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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 FIRST AMENDED  
COUNTERCLAIM FOR  
DECLARATORY JUDGMENT OF NON-  
INFRINGEMENT OF THE '459 PATENT**

**JURY TRIAL DEMANDED**

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

25 Iconfind, Inc.'s Answer And Affirmative Defenses To Google Inc.'s First Amended  
26 Counterclaim For Declaratory Judgment Of Non-Infringement Of The '459 Patent

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

## **COUNTERCLAIMS**

### **THE PARTIES**

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

#### **RESPONSE:**

Admitted.

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

#### **RESPONSE:**

Admitted.

## **JURISDICTION AND VENUE**

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.

#### **RESPONSE:**

Admitted.

4. This Court has personal jurisdiction over IconFind.

#### **RESPONSE:**

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

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

3                **RESPONSE:**

4                Denied to the extent Google is entitled to any relief; otherwise admitted.

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

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

8                **RESPONSE:**

9                IconFind restates and incorporates by reference its responses to the allegations in paragraphs  
10 1 - 5 of Google's Answer and Counterclaims, inclusive, as though fully set forth herein.

11        7.        An actual case or controversy exists between Google and IconFind as to whether the  
12 '459 patent is infringed by Google.

13                **RESPONSE:**

14                Admitted.

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

17                **RESPONSE:**

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

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

22                **RESPONSE:**

23                Denied.

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

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

1 **EXCEPTIONAL CASE**

2 13. On information and belief, this is an exceptional case entitling Google to an award of  
3 its attorneys' fees incurred in connection with defending and prosecuting this action pursuant to 35  
4 U.S.C. § 285, as a result of, *inter alia*, IconFind's assertion of the Patent-in-suit against Google with  
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.

5 **RESPONSE:**

6 Denied.

7 **PLAINTIFF'S AFFIRMATIVE DEFENSES**

8 IconFind asserts the following Affirmative Defenses against Google's First Amended  
9 Counterclaim and reserves the right to further amend its responses pending the outcome of its  
10 motion to dismiss and strike and as additional information becomes available.

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

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

17 3. Google's amended counterclaim fail to state claims upon which relief may be  
18 granted.

19 4. IconFind is entitled to judgment as a matter of law on Google's amended  
20 counterclaim.

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

24 6. IconFind adopts and incorporates herein all affirmative defenses available  
25 pursuant to Federal Rule of Civil Procedure 8 (or any applicable statute or regulation), to the  
26 Iconfind, Inc.'s Answer And Affirmative Defenses To Google Inc.'s First Amended  
Counterclaim For Declaratory Judgment Of Non-Infringement Of The '459 Patent

1 extent the facts known at this time would make any of said defenses available or facts developed  
2 in the future would make same available. No affirmative defense is waived.

3 WHEREFORE, IconFind requests that judgment be entered against Google and in  
4 IconFind's favor on the First Amended Counterclaims brought by Google. IconFind further  
5 requests that it be granted all of the relief requested in its Complaint.

6 **JURY DEMAND**

7 IconFind demands a trial by jury on all issues properly triable to a jury.

8  
9 Respectfully submitted,

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17 **Attorneys for Plaintiff IconFind, Inc.**

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

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I certify that all parties in this case are represented by counsel who are CM/ECF participants.

15	<u>/s/ Anna B. Folgers</u>
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