

EXHIBIT A

Part 3

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10 HYNIX SEMICONDUCTOR INC., and Defendant
HYNIX SEMICONDUCTOR AMERICA INC.
11

12 UNITED STATES DISTRICT COURT
13 FOR THE NORTHERN DISTRICT OF CALIFORNIA
14 SAN FRANCISCO DIVISION

15 TOSHIBA CORPORATION,
16 Plaintiff,
17 v.
18 HYNIX SEMICONDUCTOR INC., and
HYNIX SEMICONDUCTOR AMERICA INC.
19 Defendants.
20

Case No. C04 04708 VRW

**DEFENDANT HYNIX SEMICONDUCTOR
INC. AND HYNIX SEMICONDUCTOR
AMERICA INC.'S ANSWER TO
COMPLAINT FOR DECLARATORY
JUDGMENT OF NON-INFRINGEMENT
AND INVALIDITY; COUNTERCLAIMS**

DEMAND FOR JURY TRIAL

21 HYNIX SEMICONDUCTOR INC.,
22 Counterclaimant,
23 v.
24 TOSHIBA CORPORATION, TOSHIBA
AMERICA, INC., TOSHIBA AMERICA
INFORMATION SYSTEMS, INC., TOSHIBA
25 AMERICA CONSUMER PRODUCTS, L.L.C.,
TOSHIBA AMERICA ELECTRONIC
26 COMPONENTS, INC., TOSHIBA AMERICA
MEDICAL SYSTEMS, INC., and TOSHIBA
27 AMERICA BUSINESS SOLUTIONS, INC.
28

Counterdefendants.

1 Defendants, HYNIX SEMICONDUCTOR INC. (“HSI”) and HYNIX SEMICONDUCTOR
2 AMERICA INC. (“HSA”) (collectively “Hynix”), by and through their counsel, hereby answer
3 Toshiba Corporation’s (“Toshiba”) Complaint For Declaratory Judgment Of Non-Infringement And
4 Invalidity, filed November 8, 2004 (“the Complaint”), and HSI asserts its counterclaims as follows:

5 **PARTIES**

6 1. Hynix lacks knowledge or information sufficient to respond to the allegations in
7 paragraph 1 of the Complaint and, on that basis, denies those allegations.

8 2. Hynix admits that HSI is a corporation organized under the laws of Korea and that it has a
9 place of business at San 136-1, Ami-Ri Bubal-eub Ichon-si Kyoungki-do, Korea 467-860. Except as
10 so admitted, Hynix denies the allegations contained in paragraph 2 of the Complaint.

11 3. Hynix admits that HSA is a corporation organized under the laws of the State of California
12 with a place of business at 3101 North First Street, San Jose, California 95134. Hynix admits HSA
13 maintains an office in this state. Except as so admitted, Hynix denies the allegations contained in
14 paragraph 3 of the Complaint.

15 4. Hynix avers that the definitional statement set forth in paragraph 4 of the Complaint does
16 not necessitate a response.

17 **JURISDICTION AND VENUE**

18 5. Hynix admits that Toshiba purports to bring this action pursuant to 35 U.S.C. § 1 *et. seq.*
19 Hynix further admits that jurisdiction is proper in this Court pursuant to 28 U.S.C. §§ 1331 and 1338.
20 Except as so admitted, Hynix denies the allegations contained in paragraph 5 of the Complaint.

21 6. Hynix admits that this Court has personal jurisdiction over HSI and HSA. Except as so
22 admitted, Hynix denies the allegations contained in paragraph 6 of the Complaint.

23 7. Hynix admits that venue is proper in this Court.

24 **THE PATENTS**

25 8. Hynix admits that United States Patent No. 4,718,019 (“the ‘019 patent”) is entitled
26 “Electron Beam Exposure System and an Apparatus for Carrying out a Pattern Unwinder,” and issued
27 on January 5, 1988.

28 9. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the

1 '019 patent.

2 10. Hynix admits that United States Patent No. 5,031,111 ("the '111 patent") is entitled
3 "Automated Circuit Design Method," and issued on July 9, 1991.

4 11. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
5 '111 patent.

6 12. Hynix admits that Reexamination Certificate 4297 issued for the '111 patent on March 27,
7 2001.

8 13. Hynix admits that United States Patent No. 5,422,311 ("the '311 patent") is entitled
9 "Method for Manufacturing a Conductor Layer in a Semiconductor Device," and issued on June 6,
10 1995.

11 14. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
12 '311 patent.

13 15. Hynix admits that United States Patent No. 5,509,995 ("the '995 patent") is entitled
14 "Process for Anisotropically Etching Semiconductor Material," and issued on April 23, 1996.

15 16. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
16 '995 patent.

17 17. Hynix admits that United States Patent No. 5,512,519 ("the '519 patent") is entitled
18 "Method of Forming a Silicon Insulating Layer in a Semiconductor Device," and issued on April 30,
19 1996.

20 18. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
21 '519 patent.

22 19. Hynix admits that United States Patent No. 5,663,102 ("the '102 patent") is entitled
23 "Method for Forming Multi-Layered Metal Wiring Semiconductor Element Using CMP or Etch
24 Back," and issued September 2, 1997.

25 20. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
26 '102 patent.

27 21. Hynix admits that United States Patent No. 5,807,728 ("the '728 Patent") is entitled "Thin
28 Film Transistor for Antistatic Circuit and Method for Fabricating the Same," and issued September 15,

1 1998.

2 22. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
3 '728 patent.

4 23. Hynix admits that United States Patent No. 5,861,334 ("the '334 patent") is entitled
5 "Method for Fabricating Semiconductor Device Having A Buried Channel," and issued January 19,
6 1999.

7 24. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
8 '334 patent.

9 25. Hynix admits that United States Patent No. 5,869,404 ("the '404 patent") is entitled
10 "Method for Forming Contact Hole of Semiconductor Device," and issued February 9, 1999.

11 26. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
12 '404 patent.

13 27. Hynix admits that United States Patent No. 6,207,997 ("the '997 patent") is entitled "Thin
14 Film Transistor for Antistatic Circuit and Method for Fabricating the Same," and issued on March 27,
15 2001.

16 28. Hynix admits that HSI is owner by assignment of all right, title and interest in and to the
17 '997 patent.

18 29. Hynix admits that United States Patent No. 6,330,190 ("the '190 patent") is entitled
19 "Semiconductor Structure for Flash Memory Enabling Low Operating Potentials," and issued on
20 December 11, 2001.

21 30. Hynix denies the allegations stated in paragraph 30 of the Complaint.

22 31. Hynix avers that the definitional statement set forth paragraph 31 of the Complaint does
23 not necessitate a response.

24 **ASSERTION BY DEFENDANTS**

25 32. Hynix admits that HSI has alleged, alleges and will continue to allege that Toshiba has
26 been and is making, using, offering for sale, selling, and/or importing into the United States devices
27 that were manufactured using methods or that embody the inventions disclosed and claimed in the
28 patents-at-issue. Except as so admitted, Hynix denies the allegations contained in paragraph 32 of the

1 Complaint.

2 COUNT I

3 **(Declaratory Judgment - Non-Infringement of the '019 Patent)**

4 33. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
5 forth herein.

