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PROMOS TECHNOLOGIES INC.

UNITED STATES DISTRICT COURT

NORTHERN DISTRICT OF CALIFORNIA

PROMOS TECHNOLOGIES INC.,

Plaintiff,

v.

MOSAID TECHNOLOGIES, INCORPORATED,

Defendant.

CASE NO. C06 05788 JCS

COMPLAINT FOR DECLARATORY JUDGMENT

– AND –

DEMAND FOR JURY TRIAL

Plaintiff ProMOS Technologies Inc. ("ProMOS") alleges as follows for its Complaint for Declaratory Judgment against defendant MOSAID Technologies, Incorporated ("MOSAID"):

PARTIES

1. ProMOS is a corporation organized under the laws of Taiwan, R.O.C. with its principle place of business at No. 19, Li-Hsin Road, Hsinchu Science Park, Hsinchu, Taiwan 30078, R.O.C. ProMOS is engaged in the business of designing, manufacturing and selling dynamic random access memory devices ("DRAMs").

2. Upon information and belief, MOSAID is a foreign corporation with its principal place of business in Kanata, Ontario, Canada. MOSAID's primary business is licensing and enforcing patents whose claims purportedly cover semiconductor technology. MOSAID maintains two offices in this district. Upon information and belief, MOSAID does substantial business in, and has general and systematic contacts with, this judicial district.

NATURE OF THE DISPUTE

3. In this action, ProMOS seeks a declaration judgment of patent non-infringement, invalidity and unenforceability of eleven United States patents owned by MOSAID. These eleven MOSAID patents are identified below and will be referred to herein as the "MOSAID Patents" or the "patents-in-suit."

4. MOSAID filed a suit on July 25, 2006 against ProMOS in the Eastern District of Texas for patent infringement of nine of the MOSAID Patents, captioned *MOSAID Technologies Inc. v. Micron Technology, Inc., Powerchip Semiconductor Corporation, and ProMOS Technologies*, Case No. 2:06CV302-DF ("the Texas case").

5. On August 31, 2006, MOSAID filed an amended complaint in the Texas case and added the remaining two of the MOSAID Patents.

6. Accordingly, there is an actual and justiciable controversy between ProMOS and MOSAID as to whether ProMOS infringes the MOSAID Patents and whether the MOSAID Patents are valid. On that basis, ProMOS brings this declaratory judgment action.

JURISDICTION, VENUE AND INTRADISTRICT ASSIGNMENT

7. This Court has jurisdiction over the subject matter of this lawsuit pursuant to 28 U.S.C. §§ 2201-2202, 1331 and 1338(a).

8. Venue is proper in this judicial district under 28 U.S.C. § 1391. MOSAID is subject to personal jurisdiction in this district because, among other reasons, it maintains two offices in this district, has general and systematic contacts with this district and has purposefully directed activities to this district.

9. This is an intellectual property action; therefore, pursuant to Civil L.R. 3-2(c), it may be assigned on a district-wide basis. Nevertheless, ProMOS believes this case is related to another case currently pending in this Court before the Honorable Jeremy Fogel, captioned *Infineon Technologies North America Corp. v. MOSAID Technologies Incorporated*, Case No. 5:02-cv-05772-JF (RS), and efficiency considerations therefore dictate that it be assigned to Judge Fogel.

THE MOSAID PATENTS-IN-SUIT

10. ProMOS incorporates and realleges the allegations of paragraphs 1-9 as if set forth fully herein.

11. ProMOS seeks a declaratory judgment of patent non-infringement and invalidity of the following MOSAID Patents:

"Lines Family Patents"

