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CLERK, U.S. DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

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ANALOG DEVICES, INC.,
14 FREESCALE SEMICONDUCTOR, INC., and
NATIONAL SEMICONDUCTOR CORP.

LB

15
16 **IN THE UNITED STATES DISTRICT COURT**
17 **FOR THE NORTHERN DISTRICT OF CALIFORNIA**
18 **SAN FRANCISCO DIVISION**

19
20 FREESCALE SEMICONDUCTOR, INC.,
21 NATIONAL SEMICONDUCTOR CORP., and
ANALOG DEVICES, INC.,
22 Plaintiffs,
23
24 v.
25 UNITED MODULE CORP., and
KERANOS, LLC,
26 Defendants.

Case No. **CV 10 5196**

COMPLAINT
Demand for Jury Trial

1 Plaintiffs, Freescale Semiconductor, Inc. (“Freescale”), National Semiconductor Corp.
2 (“NSC”), and Analog Devices, Inc. (“Analog Devices”), hereby demand a jury trial and seek a
3 declaration that they did not infringe expired United States Patent Nos. 4,795,719 (“’719
4 Patent”), attached hereto as Exhibit 1, 4,868,629 (“’629 Patent”), attached hereto as Exhibit 2,
5 and 5,042,009 (“’009 Patent”), attached hereto as Exhibit 3; and that each of those patents—the
6 ’719 Patent, ’629 Patent, and ’009 Patent—is invalid and unenforceable.

7 **PARTIES**

8 1. Plaintiff Analog Devices is a Massachusetts corporation with its principal place of
9 business at One Technology Way, Norwood, MA 02062.

10 2. Plaintiff Freescale is a Delaware corporation with a principal place of business at
11 6501 William Cannon Drive West, Austin, TX 78735.

12 3. Plaintiff NSC is a Delaware corporation with a principal place of business at 2900
13 Semiconductor Drive, Santa Clara, CA 95052.

14 4. Upon information and belief, Defendant United Module Corp. (“United Module”)
15 is a California corporation having its principal place of business located at 978 Highlands Circle,
16 Los Altos, CA 94024.

17 5. Upon information and belief, Defendant Keranos, LLC (“Keranos”) is a Texas
18 limited liability company having its principal place of business located at 211 E. 7th Street, Suite
19 620, Austin, TX 78701.

20 **JURISDICTION**

21 6. This complaint arises under the patent laws of the United States, Title 35 of the
22 United States Code, and the Federal Declaratory Judgment Act, 28 U.S.C. §§ 2201–02. This
23 Court has original jurisdiction over the subject matter of these claims made under 28 U.S.C.
24 §§ 1331 & 1338(a).

25 7. On June 23, 2010, Defendant Keranos filed an action alleging past infringement
26 of the ’719 Patent, ’629 Patent, and ’009 Patent (collectively the “patents-in-suit”) by plaintiffs
27 Analog Devices, Freescale, NSC, and other parties, including Microchip Technology, Inc.
28 (“Microchip”) in United States District Court for the Eastern District of Texas. The case is

1 captioned *Keranos LLC v. Analog Devices, Inc., et al.*, Civil Action No. 2:10-cv-207 (“Texas
2 Case”). Defendant United Module is not a party to that suit.

3 8. On September 20, 2010, Microchip moved to dismiss the Texas Case on grounds
4 that Defendant Keranos lacks constitutional standing.

5 9. Defendant Keranos lacks standing because it is not the owner or exclusive
6 licensee of any of the patents-in-suit.

7 10. Defendant United Module, not Keranos, is the owner of the patents-in-suit.

8 11. Defendant United Module is listed with the U.S. Patent and Trademark Office
9 (“PTO”) as the assignee of record of each of the patents-in-suit.

10 12. Keranos alleges in its complaint in the Texas Case that United Module is the
11 owner of the patents-in-suit: “Keranos currently holds all applicable exclusive enforcement
12 rights for infringement of the patents-in-suit through an agreement with United Module, Inc.,
13 which owns all rights, title and interest in the patents-in-suit.”