6 34. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
7 infringement of any valid claim of the '019 patent. Except as so admitted, Hynix denies the
8 allegations contained in paragraph 34 of the Complaint.

9 35. Hynix admits the allegations contained in paragraph 35 of the Complaint.

10 36. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
11 been and is making, using, offering for sale, selling and/or importing into the United States devices
12 that were manufactured using methods disclosed and claimed in the '019 patent. Except as so
13 admitted, Hynix denies the allegations contained in paragraph 36 of the Complaint.

14 37. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
15 induced and contributed to infringement of the '019 patent by others. Except as so admitted, Hynix
16 denies the allegations contained in paragraph 37 of the Complaint.

17 38. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
18 infringement of the '019 patent was willful and deliberate. Except as so admitted, Hynix denies the
19 allegations contained in paragraph 38 of the Complaint.

20 39. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
21 and will continue to be irreparably harmed by Toshiba's infringement of the '019 patent. Except as so
22 admitted, Hynix denies the allegations contained in paragraph 39 of the Complaint.

23 40. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
24 adequate remedy at law for Toshiba's infringement of the '019 patent. Except as so admitted, Hynix
25 denies the allegations contained in paragraph 40 of the Complaint.

26 41. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
27 Hynix denies the allegations contained in paragraph 41 of the Complaint.

28 42. Hynix denies the allegations stated in paragraph 42 of the Complaint.

1 43. Hynix denies the allegations stated in paragraph 43 of the Complaint.

2 44. Hynix denies the allegations stated in paragraph 44 of the Complaint.

3 45. Hynix admits that Toshiba purports to desire and request a judicial determination and
4 declaration of the respective rights and duties of the parties based on the purported disputes regarding
5 the infringement or non-infringement of the '019 patent. Except as so admitted, Hynix denies the
6 allegations contained in paragraph 45 of the Complaint.

7 **COUNT II**

8 **(Declaratory Judgment - Invalidity of the '019 Patent)**

9 46. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
10 forth herein.

11 47. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
12 invalidity of any and all claims of the '019 patent. Except as so admitted, Hynix denies the allegations
13 contained in paragraph 47 of the Complaint.

14 48. Hynix admits the allegations contained in paragraph 48 of the Complaint.

15 49. Hynix denies the allegations stated in paragraph 49 of the Complaint.

16 50. Hynix admits that Toshiba purports to desire and request a judicial determination and
17 declaration of the respective rights and duties of the parties based on the purported disputes regarding
18 the validity of the '019 patent. Except as so admitted, Hynix denies the allegations contained in
19 paragraph 50 of the Complaint.

20 **COUNT III**

21 **(Declaratory Judgment - Non-Infringement of the '111 Patent)**

22 51. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
23 forth herein.

24 52. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
25 infringement of any valid claim of the '111 patent. Except as so admitted, Hynix denies the
26 allegations contained in paragraph 52 of the Complaint.

27 53. Hynix admits the allegations contained in paragraph 53 of the Complaint.

28 54. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has

1 been and is making, using, offering for sale, selling and/or importing into the United States devices
2 that were manufactured using methods disclosed and claimed in the '111 patent. Except as so
3 admitted, Hynix denies the allegations contained in paragraph 54 of the Complaint.

4 55. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
5 induced and contributed to infringement of the '111 patent by others. Except as so admitted, Hynix
6 denies the allegations contained in paragraph 55 of the Complaint.

7 56. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
8 infringement of the '111 patent was willful and deliberate. Except as so admitted, Hynix denies the
9 allegations contained in paragraph 56 of the Complaint.

10 57. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
11 and will continue to be irreparably harmed by Toshiba's infringement of the '111 patent. Except as so
12 admitted, Hynix denies the allegations contained in paragraph 57 of the Complaint.

13 58. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
14 adequate remedy at law for Toshiba's infringement of the '111 patent. Except as so admitted, Hynix
15 denies the allegations contained in paragraph 58 of the Complaint.

16 59. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
17 Hynix denies the allegations contained in paragraph 59 of the Complaint.

18 60. Hynix denies the allegations stated in paragraph 60 of the Complaint.

19 61. Hynix denies the allegations stated in paragraph 61 of the Complaint.

20 62. Hynix denies the allegations stated in paragraph 62 of the Complaint.

21 63. Hynix admits that Toshiba purports to desire and request a judicial determination and
22 declaration of the respective rights and duties of the parties based on the purported disputes regarding
23 the infringement or non-infringement of the '111 patent. Except as so admitted, Hynix denies the
24 allegations contained in paragraph 63 of the Complaint.

25 **COUNT IV**

26 **(Declaratory Judgment - Invalidity of the '111 Patent)**

27 64. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
28 forth herein.

1 65. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
2 invalidity of any and all claims of the '111 patent. Except as so admitted, Hynix denies the allegations
3 contained in paragraph 65 of the Complaint.

4 66. Hynix admits the allegations contained in paragraph 66 of the Complaint.

5 67. Hynix denies the allegations stated in paragraph 67 of the Complaint.

6 68. Hynix admits that Toshiba purports to desire and request a judicial determination and
7 declaration of the respective rights and duties of the parties based on the purported disputes regarding
8 the validity of the '111 patent. Except as so admitted, Hynix denies the allegations contained in
9 paragraph 68 of the Complaint.

10 **COUNT V**

11 **(Declaratory Judgment - Non-Infringement of the '311 Patent)**

12 69. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
13 forth herein.

14 70. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
15 infringement of any valid claim of the '311 patent. Except as so admitted, Hynix denies the
16 allegations contained in paragraph 70 of the Complaint.

17 71. Hynix admits the allegations contained in paragraph 71 of the Complaint.

18 72. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
19 been and is making, using, offering for sale, selling and/or importing into the United States devices
20 that were manufactured using methods disclosed and claimed in the '311 patent. Except as so
21 admitted, Hynix denies the allegations contained in paragraph 72 of the Complaint.

22 73. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
23 induced and contributed to infringement of the '311 patent by others. Except as so admitted, Hynix
24 denies the allegations contained in paragraph 73 of the Complaint.

25 74. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
26 infringement of the '311 patent was willful and deliberate. Except as so admitted, Hynix denies the
27 allegations contained in paragraph 74 of the Complaint.

28 75. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been

1 and will continue to be irreparably harmed by Toshiba's infringement of the '311 patent. Except as so
2 admitted, Hynix denies the allegations contained in paragraph 75 of the Complaint.

3 76. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
4 adequate remedy at law for Toshiba's infringement of the '311 patent. Except as so admitted, Hynix
5 denies the allegations contained in paragraph 76 of the Complaint.

6 77. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
7 Hynix denies the allegations contained in paragraph 77 of the Complaint.

8 78. Hynix denies the allegations stated in paragraph 78 of the Complaint.

9 79. Hynix denies the allegations stated in paragraph 79 of the Complaint.