- U.S. Patent No. 5,822,253 ("the '253 patent") entitled "Dynamic Memory Word Line Driver Scheme," which was filed on August 16, 1995 and issued on October 13, 1998. The inventor named on the '253 patent is Valerie L. Lines. A copy of the '253 patent is attached hereto as Exhibit A.
- U.S. Patent No. 5,751,643 ("the '643 patent") entitled "Dynamic Memory Word Line Driver," which was filed on March 6, 1996 and issued on May 12, 1998. The inventor named on the '643 patent is Valerie L. Lines. A copy of the '643 patent is attached hereto as Exhibit B.
- U.S. Patent No. 6,278,640 B1 ("the '640 patent") entitled "Dynamic Memory Word Line Driver Scheme," which was filed on April 13, 2000 and issued on

August 21, 2001. The inventor named on the '640 patent is Valerie L. Lines. A copy of the '640 patent is attached hereto as Exhibit C.

- U.S. Patent No. 6,603,703 B2 ("the '703 patent") entitled "Dynamic Memory Word Line Driver Scheme," which was filed on July 31, 2001 and issued on August 5, 2003. The inventor named on the '703 patent is Valerie L. Lines. A copy of the '703 patent is attached hereto as Exhibit D.
- U.S. Patent No. 7,038,937 B2 ("the '937 patent") entitled "Dynamic Memory Word Line Driver Scheme," which was filed on March 2, 2004 and issued on May 2, 2006. The inventor named on the '937 patent is Valerie L. Lines. A copy of the '937 patent is attached hereto as Exhibit E.

"Foss Family Patents"

- U.S. Patent 5,406,523 ("the '523 patent") entitled "High Voltage Boosted Word Line Supply Charge Pump and Regulator for DRAM," which was filed on October 12, 1993 and issued on April 11, 1995. The inventors named on the '523 patent are Richard C. Foss, Peter B. Gillingham, Robert F. Harland and Valerie L. Lines. A copy of the '620 patent is attached hereto as Exhibit F.
- U.S. Patent 5,828,620 ("the '620 patent") entitled "High Voltage Boosted Word Line Supply Charge Pump and Regulator for DRAM," which was filed on September 2, 1997 and issued on October 27, 1998. The inventors named on the '620 patent are Richard C. Foss, Peter B. Gillingham, Robert F. Harland and Valerie L. Lines. A copy of the '620 patent is attached hereto as Exhibit G.
- U.S. Patent No. 6,236,581 B1 ("the '581 patent") entitled "High Voltage Boosted Word Line Supply Charge Pump and Regulator for DRAM," which was filed on January 14, 2000 and issued on May 22, 2001. The inventors named in the '581 patent are Richard C. Foss, Peter B. Gillingham, Robert F. Harland and Valerie L. Lines. A copy of the '581 patent is attached hereto as Exhibit H.
- U.S. Patent No. 6,980,448 B2 ("the '448 patent") entitled "DRAM Boosted Voltage Supply," which was filed on June 17, 2003 and issued on December 27,

2005. The inventors named in the '448 patent are Richard C. Foss, Peter B. Gillingham, Robert F. Harland and Valerie L. Lines. A copy of the '448 patent is attached hereto as Exhibit I.

"Delayed Locked Loop Family Patents"

- U.S. Patent No. 6,657,919 B2 ("the '919 patent"), entitled 'Delayed Locked Loop Implementation in a Synchronous Dynamic Random Access Memory," which was filed on January 17, 2003 and issued on December 2, 2003. The inventors named on the '919 patent are Richard C. Foss, Peter B. Gillingham and Graham Allan. A copy of the '919 patent is attached hereto as Exhibit J.
- U.S. Patent No. 6,992,950 B2 ("the '950 patent"), entitled 'Delayed Locked Loop Implementation in a Synchronous Dynamic Random Access Memory," which was filed on August 21, 2003 and issued on January 31, 2006. The inventors named on the '950 patent are Richard C. Foss, Peter B. Gillingham and Graham Allan. A copy of the '950 patent is attached hereto as Exhibit K.

12. On information and belief, MOSAID is the owner by assignment of each of the patents-in-suit.

COUNT I

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 5,822,253)

13. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

14. MOSAID has accused ProMOS of infringing the '253 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '253 patent.

15. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '253 patent, either literally or under the doctrine of equivalents.

