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Attorneys for Plaintiff, IconFind, Inc.

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

ICONFIND, INC.,

Plaintiff,

v.

GOOGLE INC.,

Defendant.

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

**ICONFIND'S ANSWER TO
GOOGLE'S SECOND AMENDED
COUNTERCLAIMS**

Iconfind, Inc.'s Answer And Affirmative Defenses To Google Inc.'s Second Amended Counterclaims

1
2 **THE PARTIES**

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

6 **Response:** Admitted.

7 2. Upon information and belief, Plaintiff IconFind, Inc. is a corporation
8 organized and existing under the laws of California with a principal place of business at
9 1660 Drew Circle #27, Davis, California 95618.

10 **Response:** Admitted.

11 **JURISDICTION AND VENUE**

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

14 **Response:** Admitted.

15 4. This Court has personal jurisdiction over IconFind.

16 **Response:** Admitted.

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

19 **Response:** Admitted.

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

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

23 **Response:** IconFind restates and incorporates by reference its answers to the
24 allegations in paragraphs 1-5 of its Answer and Counterclaims.

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

Response: Admitted.

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

2 **Response:** Admitted that Google purports to seek a judicial declaration so that it may
3 ascertain its rights regarding the '459 patent; denied to the extent Google is entitled to
4 any relief; otherwise denied.
5

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

7 **Response:** Denied.
8

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

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

11 **Response:** IconFind restates and incorporates by reference its answers to the
12 allegations in paragraphs 1-5 of its Counterclaims.
13

14 11. The claims of the '459 patent are invalid under 35 U.S.C. § 101 because
they fail to claim patentable subject matter insofar as each seeks to claim an abstract
15 idea for at least the reasons set forth in Google's Invalidity Contentions which are
hereby incorporated by reference and included as Exhibit 1 to this pleading, Defendant
16 Google Inc.'s Second Amended Answer To Plaintiff's Complaint For Patent Infringement
And Counterclaims.

17 **Response:** Denied.

18 12. The claims of the '459 patent are invalid for claiming non-novel and/or
obvious subject matter pursuant to 35 U.S.C. §§ 102 (a), 102 (b), 102 (e), and/or 103
19 (a) for at least the reasons set forth in Google's Invalidity Contentions which are hereby
incorporated by reference and included as Exhibit 1.
20

21 **Response:** Denied.

22 13. The claims of the '459 patent are invalid and/or unenforceable for failure
satisfy one or more conditions of patentability set forth in 35 U.S.C. § 112 including
23 failure of written description, lack of enablement, and claim indefiniteness for at least the
reasons set forth in Google's Invalidity Contentions which are hereby incorporated by
reference and included as Exhibit 1.
24

1 **Response:** Denied.

2 **EXCEPTIONAL CASE**

3 14. On information and belief, this is an exceptional case entitling Google to
4 an award of its attorneys' fees incurred in connection with defending and prosecuting
5 this action pursuant to 35 U.S.C. § 285, as a result of, *inter alia*, IconFind's assertion of
6 the Patent-in-Suit against Google with the knowledge that Google does not infringe any
7 valid or enforceable claim of the Patent-in- Suit and/or that the Patent-in-Suit is invalid
8 and/or unenforceable.

9 **Response:** Denied.

10 **PLAINTIFF'S AFFIRMATIVE DEFENSES**

11 IconFind asserts the following Affirmative Defenses against Google's Second
12 Amended Counterclaims and reserves the right to further amend its responses as
13 additional information becomes available.

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

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

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

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

25 5. IconFind adopts and incorporates herein all affirmative defenses available
pursuant to Federal Rule of Civil Procedure 8 (or any applicable statute or regulation),

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

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

7 **JURY DEMAND**

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

9
10 Respectfully submitted,

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