14 13. Defendant Keranos is not an exclusive licensee of the patents-in-suit because each
15 of these expired before Keranos was formed and before the date of the agreement purporting to
16 transfer rights in these patents to Keranos.

17 14. Plaintiffs Freescale, NSC, and Analog Devices have joined Microchip’s motion to
18 dismiss the Texas Case under Rule 12(b)(1). The motion to dismiss in the Texas Case is
19 pending.

20 15. On September 20, 2010, Microchip and Silicon Storage Technology, Inc. (“SST”)
21 filed a related lawsuit in the United States District Court for the Northern District of California
22 seeking a declaration of past non-infringement and invalidity of the same patents as the expired
23 patents-in-suit. This case is captioned: *Microchip Tech., Inc. et al. v. United Module Corp. et al.*,
24 Case No. 3:10-cv-4241-JCS (N.D. Cal.) (“Microchip California Case”).

25 16. Because this case and the Microchip California Case are in their nascent stages
26 and involve the same patents and common questions of fact and law, consolidation of the present
27 lawsuit with the Microchip California Case is appropriate.

1 17. Upon information and belief, defendant United Module resides and conducts
2 business in this judicial district, and is subject to personal jurisdiction in this Court.

3 18. Upon information and belief, defendant Keranos conducts business in this judicial
4 district, and is subject to personal jurisdiction in this Court. For example, in its complaint filed
5 in the Texas Case, Keranos alleges it entered into an agreement relating to the expired patents-in-
6 suit with United Module, which is a resident of this judicial district. As alleged in the Texas
7 Case, that agreement involves the purported rights in the patents-in-suit. Further, upon
8 information and belief, J. Nicholas Gross is a resident of this judicial district and is the sole
9 governing member of Keranos.

10 19. In its complaint filed in the Texas Case, defendant Keranos alleges that Analog
11 Devices “infringed; induced others to infringe; and/or committed acts of contributory
12 infringement, literally or under the doctrine of equivalents, of one or more claims of the [patents-
13 in-suit] by importing, making using, offering to sell, and/or selling products and devices which
14 embody the patented invention, including, among other devices, integrated circuits using
15 embedded flash memory embodied in discrete form, wafer form, or incorporated within larger
16 systems on printed circuit boards.” Analog Devices products that are specifically accused of
17 patent infringement in the Texas Case “include certain devices identified by Analog Devices in
18 press releases and other public literature as model numbers/series ADUC814; ADUC824; and
19 ADUC831 and related family of products.”

20 20. Because defendant Keranos has accused Analog Devices’s ADUC814;
21 ADUC824; and ADUC831 products of infringing the patents-in-suit in the Texas Case, Keranos
22 has taken a position that raises a substantial controversy, between parties having adverse legal
23 interests, that is of sufficient immediacy and reality to warrant the issuance of a declaratory
24 judgment. Accordingly, an actual controversy exists between the Defendants and Analog
25 Devices as to past non-infringement and invalidity of each of the patents-in-suit.

26 21. In its complaint filed in the Texas Case, defendant Keranos alleges that Freescale
27 “infringed; induced others to infringe; and/or committed acts of contributory infringement,
28 literally or under the doctrine of equivalents, of one or more claims of the [patents-in-suit] by

1 importing, making using, offering to sell, and/or selling products and devices which embody the
2 patented invention, including, among other devices, integrated circuits using embedded flash
3 memory embodied in discrete form, wafer form, or incorporated within larger systems on printed
4 circuit boards.” Freescale products that are specifically accused of past infringement in the
5 Texas Case “include certain microcontrollers identified by defendant in press releases and other
6 public literature as model numbers/series 68HC05 (CPU05), 68HC08 (CPU08), 68HC11
7 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250,
8 MPC 8540/8555/8560, MM908E624 & 625; HC08 and related family of products.”

9 22. Because defendant Keranos has accused Freescale’s 68HC05 (CPU05), 68HC08
10 (CPU08), 68HC11 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC
11 860, MPC 8240/8250, MPC 8540/8555/8560, MM908E624 & 625, and HC08 products of
12 infringing the patents-in-suit in the Texas Case, Keranos has taken a position that raises a
13 substantial controversy, between parties having adverse legal interests, that is of sufficient
14 immediacy and reality to warrant the issuance of a declaratory judgment. Accordingly, an actual
15 controversy exists between defendants and Freescale as to past non-infringement and invalidity
16 of each of the patents-in-suit.

