

Henry C. Bunsow (SBN 060707)

[bunsowh@howrey.com](mailto:bunsowh@howrey.com)

K.T. Cherian (SBN 133967)

[cheriank@howrey.com](mailto:cheriank@howrey.com)

Robert M. Harkins (SBN 179525)

[harkinsr@howrey.com](mailto:harkinsr@howrey.com)

Vinay V. Joshi (SBN 213487)

[joshiv@howrey.com](mailto:joshiv@howrey.com)

HOWREY LLP

525 Market Street, Suite 3600

San Francisco, California 94105

Telephone: (415) 848-4900

Facsimile: (415) 848-4999

Attorneys for KLA-Tencor Corporation

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

OAKLAND DIVISION

KLA-TENCOR CORP.,

Plaintiff,

vs.

FUJITSU LIMITED and FUJITSU

MICROELECTRONICS AMERICA, INC.

Defendants.

) Case No. C08-01254 (CW)

) **FIRST AMENDED COMPLAINT FOR**  
) **DECLARATORY JUDGMENT**

) **DEMAND FOR JURY TRIAL**

**Complaint for Declaratory Judgment of Patent Non-Infringement, Invalidity, and**

**Unenforceability**

Plaintiff KLA-Tencor Corporation (“KLA-Tencor”) complains against Defendants Fujitsu Limited and Fujitsu Microelectronics America, Inc. (“Fujitsu America”) (collectively “Fujitsu”), demands a jury trial, and alleges as follows:

**NATURE OF THE ACTION**

1. This is an action arising under the patent laws of the United States, 35 U.S.C. § 1, *et seq.*, and under the Declaratory Judgment Act, 28 U.S.C. § 2201, *et seq.*, for a declaratory judgment that

1 KLA-Tencor does not infringe Fujitsu's U.S. Patent No. 6,104,486 and that the patent is invalid and  
2 unenforceable.

3 **PARTIES**

4 2. Plaintiff KLA-Tencor is a corporation organized and existing under the laws of the  
5 Delaware, having its principal place of business at 160 Rio Robles, San Jose, California 95134.

6 3. Upon information and belief, Defendant Fujitsu Limited is a corporation organized and  
7 existing under the laws of Japan, having its principal place of business in Japan.

8 4. Upon information and belief, Defendant Fujitsu America is a wholly owned subsidiary  
9 of Fujitsu Limited and is a corporation organized and existing under the laws of California, having its  
10 principal place of business at 1250 E. Arques Ave., M/S 333, Sunnyvale, California 94088-3470.

11 **JURISDICTION**

12 5. This Court has jurisdiction over the subject matter of this action under 28 U.S.C. §§  
13 1331, 1338(a) and 2201 because this action seeks a declaratory judgment regarding rights arising under  
14 the patent laws of the United States.

15 6. This Court has personal jurisdiction over Fujitsu Limited because Fujitsu Limited has  
16 established minimum contacts with the forum and the exercise of jurisdiction over Fujitsu Limited  
17 would not offend traditional notions of fair play and substantial justice. Fujitsu Limited has also  
18 availed itself of the benefits of this state and forum.

19 7. This Court has personal jurisdiction over Fujitsu America because Fujitsu America is a  
20 resident of this state and this district.

21 **VENUE**

22 8. Venue is proper in this District under 28 U.S.C. §§ 1391(d) because Plaintiff KLA-  
23 Tencor resides in this district, because Fujitsu Limited is an alien that may be sued in any district, and  
24 because Defendant Fujitsu America resides in this district.

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**INTRADISTRICT ASSIGNMENT**

9. The Oakland Division is proper for intradistrict assignment because this action is an Intellectual Property action and is related to another action already pending before Judge Wilken in the Oakland Division.

**JURISDICTION AND VENUE**

10. This Court has jurisdiction over the subject matter of this action under 28 U.S.C. §§ 1331, 1338(a) and 2201 because this action seeks a declaratory judgment regarding rights arising under the patent laws of the United States.

**FACTUAL BACKGROUND FOR DECLARATORY JUDGMENT COUNTS**

11. On information and belief, Fujitsu Limited is the assignee of record of U.S. Patent No. 6,104,486 entitled "Fabrication Process of Semiconductor Device Using Ellipsometry" (the "'486 patent" or the "patent in suit"), which is attached hereto as Exhibit A.

12. On information and belief, Fujitsu America is a wholly owned subsidiary of Fujitsu Limited and has asserted that it is damaged by the alleged infringement of the patent in suit by KLA-Tencor products.

13. A valid and justiciable controversy regarding the patents in suit has arisen between KLA-Tencor and Fujitsu that is properly presented for judicial relief under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202. Fujitsu has asserted that the use of KLA-Tencor products infringes, constitutes contributory infringement of, or induces to infringe claims of the '486 patent and has threatened to pursue or pursued legal action for infringement of claims of the '486 patent for one or more KLA-Tencor products.

14. KLA-Tencor has not infringed, contributed to the infringement of, or induced infringement of any valid and enforceable claim of the patent in suit as properly construed. In addition, the claims of the patent in suit are invalid and unenforceable.

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**FIRST CLAIM FOR RELIEF****(Request for Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,104,486)**

15. KLA-Tencor realleges and incorporates herein by reference the allegations contained in Paragraphs 1 through 14.

16. KLA-Tencor has not infringed, contributed to the infringement of, or induced infringement of any valid and enforceable claim of the '486 patent as properly construed, either literally or under the doctrine of equivalents.

