

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
TYLER DIVISION**

MOSAID TECHNOLOGIES INC.,)	
)	
Plaintiff,)	
)	
v.)	Civil Action No. 6:05CV120
)	
INFINEON TECHNOLOGIES NORTH AMERICA CORP.,)	
)	
INFINEON TECHNOLOGIES AG,)	
)	
INFINEON TECHNOLOGIES HOLDING NORTH AMERICA INC., and)	JURY TRIAL DEMANDED
)	
INFINEON TECHNOLOGIES RICHMOND LP,)	
)	
Defendants.)	

DEFENDANTS’ ANSWER AND COUNTERCLAIMS

THE PARTIES

Defendants Infineon Technologies North America Corp., Infineon Technologies AG, Infineon Technologies Holding North America Inc., and Infineon Technologies Richmond LP (collectively “Infineon Defendants”) hereby answer the allegations of the Complaint for Patent Infringement (“Complaint”) of Plaintiff Mosaid Technologies Inc. (“Mosaid”) and Infineon Technologies North America Corp. asserts counterclaims as follows:

1. Infineon Defendants, on information and belief, admit the allegations contained in paragraph 1.
2. Infineon Defendants admit the allegations contained in paragraph 2.
3. Infineon Defendants admit the allegations contained in paragraph 3.

4. Infineon Defendants admit the allegations contained in paragraph 4.

5. Infineon Defendants admit the allegations of paragraph 5 except that Infineon Defendants deny that Infineon Technologies Richmond LP maintains a principal place of business in Richmond, Virginia. Infineon Technologies Richmond LP maintains a principal place of business in Sandston, Virginia.

JURISDICTION AND VENUE

6. The allegations in paragraph 6 state legal conclusions to which no responsive pleading is required. To the extent a responsive pleading is deemed to be required, Infineon Defendants admit that the Complaint purports to assert an action under the patent laws of the United States and that this Court has subject matter jurisdiction over the purported action. To the extent paragraph 6 contains any other or different allegations, Infineon Defendants deny them.

7. The allegations in paragraph 7 state legal conclusions to which no responsive pleading is required. To the extent a responsive pleading is deemed to be required, Infineon Defendants admit that personal jurisdiction exists only with respect to Infineon Technologies North America Corp. Infineon Defendants deny that personal jurisdiction exists over Infineon Technologies AG, Infineon Technologies Holding North America Inc., and Infineon Technologies Richmond, LP, and deny that there is any legal or factual basis for any claim of this purported action. To the extent paragraph 7 contains any other or different allegations, Infineon Defendants deny them.

8. The allegations in paragraph 8 state legal conclusions to which no responsive pleading is required.

PATENT INFRINGEMENT

9. Infineon Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 9 that Mosaid is the owner of

United States Patent No. 6,657,919 (“the ’919 patent”), and therefore deny that allegation. On information and belief, Infineon Defendants deny that the ’919 patent was duly and legally issued as alleged, and deny all remaining allegations contained in paragraph 9.

10. Infineon Defendants deny the allegations contained in paragraph 10.

11. Infineon Defendants deny the allegations contained in paragraph 11.

12. Infineon Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 12 that Mosaid is the owner of United States Reissued Patent No. RE 37,641 (“the ’641 patent”), and therefore deny that allegation. On information and belief, Infineon Defendants deny that the ’641 patent was duly and legally issued as alleged, and deny all remaining allegations contained in paragraph 12.

13. Infineon Defendants deny the allegations contained in paragraph 13.

14. Infineon Defendants deny the allegations contained in paragraph 14.

15. Infineon Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph 15 that Mosaid is the owner of United States Patent No. 6,057,676 (“the ’676 patent”), and therefore deny that allegation. On information and belief, Infineon Defendants deny that the ’676 patent was duly and legally issued as alleged, and deny all remaining allegations contained in paragraph 15.

16. Infineon Defendants deny the allegations contained in paragraph 16.

17. Infineon Defendants deny the allegations contained in paragraph 17.

18. Infineon Defendants admit that this is an exceptional case within the meaning of 35 U.S.C. § 285 for which Infineon Defendants should be awarded their costs, attorneys’ fees, and expenses, but deny that this is an exceptional case within the meaning of 35 U.S.C. § 285 for which Mosaid should be awarded its costs, attorneys’ fees, and expenses.

19. Infineon Defendants deny the allegations contained in paragraph 19.

20. Infineon Defendants deny any of the allegations of the Complaint not specifically admitted in the responses set forth in paragraphs 1–19 above.