17 23. In its complaint filed in the Texas Case, defendant Keranos alleges that NSC
18 “infringed; induced others to infringe; and/or committed acts of contributory infringement,
19 literally or under the doctrine of equivalents, of one or more claims of the [patents-in-suit] by
20 importing, making using, offering to sell, and/or selling products and devices which embody the
21 patented invention, including, among other devices, integrated circuits using embedded flash
22 memory embodied in discrete form, wafer form, or incorporated within larger systems on printed
23 circuit boards.” NSC products that are specifically accused of past infringement in the Texas
24 Case “include certain microcontrollers identified by defendant in press releases and other public
25 literature as model numbers/series COP8, CR16 and related family of products.”

26 24. Because defendant Keranos has accused NSC’s COP8 and CR16 products of
27 infringing the patents-in-suit in the Texas Case, Keranos has taken a position that raises a
28 substantial controversy, between parties having adverse legal interests, that is of sufficient

1 immediacy and reality to warrant the issuance of a declaratory judgment. Accordingly, an actual
2 controversy exists between defendants and NSC as to non-infringement and invalidity of each of
3 the patents-in-suit.

4 VENUE

5 25. Venue is proper in this district under 28 U.S.C. §§ 1391 and 1400 because, on
6 information and belief, defendant United Module resides in this district. On information and
7 belief, defendant Keranos is subject to personal jurisdiction in this district. Plaintiffs Freescale,
8 NSC, and Analog Devices do business in this district.

9 **COUNT I**
10 **DECLARATORY JUDGMENT OF**
11 **NON-INFRINGEMENT OF THE EXPIRED '719 PATENT**

12 26. Plaintiffs reallege the allegations in paragraphs 1–25 as though fully set forth
13 herein.

14 27. An actual and justiciable controversy has arisen and exists between Plaintiffs
15 Freescale, NSC, and Analog Devices, and defendants United Module and Keranos regarding the
16 '719 Patent.

17 **Declaratory Judgment that Analog Devices Did Not Infringe the Expired '719 Patent**

18 28. Analog Devices did not directly or indirectly infringe any claim of the '719 Patent
19 before it expired, either literally or under the doctrine of equivalents, by previously making,
20 using, selling, offering to sell, marketing, licensing, or importing its products, the ADUC814;
21 ADUC824; ADUC831 and related family of products.

22 29. Analog Devices did not induce its customers to infringe any claim of the '719
23 Patent before it expired by previously making, using, selling, offering to sell, marketing,
24 licensing, or importing its products, the ADUC814; ADUC824; ADUC831 and related family of
25 products.

26 30. Analog Devices did not engage in contributory infringement any claim of the
27 expired '719 Patent before it expired by previously making, using, selling, offering to sell,
28 marketing, licensing, or importing its products, including the ADUC814; ADUC824; ADUC831
and related family of products,

1 31. A judicial declaration of non-infringement of the expired '719 Patent is necessary
2 and appropriate so that Analog Devices can ascertain its rights, duties, and obligations with
3 respect to the defendants, the expired '719 Patent, and its past conduct involving its products,
4 including the ADUC814; ADUC824; ADUC831 and related family of products.

5 **Declaratory Judgment that Freescale Did Not Infringe the Expired '719 Patent**

6 32. Freescale did not directly or indirectly infringe any claim of the '719 Patent,
7 literally or under the doctrine of equivalents, before it expired by previously making, using,
8 selling, offering to sell, marketing, licensing, or importing its products, including the 68HC05
9 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX,
10 MPC500, MPC 860, MPC 8240/8250, MPC 8540/8555/8560, MM908E624 &625; HC08 and
11 related family of products.

12 33. Freescale did not induce its customers to infringe any claim of the '719 Patent
13 before it expired by previously making, using, selling, offering to sell, marketing, licensing, or
14 importing its products, including the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11),
15 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250, MPC
16 8540/8555/8560, MM908E624 &625; HC08 and related family of products.