10 80. Hynix denies the allegations stated in paragraph 80 of the Complaint.

11 81. Hynix admits that Toshiba purports to desire and request a judicial determination and
12 declaration of the respective rights and duties of the parties based on the purported disputes regarding
13 the infringement or non-infringement of the '311 patent. Except as so admitted, Hynix denies the
14 allegations contained in paragraph 81 of the Complaint.

15 **COUNT VI**

16 **(Declaratory Judgment - Invalidity of the '311 Patent)**

17 82. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
18 forth herein.

19 83. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
20 invalidity of any and all claims of the '311 patent. Except as so admitted, Hynix denies the allegations
21 contained in paragraph 83 of the Complaint.

22 84. Hynix admits the allegations contained in paragraph 84 of the Complaint.

23 85. Hynix denies the allegations stated in paragraph 85 of the Complaint.

24 86. Hynix admits that Toshiba purports to desire and request a judicial determination and
25 declaration of the respective rights and duties of the parties based on the purported disputes regarding
26 the validity of the '311 patent. Except as so admitted, Hynix denies the allegations contained in
27 paragraph 86 of the Complaint.

COUNT VII

(Declaratory Judgment - Non-Infringement of the '995 Patent)

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3 87. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
4 forth herein.

5 88. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
6 infringement of any valid claim of the '995 patent. Except as so admitted, Hynix denies the
7 allegations contained in paragraph 88 of the Complaint.

8 89. Hynix admits the allegations contained in paragraph 89 of the Complaint.

9 90. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
10 been and is making, using, offering for sale, selling and/or importing into the United States devices
11 that were manufactured using methods disclosed and claimed in the '995 patent. Except as so
12 admitted, Hynix denies the allegations contained in paragraph 90 of the Complaint.

13 91. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
14 induced and contributed to infringement of the '995 patent by others. Except as so admitted, Hynix
15 denies the allegations contained in paragraph 91 of the Complaint.

16 92. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
17 infringement of the '995 patent was willful and deliberate. Except as so admitted, Hynix denies the
18 allegations contained in paragraph 92 of the Complaint.

19 93. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
20 and will continue to be irreparably harmed by Toshiba's infringement of the '995 patent. Except as so
21 admitted, Hynix denies the allegations contained in paragraph 93 of the Complaint.

22 94. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
23 adequate remedy at law for Toshiba's infringement of the '995 patent. Except as so admitted, Hynix
24 denies the allegations contained in paragraph 94 of the Complaint.

25 95. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
26 Hynix denies the allegations contained in paragraph 95 of the Complaint.

27 96. Hynix denies the allegations stated in paragraph 96 of the Complaint.

28 97. Hynix denies the allegations stated in paragraph 97 of the Complaint.

1 98. Hynix denies the allegations stated in paragraph 98 of the Complaint.

2 99. Hynix admits that Toshiba purports to desire and request a judicial determination and
3 declaration of the respective rights and duties of the parties based on the purported disputes regarding
4 the infringement or non-infringement of the '995 patent. Except as so admitted, Hynix denies the
5 allegations contained in paragraph 99 of the Complaint.

6 **COUNT VIII**

7 **(Declaratory Judgment - Invalidity of the '995 Patent)**

8 100. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
9 forth herein.

10 101. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
11 invalidity of any and all claims of the '995 patent. Except as so admitted, Hynix denies the allegations
12 contained in paragraph 101 of the Complaint.

13 102. Hynix admits the allegations contained in paragraph 102 of the Complaint.

14 103. Hynix denies the allegations stated in paragraph 103 of the Complaint.

15 104. Hynix admits that Toshiba purports to desire and request a judicial determination and
16 declaration of the respective rights and duties of the parties based on the purported disputes regarding
17 the validity of the '995 patent. Except as so admitted, Hynix denies the allegations contained in
18 paragraph 104 of the Complaint.

19 **COUNT IX**

20 **(Declaratory Judgment - Non-Infringement of the '519 Patent)**

21 105. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
22 forth herein.

23 106. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
24 infringement of any valid claim of the '519 patent. Except as so admitted, Hynix denies the
25 allegations contained in paragraph 106 of the Complaint.

26 107. Hynix admits the allegations contained in paragraph 107 of the Complaint.

27 108. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
28 been and is making, using, offering for sale, selling and/or importing into the United States devices

1 that were manufactured using methods disclosed and claimed in the '519 patent. Except as so
2 admitted, Hynix denies the allegations contained in paragraph 108 of the Complaint.

3 109. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
4 induced and contributed to infringement of the '519 patent by others. Except as so admitted, Hynix
5 denies the allegations contained in paragraph 109 of the Complaint.

6 110. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
7 infringement of the '519 patent was willful and deliberate. Except as so admitted, Hynix denies the
8 allegations contained in paragraph 110 of the Complaint.

9 111. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
10 and will continue to be irreparably harmed by Toshiba's infringement of the '519 patent. Except as so
11 admitted, Hynix denies the allegations contained in paragraph 111 of the Complaint.

12 112. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
13 adequate remedy at law for Toshiba's infringement of the '519 patent. Except as so admitted, Hynix
14 denies the allegations contained in paragraph 112 of the Complaint.

15 113. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
16 Hynix denies the allegations contained in paragraph 113 of the Complaint.

17 114. Hynix denies the allegations stated in paragraph 114 of the Complaint.

18 115. Hynix denies the allegations stated in paragraph 115 of the Complaint.

19 116. Hynix denies the allegations stated in paragraph 116 of the Complaint.

20 117. Hynix admits that Toshiba purports to desire and request a judicial determination and
21 declaration of the respective rights and duties of the parties based on the purported disputes regarding
22 the infringement or non-infringement of the '519 patent. Except as so admitted, Hynix denies the
23 allegations contained in paragraph 117 of the Complaint.

24 **COUNT X**

25 **(Declaratory Judgment - Invalidity of the '519 Patent)**

26 118. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
27 forth herein.

28 119. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the

1 invalidity of any and all claims of the '519 patent. Except as so admitted, Hynix denies the allegations
2 contained in paragraph 119 of the Complaint.

3 120. Hynix admits the allegations contained in paragraph 120 of the Complaint.

4 121. Hynix denies the allegations stated in paragraph 121 of the Complaint.

5 122. Hynix admits that Toshiba purports to desire and request a judicial determination and
6 declaration of the respective rights and duties of the parties based on the purported disputes regarding
7 the validity of the '519 patent. Except as so admitted, Hynix denies the allegations contained in
8 paragraph 122 of the Complaint.

9 **COUNT XI**

10 **(Declaratory Judgment - Non-Infringement of the '102 Patent)**

11 123. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
12 forth herein.

13 124. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
14 infringement of any valid claim of the '102 patent. Except as so admitted, Hynix denies the
15 allegations contained in paragraph 124 of the Complaint.

16 125. Hynix admits the allegations contained in paragraph 125 of the Complaint.

17 126. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
18 been and is making, using, offering for sale, selling and/or importing into the United States devices
19 that were manufactured using methods disclosed and claimed in the '102 patent. Except as so
20 admitted, Hynix denies the allegations contained in paragraph 126 of the Complaint.