16. The '253 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

17. The '253 patent is invalid under the doctrine of double patenting.

18. The '253 patent is unenforceable due to prosecution laches.

19. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT II

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 5,751,643)

20. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

21. MOSAID has accused ProMOS of infringing the '643 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '643 patent.

22. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '643 patent, either literally or under the doctrine of equivalents.

23. The '643 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

24. The '643 patent is invalid under the doctrine of double patenting.

25. The '643 patent is unenforceable due to prosecution laches.

26. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT III

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 6,278,640 B1)

27. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

28. MOSAID has accused ProMOS of infringing the '640 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '640 patent.

29. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '640 patent, either literally or under the doctrine of equivalents.

30. The '640 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

31. The '640 patent is invalid under the doctrine of double patenting.

32. The '640 patent is unenforceable due to prosecution laches.

33. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT IV

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 6,603,703 B2)

34. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

35. MOSAID has accused ProMOS of infringing the '703 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '703 patent.

36. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '703 patent, either literally or under the doctrine of equivalents.

37. The '703 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

38. The '703 patent is invalid under the doctrine of double patenting.

39. The '703 patent is unenforceable due to prosecution laches.

40. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT V

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 7,038,937 B2)

41. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

42. MOSAID has accused ProMOS of infringing the '937 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '937 patent.

43. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '937 patent, either literally or under the doctrine of equivalents.

44. The '937 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

45. The '937 patent is invalid under the doctrine of double patenting.

46. The '937 patent is unenforceable due to prosecution laches.

47. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT VI

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 5,406,523)

48. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

49. MOSAID has accused ProMOS of infringing the '523 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '523 patent.

50. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '523 patent, either literally or under the doctrine of equivalents.

51. The '523 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

52. The '523 patent is invalid under the doctrine of double patenting.

53. The '523 patent is unenforceable due to prosecution laches.

54. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT VII

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 5,828,620)

55. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

56. MOSAID has accused ProMOS of infringing the '620 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '620 patent.

57. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '620 patent, either literally or under the doctrine of equivalents.

58. The '620 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

59. The '620 patent is invalid under the doctrine of double patenting.

60. The '620 patent is unenforceable due to prosecution laches.

61. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT VIII

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 6,236,581 B1)

62. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

63. MOSAID has accused ProMOS of infringing the '581 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '581 patent.

64. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '581 patent, either literally or under the doctrine of equivalents.

65. The '581 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

66. The '581 patent is invalid under the doctrine of double patenting.

67. The '581 patent is unenforceable due to prosecution laches.

68. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT IX

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 6,980,448 B2)

69. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

70. MOSAID has accused ProMOS of infringing the '448 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '448 patent.

71. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '448 patent, either literally or under the doctrine of equivalents.

72. The '448 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

73. The '448 patent is invalid under the doctrine of double patenting.

74. The '448 patent is unenforceable due to prosecution laches.

75. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT X

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 6,657,919 B2)

76. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

77. MOSAID has accused ProMOS of infringing the '919 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '919 patent.

78. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '919 patent, either literally or under the doctrine of equivalents.

79. The '919 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

80. The '919 patent is invalid under the doctrine of double patenting.

81. The '919 patents is unenforceable due to prosecution laches and inequitable conduct in its procurement.

a. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '919 patent and its predecessor applications were aware of U.S. Patent Nos. 5,220,206 ("the '206 patent"), 5,497,115 ("the '115 patent"), 5,610,543 ("the '543 patent"), and 5,657,481 ("the '481 patent") prior to the issuance of the '919 patent. Prior to issuance of the '919 patent, the '206, '115, '543 and '481 patents were cited by MOSAID counsel Pascal & Associates in connection with U.S. Patent Nos. 5,777,501, 5,991,226, and 6,087,868, which are also assigned to MOSAID. Pascal & Associates were counsel of record for at least part of the prosecution of the '919 patent and/or its predecessor applications. The information contained in the '206, '115, '543, and '481 patents is material to one or more claims of the '919 patent and/or its predecessor applications. Nevertheless, the '206, '115, '543, '481 patents were not disclosed to the PTO during the prosecution of the '919 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '919 patent. As a result, the '919 patent is unenforceable.

b. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '919 patent and its predecessor applications were aware of U.S. Patent Nos. 5,295,164 ("the '164 patent") prior to the issuance of the '919 patent. For example, prior to issuance of the '919 patent, the '164 patent was cited by MOSAID in connection with U.S. Patent No. 6,327,318 ("the '318 patent") which is also assigned to MOSAID and includes Graham Allen as an inventor. The information contained in the '164 patent is material to one or more claims of the predecessor applications to the '919 patent. Nevertheless, the '164 patent was not disclosed to the PTO during the prosecution of the '919 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing,

willful, and done with the intent to deceive the PTO into issuing the '919 patent. As a result, the '919 patent is unenforceable.

c. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '919 patent and its predecessor applications were aware of (1) a 1992 presentation given by Xerox disclosing the use of an on-chip DLL ("the Xerox Presentation") and (2) a 1994 presentation given by NEC concerning a "PLL Enable Mode" ("the NEC Presentation") prior to the issuance of the '919 patent. For example, Richard Foss and Peter Gillingham, named inventors of the '919 patent are listed as attendees of the December 18, 1992 JEDEC JC-42.3 DRAM Task Group Special Meeting at which the Xerox Presentation was delivered. Moreover, Richard Foss and Graham Allen named inventor of the '919 patent are listed as attendees of the JEDEC JC-42.3 meeting at which the NEC Presentation was delivered. Information relating to the Xerox Presentation and the NEC Presentation is material to one or more claims of the '919 patent and/or its predecessor applications. Nevertheless, the Xerox Presentation and the NEC Presentation were not disclosed to the PTO during the prosecution of the '919 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '919 patent. As a result, the '919 patent is unenforceable.

d. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '919 patent and its predecessor applications were aware of Horowitz et. al., "Clocking Strategies in High Performance Processors," 1992 Symposium on VLSI Circuits Digest of Technical Papers ("the Horowitz Reference") prior to the issuance of the predecessors to the '919 patent. For example Richard Foss, a named inventors of the '919 patent, attended the June 1992 VLSI Symposium at which the Horowitz Reference was presented. Information relating to the Horowitz Reference is material to one or more claims of the '919 patent and or the predecessor applications to the '919 patent. Nevertheless, the Horowitz Reference was not disclosed to the PTO during the prosecution of the predecessor applications to the '919 patent application. Upon information and belief, the failure to disclose this material information was knowing,

willful, and done with the intent to deceive the PTO into issuing the '919 patent and its predecessors. As a result, the '919 patent is unenforceable.

e. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '919 patent and its predecessor applications were aware of Waizman et. al., "A Delay Line Loop for Frequency Synthesis of De-Skewed Clock," IEEE International Solid-State Circuits Conference (1994)("the Waizman Reference") and Lee et. al., "A 2.5V Delay-Locked Loop for an 18Mb 500MB/s DRAM," IEEE International Solid-state Circuits Conference (1994) ("the Lee Reference") prior to the issuance of the '919 patent. For example, Richard Foss, a named inventor of the '919 patent, attended the February 1994 ISSC Conference at which the Waizman and Lee References were presented. Information relating to the Waizman and Lee References is material to one or more claims of the '919 patent. Nevertheless, the Waizman and Lee References were not disclosed to the PTO during the prosecution of the '919 patent its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '919 patent and its predecessor. As a result, the '919 patent is unenforceable.

f. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '919 patent and its predecessor applications were aware of Kim et. al. "A Pseudo–Synchronous Skew–Incentive I/O Scheme for High Bandwidth Memories" (1994) ("the Kim Reference") and Sidiropolous et. al., "A 500 Mbps/pin synchronous point to point link interface" (1994) ("the Sidiropolous Reference") prior to the issuance of the '919 patent. For example, Peter Gillingham and Graham Allen, named inventors of the '919 patent, received a report on the June 1994 VLSI Conference at which the Sidiropolous and Kim References were presented. Information relating to the Sidiropolous and Kim References is material to one or more claims of the '919 patent. Nevertheless, the Sidiropolous and Kim References were not disclosed to the PTO during the prosecution of the '919 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '919 patent and its predecessors. As a result, the '919 patent is unenforceable.

g. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '919 patent and its predecessor applications were aware of numerous Rambus, Inc. ("Rambus") patents relating to DLL technology, Rambus data sheets, Rambus manuals, and other literature prior to the issuance of the '919 patent and its predecessor applications. For example, MOSAID gained knowledge of these patents through its knowledge of the litigation between Infineon and Rambus (*Rambus Inc. v. Infineon Technologies, AG*, Civil Action No. 3:00CV524, E.D. Va.) and through communications with Rambus. As a further example, Peter Gillingham, a named inventor on the '919 patent, cites and discusses Rambus DLL patents in his U.S. Patent No. 6,510,503, also assigned to MOSAID. Further still, MOSAID assisted Steven Przybylski in drafting "New DRAM Technologies" (1994), a text which noted Rambus' use of delay locked loops in its commercial RDRAM products. Information relating to Rambus' technology is material to one or more claims of the '919 patent and its predecessor applications. Nevertheless, the Rambus patents were not disclosed to the PTO during the prosecution of the '919 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '919 patent. As a result, the '919 patent is unenforceable.

82. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

COUNT XI

DECLARATORY JUDGMENT

(Non-infringement, Invalidity and Unenforceability of U.S. Patent No. 6,992,950 B2)

83. ProMOS incorporates and realleges the allegations of paragraphs 1-12 as if set forth fully herein.

84. MOSAID has accused ProMOS of infringing the '950 patent through its manufacture, sale and/or use of certain of its DRAMs in the Texas case. Therefore, a valid and justiciable controversy has arisen and exists between MOSAID and ProMOS within the meaning of 28 U.S.C. § 2201. ProMOS desires a judicial determination and a declaration of the respective rights of the parties regarding the '950 patent.

85. ProMOS has not directly or indirectly infringed any valid and enforceable claim of the '950 patent, either literally or under the doctrine of equivalents.

86. The '950 patent is invalid because of its failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. §§ 102, 103 and/or 112.

87. The '950 patent is invalid under the doctrine of double patenting.

88. The '950 patent is unenforceable due to prosecution laches and inequitable conduct in its procurement.

a. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '950 patent and its predecessor applications were aware of U.S. Patent Nos. 5,220,206 ("the '206 patent"), 5,497,115 ("the '115 patent"), 5,610,543 ("the '543 patent"), and 5,657,481 ("the '481 patent") prior to the issuance of the '950 patent. Prior to issuance of the '950 patent, the '206, '115, '543 and '481 patents were cited by MOSAID counsel Pascal & Associates in connection with U.S. Patent Nos. 5,777,501, 5,991,226, and 6,087,868, which are also assigned to MOSAID. Pascal & Associates were counsel of record for at least part of the prosecution of the '950 patent and/or its predecessor applications. The information contained in the '206, '115, '543, and '481 patents is material to one or more claims of the '950 patent and/or its predecessor applications. Nevertheless, the '206, '115, '543, '481 patents were not disclosed to the PTO during the prosecution of the '950 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '950 patent. As a result, the '950 patent is unenforceable.

b. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '950 patent and its predecessor applications were aware of U.S. Patent No. 5,295,164 ("the '164 patent") prior to the issuance of the '950 patent. For example, prior to issuance of the '950 patent, the '164 patent was cited by MOSAID in connection with U.S. Patent No. 6,327,318 ("the '318 patent") which is also assigned to MOSAID and includes Graham Allen as an inventor. The information contained in the '164 patent is material to one or more claims of the predecessor applications to the '950 patent. Nevertheless, the '164 patent was not disclosed to the PTO during the prosecution of the '950 patent and its predecessor

applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '950 patent. As a result, the '950 patent is unenforceable.

c. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '950 patent and its predecessor applications were aware of (1) a 1992 presentation given by Xerox disclosing the use of an on-chip DLL ("the Xerox Presentation") and (2) a 1994 presentation given by NEC concerning a "PLL Enable Mode" ("the NEC Presentation") prior to the issuance of the '950 patent. For example, Richard Foss and Peter Gillingham, named inventors of the '950 patent are listed as attendees of the December 18, 1992 JEDEC JC-42.3 DRAM Task Group Special Meeting at which the Xerox Presentation was delivered. Moreover, Richard Foss and Graham Allen named inventor of the '950 patent are listed as attendees of the JEDEC JC-42.3 meeting at which the NEC Presentation was delivered. Information relating to the Xerox Presentation and the NEC Presentation is material to one or more claims of the '950 patent and/or its predecessor applications. Nevertheless, the Xerox Presentation and the NEC Presentation were not disclosed to the PTO during the prosecution of the '950 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '950 patent. As a result, the '950 patent is unenforceable.

d. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '950 patent and its predecessor applications were aware of Horowitz et. al., "Clocking Strategies in High Performance Processors," 1992 Symposium on VLSI Circuits Digest of Technical Papers ("the Horowitz Reference") prior to the issuance of the predecessors to the '950 patent. For example Richard Foss, a named inventors of the '950 patent, attended the June 1992 VLSI Symposium at which the Horowitz Reference was presented. Information relating to the Horowitz Reference is material to one or more claims of the '950 patent and or the predecessor applications to the '950 patent. Nevertheless, the Horowitz Reference was not disclosed to the PTO during the prosecution of the predecessor applications to the '950 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information

was knowing, willful, and done with the intent to deceive the PTO into issuing the '950 patent and its predecessors. As a result, the '950 patent is unenforceable.

e. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '950 patent and its predecessor applications were aware of Waizman et. al., "A Delay Line Loop for Frequency Synthesis of De-Skewed Clock," IEEE International Solid-State Circuits Conference (1994) ("the Waizman Reference") prior to the issuance of the '950 patent. For example, Richard Foss, a named inventor of the '950 patent, attended the February 1994 ISSC Conference at which the Waizman Reference was presented. Information relating to the Waizman Reference is material to one or more claims of the '950 patent. Nevertheless, the Waizman Reference was not disclosed to the PTO during the prosecution of the '950 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '950 patent and its predecessor. As a result, the '950 patent is unenforceable.

f. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '950 patent and its predecessor applications were aware of Kim et. al. "A Pseudo–Synchronous Skew–Incentive I/O Scheme for High Bandwidth Memories" (1994) ("the Kim Reference") and Sidiropolous et. al., "A 500 Mbps/pin synchronous point to point link interface" (1994) ("the Sidiropolous Reference") prior to the issuance of the '950 patent. For example, Peter Gillingham and Graham Allen, named inventors of the '950 patent, received a report on the June 1994 VLSI Conference at which the Sidiropolous and Kim References were presented. Information relating to the Sidiropolous and Kim References is material to one or more claims of the '950 patent. Nevertheless, the Sidiropolous and Kim References were not disclosed to the PTO during the prosecution of the '950 patent application. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '919 patent and its predecessors. As a result, the '950 patent is unenforceable.

