

JS 44 (Rev. 12/07) (CAND Rev 1/10)

## CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON PAGE TWO OF THE FORM.)

## I. (a) PLAINTIFFS

RENESAS ELECTRONICS CORPORATION and RENESAS ELECTRONICS AMERICA, INC.

## DEFENDANTS

HSM PORTFOLIO LLC, TECHNOLOGY PROPERTIES LIMITED LLC and ALLIACENSE LTD.

(b) County of Residence of First Listed Plaintiff Japan  
(EXCEPT IN U.S. PLAINTIFF CASES)County of Residence of First Listed Defendant Santa Clara  
(IN U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE LAND INVOLVED.

(c) Attorney's (Firm Name, Address, and Telephone Number)

RACHEL KREVANS (CA SBN 116421)  
MORRISON & FOERSTER  
425 Market Street  
San Francisco, CA 94105, (415) 268-7000

Attorneys (If Known)

## II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff  
☐ 2 U.S. Government Defendant  
☒ 3 Federal Question (U.S. Government Not a Party)  
☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

## III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- (For Diversity Cases Only)
- |   | PTF                        | DEF                        |   | PTF                        | DEF                        |
|---|----------------------------|----------------------------|---|----------------------------|----------------------------|
| Citizen of This State                   | <input type="checkbox"/> 1 | <input type="checkbox"/> 1 | Incorporated or Principal Place of Business In This State     | <input type="checkbox"/> 4 | <input type="checkbox"/> 4 |
| Citizen of Another State                | <input type="checkbox"/> 2 | <input type="checkbox"/> 2 | Incorporated and Principal Place of Business In Another State | <input type="checkbox"/> 5 | <input type="checkbox"/> 5 |
| Citizen or Subject of a Foreign Country | <input type="checkbox"/> 3 | <input type="checkbox"/> 3 | Foreign Nation  | <input type="checkbox"/> 6 | <input type="checkbox"/> 6 |

## IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	<b>PERSONAL INJURY</b> <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury <b>PERSONAL PROPERTY</b> <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability <b>PRISONER PETITIONS</b> <input type="checkbox"/> 510 Motions to Vacate Sentence <b>Habeas Corpus:</b> <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition <input type="checkbox"/> 440 Other Civil Rights	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other <b>LABOR</b> <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations & Disclosure Act <input type="checkbox"/> 730 Labor/Mgmt. Reporting <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act <b>IMMIGRATION</b> <input type="checkbox"/> 462 Naturalization Application <input type="checkbox"/> 463 Habeas Corpus - Alien Detainee <input type="checkbox"/> 465 Other Immigration Actions	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 <b>PROPERTY RIGHTS</b> <input type="checkbox"/> 820 Copyrights <input checked="" type="checkbox"/> 830 Patent <input type="checkbox"/> 840 Trademark <b>SOCIAL SECURITY</b> <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) <b>FEDERAL TAX SUITS</b> <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes

## V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding  
☐ 2 Removed from State Court  
☐ 3 Remanded from Appellate Court  
☐ 4 Reinstated or Reopened  
☐ 5 Transferred from another district (specify)  
☐ 6 Multidistrict Litigation  
☐ 7 Appeal to District Judge from Magistrate Judgment

## VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing (Do not cite jurisdictional statutes unless diversity):

28 U.S.C. 1331, 1338, 2201-2202

Brief description of cause:

Declaratory judgment of patent non-infringement/invalidity

## VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION  
UNDER F.R.C.P. 23

## DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No

## VIII. RELATED CASE(S) IF ANY

PLEASE REFER TO CIVIL L.R. 3-12 CONCERNING REQUIREMENT TO FILE "NOTICE OF RELATED CASE".

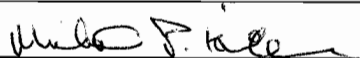
## IX. DIVISIONAL ASSIGNMENT (CIVIL L.R. 3-2) (PLACE AND "X" IN ONE BOX ONLY)

☒ SAN FRANCISCO/OAKLAND ☐ SAN JOSE ☐ EUREKA

DATE

12/28/2011

SIGNATURE OF ATTORNEY OF RECORD



ORIGINAL

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 8 RENESAS ELECTRONICS CORPORATION and  
 RENESAS ELECTRONICS AMERICA, INC.

9 UNITED STATES DISTRICT COURT  
 10 NORTHERN DISTRICT OF CALIFORNIA

11 RENESAS ELECTRONICS CORPORATION,  
 12  
 13 and

14 RENESAS ELECTRONICS AMERICA, INC.,  
 15

16 Plaintiffs,

17 v.

18 HSM PORTFOLIO LLC,  
 19

20 TECHNOLOGY PROPERTIES LIMITED LLC,  
 21

22 and

23 ALLIACENSE LTD.,  
 24

25 Defendants.  
 26  
 27  
 28

FILED  
 2011 DEC 28 P 12:22  
 RICHARD W. HENNING  
 CLERK, U.S. DISTRICT COURT  
 NORTHERN DISTRICT OF CALIFORNIA

E-filing

CV11  
 Case No.