21 127. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
22 induced and contributed to infringement of the '102 patent by others. Except as so admitted, Hynix
23 denies the allegations contained in paragraph 127 of the Complaint.

24 128. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
25 infringement of the '102 patent was willful and deliberate. Except as so admitted, Hynix denies the
26 allegations contained in paragraph 128 of the Complaint.

27 129. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
28 and will continue to be irreparably harmed by Toshiba's infringement of the '102 patent. Except as so

1 admitted, Hynix denies the allegations contained in paragraph 129 of the Complaint.

2 130. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
3 adequate remedy at law for Toshiba's infringement of the '102 patent. Except as so admitted, Hynix
4 denies the allegations contained in paragraph 130 of the Complaint.

5 131. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
6 Hynix denies the allegations contained in paragraph 131 of the Complaint.

7 132. Hynix denies the allegations stated in paragraph 132 of the Complaint.

8 133. Hynix denies the allegations stated in paragraph 133 of the Complaint.

9 134. Hynix denies the allegations stated in paragraph 134 of the Complaint.

10 135. Hynix admits that Toshiba purports to desire and request a judicial determination and
11 declaration of the respective rights and duties of the parties based on the purported disputes regarding
12 the infringement or non-infringement of the '102 patent. Except as so admitted, Hynix denies the
13 allegations contained in paragraph 135 of the Complaint.

14 **COUNT XII**

15 **(Declaratory Judgment - Invalidity of the '102 Patent)**

16 136. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
17 forth herein.

18 137. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
19 invalidity of any and all claims of the '102 patent. Except as so admitted, Hynix denies the allegations
20 contained in paragraph 137 of the Complaint.

21 138. Hynix admits the allegations contained in paragraph 138 of the Complaint.

22 139. Hynix denies the allegations stated in paragraph 139 of the Complaint.

23 140. Hynix admits that Toshiba purports to desire and request a judicial determination and
24 declaration of the respective rights and duties of the parties based on the purported disputes regarding
25 the validity of the '102 patent. Except as so admitted, Hynix denies the allegations contained in
26 paragraph 140 of the Complaint.

COUNT XIII

(Declaratory Judgment - Non-Infringement of the '728 Patent)

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2
3 141. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
4 forth herein.

5 142. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
6 infringement of any valid claim of the '728 patent. Except as so admitted, Hynix denies the
7 allegations contained in paragraph 142 of the Complaint.

8 143. Hynix admits the allegations contained in paragraph 143 of the Complaint.

9 144. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
10 been and is making, using, offering for sale, selling and/or importing into the United States devices
11 that were manufactured using methods disclosed and claimed in the '728 patent. Except as so
12 admitted, Hynix denies the allegations contained in paragraph 144 of the Complaint.

13 145. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
14 induced and contributed to infringement of the '728 patent by others. Except as so admitted, Hynix
15 denies the allegations contained in paragraph 145 of the Complaint.

16 146. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
17 infringement of the '728 patent was willful and deliberate. Except as so admitted, Hynix denies the
18 allegations contained in paragraph 146 of the Complaint.

19 147. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
20 and will continue to be irreparably harmed by Toshiba's infringement of the '728 patent. Except as so
21 admitted, Hynix denies the allegations contained in paragraph 147 of the Complaint.

22 148. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
23 adequate remedy at law for Toshiba's infringement of the '728 patent. Except as so admitted, Hynix
24 denies the allegations contained in paragraph 148 of the Complaint.

25 149. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
26 Hynix denies the allegations contained in paragraph 149 of the Complaint.

27 150. Hynix denies the allegations stated in paragraph 150 of the Complaint.

28 151. Hynix denies the allegations stated in paragraph 151 of the Complaint.

1 152. Hynix denies the allegations stated in paragraph 152 of the Complaint.

2 153. Hynix admits that Toshiba purports to desire and request a judicial determination and
3 declaration of the respective rights and duties of the parties based on the purported disputes regarding
4 the infringement or non-infringement of the '728 patent. Except as so admitted, Hynix denies the
5 allegations contained in paragraph 153 of the Complaint.

6 **COUNT XIV**

7 **(Declaratory Judgment - Invalidity of the '728 Patent)**

8 154. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
9 forth herein.

10 155. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
11 invalidity of any and all claims of the '728 patent. Except as so admitted, Hynix denies the allegations
12 contained in paragraph 155 of the Complaint.

13 156. Hynix admits the allegations contained in paragraph 156 of the Complaint.

14 157. Hynix denies the allegations stated in paragraph 157 of the Complaint.

15 158. Hynix admits that Toshiba purports to desire and request a judicial determination and
16 declaration of the respective rights and duties of the parties based on the purported disputes regarding
17 the validity of the '728 patent. Except as so admitted, Hynix denies the allegations contained in
18 paragraph 158 of the Complaint.

19 **COUNT XV**

20 **(Declaratory Judgment - Non-Infringement of the '334 Patent)**

21 159. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
22 forth herein.

23 160. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
24 infringement of any valid claim of the '334 patent. Except as so admitted, Hynix denies the
25 allegations contained in paragraph 160 of the Complaint.

26 161. Hynix admits the allegations contained in paragraph 161 of the Complaint.

27 162. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
28 been and is making, using, offering for sale, selling and/or importing into the United States devices

1 that were manufactured using methods disclosed and claimed in the '334 patent. Except as so
2 admitted, Hynix denies the allegations contained in paragraph 162 of the Complaint.

3 163. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
4 induced and contributed to infringement of the '334 patent by others. Except as so admitted, Hynix
5 denies the allegations contained in paragraph 163 of the Complaint.

6 164. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
7 infringement of the '334 patent was willful and deliberate. Except as so admitted, Hynix denies the
8 allegations contained in paragraph 164 of the Complaint.

9 165. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
10 and will continue to be irreparably harmed by Toshiba's infringement of the '334 patent. Except as so
11 admitted, Hynix denies the allegations contained in paragraph 165 of the Complaint.

12 166. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
13 adequate remedy at law for Toshiba's infringement of the '334 patent. Except as so admitted, Hynix
14 denies the allegations contained in paragraph 166 of the Complaint.

15 167. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
16 Hynix denies the allegations contained in paragraph 167 of the Complaint.

17 168. Hynix denies the allegations stated in paragraph 168 of the Complaint.

18 169. Hynix denies the allegations stated in paragraph 169 of the Complaint.

19 170. Hynix denies the allegations stated in paragraph 170 of the Complaint.

20 171. Hynix admits that Toshiba purports to desire and request a judicial determination and
21 declaration of the respective rights and duties of the parties based on the purported disputes regarding
22 the infringement or non-infringement of the '334 patent. Except as so admitted, Hynix denies the
23 allegations contained in paragraph 171 of the Complaint.

24 **COUNT XVI**

25 **(Declaratory Judgment - Invalidity of the '334 Patent)**

26 172. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
27 forth herein.