17 34. Freescale did not engage in contributory infringement of any claim of the '719
18 Patent before it expired by previously making, using, selling, offering to sell, marketing,
19 licensing, or importing its products, including the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11
20 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250,
21 MPC 8540/8555/8560, MM908E624 &625; HC08 and related family of products.

22 35. A judicial declaration of non-infringement of the expired '719 Patent is necessary
23 and appropriate so that Freescale can ascertain its past rights, duties, and obligations with respect
24 to the defendants, the expired '719 Patent, and its past conduct involving its products, including
25 the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11), 68HC12 (CPU12), 68HC16
26 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250, MPC 8540/8555/8560, MM908E624
27 &625; HC08, and related family of products.
28

1 **Declaratory Judgment that NSC Did Not Infringe the Expired '719 Patent**

2 36. NSC did not directly or indirectly infringe any claim of the '719 Patent, literally
3 or under the doctrine of equivalents, before it expired by previously making, using, selling,
4 offering to sell, marketing, licensing, or importing its products, including the COP8, CR16, and
5 related family of products.

6 37. NSC did not induce its customers to infringe any claim of the '719 Patent before
7 it expired by previously making, using, selling, offering to sell, marketing, licensing, or
8 importing its products, including the COP8, CR16, and related family of products.

9 38. NSC did not engage in contributory infringement of any claim of the '719 Patent
10 before it expired by previously making, using, selling, offering to sell, marketing, licensing, or
11 importing its products, including the COP8, CR16, and related family of products.

12 39. A judicial declaration of non-infringement of the expired '719 Patent is necessary
13 and appropriate so that NSC can ascertain its past rights, duties, and obligations with respect to
14 the defendants, the expired '719 Patent, and its past conduct involving its products, including the
15 COP8, CR16, and related family of products.

16
17 **COUNT II**
18 **DECLARATORY JUDGMENT OF**
19 **INVALIDITY OF THE EXPIRED '719 PATENT**

20 40. Plaintiffs reallege the allegations in paragraphs 1–39 as though fully set forth
21 herein.

22 41. An actual and justiciable controversy has arisen regarding the invalidity of the
23 '719 Patent during the period before it expired.

24 42. The claims of the expired '719 Patent are invalid because of a failure to meet the
25 conditions of patentability and/or otherwise comply with one or more of 35 U.S.C. §§ 100 *et*
26 *seq.*, including §§ 102, 103, and 112.

27 43. One or more prior art references disclose or render obvious each of the claims of
28 the '719 Patent, including prior art references identified in the expired '719 Patent and its
prosecution history.

1 44. A judicial declaration that the claims of the expired '719 Patent were not valid is
2 necessary and appropriate so that plaintiffs Freescale, NSC, and Analog Devices can ascertain
3 their past rights, duties, and obligations with respect to the expired '719 Patent.

4
5 **COUNT III**
6 **DECLARATORY JUDGMENT OF**
7 **NON-INFRINGEMENT OF THE EXPIRED '629 PATENT**

8 45. Plaintiffs reallege the allegations in paragraphs 1–44 as though fully set forth
9 herein.

10 46. An actual and justiciable controversy has arisen and exists between plaintiffs
11 Freescale, NSC, and Analog Devices, and defendants United Module and Keranos regarding the
12 expired '629 Patent.

13 **Declaratory Judgment that Analog Devices Did Not Infringe the Expired '629 Patent**

14 47. Analog Devices did not directly or indirectly infringe any claim of the '629 Patent
15 before it expired, either literally or under the doctrine of equivalents, by previously making,
16 using, selling, offering to sell, marketing, licensing, or importing its products, the ADUC814;
17 ADUC824; ADUC831 and related family of products.

18 48. Analog Devices did not induce its customers to infringe any claim of the '629
19 Patent before it expired by previously making, using, selling, offering to sell, marketing,
20 licensing, or importing its products, the ADUC814; ADUC824; ADUC831 and related family of
21 products.