MEJ  
 6662

COMPLAINT FOR  
 DECLARATORY JUDGMENT  
 OF PATENT NON-  
 INFRINGEMENT AND  
 INVALIDITY

JURY TRIAL DEMANDED

1 Plaintiffs Renesas Electronics Corporation (“REL”) and Renesas Electronics America,  
 2 Inc. (“REA,” and collectively with REL, “Renesas”) bring this action against Defendants HSM  
 3 Portfolio LLC (“HSM”), Technology Properties Limited, LLC (“TPL”), and Alliacense Ltd.  
 4 (“Alliacense,” and collectively with HSM and TPL, “Defendants”) and complain as follows:

### 5 **THE NATURE OF THE ACTION**

6 1. U.S. Patent no. 5,030,853 (“the ’853 Patent”), entitled “High Speed Logic and  
 7 Memory Family Using Ring Segment Buffer,” issued on July 9, 1991 to named inventor Albert  
 8 W. Vinal. A reexamination certificate for the ’853 Patent issued on February 16, 1993, and a  
 9 second reexamination certificate for the ’853 Patent issued on July 20, 2010.

10 2. U.S. Patent no. 5,391,949 (“the ’949 Patent”), entitled “Differential Latching  
 11 Inverter Circuit,” issued on February 21, 1995 to named inventor Albert W. Vinal.

12 3. HSM and TPL, through Alliacense, assert that they are assignees and own all  
 13 rights in the ’853 and ’949 Patents.

14 4. As a result of Defendants’ communications to Renesas of their intention to pursue  
 15 claims of infringement of the ’853 and ’949 Patents against Renesas, Renesas is under the  
 16 reasonable apprehension of imminent suit by Defendants. Renesas does not infringe and has not  
 17 infringed ’853 and ’949 Patents, which are invalid. Renesas brings this action to obtain  
 18 declaratory judgments of non-infringement and invalidity of the ’853 and ’949 Patents.

### 19 **THE PARTIES**

20 5. REL is a corporation organized under the laws of Japan, with its registered head  
 21 office at 1753 Shimonumabe, Nakahara-Ku, Kawasaki, Kanagawa 211-8668, Japan, and its  
 22 principal place of business at Nippon Bldg., 2-6-2, Ote-machi, Chiyoda-ku, Tokyo 100-0004,  
 23 Japan.

24 6. REA is a corporation organized under the laws of California, with its principal  
 25 place of business at 2880 Scott Boulevard Santa Clara, California 95050-2554.

26 7. Upon information and belief, HSM is a Delaware limited liability company with  
 27 its principal place of business located at 20883 Stevens Creek Blvd., Suite 100, Cupertino,  
 28 California 95014.

8. Upon information and belief, TPL is a California corporation with its principal place of business located at 20883 Stevens Creek Blvd., Suite 100, Cupertino, California 95014.

9. Upon information and belief, Alliacense is a Delaware limited liability company with its principal place of business located at 20883 Stevens Creek Blvd., Suite 100, Cupertino, California 95014.

### **JURISDICTION**

10. This action arises under the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.*

11. This Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1331 (federal question); 28 U.S.C. § 1338(a) (any Act of Congress relating to patents or trademarks); 28 U.S.C. § 2201 (declaratory judgment); and 28 U.S.C. § 2202 (further relief based on declaratory judgment).

12. This Court has personal jurisdiction over Defendants in that upon information and belief Defendants maintain their principal places of business within this District and regularly conduct business activities within California and this District.

### **VENUE AND INTRADISTRICT ASSIGNMENT**

13. Venue is proper in this District pursuant to 28 U.S.C. § 1391(b) and (c) and 28 U.S.C. § 1400(b).

14. Because this action is an Intellectual Property Action within the meaning of Civil L. R. 3-2(c), the action is to be assigned on a district-wide basis.

### **GENERAL ALLEGATIONS**

15. In August 2011, Renesas was contacted by Mr. Mac Leckrone. Mr. Leckrone indicated that he works for Alliacense, a "TPL Group Enterprise." Mr. Leckrone informed Renesas that he represented Defendants and wished to discuss Renesas's licensing of the '853 and '949 Patents from Defendants, which Defendants stated they believed Renesas infringes.

16. Correspondence, including detailed claim charts and reverse engineering reports, and meetings between Mr. Leckrone and Renesas have continued through December of 2011, with no agreement to license the '853 and '949 Patents reached.

