

**UNITED STATES DISTRICT COURT  
DISTRICT OF NEW MEXICO**

STC.UNM,

Plaintiff,

v.

INTEL CORPORATION,

Defendant.

Civil No. 10-CV-01077-RB-WDS

**STC'S SUPPLEMENTAL ANSWER TO INTEL'S AMENDED COUNTERCLAIMS**

STC hereby replies to the counterclaims of Intel as follows:

**Parties**

53. Admitted.

54. Admitted.

**Jurisdiction and Venue**

55. Admitted.

56. Admitted.

57. Admitted.

**First Counterclaim - Non-Infringement**

58. STC incorporates by reference its forgoing responses.

59. Admitted.

60. STC is without knowledge of the allegations in paragraph 60 and therefore denies the same.

### **Second Counterclaim - Invalidity**

61. STC incorporates by reference its forgoing responses.

62. Admitted.

63. STC is without knowledge of the allegations in paragraph 63 and therefore denies the same.

### **Third Counterclaim – Unenforceability**

64. STC incorporates by reference its forgoing responses. To the extent that any allegation set forth in Intel's Fifth Affirmative Defense of Inequitable Conduct is not repeated in its Third Amended Counterclaim for Unenforceability, it is denied.

65. Denied.

66. The allegations in this paragraph have been withdrawn.

67. STC admits it sought a Certificate of Correction to correct the continuation-in-part status the '998 patent, and denies the remaining allegations in paragraph 67.

68-70. The allegations in paragraphs 68-70 have been withdrawn.

71. STC admits the '998 patent application did not claim priority to any earlier-filed patent applications, and denies the remaining allegations in paragraph 71.

72. STC is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 72 and on this basis STC denies such allegations.

73. STC objects to the allegations in paragraph 73 as vague and indefinite with respect to the terms “related.” As a result, STC denies the allegations set forth in paragraph 73.
74. STC admits it contends that the '998 patent is a continuation-in-part of the '321 patent, which, in turn, is a continuation of U.S. Patent Application No. 08/123,543, filed on September 20, 1993, and denies the remaining allegations in paragraph 74.
75. STC admits that the PTO issued a first Office Action rejecting the claims, and that remarks were submitted in response that were subsequently deemed non-meritorious by the Patent Office. STC denies the remaining allegations of paragraph 75.
76. STC is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 76 and on this basis STC denies such allegations.
77. STC admits that the PTO issued a second Office Action rejecting the claims, and that remarks were submitted in response that were subsequently deemed non-meritorious by the Patent Office. STC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 77 and on this basis STC denies such allegations.

78. STC admits that a Terminal Disclaimer was executed that relinquished that part of the '998 patent term that would have otherwise extended beyond the term of the '321 patent. STC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 78 and on this basis STC denies such allegations.

79. STC is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 79 and on this basis STC denies such allegations.

80. STC admits that the on or about June 22, 1999, the Examiner allowed the '998 patent based upon, *inter alia*, an "Examiner's Amendment," "amendments made in the response filed 5/21/99," and "the filing of a terminal disclaimer." STC admits the '998 patent issued on March 28, 2000.

81. Admitted.

82. STC admits that it STC learned of the '258 patent sometime after UNM's assignment, and denies the remaining allegations of paragraph 82.

83. STC admits that it filed a Request for a Certificate of Correction to correct the continuation-in-part status of the '998 patent and denies the remaining allegations of paragraph 83.

84. STC admits that paragraph 84 cites MPEP §§ 1481 & 1485. STC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 84 and on this basis STC denies such allegations. For example, the instant request for certificate of correction was routed from the certificate of corrections branch to Examiner Huff in art unit 1756, and approved on November 25, 2008.

85. STC objects to the allegations in paragraph 85 as vague and indefinite with respect to the terms “issues” and “priority.” As a result, STC denies the allegations set forth in paragraph 85. In addition, STC is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations set forth in paragraph 85 and on this basis STC denies such allegations.

86. Denied.

87. Denied.

88. STC admits that pursuant to the statutory language of 35 U.S.C. 255, STC classified the failure to claim priority to the '321 patent as a “clerical mistake.” STC further admits that in support of satisfaction of the requirements for the requested correction it stated, *inter alia*:

“U.S. Patent Application No. 08/490,101 (the parent application) was filed on June 6, 1995 and issued as U.S. Patent No. 5,705,321 on January 6, 1998. U.S. Patent Application No. 08/932,428 (the child application) was filed on September 17, 1997 and issued as US. Patent No. 6,042,998 on March 28, 2000. Accordingly, these applications were copending from September 17, 1997 until January 6, 1998. These application have common inventors, i.e., Steven R. J. Brueck and Saleem H. Zaidi. These applications have common subject matter, e.g., method of obtaining a pattern by coating, exposing, etc.

The record of the parent and child applications demonstrate that they were entitled to a filing date and all necessary fees were properly paid such that priority is appropriate.

STC denies there was no further discussion of the original prosecution history, and objects to the remaining allegations in paragraph 88 as vague and indefinite with respect to the terms “applicants’ prior positions to the contrary.” As a result, STC denies the remaining allegations set forth in paragraph 88.

89. Denied.

90. Denied.

91. Denied.

92. STC admits that the PTO approved STC’s Request for a Certificate of Correction on November 25, 2008, and denies the remaining allegations in paragraph 92.

93. Denied.

94. Denied.

WHEREFORE, STC prays that the Court find for STC on Intel’s counterclaims, dismissing such counterclaims with prejudice. STC further requests its attorney fees and costs associated with the defense against such counterclaims, and such additional relief as the Court deems appropriate.

Dated: October 13, 2011

Respectfully submitted,

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*Attorneys for Plaintiff STC.UNM*

**DEMAND FOR JURY TRIAL**

Pursuant to Fed. R. Civ. P. 38(b), STC demands a jury trial of all issues properly triable to a jury in this case.

Dated: October 13, 2011

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**CERTIFICATE OF SERVICE:** I hereby certify that on October 13, 2011, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing via electronic mail to all counsel of record.

/s/ Steven R. Pedersen