22 49. Analog Devices did not engage in contributory infringement any claim of the
23 expired '629 Patent before it expired by previously making, using, selling, offering to sell,
24 marketing, licensing, or importing its products, including the ADUC814; ADUC824; ADUC831
25 and related family of products,

26 50. A judicial declaration of non-infringement of the expired '629 Patent is necessary
27 and appropriate so that Analog Devices can ascertain its rights, duties, and obligations with
28 respect to the defendants, the expired '629 Patent, and its past conduct involving its products,
including the ADUC814; ADUC824; ADUC831 and related family of products.

Declaratory Judgment that Freescale Did Not Infringe the Expired '629 Patent

1
2 51. Freescale did not directly or indirectly infringe any claim of the '629 Patent,
3 literally or under the doctrine of equivalents, before it expired by previously making, using,
4 selling, offering to sell, marketing, licensing, or importing its products, including the 68HC05
5 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX,
6 MPC500, MPC 860, MPC 8240/8250, MPC 8540/8555/8560, MM908E624 &625; HC08 and
7 related family of products.

8 52. Freescale did not induce its customers to infringe any claim of the '629 Patent
9 before it expired by previously making, using, selling, offering to sell, marketing, licensing, or
10 importing its products, including the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11),
11 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250, MPC
12 8540/8555/8560, MM908E624 &625; HC08 and related family of products.

13 53. Freescale did not engage in contributory infringement of any claim of the '629
14 Patent before it expired by previously making, using, selling, offering to sell, marketing,
15 licensing, or importing its products, including the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11
16 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250,
17 MPC 8540/8555/8560, MM908E624 &625; HC08 and related family of products.

18 54. A judicial declaration of non-infringement of the expired '629 Patent is necessary
19 and appropriate so that Freescale can ascertain its past rights, duties, and obligations with respect
20 to the defendants, the expired '629 Patent, and its past conduct involving its products, including
21 the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11), 68HC12 (CPU12), 68HC16
22 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250, MPC 8540/8555/8560, MM908E624
23 &625; HC08, and related family of products.

Declaratory Judgment that NSC did not infringe the expired '629 Patent

24
25 55. NSC did not directly or indirectly infringe any claim of the '629 Patent, literally
26 or under the doctrine of equivalents, before it expired by previously making, using, selling,
27 offering to sell, marketing, licensing, or importing its products, including the COP8, CR16, and
28 related family of products.

1 56. NSC did not induce its customers to infringe any claim of the '629 Patent before
2 it expired by previously making, using, selling, offering to sell, marketing, licensing, or
3 importing its products, including the COP8, CR16, and related family of products.

4 57. NSC did not engage in contributory infringement of any claim of the '629 Patent
5 before it expired by previously making, using, selling, offering to sell, marketing, licensing, or
6 importing its products, including the COP8, CR16, and related family of products.

7 58. A judicial declaration of non-infringement of the expired '629 Patent is necessary
8 and appropriate so that NSC can ascertain its past rights, duties, and obligations with respect to
9 the defendants, the expired '629 Patent, and its past conduct involving its products, including the
10 COP8, CR16, and related family of products.

11
12 **COUNT IV**
13 **DECLARATORY JUDGMENT OF**
INVALIDITY OF THE EXPIRED '629 PATENT

14 59. Plaintiffs reallege the allegations in paragraphs 1–58 as though fully set forth
15 herein.

16 60. An actual and justiciable controversy has arisen regarding the invalidity of the
17 '629 Patent during the period before it expired.

18 61. The claims of the expired '629 Patent are invalid because of a failure to meet the
19 conditions of patentability and/or otherwise comply with one or more of 35 U.S.C. §§ 100 *et*
20 *seq.*, including §§ 102, 103, and 112.

21 62. One or more prior art references disclose or render obvious each of the claims of
22 the '629 Patent, including prior art references identified in the expired '629 Patent and its
23 prosecution history.

24 63. A judicial declaration that the claims of the expired '629 Patent were not valid is
25 necessary and appropriate so that plaintiffs Freescale, NSC, and Analog Devices can ascertain
26 their past rights, duties, and obligations with respect to the expired '629 Patent.

27
28

**COUNT V
DECLARATORY JUDGMENT OF
NON-INFRINGEMENT OF THE EXPIRED '009 PATENT**

1
2
3 64. Plaintiffs reallege the allegations in paragraphs 1–63 as though fully set forth
4 herein.