28 173. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the

1 invalidity of any and all claims of the '334 patent. Except as so admitted, Hynix denies the allegations
2 contained in paragraph 173 of the Complaint.

3 174. Hynix admits the allegations contained in paragraph 174 of the Complaint.

4 175. Hynix denies the allegations stated in paragraph 175 of the Complaint.

5 176. Hynix admits that Toshiba purports to desire and request a judicial determination and
6 declaration of the respective rights and duties of the parties based on the purported disputes regarding
7 the validity of the '334 patent. Except as so admitted, Hynix denies the allegations contained in
8 paragraph 176 of the Complaint.

9 **COUNT XVII**

10 **(Declaratory Judgment - Non-Infringement of the '404 Patent)**

11 177. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
12 forth herein.

13 178. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
14 infringement of any valid claim of the '404 patent. Except as so admitted, Hynix denies the
15 allegations contained in paragraph 178 of the Complaint.

16 179. Hynix admits the allegations contained in paragraph 179 of the Complaint.

17 180. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
18 been and is making, using, offering for sale, selling and/or importing into the United States devices
19 that were manufactured using methods disclosed and claimed in the '404 patent. Except as so
20 admitted, Hynix denies the allegations contained in paragraph 180 of the Complaint.

21 181. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
22 induced and contributed to infringement of the '404 patent by others. Except as so admitted, Hynix
23 denies the allegations contained in paragraph 181 of the Complaint.

24 182. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
25 infringement of the '404 patent was willful and deliberate. Except as so admitted, Hynix denies the
26 allegations contained in paragraph 182 of the Complaint.

27 183. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
28 and will continue to be irreparably harmed by Toshiba's infringement of the '404 patent. Except as so

1 admitted, Hynix denies the allegations contained in paragraph 183 of the Complaint.

2 184. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
3 adequate remedy at law for Toshiba's infringement of the '404 patent. Except as so admitted, Hynix
4 denies the allegations contained in paragraph 184 of the Complaint.

5 185. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
6 Hynix denies the allegations contained in paragraph 185 of the Complaint.

7 186. Hynix denies the allegations stated in paragraph 186 of the Complaint.

8 187. Hynix denies the allegations stated in paragraph 187 of the Complaint.

9 188. Hynix denies the allegations stated in paragraph 188 of the Complaint.

10 189. Hynix admits that Toshiba purports to desire and request a judicial determination and
11 declaration of the respective rights and duties of the parties based on the purported disputes regarding
12 the *infringement or non-infringement* of the '404 patent. Except as so admitted, Hynix denies the
13 allegations contained in paragraph 189 of the Complaint.

14 **COUNT XVIII**

15 **(Declaratory Judgment - Invalidity of the '404 Patent)**

16 190. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
17 forth herein.

18 191. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
19 invalidity of any and all claims of the '404 patent. Except as so admitted, Hynix denies the allegations
20 contained in paragraph 191 of the Complaint.

21 192. Hynix admits the allegations contained in paragraph 192 of the Complaint.

22 193. Hynix denies the allegations stated in paragraph 193 of the Complaint.

23 194. Hynix admits that Toshiba purports to desire and request a judicial determination and
24 declaration of the respective rights and duties of the parties based on the purported disputes regarding
25 the validity of the '404 patent. Except as so admitted, Hynix denies the allegations contained in
26 paragraph 194 of the Complaint.

COUNT XIX

(Declaratory Judgment - Non-Infringement of the '997 Patent)

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3 195. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
4 forth herein.

5 196. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
6 infringement of any valid claim of the '997 patent. Except as so admitted, Hynix denies the
7 allegations contained in paragraph 196 of the Complaint.

8 197. Hynix admits the allegations contained in paragraph 197 of the Complaint.

9 198. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
10 been and is making, using, offering for sale, selling and/or importing into the United States devices
11 that embody the invention disclosed and claimed in the '997 patent. Except as so admitted, Hynix
12 denies the allegations contained in paragraph 198 of the Complaint.

13 199. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba has
14 induced and contributed to infringement of the '997 patent by others. Except as so admitted, Hynix
15 denies the allegations contained in paragraph 199 of the Complaint.

16 200. Hynix admits that HSI has alleged, is alleging and will continue to allege that Toshiba's
17 infringement of the '997 patent was willful and deliberate. Except as so admitted, Hynix denies the
18 allegations contained in paragraph 200 of the Complaint.

19 201. Hynix admits that HSI has alleged, is alleging and will continue to allege that HSI has been
20 and will continue to be irreparably harmed by Toshiba's infringement of the '997 patent. Except as so
21 admitted, Hynix denies the allegations contained in paragraph 201 of the Complaint.

22 202. Hynix admits that HSI has alleged, is alleging, and will continue to allege that HSI has no
23 adequate remedy at law for Toshiba's infringement of the '997 patent. Except as so admitted, Hynix
24 denies the allegations contained in paragraph 202 of the Complaint.

25 203. Hynix admits that Toshiba purports to deny HSI's allegations. Except as so admitted,
26 Hynix denies the allegations contained in paragraph 203 of the Complaint.

27 204. Hynix denies the allegations stated in paragraph 204 of the Complaint.

28 205. Hynix denies the allegations stated in paragraph 205 of the Complaint.

1 206. Hynix denies the allegations stated in paragraph 206 of the Complaint.

2 207. Hynix admits that Toshiba purports to desire and request a judicial determination and
3 declaration of the respective rights and duties of the parties based on the purported disputes regarding
4 the infringement or non-infringement of the '997 patent. Except as so admitted, Hynix denies the
5 allegations contained in paragraph 207 of the Complaint.

6 **COUNT XX**

7 **(Declaratory Judgment - Invalidity of the '997 Patent)**

8 208. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
9 forth herein.

10 209. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
11 invalidity of any and all claims of the '997 patent. Except as so admitted, Hynix denies the allegations
12 contained in paragraph 209 of the Complaint.

13 210. Hynix admits the allegations contained in paragraph 210 of the Complaint.

14 211. Hynix denies the allegations stated in paragraph 211 of the Complaint.

15 212. Hynix admits that Toshiba purports to desire and request a judicial determination and
16 declaration of the respective rights and duties of the parties based on the purported disputes regarding
17 the validity of the '997 patent. Except as so admitted, Hynix denies the allegations contained in
18 paragraph 212 of the Complaint.

19 **COUNT XXI**

20 **(Declaratory Judgment - Non-Infringement of the '190 Patent)**

21 213. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
22 forth herein.

23 214. Hynix admits that Toshiba asserts this is an action for declaratory judgment of non-
24 infringement of any valid claim of the '190 patent. Except as so admitted, Hynix denies the
25 allegations contained in paragraph 214 of the Complaint.

26 215. Hynix denies the allegations stated in paragraph 215 of the Complaint.

27 216. Hynix denies the allegations stated in paragraph 216 of the Complaint.

28 217. Hynix denies the allegations stated in paragraph 217 of the Complaint.

