

**UNITED STATES DISTRICT COURT  
NORTHERN DISTRICT OF TEXAS  
DALLAS DIVISION**

**NANYA TECHNOLOGY  
CORPORATION and NANYA  
TECHNOLOGY CORPORATION USA**

*Plaintiffs,*

v.

**NEC CORPORATION and  
NEC ELECTRONICS CORPORATION,**

*Defendants.*

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**NO. 3-07CV0829-K**

**JURY DEMANDED**

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**PLAINTIFFS' FIRST AMENDED COMPLAINT AND JURY DEMAND**

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Nanya Technology Corporation and Nanya Technology Corporation USA (“Plaintiffs”) file this first amended complaint for declaratory relief against NEC Corporation and NEC Electronics Corporation (“Defendants”) and state:

**THE PARTIES**

1. Plaintiff Nanya Technology Corporation is a corporation organized and existing under the laws of Taiwan having its principal place of business at Hwa Ya Technology Park, 669, Fu Hsing 3rd Road, Kueishan, Taoyuan, 333, Taiwan, Republic of China. Plaintiff Nanya Technology Corporation USA is corporation organized and existing under the laws of California and is a wholly owned subsidiary of Nanya Technology Corporation and has an address of 5104 Old Ironsides Drive, Suite 113, Santa Clara, California 95054.

2. Defendants NEC Corporation and NEC Electronics Corporation are organized and existing under the laws of Japan having their principal places of business at 7-1, Shiba 5-chome, Minato-ku, Tokyo 108-8001, Japan, and 1753, Shimonumabe, Nakahara-Ku, Kawasaki,

Kanagawa 211-8668, Japan. Defendants have done business within this judicial district, including pursuing claims of patent infringement against others in this Court.

#### **JURISDICTION AND VENUE**

3. This is an action for declaratory judgment brought under 28 U.S.C. §§ 2201-2202. Plaintiffs seek a declaration from the Court that Defendants' U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203, are each not infringed, invalid, and/or unenforceable.

4. This Court has personal jurisdiction over Defendants because Defendants have done and are doing business in this state.

5. The Court has subject matter jurisdiction under 28 U.S.C. § 1331 because this case involves federal questions. This Court has subject matter jurisdiction under 28 U.S.C. §§ 2201-2202 because the action arises under the patent laws of the United States.

6. Venue is proper in this district under 28 U.S.C. § 1391 because Defendants are subject to personal jurisdiction in this district and because acts of infringement alleged by Defendants occur in this district.

#### **FACTS**

7. On August 26, 2006, Defendants' representatives Sumio Kogure and Shunsaku Naga met with Plaintiffs' representatives in Taipei, Taiwan. During the meeting, Mr. Kogure and Mr. Naga expressly alleged infringement of Defendants' U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,648,931, and U.S. Patent No. 6,133,122.

8. On September 5, 2006, Plaintiffs' patent counsel in Dallas, Texas sent a letter informing Defendants that a list of questions seeking clarification of Defendants' infringement

allegations would be sent in October 2006. On October 4, 2006, Plaintiffs' patent counsel sent Defendants a first list of questions. On October 30, 2006, Plaintiffs' patent counsel sent Defendants a second list of questions.

9. On January 22, 2007, Mr. Kogure sent Plaintiffs' patent counsel a letter characterizing Plaintiffs' questions as a "waste of time" and "irritation" and further accusing Plaintiffs of infringing Defendants' U.S. Patent No. 5,495,435, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203.

10. March 6, 2007 and March 26, 2007, Defendants' litigation counsel Peter C. Schechter, Esq. of Edwards Angell Palmer & Dodge LLP sent letters to Plaintiffs' counsel confirming Defendants' infringement allegations, refusing to answer Plaintiffs' questions, and demanding that Plaintiffs pay Defendants royalties or face "more patent litigation."

11. Plaintiffs have a reasonable apprehension that Defendants will file suit against Plaintiffs for allegedly infringing U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203. Accordingly, there is a justiciable controversy between the parties concerning whether any acts of Plaintiffs constitute infringement of these patents and the invalidity and unenforceability of these patents.

#### **NON-INFRINGEMENT**

12. Plaintiffs have not infringed and are not infringing U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, or U.S. Reissue Patent No. 36,203.

13. Plaintiffs have not contributed to, are not contributing to, have not induced, and are not inducing infringement of U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S.

Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, or U.S. Reissue Patent No. 36,203.

14. Thus, there has been and is now an actual controversy between the parties as to the noninfringement of U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203.

#### **INVALIDITY**

15. U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203 are each invalid for failing to satisfy the conditions for patentability set forth in Part II of Title 35 of the United States Code, including but not limited to section 101, 102, 103, and/or 112.

16. Thus, there has been and is now an actual controversy between the parties as to the invalidity of U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203.

#### **ESTOPPEL**

17. Defendants are estopped from construing any valid claim of U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, or U.S. Reissue Patent No. 36,203 to cover or include, either literally or by application of the doctrine of equivalents, any product made, used, sold, offered for sale or imported by Plaintiffs because of admissions and statements to the United States Patent & Trademark Office during prosecution of the applications leading to

the issuance of said patents.

18. Thus, there has been and is now an actual controversy between the parties as to whether estoppel bars Defendants from asserting claims against Plaintiffs that U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203 are infringed.

### **NO INJUNCTION**

19. Defendants are not entitled to injunctive relief because any alleged injury to Defendants is not immediate or irreparable, and Defendants have an adequate remedy at law.

20. Thus, there has been and is now an actual controversy between the parties as to whether Plaintiffs can be enjoined, either preliminarily or permanently, from any activities relating to Defendants' U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203.

WHEREFORE, Plaintiffs respectfully requests that the Court:

a. Render a declaratory judgment that Plaintiffs do not infringe any claim of U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203.

b. Render a declaratory judgment that the claims of U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203 are invalid;

c. Render a declaratory judgment that U.S. Patent No. 4,855,956, U.S. Patent No. 5,517,456, U.S. Patent No. 5,495,435, U.S. Patent No. 5,648,931, U.S. Patent No. 6,133,122, U.S. Patent No. 6,610,597, and U.S. Reissue Patent No. 36,203 cannot be enforced due to, *inter alia*, estoppel;

d. Declare this to be an exceptional case and award Plaintiffs their attorneys' fees and other related costs and expenses under 35 U.S.C. § 285; and

e. Award such other and necessary relief to which Plaintiffs may show themselves to be entitled.

#### **JURY DEMAND**

In accordance with FEDERAL RULES OF CIVIL PROCEDURE 38 and 39, Plaintiffs assert their rights under the SEVENTH AMENDMENT OF THE U.S. CONSTITUTION and demands a trial by jury on all issues so triable.

DATED May 11, 2007.

Respectfully Submitted,

/s/ Alfonso Garcia Chan

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Michael W. Shore (SBN 18294915)  
Alfonso Garcia Chan (SBN 24012408)  
Jeffrey R. Bragalone (SBN 02855775)

Shore Chan Bragalone LLP  
325 N. St. Paul Street, Suite 4450  
Dallas, Texas 75201  
Telephone (214) 593-9110  
Facsimile (214) 593-9111

ATTORNEYS FOR PLAINTIFFS  
NANYA TECHNOLOGY CORPORATION and  
NANYA TECHNOLOGY CORPORATION USA