5 65. An actual and justiciable controversy has arisen and exists between plaintiffs
6 Freescale, NSC, and Analog Devices, and defendants United Module and Keranos regarding the
7 expired '009 Patent.

8 **Declaratory Judgment that Analog Devices did not infringe the expired '009 Patent**

9 66. Analog Devices did not directly or indirectly infringe any claim of the '009 Patent
10 before it expired, either literally or under the doctrine of equivalents, by previously making,
11 using, selling, offering to sell, marketing, licensing, or importing its products, the ADUC814;
12 ADUC824; ADUC831 and related family of products.

13 67. Analog Devices did not induce its customers to infringe any claim of the '009
14 Patent before it expired by previously making, using, selling, offering to sell, marketing,
15 licensing, or importing its products, the ADUC814; ADUC824; ADUC831 and related family of
16 products.

17 68. Analog Devices did not engage in contributory infringement any claim of the
18 expired '009 Patent before it expired by previously making, using, selling, offering to sell,
19 marketing, licensing, or importing its products, including the ADUC814; ADUC824; ADUC831
20 and related family of products,

21 69. A judicial declaration of non-infringement of the expired '009 Patent is necessary
22 and appropriate so that Analog Devices can ascertain its rights, duties, and obligations with
23 respect to the defendants, the expired '009 Patent, and its past conduct involving its products,
24 including the ADUC814; ADUC824; ADUC831 and related family of products.

25 **Declaratory Judgment that Freescale Did Not Infringe the Expired '009 Patent**

26 70. Freescale did not directly or indirectly infringe any claim of the '009 Patent,
27 literally or under the doctrine of equivalents, before it expired by previously making, using,
28 selling, offering to sell, marketing, licensing, or importing its products, including the 68HC05

1 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX,
2 MPC500, MPC 860, MPC 8240/8250, MPC 8540/8555/8560, MM908E624 &625; HC08 and
3 related family of products.

4 71. Freescale did not induce its customers to infringe any claim of the '009 Patent
5 before it expired by previously making, using, selling, offering to sell, marketing, licensing, or
6 importing its products, including the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11),
7 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250, MPC
8 8540/8555/8560, MM908E624 &625; HC08 and related family of products.

9 72. Freescale did not engage in contributory infringement of any claim of the '009
10 Patent before it expired by previously making, using, selling, offering to sell, marketing,
11 licensing, or importing its products, including the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11
12 (CPU11), 68HC12 (CPU12), 68HC16 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250,
13 MPC 8540/8555/8560, MM908E624 &625; HC08 and related family of products.

14 73. A judicial declaration of non-infringement of the expired '009 Patent is necessary
15 and appropriate so that Freescale can ascertain its past rights, duties, and obligations with respect
16 to the defendants, the expired '009 Patent, and its past conduct involving its products, including
17 the 68HC05 (CPU05), 68HC08 (CPU08), 68HC11 (CPU11), 68HC12 (CPU12), 68HC16
18 (CPU16), 683XX, MPC500, MPC 860, MPC 8240/8250, MPC 8540/8555/8560, MM908E624
19 &625; HC08, and related family of products.

20 **Declaratory Judgment that NSC Did Not Infringe the Expired '009 Patent**

21 74. NSC did not directly or indirectly infringe any claim of the '009 Patent, literally
22 or under the doctrine of equivalents, before it expired by previously making, using, selling,
23 offering to sell, marketing, licensing, or importing its products, including the COP8, CR16, and
24 related family of products.

25 75. NSC did not induce its customers to infringe any claim of the '009 Patent before
26 it expired by previously making, using, selling, offering to sell, marketing, licensing, or
27 importing its products, including the COP8, CR16, and related family of products.
28

1 76. NSC did not engage in contributory infringement of any claim of the '009 Patent
2 before it expired by previously making, using, selling, offering to sell, marketing, licensing, or
3 importing its products, including the COP8, CR16, and related family of products.

4 77. A judicial declaration of non-infringement of the expired '009 Patent is necessary
5 and appropriate so that NSC can ascertain its past rights, duties, and obligations with respect to
6 the defendants, the expired '009 Patent, and its past conduct involving its products, including the
7 COP8, CR16, and related family of products.

