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8  
 9 UNITED STATES DISTRICT COURT  
 10 NORTHERN DISTRICT OF CALIFORNIA  
 11 SAN JOSE DIVISION

12 ELAN MICROELECTRONICS  
 CORPORATION,  
 13  
 Plaintiff and Counterclaim  
 14 Defendant,  
 15 v.  
 16 APPLE, INC.,  
 17 Defendant and Counterclaim  
 18 Plaintiff.

Case No. C-09-01531 RS  
 APPLE, INC.'S FIRST AMENDED  
 ANSWER, AFFIRMATIVE DEFENSES,  
 AND COUNTERCLAIMS TO ELAN  
 MICROELECTRONICS  
 CORPORATION'S COMPLAINT FOR  
 PATENT INFRINGEMENT  
 Hon. Richard Seeborg  
 Demand for Jury Trial

19  
 20 Defendant Apple, Inc. ("Apple") by and through its undersigned counsel, hereby  
 21 responds to Plaintiff Elan Microelectronics Corporation's ("Elan") Complaint for Patent  
 22 Infringement ("Complaint") as follows:

23 I.  
 24 ANSWER  
 25 PARTIES

26 1. Apple is without knowledge or information sufficient to form a belief as to  
 27 the truth of the statements in Paragraph 1 of the Complaint, and, on that basis, denies those  
 28 allegations.





1 interest, or any other type of recovery from Apple. Elan's prayer should, therefore, be denied in  
2 its entirety and with prejudice, and Elan should take nothing.

3 **DEMAND FOR JURY TRIAL**

4 23. Apple does not object to a trial by jury on all issues so triable.

5 **II.**

6 **DEFENSES**

7 As and for its affirmative defenses, Apple alleges as follows:

8 **FIRST DEFENSE – NON-INFRINGEMENT**

9 24. Apple does not infringe and has not directly or indirectly infringed any  
10 claims of the '352 and '353 patents, either literally or under the doctrine of equivalents, willfully  
11 or otherwise.

12 **SECOND DEFENSE – INVALIDITY**

13 25. Elan's alleged claims for infringement of the '352 and '353 patents are  
14 barred because each and every claim of the '352 and '353 patents is invalid for failure to comply  
15 with the requirements of Title 35 of the United States Code, including but not limited to  
16 Sections 101, 102, 103, and/or 112.

17 **THIRD DEFENSE – LACHES**

18 26. Elan's claims for relief are barred in whole or in part by the doctrine of  
19 laches.

20 **FOURTH DEFENSE – ESTOPPEL**

21 27. Elan's claims for relief are barred in whole or in part by the doctrine of  
22 equitable estoppel.

23 **FIFTH DEFENSE – STATUTE OF LIMITATIONS**

24 28. To the extent Elan seeks damages for alleged infringement more than six  
25 years prior to filing of this action, the relief sought by Elan is barred by 35 U.S.C. § 286.  
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**SIXTH DEFENSE – NOTICE**

29. To the extent Elan seeks damages for alleged infringement prior to its giving actual or constructive notice of the '352 and '353 patents to Apple, the relief sought by Elan is barred by 35 U.S.C. § 287.

**SEVENTH DEFENSE – NO INJUNCTIVE RELIEF**

30. To the extent Elan seeks injunctive relief for alleged infringement, the relief sought by Elan is unavailable because any alleged injury to Elan is not immediate or irreparable and because Elan has an adequate remedy at law for any alleged injury.

**III.**

**COUNTERCLAIMS**

Counterclaim-Plaintiff Apple counterclaims against Counterclaim-Defendant Elan as follows:

**PARTIES**

31. Apple is a corporation organized under the laws of the State of California and having a principal place of business at 1 Infinite Loop, Cupertino, CA 95014.

32. Elan alleges that it is a corporation organized under the laws of Taiwan R.O.C. with a principal place of business at No. 12, Innovation 1st Road, Science Based Industrial Park, Hsinchu Taiwan R.O.C.

**JURISDICTION AND VENUE**

33. These counterclaims arise under Title 35 of the United States Code. The Court has subject matter jurisdiction over these counterclaims pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, and 2202.

34. Elan is subject to personal jurisdiction in this district arising out of its systematic and continuous contacts with this district and its purposeful acts and/or transactions directed toward this district. Such contacts include without limitation Elan's past and ongoing infringing conduct in this district, Elan's bringing of this lawsuit in this district, and, on information and belief, Elan's presence and conduct of business in this district through ELAN Information Technology Group, operating in Cupertino, California 95015.

1 35. Venue is proper in this judicial district under 28 U.S.C. § 1391.

2 **FIRST COUNTERCLAIM – DECLARATORY JUDGMENT**

3 **'352 PATENT**

4 36. Apple incorporates herein by reference the allegations of paragraphs 1 - 35  
5 of this Answer, Affirmative Defenses and Counterclaims (“Answer”).

6 37. Apple counterclaims against Elan pursuant to the patent laws of the United  
7 States, Title 35 of the United States Code, and the Declaratory Judgments Act, 28 U.S.C. §§ 2201  
8 and 2202.

9 38. In its Complaint, Elan alleges that Apple is now and has been directly  
10 and/or indirectly infringing the '352 patent by the sale of at least its iBook, PowerBook,  
11 MacBook, iPhone and iPod Touch products.

12 39. An actual controversy exists between Elan and Apple by virtue of the  
13 allegations of Elan’s Complaint and Apple’s Answer as to the validity and infringement of the  
14 '352 patent.