1           17.     On December 14, Mr. Leckrone emailed Renesas, writing that "I have been  
2     advised by TPL and its litigation counsel that, unless there is significant concrete progress toward  
3     final resolution prior to year end, that the litigation schedule could not withstand any further  
4     delay." In other words, it is Defendants' position that if Renesas does not agree to license the  
5     '853 and '949 Patents by the end of 2011, Defendants will sue Renesas for infringement of the  
6     '853 and '949 Patents, either before year's end or immediately in January.

7           18.     Accordingly, Renesas is under the reasonable apprehension of imminent suit by  
8     Defendants.

9           19.     Renesas does not infringe and has not infringed, either directly, contributorily, or  
10    by inducement, any valid and enforceable claim of the '853 and '949 Patents, either literally or  
11    under the doctrine of equivalents.

12                               **FIRST CLAIM FOR RELIEF**

13                   **(Declaratory Judgment of Non-Infringement of the '853 Patent)**

14           20.     Renesas realleges and incorporates by reference paragraphs 1 through 19,  
15    inclusive, as though fully set forth in this paragraph.

16           21.     Renesas does not infringe and has not infringed, either directly, contributorily, or  
17    by inducement, any valid and enforceable claim of the '853 Patent, either literally or under the  
18    doctrine of equivalents.

19           22.     There is an actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
20    between Renesas and Defendants concerning the non-infringement of the '853 Patent.

21           23.     Renesas is entitled to a declaratory judgment that it does not infringe and has not  
22    infringed, either directly, contributorily, or by inducement, any valid and enforceable claim of the  
23    '853 Patent, either literally or under the doctrine of equivalents.

24                               **SECOND CLAIM FOR RELIEF**

25                   **(Declaratory Judgment of Non-Infringement of the '949 Patent)**

26           24.     Renesas realleges and incorporates by reference paragraphs 1 through 23,  
27    inclusive, as though fully set forth in this paragraph.

1           25.     Renesas does not infringe and has not infringed, either directly, contributorily, or  
2 by inducement, any valid and enforceable claim of the '949 Patent, either literally or under the  
3 doctrine of equivalents.

4           26.     There is an actual controversy, within the meaning of 28 U.S.C. §§ 2201 and 2202,  
5 between Renesas and Defendants concerning the non-infringement of the '949 Patent.

6           27.     Renesas is entitled to a declaratory judgment that it does not infringe and has not  
7 infringed, either directly, contributorily, or by inducement, any valid and enforceable claim of the  
8 '949 Patent, either literally or under the doctrine of equivalents.

9                           **THIRD CLAIM FOR RELIEF**

10                   **(Declaratory Judgment of Invalidity of the '853 Patent)**

11           28.     Renesas realleges and incorporates by reference paragraphs 1 through 27,  
12 inclusive, as though fully set forth in this paragraph.

13           29.     The '853 Patent is invalid for failure to comply with the requirements of Title 35  
14 of the U.S. Code, including at least one or more of 35 U.S.C. §§ 101, 102, 103, 112, 133, 200, *et*  
15 *seq.*, and 301 *et seq.*

16           30.     Renesas is entitled to a declaratory judgment that the claims of the '853 Patent are  
17 invalid.

18                           **FOURTH CLAIM FOR RELIEF**

19                   **(Declaratory Judgment of Invalidity of the '949 Patent)**

20           31.     Renesas realleges and incorporates by reference paragraphs 1 through 30,  
21 inclusive, as though fully set forth in this paragraph.

22           32.     The '949 Patent is invalid for failure to comply with the requirements of Title 35  
23 of the U.S. Code, including at least one or more of 35 U.S.C. §§ 101, 102, 103, 112, 133, 200, *et*  
24 *seq.*, and 301 *et seq.*

25           33.     Renesas is entitled to a declaratory judgment that the claims of the '949 Patent are  
26 invalid.

**PRAYER FOR RELIEF**

Wherefore, Renesas prays for judgment against Defendants, as follows:

- A. For a declaration that Renesas does not infringe and has not infringed, either directly, contributorily, or by inducement, any valid and enforceable claim of the '853 Patent, either literally or under the doctrine of equivalents;
- B. For a declaration that Renesas does not infringe and has not infringed, either directly, contributorily, or by inducement, any valid and enforceable claim of the '949 Patent, either literally or under the doctrine of equivalents.
- C. For a declaration that the '853 Patent is invalid;
- D. For a declaration that the '949 Patent is invalid;
- E. For an order awarding Renesas its costs; *and*
- F. For such other relief as this Court deems just and proper.

**DEMAND FOR JURY TRIAL**

Renesas demands a trial by jury on all issues so triable in this action.

Dated: December 28, 2011

RACHEL KREVANS  
JOHN K. BLAKE, JR.  
MICHAEL P. KNIFFEN

MORRISON & FOERSTER LLP

By:

  
MICHAEL P. KNIFFEN

Attorneys for Plaintiffs  
RENESAS ELECTRONICS  
CORPORATION and  
RENESAS ELECTRONICS  
AMERICA, INC.