8
9 **COUNT VI**
10 **DECLARATORY JUDGMENT OF**
INVALIDITY OF THE EXPIRED '009 PATENT

11 78. Plaintiffs reallege the allegations in paragraphs 1-77 as though fully set forth
12 herein.

13 79. An actual and justiciable controversy has arisen regarding the validity of the
14 expired '009 Patent.

15 80. The claims of the expired '009 Patent are invalid because of a failure to meet the
16 conditions of patentability and/or otherwise comply with one or more of 35 U.S.C. §§ 100 *et*
17 *seq.*, including §§ 102, 103, and 112.

18 81. One or more prior art references disclose or render obvious each of the claims of
19 the '009 Patent, including prior art references identified in the expired '009 Patent and its
20 prosecution history.

21 82. A judicial declaration that the claims of the expired '009 Patent were not valid is
22 necessary and appropriate so that Plaintiffs Freescale, NSC, and Analog Devices can ascertain
23 their past rights, duties, and obligations with respect to the expired '009 Patent.
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REQUEST FOR RELIEF

1
2 WHEREFORE, Plaintiffs Freescale, NSC, and Analog Devices request judgment as
3 follows:

4 A. For a declaration that the claims of expired U.S. Patent No. 4,795,719 were
5 invalid;

6 B. For a declaration that neither Analog Devices nor any of its products previously
7 infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) any claim of
8 expired U.S. Patent No. 4,795,719;

9 C. For a declaration that Analog Devices did not previously engage in contributory
10 infringement or induce infringement of any valid claim of expired U.S. Patent No. 4,795,719;

11 D. For a declaration that no valid claim of expired U.S. Patent No. 4,795,719 was
12 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
13 any of Analog Devices's customers by virtue of incorporating any Analog Devices product into
14 any such customer's products;

15 E. For a declaration that neither Freescale nor any of its products previously
16 infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim
17 of expired U.S. Patent No. 4,795,719;

18 F. For a declaration that Freescale did not previously engage in contributory
19 infringement or induce infringement of any valid claim of expired U.S. Patent No. 4,795,719;

20 G. For a declaration that no valid claim of expired U.S. Patent No. 4,795,719 was
21 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
22 any of Freescale's customers/licensees by virtue of incorporating any Freescale technology into
23 any such customer's/licensee's products;

24 H. For a declaration that neither NSC nor any of its products previously infringed
25 (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim of expired
26 U.S. Patent No. 4,795,719;

27 I. For a declaration that NSC did not previously engage in contributory infringement
28 or induce infringement of any valid claim of expired U.S. Patent No. 4,795,719;

1 J. For a declaration that no valid claim of expired U.S. Patent No. 4,795,719 was
2 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
3 any of NSC's customers by virtue of incorporating any NSC product into any such customer's
4 products;

5 K. For a declaration that the claims of expired U.S. Patent No. 4,868,629 were
6 invalid;

7 L. For a declaration that neither Analog Devices nor any of its products previously
8 infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim
9 of expired U.S. Patent No. 4,868,629;

10 M. For a declaration that Analog Devices did not previously engage in contributory
11 infringement or induce infringement of any valid claim of expired U.S. Patent No. 4,868,629;

12 N. For a declaration that no valid claim of expired U.S. Patent No. 4,868,629 was
13 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
14 any of Analog Devices's customers by virtue of incorporating any Analog Devices product into
15 any such customer's products;

16 O. For a declaration that neither Freescale nor any of its products previously
17 infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim
18 of expired U.S. Patent No. 4,868,629;

19 P. For a declaration that Freescale did not previously engage in contributory
20 infringement or induce infringement of any valid claim of expired U.S. Patent No. 4,868,629;

21 Q. For a declaration that no valid claim of expired U.S. Patent No. 4,868,629 was
22 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
23 any of Freescale's customers/licensees by virtue of incorporating any Freescale technology into
24 any such customer's/licensee's products;

25 R. For a declaration that neither NSC nor any of its products previously infringed
26 (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim of expired
27 U.S. Patent No. 4,868,629;