- 1 218. Hynix denies the allegations stated in paragraph 218 of the Complaint.
- 2 219. Hynix denies the allegations stated in paragraph 219 of the Complaint.
- 3 220. Hynix denies the allegations stated in paragraph 220 of the Complaint.
- 4 221. Hynix admits that Toshiba purports to deny HSA's purported allegations. Except as so
- 5 admitted, Hynix denies the allegations contained in paragraph 221 of the Complaint.
- 6 222. Hynix denies the allegations stated in paragraph 222 of the Complaint.
- 7 223. Hynix denies the allegations stated in paragraph 223 of the Complaint.
- 8 224. Hynix denies the allegations stated in paragraph 224 of the Complaint.
- 9 225. Hynix admits that Toshiba purports to desire and request a judicial determination and
- 10 declaration of the respective rights and duties of the parties based on the purported disputes regarding
- 11 the infringement or non-infringement of the '190 patent. Except as so admitted, Hynix denies the
- 12 allegations contained in paragraph 225 of the Complaint.

13 **COUNT XXII**

14 **(Declaratory Judgment - Invalidity of the '190 Patent)**

- 15 226. Hynix incorporates by reference the responses to paragraphs 1 through 32 as if fully set
- 16 forth herein.
- 17 227. Hynix admits that Toshiba asserts this is an action for declaratory judgment of the
- 18 invalidity of any and all claims of the '190 patent. Except as so admitted, Hynix denies the allegations
- 19 contained in paragraph 227 of the Complaint.
- 20 228. Hynix denies the allegations stated in paragraph 228 of the Complaint.
- 21 229. Hynix denies the allegations stated in paragraph 229 of the Complaint.
- 22 230. Hynix admits that Toshiba purports to desire and request a judicial determination and
- 23 declaration of the respective rights and duties of the parties based on the purported disputes regarding
- 24 the validity of the '190 patent. Except as so admitted, Hynix denies the allegations contained in
- 25 paragraph 230 of the Complaint.

26 **ATTORNEY'S FEES**

- 27 231. Hynix denies the allegations stated in paragraph 231 of the Complaint.

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PLAINTIFF'S PRAYER FOR RELIEF

Hynix denies that any basis exists for relief in this case as requested by plaintiff Toshiba.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

(Failure to State a Claim Against HSI)

Toshiba's Complaint for Declaratory Judgment of Non-Infringement and Invalidity and each and every purported claim for relief fails to allege facts sufficient to state a claim against HSI.

SECOND AFFIRMATIVE DEFENSE

(Failure to State a Claim Against HSA)

Toshiba's Complaint for Declaratory Judgment of Non-Infringement and Invalidity and each and every purported claim for relief fails to allege facts sufficient to state a claim against HSA.

WHEREFORE, Hynix prays for judgment in its favor and against Toshiba as follows:

1. Declaring that United States Patent Nos. 4,718,019; 5,031,111 (including claims issued in Reexamination Certificate 4297); 5,422,311; 5,509,995; 5,512,519; 5,663,102; 5,807,728; 5,861,334; 5,869,404; 6,207,997; and 6,330,190 and all claims therein are valid and enforceable;
2. Declaring that Toshiba Corporation infringes United States Patent Nos. 4,718,019; 5,031,111 (including claims issued in Reexamination Certificate 4297); 5,422,311; 5,509,995; 5,512,519; 5,663,102; 5,807,728; 5,861,334; 5,869,404; 6,207,997; and 6,330,190;
3. Dismissing the Complaint with prejudice;
4. Awarding Hynix its attorneys' fees;
5. Awarding Hynix costs of suit; and
6. Awarding Hynix such other costs and further relief as the Court deems just and proper.

COUNTERCLAIMS

Counterclaimant HSI alleges as follows:

THE PARTIES

1
2 1. Counterclaimant HSI is a corporation organized under the laws of Korea with its
3 principal place of business at San 136-1, Ami-Ri Bubal-eub Ichon-si Kyoungki-do, Korea 467-860.

4 2. Upon information and belief, Counterdefendant Toshiba is a corporation organized
5 under the laws of Japan having its principal place of business at 1-1 Shibaura 1-Chome, Minato-Ku,
6 Tokyo 105-8001, Japan.

7 3. Upon information and belief Counterdefendant Toshiba America, Inc. ("TAI"), is a
8 corporation organized under the laws of the State of Delaware with its principal place of business at
9 1251 Avenue of the Americas, Suite 4100, New York, New York, 10020 and/or at 376 Hollywood
10 Avenue, Fairfield, New Jersey 07004.

11 4. Upon information and belief Counterdefendant Toshiba America Information Systems,
12 Inc. ("TAIS") is a corporation organized under the laws of the State of California with its principal
13 place of business at 9740 Irvine Blvd., Irvine, California 92618.

14 5. Upon Information and belief, Counterdefendant Toshiba America Consumer Products,
15 L.L.C. ("TACP"), is a limited liability company organized under the laws of the State of New Jersey
16 with its principal place of business at 82 Totowa Road, Wayne, New Jersey 07470.

17 6. Upon information and belief, Toshiba America Electronic Components, Inc. ("TAEC")
18 is a corporation organized under the laws of the State of California with its principal place of business
19 at 1990 MacArthur Blvd, Suite 400, Irvine, California 92612.

20 7. Upon information and belief, Toshiba America Medical Systems, Inc., ("TAMS") is a
21 corporation organized under the laws of the State of California with its principal place of business at
22 2441 Michelle Drive, Tustin, California 92780.

23 8. Upon information and belief, Toshiba America Business Solutions, Inc., ("TABS") is a
24 corporation organized under the laws of the State of California with its principal place of business at 2
25 Musick, Irvine, California 92618.

26 9. Toshiba, TAI, TAIS, TACP, TAEC, TAMS, and TABS are referred to collectively
27 herein as the "Toshiba Counterdefendants."
28

1 **JURISDICTION AND VENUE**

2 10. These Counterclaims constitute a civil action for patent infringement arising under the
3 patent laws of the United States, 35 U.S.C. § 101, *et seq.* This Court has subject matter jurisdiction
4 under 28 U.S.C. §§ 1331 and 1338. Venue is proper in this judicial district under 28 U.S.C.
5 §§ 1391(b), (c) and (d) and 1400(b).

6 11. This court has personal jurisdiction over Toshiba because Toshiba has submitted to
7 jurisdiction herein by commencing this action and has sufficient minimum contacts with the United
8 States and with the State of California.

9 12. This court has personal jurisdiction over TAI because TAI has sufficient minimum
10 contacts with this State, maintains offices within this State and, on information and belief, conducts
11 substantial business within this State.

12 13. This court has personal jurisdiction over TAIS because TAIS has sufficient minimum
13 contacts with this State, maintains offices within this State and, on information and belief, conducts
14 substantial business within this State.

15 14. This court has personal jurisdiction over TACP because TACP has sufficient minimum
16 contacts with this State, maintains offices within this State and, on information and belief, conducts
17 substantial business within this State.

18 15. This court has personal jurisdiction over TAEC because TAEC has sufficient minimum
19 contacts with this State, maintains offices within this State and, on information and belief, conducts
20 substantial business within this State.