**SECOND CLAIM FOR RELIEF****(Request for Declaratory Judgment of Patent Invalidity of U.S. Patent No. 6,104,486)**

17. KLA-Tencor realleges and incorporates herein by reference the allegations contained in Paragraphs 1 through 16.

18. The '486 patent is invalid for failing to satisfy one or more of the conditions of patentability under Title 35 of the United States Code, including but not limited to Sections 102, 103, and/or 112.

19. Fujitsu is estopped from construing any valid claim of U.S. Patent No. 6,104,486 to cover or include, either literally or by application of the doctrine of equivalents, any product made, used, imported, sold or offered for sale by Counterclaim-Plaintiffs because of admissions and statements to the U.S. Patent and Trademark Office in the specifications of and during prosecution of the applications leading to issuance of U.S. Patent No. 6,104,486.

**THIRD CLAIM FOR RELIEF****(Request for Declaratory Judgment of Patent Unenforceability of U.S. Patent No. 6,104,486)**

20. KLA-Tencor realleges and incorporates herein by reference the allegations contained in Paragraphs 1 through 19.

21. Fujitsu is barred by laches and limited by 35 U.S.C. sections 286 and 287 and thus is not entitled to enforce any claim of U.S. Patent No. 6,104,486 against KLA-Tencor.

1           22.     U.S. Patent No. 6,104,486 is unenforceable for failing to satisfy the conditions of  
2 enforceability required in law and equity, and for Fujitsu's acts of misuse, and for inequitable conduct  
3 on the part of Fujitsu's that occurred during prosecution in the U.S. Patent and Trademark Office.

4           23.     On information and belief, the '486 patent is unenforceable because Fujitsu has used  
5 said patents in connection with and in furtherance of an unlawful course of conduct constituting patent  
6 misuse. On information and belief, Fujitsu knowingly attempted and presently attempts to unlawfully  
7 recover past damages related to the '486 patent barred by the six year limitation under 35 U.S.C. § 286  
8 and barred by the notice requirements of 35 U.S.C. § 287, and to assert infringement of claims and  
9 damages that Fujitsu knows to be barred by the doctrine of laches.

10          24.     On information and belief, the '486 patent is also unenforceable due to inequitable  
11 conduct. On information and belief, during the prosecution of the application leading to the '486  
12 patent, the patentee failed to present prior art to the U.S. Patent and Trademark Office that the patentee  
13 knew of and understood to be material to the patentability of the claims sought during the prosecution,  
14 including but not limited to prior art by Nadine Blayo, including U.S. Patent No. 5,739,909. On  
15 information and belief, during prosecution of the '486 patent from at least April 14, 1998 to August 15,  
16 2000, Fujitsu withheld from the U.S. Patent and Trademark Office highly material prior art, including  
17 but not limited to prior art references from Nadine Blayo such as U.S. Patent No. 5,739,909 (the "'909  
18 patent to Blayo"). The materiality of the '909 patent to Blayo has been confirmed by the U.S. Patent  
19 and Trademark Office in its granting of reexamination proceedings regarding the claims of the '486  
20 patent. Fujitsu had knowledge of prior art by Blayo, which is confirmed by the disclosure of a related,  
21 but less material article by Blayo made to the U.S. Patent and Trademark Office during the '486 patent  
22 prosecution, yet Fujitsu failed to disclose the highly material '909 patent to Blayo. In view of the  
23 reference's high degree of materiality and its knowledge of the reference, Fujitsu was required to  
24 disclose the '909 patent to Blayo to the U.S. Patent and Trademark Office during its prosecution of the  
25 '486 patent from at least April 14, 1998 to August 15, 2000. But in fact Plaintiff Fujitsu Limited never  
26 disclosed the '909 patent to Blayo to the U.S. Patent and Trademark Office. Moreover, the inventor of  
27 the '486 patent, Hiroshi Arimoto, and the patent attorney for Fujitsu, John Kong, were deposed in  
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2008, and did not testify in a manner inconsistent with a finding and conclusion that the '486 patent was procured through inequitable conduct. On the contrary, their testimony confirmed that the reference was material to the '486 patent prosecution. Additionally, Fujitsu made misstatements of fact to the U.S. Patent and Trademark Office regarding the database in the alleged invention as well as the state of the prior art known to Fujitsu at the time, including that it did not suggest the suitability of using ellipsometry to determine critical dimension, when in fact the prior art known to Fujitsu at the time such as prior art by Blayo did disclose such suitability. Therefore, the '486 patent claims are unenforceable.

### **JURY DEMAND**

25. Under Rule 38(b) of the Federal Rules of Civil Procedure, KLA-Tencor respectfully requests a jury trial on all issues and claims.

### **PRAYER FOR RELIEF**

WHEREFORE, KLA-Tencor prays for judgment against Fujitsu, and that the Court award the following relief:

A. Declare that KLA-Tencor has not infringed, has not contributed to infringement of, and has not induced infringement of any claims of the patent in suit, either literally or under the doctrine of equivalents;

B. Declare that the claims of the patent in suit are invalid;

C. Enter an order preliminarily and permanently enjoining Fujitsu, its officers, directors, servants, managers, employees, agents, successors and assignees, and all persons in active concert or participation with any of them, from directly or indirectly charging KLA-Tencor with infringement of any claim of the patent in suit;

D. Declare this case exceptional under 35 U.S.C. § 285 and award KLA-Tencor its reasonable attorneys' fees, expenses and costs incurred in this action; and

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E. Such other and further relief as this Court deems just and proper.

DATED: June 30, 2008

Respectfully submitted,

By: /s/Robert M. Harkins

Robert M. Harkins, Jr.

Attorneys for Plaintiff  
KLA-TENCOR CORPORATION