RELIEF

21. Infineon Defendants deny that Mosaid is entitled to any relief in this action from either Infineon Defendants or this Court, including the relief sought in paragraphs A–F, or otherwise.

DEFENSES

22. Infineon Defendants allege and assert the following defenses in response to the allegations of the Complaint, undertaking the burden of proof only as to those defenses deemed affirmative defenses by law, regardless of how such defenses are denominated herein.

FIRST DEFENSE

23. This Court lacks personal jurisdiction with respect to Infineon Technologies AG, Infineon Technologies Holding North America Inc., and Infineon Technologies Richmond, LP.

SECOND DEFENSE

24. Infineon Defendants do not and have not infringed any valid and enforceable claim of the '919, '641 and '676 patents (collectively, "patents-in-suit"), either directly or indirectly, nor literally or under the doctrine of equivalents.

THIRD DEFENSE

25. Infineon Defendants have not willfully infringed and are not willfully infringing any valid and enforceable claim of the patents-in-suit.

FOURTH DEFENSE

26. The claims of the patents-in-suit are invalid and/or unenforceable for failure to comply with the requirements of the Patent Laws of the United States as set forth in Title 35 of

the United States Code, including without limitation §§ 101 (due to lack of utility/operability), 102, 103, and/or 112.

FIFTH DEFENSE

27. Mosaid's claims for relief are barred in whole or in part by failure to comply with the requirements of 35 U.S.C. § 287.

SIXTH DEFENSE

28. The claims of the patents-in-suit are invalid and/or unenforceable due to obviousness-type double patenting.

SEVENTH DEFENSE

29. Mosaid's claims for relief are barred in whole or in part by the doctrine of laches.

EIGHTH DEFENSE

30. Mosaid's claims for relief are barred in whole or in part by the doctrine of equitable estoppel and waiver.

NINTH DEFENSE

31. On information and belief, Mosaid's claims for relief are barred in whole or in part by the doctrine of unclean hands.

TENTH DEFENSE

32. Mosaid's claims are barred by estoppel, including the doctrine of prosecution history estoppel.

ELEVENTH DEFENSE

33. 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.

TWELFTH DEFENSE

34. Collateral estoppel bars Mosaid from raising issues already decided and/or taken.

THIRTEENTH DEFENSE

35. Res judicata bars Mosaid from asserting its patents-in-suits against Infineon products.

FOURTEENTH DEFENSE

36. Mosaid is estopped from obtaining an injunction against Infineon under the '919 patent — Infineon has an implied license and/or a right to license the '919 patent under reasonable terms that are demonstrably free of any unfair discrimination.

FIFTEENTH DEFENSE

37. Mosaid's claims for relief with regard to at least the '919 patent are barred in whole or in part due to patent misuse.

SIXTEENTH DEFENSE

38. Mosaid's claims for relief with respect to the '919 and '641 patents are barred in whole or in part by the doctrine of prosecution laches.

SEVENTEENTH DEFENSE

39. Mosaid's claims for relief with respect to the '641 patent are or may be barred by Infineon Defendants' absolute and/or equitable intervening rights under 35 U.S.C. § 252.

EIGHTEENTH DEFENSE

40. Infineon Defendants reserve their right to assert any additional defenses to Mosaid's claims as they become known during the course of this litigation.

COUNTERCLAIMS

1. Infineon Technologies North America Corp. (“Infineon Counterclaim-Plaintiff”), for its counterclaims against Mosaid Technologies Inc. (“Mosaid”), state as follows:

2. This is an action for a declaration of non-infringement, invalidity, unenforceability, and/or license of all claims of the patents-in-suit, arising under the Patent Laws of the United States, Title 35 U.S.C. § 100 *et seq.*, and the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201–02.

3. This Court has subject matter jurisdiction over these counterclaims under 28 U.S.C. §§ 1331, 1338(a), 2201 and 2202.

4. This Court has personal jurisdiction over Mosaid because Mosaid has commenced the underlying patent infringement action in this Court.

5. If venue is proper for the underlying patent infringement action, then it is also proper for Infineon Counterclaim-Plaintiff’s counterclaims under 28 U.S.C. §§ 1391(b), 1391(c) and 1400(b).

FACTUAL BACKGROUND FOR COUNTERCLAIMS

JEDEC

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

JEDEC Policies and Procedures

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

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

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

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

11. This practice conforms with requirements set forth in the JEDEC Manual, which provides: “The chairperson of any JEDEC committee [expressly defined to include, among other things, subcommittees] must call to the attention of all those present the requirements contained in EIA Legal Guides, and the obligation of all participants to inform the meeting of any knowledge they may have of any patents, or pending patents, that might be involved in the work they are undertaking.”