21 16. This court has personal jurisdiction over TAMS because TAMS has sufficient
22 minimum contacts with this State, maintains offices within this State and, on information and belief,
23 conducts substantial business within this State.

24 17. This court has personal jurisdiction over TABS because TABS has sufficient minimum
25 contacts with this State, maintains offices within this State and, on information and belief, conducts
26 substantial business within this State.

27 **THE PATENTS**

28 18. United States Patent No. 4,718,019 (“the ‘019 patent”), entitled “Electron Beam

1 Exposure System and an Apparatus for Carrying Out a Pattern Unwinder,” duly and legally issued on
2 January 5, 1988. A true and correct copy of the ‘019 patent is attached hereto as Exhibit A and
3 incorporated herein by reference.

4 19. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
5 and interest in and to the ‘019 patent.

6 20. United States Patent No. 5,031,111 (“the ‘111 patent”), entitled “Automated Circuit
7 Design Method,” duly and legally issued on July 9, 1991.

8 21. Reexamination Certificate 4297 issued for the ‘111 patent on March 27, 2001. A true
9 and correct copy of the ‘111 patent (including Reexamination Certificate 4297) is attached hereto as
10 Exhibit B and incorporated herein by reference.

11 22. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
12 and interest in and to the ‘111 patent.

13 23. United States Patent No. 5,422,311 (“the ‘311 patent”), entitled “Method for
14 Manufacturing a Conductor Layer in a Semiconductor Device,” duly and legally issued on June 6,
15 1995. A true and correct copy of the ‘311 patent is attached hereto as Exhibit C and incorporated
16 herein by reference.

17 24. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
18 and interest in and to the ‘311 patent.

19 25. United States Patent No. 5,509,995 (“the ‘995 patent”), entitled “Process for
20 Anisotropically Etching Semiconductor Material,” duly and legally issued on April 23, 1996. A true
21 and correct copy of the ‘995 patent is attached hereto as Exhibit D and incorporated herein by
22 reference.

23 26. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
24 and interest in and to the ‘995 patent.

25 27. United States Patent No. 5,512,519 (“the ‘519 patent”), entitled “Method of Forming a
26 Silicon Insulating Layer in a Semiconductor Device,” duly and legally issued on April 30, 1996. A
27 true and correct copy of the ‘519 patent is attached hereto as Exhibit E and incorporated herein by
28 reference.

1 28. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
2 and interest in and to the '519 patent.

3 29. United States Patent No. 5,663,102 ("the '102 patent"), entitled "Method for Forming
4 Multi-Layered Metal Wiring Semiconductor Element Using CMP or Etch Back," duly and legally
5 issued September 2, 1997. A true and correct copy of the '102 patent is attached hereto as Exhibit F
6 and incorporated herein by reference.

7 30. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
8 and interest in and to the '102 patent.

9 31. United States Patent No. 5,807,728 ("the '728 Patent"), entitled "Thin Film Transistor
10 for Antistatic Circuit and Method for Fabricating the Same," duly and legally issued September 15,
11 1998. A true and correct copy of the '728 patent is attached hereto as Exhibit G and incorporated
12 herein by reference.

13 32. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
14 and interest in and to the '728 patent.

15 33. United States Patent No. 5,861,334 ("the '334 patent"), entitled "Method for
16 Fabricating Semiconductor Device Having A Buried Channel," duly and legally issued January 19,
17 1999. A true and correct copy of the '334 patent is attached hereto as Exhibit H and incorporated
18 herein by reference.

19 34. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
20 and interest in and to the '334 patent.

21 35. United States Patent No. 5,869,404 ("the '404 patent"), entitled "Method for Forming
22 Contact Hole of Semiconductor Device," duly and legally issued February 9, 1999. A true and correct
23 copy of the '404 patent is attached hereto as Exhibit I and incorporated herein by reference.

24 36. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
25 and interest in and to the '404 patent.

26 37. United States Patent No. 6,207,997 ("the '997 patent"), entitled "Thin Film Transistor
27 for Antistatic Circuit and Method for Fabricating the Same," duly and legally issued on March 27,
28 2001. A true and correct copy of the '997 patent is attached hereto as Exhibit J and incorporated

1 herein by reference.

2 38. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
3 and interest in and to the '997 patent.

4 39. United States Patent No. 6,330,190 ("the '190 patent") is entitled "Semiconductor
5 Structure for Flash Memory Enabling Low Operating Potentials," duly and legally issued on
6 December 11, 2001. A true and correct copy of the '190 patent is attached hereto as Exhibit K and
7 incorporated herein by reference.

8 40. HSI is, and at all time relevant to this action was, owner by assignment of all right, title
9 and interest in and to the '190 patent.

10 **FIRST COUNTERCLAIM**

11 **(Infringement of the '019 Patent)**

12 41. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
13 Counterclaims.

14 42. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
15 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '019 patent
16 by making, having made, using, selling, importing, and/or offering to sell products that were
17 manufactured using methods disclosed and claimed in the '019 patent within this judicial district and
18 elsewhere in the United States.

19 43. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
20 each of them, have infringed and continue to infringe the '019 patent by knowingly contributing to the
21 infringement of and/or inducing infringement by others of the '019 patent in this judicial district and
22 elsewhere in the United States.

23 44. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
24 infringement of the '019 patent has been willful, deliberate and in conscious disregard of HSI's rights,
25 making this an exceptional case within the meaning of 35 U.S.C. § 285.

26 45. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
27 each of them, will continue to infringe the '019 patent unless enjoined by this Court.

28 46. The Toshiba Counterdefendants' infringement of the '019 patent has caused, and

1 continues to cause, damage to HSI in an amount to be proven at trial.

2 **SECOND COUNTERCLAIM**

3 **(Infringement of the '111 Patent)**

4 47. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
5 Counterclaims.

6 48. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
7 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '111 patent
8 (including claims issued in Reexamination Certificate 4297) by making, having made, using, selling,
9 importing, and/or offering to sell products that were manufactured using methods *disclosed and claimed*
10 in the '111 patent within this judicial district and elsewhere in the United States.

11 49. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
12 each of them, have infringed and continue to infringe the '111 patent (including claims issued in
13 Reexamination Certificate 4297) by knowingly contributing to the infringement of and/or inducing
14 infringement by others of the '111 patent in this judicial district and elsewhere in the United States.

15 50. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
16 infringement of the '111 patent (including claims issued in Reexamination Certificate 4297) has been
17 willful, deliberate and in conscious disregard of HSI's rights, making this an exceptional case within the
18 meaning of 35 U.S.C. § 285.

19 51. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
20 each of them, will continue to infringe the '111 patent (including claims issued in Reexamination
21 Certificate 4297) unless enjoined by this Court.

22 52. The Toshiba Counterdefendants' infringement of the '111 patent (including claims issued
23 in Reexamination Certificate 4297) has caused, and continues to cause, damage to HSI in an amount to
24 be proven at trial.

25 **THIRD COUNTERCLAIM**

26 **(Infringement of the '311 Patent)**

27 53. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
28 Counterclaims.

1 elsewhere in the United States.

