (the "'640 patent'"), and therefore do not infringe claims 31-34 of the '253 patent, claims 1-3, 8-13, 15-17, and 22-28 of the '643 patent, and claim 1 of the '640 patent, either literally or under the doctrine of equivalents.
3. Infineon's Blaze product lacks "control signals" as defined by this Court, and therefore does not literally infringe the "control signals applying" limitation of claim 15 of the '643 patent.
4. Infineon's accused products fall within the clock sources disclaimer applicable to the asserted claims of the Foss U.S. Patent Nos. 5,828,620 (the "'620 patent'"), 6,055,201 (the "'201 patent'"), and 6,580,654 (the "'654 patent'"), and therefore do not infringe claims 1-3, 5-9,

13-15, 17-21 and 24 of the '620 patent, claims 1, 10-11, and 20 of the '201 patent, and claims 1, 3-4, and 6 of the '654 patent, either literally or under the doctrine of equivalents.

5. There is a genuine issue of material fact as to whether Infineon's Hatteras product meets the "second switch" limitation of claim 1 of the '654 patent.

6. Infineon's Hatteras product meets the "clock signal" limitation of claim 1 of the '654 patent.

7. Infineon's accused products do not meet the "switching means" limitation of claims 1 and 10 of the Foss '201 patent, and therefore do not infringe these claims, either literally or under the doctrine of equivalents.

8. MOSAID has not provided particularized, limitation-by-limitation doctrine of equivalents analyses concerning the asserted Lines and Foss claims, namely claims 31-34 of the '253 patent, claims 1-3, 8-13, 15-17, and 22-28 of the '643 patent, claim 1 of the '640 patent, claims 1-2 of U.S. Patent No. 6,603,703 (the "'703 patent"), claims 1-3, 5-9, 13-15, 17-21 and 24 of the '620 patent, claims 1, 10-11, and 20 of the '201 patent, and claims 1, 3-4, and 6 of the '654 patent. Accordingly, as a matter of law, no limitation of any of the asserted claims of the patents in suit is met under the doctrine of equivalents.

### **Invalidity**

9. The OEM Agreement is not prior art under 35 U.S.C. § 102(b).

10. There is a genuine issue of material fact as to whether the Texas Instrument "old" circuit design is prior art under 35 U.S.C. § 102(g).

11. The Micron 4M DRAM is not prior art under 35 U.S.C. § 102(g).

12. There are genuine issues of material fact as to whether the prior art references Fujii and Kajigaya anticipate the asserted Lines claims under 35 U.S.C. § 102(b).

13. The reference Yanagisawa does not anticipate any of the asserted Foss claims under 35 U.S.C. § 102(b).

14. Infineon has not asserted the prior art references Harmon, Holbrook, Horiguchi and Rosenthal, and therefore the Court will not decide whether these references anticipate the asserted Foss claims under 35 U.S.C. § 102(b).

### **Unenforceability**

15. The Lines '253, '643, and '640 patents and the Foss '620 and '201 patents are not unenforceable under the doctrine of prosecution laches. But, there are genuine issues of material fact as to whether the Lines '703 patent and the Foss '654 patent are unenforceable under the doctrine of prosecution laches.

16. The Lines '602, '253, '643, '640 and '703 patents are not unenforceable due to inequitable conduct.

### **Damages**

17. MOSAID provided actual notice of alleged infringement under 35 U.S.C. § 287(a) for only three of the products now at issue in this case: (1) the HYB39S64800AT-8 DRAM, (2) the HYB39S256800AT-8 8Mx8x4 (256M) SDRAM, and (3) the MediaQ MQ-200 Graphics Controller HYP90MQARO. Accordingly, MOSAID may only seek damages for any asserted infringement by Infineon before the February 7, 2003 filing date of MOSAID's infringement

claims for those three products. The patents and dates for which any such pre-filing damages may be sought are as follows:

- (A) With regard to Infineon's HYB39S64800AT-8 DRAM, MOSAID may only seek damages for any asserted infringement of the '253 and '620 patents on or after November 4, 1999 and the '643 patent on or after August 1, 2000.
- (B) With regard to Infineon's HYB39S256800AT-8 8Mx8x4 (256M) SDRAM, MOSAID may only seek damages for any asserted infringement of the '201 patent on or after July 17, 2001.
- (C) With regard to Infineon's MediaQ MQ-200 Graphics Controller HYP90MQARO, MOSAID may only seek damages for any asserted infringement of the '640 patent on or after May 29, 2002.

18. Except as described in ¶¶ 17(A), (B), and (C) above, MOSAID may not seek damages for asserted infringement of the '253, '643, '640, '620, and '201 patents by Infineon before February 7, 2003.

19. MOSAID may not seek damages for asserted infringement of the '703 patent by Infineon before August 5, 2003, the date the methods-only patent issued.

20. MOSAID may not seek damages for asserted infringement of the '654 patent by Infineon before October 10, 2003, the date MOSAID first asserted this patent in its Third Amended Counterclaims.

**AND IT IS FURTHER ORDERED** that MOSAID's motion to strike the noninfringement expert report of Joseph McAlexander or, in the alternative, for leave to supplement the infringement expert report of David Taylor is **DENIED**.

s/ William J. Martini \_\_\_\_\_  
**William J. Martini, U.S.D.J.**