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 7 ELAN MICROELECTRONICS CORPORATION

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

12 ELAN MICROELECTRONICS CORPORATION,
 13
 14 Plaintiff and Counterdefendant,
 15 v.
 16 APPLE, INC.,
 17 Defendant and Counterclaimant.
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Case No. 5:09-cv-01531-RS (PVT)
ELAN MICROELECTRONICS CORPORATION'S CORRECTED FIRST AMENDED ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS IN RESPONSE TO APPLE, INC.'S THIRD AMENDED ANSWER, AFFIRMATIVE DEFENSES AND COUNTERCLAIMS
DEMAND FOR JURY TRIAL

1 Plaintiff Elan Microelectronics Corporation (“Elan”) by and through its undersigned counsel,
2 hereby answers the affirmative counterclaims raised in Defendant Apple, Inc.’s (“Apple”) Third
3 Amended Answer, Affirmative Defenses and Counterclaims (“Third Amended Answer”), Dkt. 96.

4 **I. ANSWER TO APPLE’S COUNTERCLAIMS**

5 Elan responds to Apple’s counterclaims as follows:

6 1-30. Apple’s responses to the allegations in Elan’s Complaint require no response from Elan.

7 **PARTIES**

8 31. Elan admits the allegations in paragraph 31.

9 32. Elan admits the allegations in paragraph 32.

10 **Jurisdiction and Venue**

11 33. Elan admits the allegations in paragraph 33.

12 34. Elan does not dispute personal jurisdiction in this district over Apple’s counterclaims in
13 Elan’s lawsuit brought in this district. Elan denies the remaining allegations in paragraph 34.

14 35. Elan does not dispute that venue is proper in this district.

15 **The Dispute**

16 36. Elan admits that it designs, markets, manufactures and sells touch-sensitive input devices or
17 touchpads, including the Smart-Pad product, and that these products are sold in the United States by
18 third parties not under Elan’s control. Elan denies the remaining allegations in paragraph 36.

19 37. Elan admits that laptop computers including Elan touchpads are available for purchase in the
20 United States, including through Amazon.com and Best Buy. Elan denies the remaining allegations in
21 paragraph 37.

22 38. Elan denies the allegations in paragraph 38.

23 39. Elan admits that the Nov. 29, 2005 Order in Case No. 05-CV-05385 JW which Apple cites
24 in paragraph 39 found that the plaintiff in that case made a prima facie showing of jurisdiction based
25 upon the factual allegations recited in paragraph 39. Elan denies that any of those alleged activities by
26 Elan Information Technology Group (“EITG”) related to any “touch-sensitive input devices or
27 touchpads and related components,” denies that EITG markets, sells or supports any such products and
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1 denies that Elan directly sells or supports any such products directly in the United States.

2 **First Counterclaim for Declaratory Judgment – '352 Patent**

3 40. Elan incorporates herein by reference its answers above.

4 41. Elan admits the allegations in paragraph 41.

5 42. Elan admits the allegations in paragraph 42.

6 43. Elan admits the allegations in paragraph 43.

7 44. Elan denies the allegations in paragraph 44.

8 45. Elan denies the allegations in paragraph 45.

9 **Second Counterclaim for Declaratory Judgment – '353 Patent**

10 46. Elan incorporates herein by reference its answers above.

11 47. Elan admits the allegations in paragraph 47.

12 48. Elan admits the allegations in paragraph 48.

13 49. Elan admits the allegations in paragraph 49.

14 50. Elan denies the allegations in paragraph 50.

15 51. Elan denies the allegations in paragraph 51.

16 **Third Counterclaim for Patent Infringement – '218 Patent**

17 52. Elan incorporates herein by reference its answers above.

18 53. Elan admits that information including the title, issue date and named inventors appears on
19 the face of U.S. Patent No. 5,764,218 (“the '218 patent”). Elan is without knowledge or information
20 sufficient to form a belief as to the truth of the information or the remaining allegations in the paragraph,
21 and on that basis denies them.

22 54. Elan denies the allegations in paragraph 54. The scope of the '218 patent is defined by the
23 patent claims themselves.

24 55. Elan denies the allegations in paragraph 55.

25 56. Elan denies the allegations in paragraph 56.

26 57. Elan denies the allegations in paragraph 57.

27 58. Elan admits having actual knowledge of the '218 patent on or about September 24, 2008
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1 when Nick Lin, a patent engineer at Elan, prepared a summary of the '218 patent and uploaded the '218
2 patent summary onto Elan's document management system. Elan denies having actual knowledge of
3 the patent before that date.

4 59. Elan denies the allegations in paragraph 59.

5 60. Elan denies the allegations in paragraph 60.

6 61. Elan denies the allegations in paragraph 61.

7 62. Elan denies the allegations in paragraph 62.

8 **Fourth Counterclaim for Patent Infringement – '659 Patent**

9 63. Elan incorporates herein by reference its answers above.