28

1 S. For a declaration that NSC did not previously engage in contributory infringement
2 or induce infringement of any valid claim of expired U.S. Patent No. 4,868,629;

3 T. For a declaration that no valid claim of expired U.S. Patent No. 4,868,629 was
4 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
5 any of NSC's customers by virtue of incorporating any NSC product into any such customer's
6 products;

7 U. For a declaration that the claims of expired U.S. Patent No. 5,042,009 were
8 invalid;

9 V. For a declaration that neither Analog Devices nor any of its products previously
10 infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim
11 of expired U.S. Patent No. 5,042,009;

12 W. For a declaration that Analog Devices did not previously engage in contributory
13 infringement or induce infringement of any valid claim of expired U.S. Patent No. 5,042,009;

14 X. For a declaration that no valid claim of expired U.S. Patent No. 5,042,009 was
15 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
16 any of Analog Devices's customers by virtue of incorporating any Analog Devices product into
17 any such customer's products;

18 Y. For a declaration that neither Freescale nor any of its products previously
19 infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim
20 of expired U.S. Patent No. 5,042,009;

21 Z. For a declaration that Freescale did not previously engage in contributory
22 infringement or induce infringement of any valid claim of expired U.S. Patent No. 5,042,009;

23 AA. For a declaration that no valid claim of expired U.S. Patent No. 5,042,009 was
24 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
25 any of Freescale's customers/licensees by virtue of incorporating any Freescale technology into
26 any such customer's/licensee's products;

1 BB. For a declaration that neither NSC nor any of its products previously infringed
2 (directly, indirectly, literally, and/or under the doctrine of equivalents) any valid claim of expired
3 U.S. Patent No. 5,042,009;

4 CC. For a declaration that NSC did not previously engage in contributory infringement
5 or induce infringement of any valid claim of expired U.S. Patent No. 5,042,009;

6 DD. For a declaration that no valid claim of expired U.S. Patent No. 5,042,009 was
7 previously infringed (directly, indirectly, literally, and/or under the doctrine of equivalents) by
8 any of NSC's customers by virtue of incorporating any NSC product into any such customer's
9 products;

10 EE. For a determination that this case is exceptional under 35 U.S.C. § 285 and an
11 award to Freescale, NSC, and Analog Devices of their attorneys' fees, costs, and expenses in
12 conjunction with this action; and

13 FF. Such other and further relief as this Court or a jury may deem proper and just.
14

15 Dated: November 16, 2010

Respectfully submitted,

16
17 

18 Paul J. Andre
19 Lisa Kobialka
20 Sean Boyle
21 KING & SPALDING LLP
22 333 Twin Dolphin Drive
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25 Telephone: (650) 590-0700
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27 Attorney for Plaintiffs
28 ANALOG DEVICES, INC.,
FREESCALE SEMICONDUCTOR, INC., and
NATIONAL SEMICONDUCTOR CORP.,

and

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Attorney for Plaintiffs
ANALOG DEVICES, INC.,
FREESCALE SEMICONDUCTOR, INC., and
NATIONAL SEMICONDUCTOR CORP.

DEMAND FOR JURY TRIAL

1
2 Freescale, NSC, and Analog Devices hereby request a jury trial as to all issues triable
3 to a jury.

4
5 Dated: November 16, 2010

Respectfully submitted,

6 

7 Paul J. Andre
8 Lisa Kobialka
9 Sean Boyle
10 KING & SPALDING LLP
11 333 Twin Dolphin Drive
12 Suite 400
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16 Attorney for Plaintiffs
17 ANALOG DEVICES, INC.,
18 FREESCALE SEMICONDUCTOR, INC., and
19 NATIONAL SEMICONDUCTOR CORP.,

20 and

21 Bruce W. Slayden II (*pro hac vice* to be filed)
22 Brian C. Banner (*pro hac vice* to be filed)
23 KING & SPALDING LLP
24 401 Congress Avenue
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26 Austin, TX 78701
27 Telephone: (512) 457-2000
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ANALOG DEVICES, INC.,
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NATIONAL SEMICONDUCTOR CORP.