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13 Attorneys for Plaintiff, IconFind, Inc.

14 IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF CALIFORNIA

15 ICONFIND, INC.,

16 Plaintiff,

17 v.

18 GOOGLE INC.,

19 Defendant.

Case No. 2:11-cv-00319-GEB-JFM

**ICONFIND, INC.'S ANSWER AND
AFFIRMATIVE DEFENSES TO
GOOGLE INC.'S COUNTERCLAIM
FOR DECLARATORY JUDGMENT OF
NON-INFRINGEMENT OF THE '459
PATENT**

JURY TRIAL DEMANDED

22 Plaintiff IconFind, Inc. ("IconFind") hereby responds to the counterclaim Count One –
23 Declaratory Judgment of Non-Infringement of the '459 Patent filed on March 24, 2011 by
24 Defendant Google inc. ("Google"). Google's counterclaim Count Two – Declaratory Judgment
25

1 of Invalidity of the '459 Patent and related Second Defense of patent invalidity are the subject of
2 *Plaintiff Iconfind, Inc.'s Motion To Dismiss Pursuant To Frcp 12(B)(6) And Motion To Strike*
3 *Pursuant To Frcp 12(F)*. Accordingly, IconFind has not answered the patent invalidity
4 allegations in Google's counterclaim Count Two or Google's Second Defense. IconFind reserves
5 the right to answer the patent invalidity allegations in Google's counterclaim Count Two and
6 Google's Second Defense pending the outcome of its motion to dismiss and strike.

7 COUNTERCLAIMS

8 THE PARTIES

9 1. Google is a corporation organized and existing under the laws of the State of
10 Delaware, with its principal place of business at 1600 Amphitheatre Parkway, Mountain View,
California 94043.

11 **RESPONSE:**

12 Admitted.

13 2. Upon information and belief, Plaintiff IconFind, Inc. is a corporation organized and
14 existing under the laws of California with a principal place of business at 1660 Drew Circle #27,
Davis, California 95618.

15 **RESPONSE:**

16 Admitted.

17 JURISDICTION AND VENUE

18 3. Venue is proper in this judicial district pursuant to 28 U.S.C. § 1391(b) and by virtue
of IconFind's admissions in the Complaint that venue is proper in this district.

19 **RESPONSE:**

20 Admitted.

21 4. This Court has personal jurisdiction over IconFind.

22 **RESPONSE:**

23 Admitted that this Court has personal jurisdiction over IconFind and Google.

24 5. This Court has subject matter jurisdiction over these Counterclaims pursuant to 28
U.S.C. §§ 1331 and 1338.

1 **RESPONSE:**

2 Denied that Google is entitled to any relief; otherwise admitted.

3 **COUNT ONE - Declaratory Judgment of Non-Infringement of the '459 Patent**

4 6. Google restates and incorporates by reference its allegations in paragraphs 1-5 of its
5 Answer and Counterclaims.

6 **RESPONSE:**

7 IconFind restates and incorporates by reference its responses to the allegations in paragraphs
8 1 - 5 of Google's Answer and Counterclaims, inclusive, as though fully set forth herein.

9 7. An actual case or controversy exists between Google and IconFind as to whether the
10 '459 patent is infringed by Google.

11 **RESPONSE:**

12 Admitted.

13 8. A judicial declaration is necessary and appropriate so that Google may ascertain its
14 rights regarding the '459 patent.

15 **RESPONSE:**

16 Admitted that Google purports to seek a judicial declaration so that it may ascertain its rights
17 regarding the '459 patent; denied that Google is entitled to any relief; otherwise denied.

18 9. Google has not infringed and does not infringe, directly or indirectly, any valid and
19 enforceable claim of the '459 patent.

20 **RESPONSE:**

21 Denied.

22 **COUNT TWO - Declaratory Judgment of Invalidity of the '459 Patent**

23 IconFind reserves the right to answer the allegations of Count Two pending the outcome of its
24 motion to dismiss and strike.

25 **EXCEPTIONAL CASE**

26 12. On information and belief, this is an exceptional case entitling Google to an award of
its attorneys' fees incurred in connection with defending and prosecuting this action pursuant to 35

1 U.S.C. § 285, as a result of, *inter alia*, IconFind's assertion of the Patent-in-suit against Google with
2 the knowledge that Google does not infringe any valid or enforceable claim of the Patent-in-suit
and/or that the Patent-in-suit is invalid and/or unenforceable.

3 **RESPONSE:**

4 Denied.

5 **PLAINTIFF'S AFFIRMATIVE DEFENSES**

6 IconFind asserts the following Affirmative Defenses against Google's Counterclaims and
7 reserves the right to further amend its responses pending the outcome of its motion to dismiss
8 and strike and as additional information becomes available.

9 1. The claims of United States Patent No. 7,181,459 B2 are valid, enforceable and
10 infringed by Google.

11 2. Google has infringed and continues to infringe at least claims 1, 6, 9, 16, 17, 19,
12 20, 21, 22, 29, 30 and 31 of the '459 patent under 35 U.S.C. § 271(a) through Google's use,
13 ownership and operation of websites in which it incorporates and facilitates Creative Commons
14 licenses, including but not limited to Google Knol, Google Books and Google Picasa.

15 3. Google's counterclaims fail to state claims upon which relief may be granted.

16 4. IconFind is entitled to judgment as a matter of law on Google's Counterclaims.

17 5. IconFind reserves the right to answer the patent invalidity allegations in Google's
18 counterclaim Count Two and Google's Second Defense pending the outcome of its motion to
19 dismiss and strike.

20 6. IconFind adopts and incorporates herein all affirmative defenses available
21 pursuant to Federal Rule of Civil Procedure 8 (or any applicable statute or regulation), to the
22 extent the facts known at this time would make any of said defenses available or facts developed
23 in the future would make same available. No affirmative defense is waived.

1 **CERTIFICATE OF SERVICE**

2 The undersigned hereby certifies that on April 8, 2011 the foregoing

3 **ICONFIND, INC.'S ANSWER AND AFFIRMATIVE DEFENSES TO GOOGLE INC.'S**
4 **COUNTERCLAIM FOR DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF**
5 **THE '459 PATENT**

6 was filed with the Clerk of Court using the CM/ECF system, which will then send a notification
7 of such filing to the following counsel of record.

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18 **Attorneys for Defendant Google Inc.**

19 I certify that all parties in this case are represented by counsel who are CM/ECF participants.
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27 /s/ Brian E. Haan
28 Attorneys for Plaintiff