g. Upon information and belief, the inventors of, prosecuting attorneys of, and/or other individuals subject to the requirements of 37 C.F.R. 1.56(c) with regard to the '950 patent and its predecessor applications were aware of numerous Rambus, Inc. ("Rambus") patents relating to DLL

technology, Rambus data sheets, Rambus manuals, and other literature prior to the issuance of the '950 patent and its predecessor applications. For example, MOSAID gained knowledge of these patents through its knowledge of the litigation between Infineon and Rambus (*Rambus Inc. v. Infineon Technologies, AG*, Civil Action No. 3:00CV524, E.D. Va.) and through communications with Rambus. As a further example, Peter Gillingham, a named inventor on the '950 patent, cites and discusses Rambus DLL patents in his U.S. Patent No. 6,510,503, also assigned to MOSAID. Further still, MOSAID assisted Steven Przybylski in drafting "New DRAM Technologies" (1994), a text which noted Rambus' use of delay locked loops in its commercial RDRAM products. Information relating to Rambus' technology is material to one or more claims of the '950 patent and its predecessor applications. Nevertheless, the Rambus patents were not disclosed to the PTO during the prosecution of the '950 patent and its predecessor applications. Upon information and belief, the failure to disclose this material information was knowing, willful, and done with the intent to deceive the PTO into issuing the '950 patent. As a result, the '950 patent is unenforceable.

89. A judicial declaration of non-infringement, invalidity and unenforceability is necessary and appropriate in order to resolve this controversy.

REQUEST FOR RELIEF

WHEREFORE, ProMOS requests that this Court:

a. declare that ProMOS has not and is not directly or indirectly infringing U.S. Patent Nos. 5,822,253; 5,751,643; 6,278,640 B1; 6,603,703 B2; 7,038,937 B2; 5,406,523; 5,828,620; 6,236,581 B1; 6,980,448 B2; 6,657,919 B2; and 6,992,950 B2.

b. declare that U.S. Patent Nos. 5,822,253; 5,751,643; 6,278,640 B1; 6,603,703 B2; 7,038,937 B2; 5,406,523; 5,828,620; 6,236,581 B1; 6,980,448 B2; 6,657,919 B2; and 6,992,950 B2 are invalid for failure to meet the conditions of patentability and/or otherwise comply with the requirements of 35 U.S.C. § § 102, 103 and/or 112;

c. declare that U.S. Patent Nos. 5,822,253; 5,751,643; 6,278,640 B1; 6,603,703 B2; 7,038,937 B2; 5,406,523; 5,828,620; 6,236,581 B1; 6,980,448 B2; 6,657,919 B2; and 6,992,950 B2 are unenforceable due to prosecution laches and/or inequitable conduct in the procurement of those patents and/or related patents;

d. declare this to be an exceptional case under 35 U.S.C. § 285 and award ProMOS its attorneys' fees, costs and expenses in connection with this action; and

e. award ProMOS such other and further relief as to which it may be entitled.

Dated: September 20, 2006

AKIN GUMP STRAUSS HAUER & FELD LLP

By _____
Sean P. DeBruine

Attorneys for Plaintiff
PROMOS TECHNOLOGIES INC.

DEMAND FOR JURY TRIAL

Plaintiff ProMOS Technologies Inc. hereby demands a jury trial on all issues so triable.

Dated: September 20, 2006

AKIN GUMP STRAUSS HAUER & FELD LLP

By _____
Sean P. DeBruine

Attorneys for Plaintiff
PROMOS TECHNOLOGIES INC.

CERTIFICATION OF INTERESTED ENTITIES OR PERSONS

Pursuant to Civil L.R. 3-16, the undersigned certifies that the following listed persons, firms, partnerships, corporations (including parent corporations) or other entities: (i) have a financial interest in the subject matter in controversy or in a party to the proceeding, or (ii) have a non-financial interest in that subject matter or in any party that could be substantially affected by the outcome of this proceeding: United Memories, Inc., a wholly-owned subsidiary of ProMOS Technologies Inc.

Dated: September 20, 2006

AKIN GUMP STRAUSS HAUER & FELD LLP

By _____
Sean P. DeBruine

Attorneys for Plaintiff
PROMOS TECHNOLOGIES INC.

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