12. Since at least October 1993, the JEDEC Manual has required that no standard be drafted to include “patented items” — or “items and processes for which a patent has been applied” — unless (1) a well-supported technical justification for inclusion of the patented items exists; and (2) the patent holder provides express written assurance that that it will license the

patented technology either “without compensation” or under “reasonable terms and conditions that are demonstrably free of any unfair discrimination.”

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

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

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

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

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

JEDEC Work Involving SDRAM Standards

16. 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”).

17. 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.

18. 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.

19. 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.

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

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

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

Mosaid’s ’042 Patent Application and Its Progeny

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

22. Mosaid filed multiple continuation applications from the original ’042 application, which are outlined in the following chart:

Patent/ Published Application	Issue/ Publication Date	Application	Application Date
20040130962	July 8, 2004	10/645,330 Continuation of '062	August 21, 2003
6,657,919	December 2, 2003	10/348,062 Continuation of '217	January 17, 2003
6,657,918	December 2, 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 '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

**Mosaid's Promise to License its DLL Patents During
DDR SDRAM Standard Setting**

23. Mosaid was a member of JEDEC from at least January 1993 and was actively involved in JC-42 and its SDRAM standardization work through the participation of Mosaid employees Graham Allan, Richard Foss, and others.

24. As a result of its membership in JEDEC, Mosaid agreed, both explicitly and implicitly, that it would abide by the rules and policies governing the organization.

25. Though JEDEC was refining its SDRAM standards and considering the use of a DLL in an SDRAM at the time Mosaid filed the '042 application on October 6, 1994, it was not until over a year later that Mosaid disclosed that application to JEDEC. At the December 6, 1995 JC-42.3 meeting in Dallas, Texas, Mosaid presented the results of the SDRAM Feature Survey Ballot, which included the strongly supported conclusion by committee members that the SDRAM should include an “on chip PLL/DLL to reduce clock access time.” On information and belief, while presenting these results, Mosaid noted that it had a “patent pending on DLL” and stated that it would comply with the JEDEC patent policy.

26. At the September 1998 JC-42 Plenary Meeting, Mosaid announced that the '673 patent had been granted. The '673 patent first appeared on the patent watch list at the December 7, 1998 JC-42 plenary meeting in San Diego, California. During this time, Mosaid had kept its pending '042 patent application alive by filing a continuation application, U.S. Patent Application 08/996,095 (“the '095 application”), which also targeted the use of a DLL in an SDRAM, but contained claims broader in scope than the '673 patent. Mosaid subsequently filed a series of continuation applications, including U.S. Patent Application 10/348,062.

27. On May 23, 2000, U.S. Patent No. 6,067,272 issued from the '095 application, and on December 2, 2003, U.S. Patent No. 6,657,919 — one of the patents-in-suit — issued from the '062 application.

28. Consistent with its 1995 promise to comply with the JEDEC patent policy, Mosaid's general counsel wrote to JEDEC on June 30, 1999, stating that Mosaid would license

the '673 patent "under reasonable terms and conditions that are demonstrably free of unfair discrimination."

29. Mosaid's June 30, 1999 letter conveyed to JEDEC members, including Infineon, that Mosaid was complying with its December 6, 1995 promise to offer licenses to patents stemming from the '042 application as required by the JEDEC patent policy.

30. If Mosaid had disclosed that it did not intend to comply with the JEDEC patent policy, that would have impacted the content of the SDRAM standards and/or the terms on which Mosaid would later be able to license any pertinent patent rights.

31. Infineon has invested hundreds of millions of dollars in developing the JEDEC-standardized DDR SDRAM products accused of infringement.

32. MOSAID has granted licenses under its patent portfolio including the '919 patent. MOSAID has sued Infineon for infringement of the '919 patent and, in exchange for rights under its portfolio including the '919 patent, has demanded that Infineon provide payments and agree to terms and conditions that exceed what MOSAID has requested of various other licensees.

COUNT I

(Declaratory Judgment Action for Declaration of Noninfringement, Invalidity, Unenforceability and License of U.S. Patent No 6,657,919)

33. Counterclaim Paragraphs 1 to 32 as set forth above are incorporated by reference as if set forth fully herein.

34. Mosaid has initiated a civil action against Infineon Counterclaim-Plaintiff by filing the Complaint in this Court alleging that Infineon Counterclaim-Plaintiff has infringed one or more claims of the '919 patent.