15 40. The '352 patent is invalid and not infringed, as set forth in paragraphs 24  
16 through 30 above.

17 41. Apple is entitled to judgment that the '352 patent is invalid and not  
18 infringed.

19 **SECOND COUNTERCLAIM – DECLARATORY JUDGMENT**

20 **'353 PATENT**

21 42. Apple incorporates herein by reference the allegations of paragraphs 1 - 41  
22 of this Answer.

23 43. Apple counterclaims against Elan pursuant to the patent laws of the United  
24 States, Title 35 of the United States Code, and the Declaratory Judgments Act, 28 U.S.C. §§ 2201  
25 and 2202.

26 44. In its Complaint, Elan alleges that Apple is now and has been directly  
27 and/or indirectly infringing the '353 patent by the sale of its iPhone and iPod Touch products.  
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**FOURTH COUNTERCLAIM – PATENT INFRINGEMENT**

**'659 PATENT**

53. Apple incorporates herein by reference the allegations of paragraphs 1 - 52 of this Answer.

54. Apple is the owner of the entire right, title and interest in and to U.S. Patent No. 7,495,659 (“the ’659 patent”) entitled “Touch Pad For Handheld Device,” which was duly and legally issued on February 24, 2009 in the name of inventors Greg Marriott, Guy Bar-Nahum, and Steven Bollinger. A copy of the ’659 patent is attached as Exhibit B hereto.

55. Pursuant to Rule 11(b)(3) and upon information and belief, it is likely that reasonable opportunity for further investigation or discovery will confirm that Elan has been and is currently, directly and/or indirectly, infringing, in violation of 35 U.S.C. § 271, the ’659 patent through its design, marketing, manufacture and/or sale of touch-sensitive input devices or touchpads, including but not limited to the Smart-Pad.

56. Apple has suffered, and will continue to suffer, irreparable injury as a result of Elan’s infringement. Pursuant to 35 U.S.C. §§ 283 and 284, Apple is entitled to damages for infringement and to a permanent injunction against further infringement.

57. This case is exceptional, and therefore, Apple is entitled to attorneys’ fees pursuant to 35 U.S.C. § 285.

**FIFTH COUNTERCLAIM – PATENT INFRINGEMENT**

**'929 PATENT**

58. Apple incorporates herein by reference the allegations of paragraphs 1 - 57 of this Answer.

59. Apple is the owner of the entire right, title and interest in and to U.S. Patent No. 6,933,929 (“the ’929 patent”) entitled “Housing For A Computing Device,” which was duly and legally issued on August 23, 2005 in the name of inventor Chris J. Novak. A copy of the ’929 patent is attached as Exhibit C hereto.

60. Pursuant to Rule 11(b)(3) and upon information and belief, it is likely that reasonable opportunity for further investigation or discovery will confirm that Elan has been and

1 is currently, directly and/or indirectly, infringing, in violation of 35 U.S.C. § 271, the '929 patent  
2 through its design, marketing, manufacture and/or sale of touch-sensitive input devices or  
3 touchpads, including but not limited to the Smart-Pad.

4 61. Apple has suffered, and will continue to suffer, irreparable injury as a  
5 result of Elan's infringement. Pursuant to 35 U.S.C. §§ 283 and 284, Apple is entitled to  
6 damages for infringement and to a permanent injunction against further infringement.

7 62. This case is exceptional, and therefore, Apple is entitled to attorneys' fees  
8 pursuant to 35 U.S.C. § 285.

9 **DEMAND FOR JURY TRIAL**

10 63. Pursuant to Rule 38 of the Federal Rules of Civil Procedure, Apple hereby  
11 demands a trial by jury on all issues so triable.

12 **PRAYER FOR RELIEF**

13 WHEREFORE, Apple prays for judgment as follows on Elan's Complaint and on  
14 Apple's Answer, Affirmative Defenses and Counterclaims:

- 15 A. That Elan's Complaint be dismissed with prejudice and that Elan take  
16 nothing;
- 17 B. That judgment be entered in favor of Apple against Elan on Elan's  
18 Complaint;
- 19 C. For entry of an Order declaring each and every claim of the '352 and '353  
20 patents invalid and not infringed by Apple;
- 21 D. For entry of an Order declaring that Elan has infringed, directly or  
22 indirectly, the '218, '659 and '929 patents under 35 U.S.C. § 271;
- 23 E. That Elan, its officers, agents, servants, employees, attorneys and those  
24 persons in active concert or participation with any of them, be preliminarily  
25 and permanently restrained and enjoined from directly and indirectly  
26 infringing the '218, '659 and '929 patents;
- 27 F. That Elan be required to pay damages to compensate Apple for Elan's  
28 infringement pursuant to 35 U.S.C. § 284;

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- G. An assessment of pre-judgment and post-judgment interest and costs against Elan, together with an award of such interest and costs;
- H. That pursuant to 35 U.S.C. § 285 and/or other applicable laws, Elan's conduct be found to render this an exceptional case and that Apple be awarded its attorneys' fees incurred in connection with this action;
- I. That Elan be required to pay Apple's costs of suit;
- J. That Apple be awarded such other and further relief as the court may deem just and proper.

Dated: July 1, 2009

WEIL, GOTSHAL & MANGES LLP

By:           /s/ Edward R. Reines            
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Counterclaim Plaintiff Apple, Inc.