10 64. Elan admits that information including the title, issue date and named inventors appears on
11 the face of U.S. Patent No. 7,495,659 ("the '659 patent"). Elan is without knowledge or information
12 sufficient to form a belief as to the truth of the information or the remaining allegations in the paragraph,
13 and on that basis denies the same.

14 65. Elan denies the allegations in paragraph 65. The scope of the '659 patent is defined by the
15 patent claims themselves.

16 66. Elan denies the allegations in paragraph 66.

17 67. Elan denies the allegations in paragraph 67.

18 68. Elan denies the allegations in paragraph 68.

19 69. Elan admits having actual knowledge of the '659 patent on or about September 25, 2008
20 when Nick Lin, a patent engineer at Elan, prepared a summary of the '659 patent, uploaded the '659
21 patent summary onto Elan's document management system and circulated the '659 patent summary.
22 Elan denies having actual knowledge of the patent before that date.

23 70. Elan denies the allegations in paragraph 70.

24 71. Elan denies the allegations in paragraph 71.

25 72. Elan denies the allegations in paragraph 72.

26 73. Elan denies the allegations in paragraph 73.

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1 **II. ELAN'S AFFIRMATIVE DEFENSES**

2 **First Affirmative Defense – Non-Infringement**

3 74. Elan does not infringe and has not directly or indirectly infringed any claims of the '218 or
4 '659 patents ("Apple Patents"), either literally or under the doctrine of equivalents, willfully or
5 otherwise.

6 **Second Affirmative Defense – Invalidity**

7 75. Apple's claims for infringement of the Apple Patents are barred because each and every
8 claim of the Apple Patents is invalid for failure to comply with the requirements of Title 35 of the
9 United States Code, including but not limited to Sections 101, 102, 103 and/or 112.

10 **Third Affirmative Defense – Laches**

11 76. Apple's claims for relief are barred in whole or in part by the doctrine of laches.

12 **Fourth Affirmative Defense – Statute of Limitations**

13 77. To the extent Apple seeks damages for alleged infringement more than six years before the
14 filing of this action, the relief sought by Apple is barred by 35 U.S.C. § 286.

15 **Fifth Affirmative Defense – Notice**

16 78. To the extent Apple seeks damages for alleged infringement before giving actual or
17 constructive notice of the Apple Patents, the relief sought by Apple is barred by 35 U.S.C. § 287.

18 **Sixth Affirmative Defense – No Injunctive Relief**

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

22 **III. ELAN'S COUNTERCLAIMS**

23 **First Counterclaim for Declaratory Judgment – '218 Patent**

24 80. Elan incorporates herein by reference its statements above.

25 81. Elan asserts this counterclaim against Apple pursuant to the patent laws of the United States,
26 Title 35 of the United States Code, and the Declaratory Judgments Act, 28 U.S.C. §§ 2201 and 2202.
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1 82. In its Third Amended Answer, Apple alleges that Elan is now and has been directly and/or
2 indirectly infringing the '218 patent by the sale of at least its Smart-Pad product. Elan denies that
3 allegation.

4 83. An actual controversy exists between Elan and Apple by virtue of the allegations in Apple's
5 Third Amended Answer and Elan's Answer in response thereto, as to the invalidity, non-infringement
6 and unenforceability of the '218 patent.

7 84. The '218 patent is invalid and not infringed, as set forth in paragraphs 74 through 79 above.

8 85. Elan is entitled to a judgment that the '218 patent is invalid and/or not infringed.

9 **Second Counterclaim for Declaratory Judgment – '659 Patent**

10 86. Elan incorporates herein by reference its statements above.

11 87. Elan asserts this counterclaim against Apple pursuant to the patent laws of the United States,
12 Title 35 of the United States Code, and the Declaratory Judgments Act, 28 U.S.C. §§ 2201 and 2202.

13 88. In its Third Amended Answer, Apple alleges that Elan is now and has been directly and/or
14 indirectly infringing the '659 patent by the sale of at least its Smart-Pad product. Elan denies that
15 allegation.

16 89. An actual controversy exists between Elan and Apple by virtue of the allegations in Apple's
17 Third Amended Answer and Elan's Answer in response thereto, as to the validity and infringement of
18 the '659 patent.

19 90. The '659 patent is invalid and not infringed, as set forth in paragraphs 74 through 79 above.

20 91. Elan is entitled to judgment that the '659 patent is invalid and not infringed.

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DEMAND FOR JURY TRIAL

Elan Microelectronics Corporation hereby demands a jury trial on all issues so triable.

Dated: September 14, 2010

Respectfully submitted,

ALSTON + BIRD LLP

By: _____ */s/ Sean P. DeBruine*
Sean P. DeBruine

Attorneys for Plaintiff and Counterdefendant
ELAN MICROELECTRONICS CORPORATION

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