35. Infineon Counterclaim-Plaintiff has not infringed, and does not infringe, any valid and enforceable claim of the '919 patent, either directly or indirectly, and either literally or under the doctrine of equivalents.

36. The claims of the '919 patent are invalid and/or unenforceable for failure to comply with the requirements of the Patent Laws of the United States as set forth in Title 35 of the United States Code, including without limitation §§ 101, 102, 103, and/or 112.

37. As demonstrated by Mosaid's Complaint and the defenses and counterclaim raised by Infineon, an actual and justiciable controversy exists between Infineon and Mosaid regarding the noninfringement, invalidity, unenforceability, and license of the '919 patent.

38. The '919 patent is unenforceable against Infineon due to equitable estoppel and/or Mosaid is barred from obtaining a license from Infineon under the '919 patent on anything more than reasonable terms and conditions that are demonstrably free of any unfair discrimination.

39. Infineon has an implied license and/or a right to license the '919 patent under reasonable terms that are demonstrably free of any unfair discrimination.

40. Infineon Counterclaim-Plaintiff is entitled to a declaratory judgment that it has have not infringed, and is not infringing, any valid and enforceable claim of the '919 patent, that the claims of the '919 patent are invalid and/or unenforceable, and that Infineon Counterclaim-Plaintiff is entitled to license the '919 patent under reasonable terms and/or has an implied license.

COUNT II

(Breach of Contract)

41. Counterclaim Paragraphs 1 to 32 as set forth above are incorporated by reference as if set forth fully herein.

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

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

44. Mosaid's conduct at JEDEC during the SDRAM and DDR SDRAM standardization process included an offer to license patents stemming from the '042 application, including the '919 and '673 patents to JEDEC members, including Infineon.

45. As consideration for, and in reliance upon, Mosaid's offer, members of JEDEC, including Infineon, agreed to include DLL technology in JEDEC SDRAM standards, including the DDR SDRAM standard.

46. Mosaid's conduct at JEDEC during the SDRAM and DDR SDRAM standardization process, including its statements that it would license patents stemming from its pending DLL patent application and the '673 patent family, gave rise to a contract between Mosaid and members of JEDEC and/or EIA (including Infineon) or, in the alternative, to a contract between Mosaid and JEDEC and/or EIA, to which members of JEDEC (including Infineon) are third party beneficiaries. The contract requires that Mosaid license the '919 patent without compensation or on fair, reasonable, and non-discriminatory terms.

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

48. Mosaid has accused Infineon of infringing the '919 patent based on Infineon's manufacture and/or sale of DDR SDRAM standards-compliant products, and has offered to

license Infineon under Mosaid's patent portfolio under unreasonable and/or unfairly discriminatory terms.

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

COUNT III

(Promissory Estoppel)

50. Counterclaim Paragraphs 1 to 32 as set forth above are incorporated by reference as if set forth fully herein.

51. Mosaid's overall conduct at JEDEC during the SDRAM and DDR SDRAM standardization process, including its statements that it would license patents stemming from its pending DLL patent application and the '673 patent, constitutes a promise that Mosaid would license the '919 patent to JEDEC members, including Infineon, either without compensation or under reasonable terms and conditions that are demonstrably free of any unfair discrimination.

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

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

54. Mosaid has breached its promise by accusing Infineon of infringing the '919 patent based on Infineon's manufacture and/or sale of DDR SDRAM standards-compliant

products, and refusing to license Infineon under Mosaid's patent portfolio under fair, reasonable, and non-discriminatory terms.

55. Having invested many millions of dollars in developing the JEDEC-standardized DDR SDRAM products accused of infringing the '919 patent, Infineon has suffered material prejudice as a result of Mosaid's breach of its promise

COUNT IV

(Declaratory Judgment Action for Declaration of Non-Infringement, Invalidity and Unenforceability of U.S. Reissued Patent No. 37,641)

56. Counterclaim Paragraphs 1 to 5 as set forth above are incorporated by reference as if set forth fully herein.

57. Mosaid has initiated a civil action against Infineon Counterclaim-Plaintiff by filing the Complaint in this Court alleging that Infineon Counterclaim-Plaintiff has infringed one or more claims of the '641 patent.

58. Infineon Counterclaim-Plaintiff has not infringed, and does not infringe, any valid and enforceable claim of the '641 patent, either directly or indirectly, and either literally or under the doctrine of equivalents.

59. The claims of the '641 patent are invalid and/or unenforceable for failure to comply with the requirements of the Patent Laws of the United States as set forth in Title 35 of the United States Code, including without limitation §§ 101, 102, 103, and/or 112.

60. As evidenced by Mosaid's Complaint against Infineon Counterclaim-Plaintiff, and Infineon Counterclaim-Plaintiff's denials, defenses and counterclaims, an actual case or controversy exists between Mosaid and Infineon Counterclaim-Plaintiff concerning the non-infringement, invalidity and unenforceability of one or more claims of the '641 patent, and that controversy is ripe for adjudication by this Court.

61. Infineon Counterclaim-Plaintiff is entitled to a declaratory judgment that it has not infringed, and is not infringing, any valid and enforceable claim of the '641 patent, and that the claims of the '641 patent are invalid and/or unenforceable.

COUNT V

(Declaratory Judgment Action for Declaration of Non-Infringement, Invalidity and Unenforceability of U.S. Patent No. 6,057,676)

62. Counterclaim Paragraphs 1 to 5 as set forth above are incorporated by reference as if set forth fully herein.

63. Mosaid has initiated a civil action against Infineon Counterclaim-Plaintiff by filing the Complaint in this Court alleging that Infineon Counterclaim-Plaintiff has infringed one or more claims of the '676 patent.

64. Infineon Counterclaim-Plaintiff has not infringed, and does not infringe, any valid and enforceable claim of the '676 patent, either directly or indirectly, and either literally or under the doctrine of equivalents.

65. The claims of the '676 patent are invalid and/or unenforceable for failure to comply with the requirements of the Patent Laws of the United States as set forth in Title 35 of the United States Code, including without limitation §§ 101, 102, 103, and/or 112.

66. As evidenced by Mosaid's Complaint against Infineon Counterclaim-Plaintiff, and Infineon Counterclaim-Plaintiff's denials, defenses and counterclaims, an actual case or controversy exists between Mosaid and Infineon Counterclaim-Plaintiff concerning the non-infringement, invalidity and unenforceability of one or more claims of the '676 patent, and that controversy is ripe for adjudication by this Court.

67. Infineon Counterclaim-Plaintiff is entitled to a declaratory judgment that it has not infringed, and is not infringing, any valid and enforceable claim of the '676 patent, and that the claims of the '676 patent are invalid and/or unenforceable.

DEMAND FOR JURY TRIAL

68. Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Infineon Counterclaim-Plaintiff demands a trial by jury on all issues so triable.

REQUEST FOR RELIEF ON ITS COUNTERCLAIMS

WHEREFORE, Infineon Counterclaim-Plaintiff requests that the Court enter a judgment in their favor and against Mosaid as follows:

- (a) Dismissing with prejudice Mosaid's Complaint in its entirety.
- (b) Denying all remedies and relief sought by Mosaid in its Complaint.
- (c) Ruling that personal jurisdiction does not exist in this case with respect to Infineon Technologies AG, Infineon Technologies Holding North America Inc., and Infineon Technologies Richmond, LP.
- (d) Declaring that Infineon Counterclaim-Plaintiff has not infringed, and is not infringing, any valid and enforceable claim of the patents-in-suit, either directly or indirectly, and either literally or under the doctrine of equivalents.
- (e) Declaring that the claims of the patent-in-suit are invalid, unenforceable and void in law.
- (f) Ruling that each of the patents-in-suit is unenforceable due to laches and/or prosecution laches.
- (g) Ruling that Mosaid is barred from asserting any of the claims of U.S. Patent No. 6,657,919 by equitable estoppel.

- (h) Ruling that Mosaid's assertion of U.S. Patent No. 6,657,919 is a breach of contract between Mosaid and the members of JEDEC and/or EIA, including Infineon.
- (i) Ruling that Infineon has an implied license to practice and/or right to license the claims of U.S. Patent No. 6,657,919.
- (j) Ruling that Mosaid's assertion of at least U.S. Patent No. 6,657,919 is barred by patent misuse.
- (k) Ruling that promissory estoppel bars Mosaid from obtaining a license from Infineon for U.S. Patent No. 6,657,919 on anything more than reasonable terms and conditions that are demonstrably free of any unfair discrimination.
- (l) Ruling that 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.
- (m) Awarding Infineon damages due Mosaid's breach of contract.
- (n) Declaring this to be an exceptional case and awarding Infineon Defendants its costs, attorneys' fees, and expenses pursuant to 35 U.S.C. § 285.
- (o) Granting such other and further relief as the Court may deem just and proper.

Date: June 15, 2005

Respectfully submitted,

/s/ Jennifer P. Ainsworth

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by certified mail, return receipt requested, on this the 15th day of June, 2005.

/s/ Jennifer P. Ainsworth

Jennifer P. Ainsworth