2 62. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
3 infringement of the '995 patent has been willful, deliberate and in conscious disregard of HSI's rights,
4 making this an exceptional case within the meaning of 35 U.S.C. § 285.

5 63. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
6 continue to infringe the '995 patent unless enjoined by this Court.

7 64. The Toshiba Counterdefendants' infringement of the '995 patent has caused, and
8 continues to cause, damage to HSI in an amount to be proven at trial.

9 **FIFTH COUNTERCLAIM**

10 **(Infringement of the '519 Patent)**

11 65. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
12 Counterclaims.

13 66. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
14 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '519 patent
15 by making, having made, using, selling, importing, and/or offering to sell products that were
16 manufactured using methods disclosed and claimed in the '519 patent within this judicial district and
17 elsewhere in the United States.

18 67. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
19 each of them, have infringed and continue to infringe the '519 patent by knowingly contributing to the
20 infringement of and/or inducing infringement by others of the '519 patent in this judicial district and
21 elsewhere in the United States.

22 68. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
23 infringement of the '519 patent has been willful, deliberate and in conscious disregard of HSI's rights,
24 making this an exceptional case within the meaning of 35 U.S.C. § 285.

25 69. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
26 continue to infringe the '519 patent unless enjoined by this Court.

27 70. The Toshiba Counterdefendants' infringement of the '519 patent has caused, and
28 continues to cause, damage to HSI in an amount to be proven at trial.

1 **SIXTH COUNTERCLAIM**

2 **(Infringement of the '102 Patent)**

3 71. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
4 Counterclaims.

5 72. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
6 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '102 patent
7 by making, having made, using, selling, importing, and/or offering to sell products that were
8 manufactured using methods disclosed and claimed in the '102 patent within this judicial district and
9 elsewhere in the United States.

10 73. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
11 each of them, have infringed and continue to infringe the '102 patent by knowingly contributing to the
12 infringement of and/or inducing infringement by others of the '102 patent in this judicial district and
13 elsewhere in the United States.

14 74. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
15 infringement of the '102 patent has been willful, deliberate and in conscious disregard of HSI's rights,
16 making this an exceptional case within the meaning of 35 U.S.C. § 285.

17 75. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
18 continue to infringe the '102 patent unless enjoined by this Court.

19 76. The Toshiba Counterdefendants' infringement of the '102 patent has caused, and
20 continues to cause, damage to HSI in an amount to be proven at trial.

21 **SEVENTH COUNTERCLAIM**

22 **(Infringement of the '728 Patent)**

23 77. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
24 Counterclaims.

25 78. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
26 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '728 patent
27 by making, having made, using, selling, importing, and/or offering to sell products that were
28 manufactured using methods disclosed and methods claimed in the '728 patent within this judicial district and

1 elsewhere in the United States.

2 79. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
3 each of them, have infringed and continue to infringe the '728 patent by knowingly contributing to the
4 infringement of and/or inducing infringement by others of the '728 patent in this judicial district and
5 elsewhere in the United States.

6 80. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
7 infringement of the '728 patent has been willful, deliberate and in conscious disregard of HSI's rights,
8 making this an exceptional case within the meaning of 35 U.S.C. § 285.

9 81. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
10 continue to infringe the '728 patent unless enjoined by this Court.

11 82. The Toshiba Counterdefendants' infringement of the '728 patent has caused, and
12 continues to cause, damage to HSI in an amount to be proven at trial.

13 **EIGHTH COUNTERCLAIM**

14 **(Infringement of the '334 Patent)**

15 83. HSI incorporates by reference the allegations set forth in paragraphs I through 40 of its
16 Counterclaims.

17 84. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
18 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '334 patent
19 by making, having made, using, selling, importing, and/or offering to sell products that were
20 manufactured using methods disclosed and claimed in the '334 patent within this judicial district and
21 elsewhere in the United States.

22 85. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
23 each of them, have infringed and continue to infringe the '334 patent by knowingly contributing to the
24 infringement of and/or inducing infringement by others of the '334 patent in this judicial district and
25 elsewhere in the United States.

26 86. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
27 infringement of the '334 patent has been willful, deliberate and in conscious disregard of HSI's rights,
28 making this an exceptional case within the meaning of 35 U.S.C. § 285.

1 87. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
2 continue to infringe the '334 patent unless enjoined by this Court.

3 88. The Toshiba Counterdefendants' infringement of the '334 patent has caused, and
4 continues to cause, damage to HSI in an amount to be proven at trial.

5 **NINTH COUNTERCLAIM**

6 **(Infringement of the '404 Patent)**

7 89. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
8 Counterclaims.

9 90. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
10 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '404 patent
11 by making, having made, using, selling, importing, and/or offering to sell products that were
12 manufactured using methods disclosed and claimed in the '404 patent within this judicial district and
13 elsewhere in the United States.

14 91. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
15 each of them, have infringed and continue to infringe the '404 patent by knowingly contributing to the
16 infringement of and/or inducing infringement by others of the '404 patent in this judicial district and
17 elsewhere in the United States.

18 92. HSI is informed and believes, and thereon alleges, Toshiba's infringement of the '404
19 patent has been willful, deliberate and in conscious disregard of HSI's rights, making this an exceptional
20 case within the meaning of 35 U.S.C. § 285.

21 93. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
22 continue to infringe the '404 patent unless enjoined by this Court.

23 94. The Toshiba Counterdefendants infringement of the '404 patent has caused, and continues
24 to cause, damage to HSI in an amount to be proven at trial.

25 **TENTH COUNTERCLAIM**

26 **(Infringement of the '997 Patent)**

27 95. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
28 Counterclaims.

1 96. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
2 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '997 patent
3 by making, having made, using, selling, importing, and/or offering to sell products that embody the
4 invention claimed in the '997 patent within this judicial district and elsewhere in the United States.

5 97. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
6 each of them, have infringed and continue to infringe the '997 patent by knowingly contributing to the
7 infringement of and/or inducing infringement by others of the '997 patent in this judicial district and
8 elsewhere in the United States.

9 98. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'
10 infringement of the '997 patent has been willful, deliberate and in conscious disregard of HSI's rights,
11 making this an exceptional case within the meaning of 35 U.S.C. § 285.

12 99. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
13 continue to infringe the '997 patent unless enjoined by this Court.

14 100. The Toshiba Counterdefendants, infringement of the '997 patent has caused, and
15 continues to cause, damage to HSI in an amount to be proven at trial.

16 **ELEVENTH COUNTERCLAIM**

17 **(Infringement of the '190 Patent)**

18 101. HSI incorporates by reference the allegations set forth in paragraphs 1 through 40 of its
19 Counterclaims.

20 102. Without the consent or authorization of HSI, Toshiba and TAEC, and upon information
21 and belief, TAI, TAIS, TACP, TAMS, and TABS, have infringed and continue to infringe the '190 patent
22 by making, having made, using, selling, importing, and/or offering to sell products that embody the
23 invention claimed in the '190 patent within this judicial district and elsewhere in the United States.

24 103. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants, and
25 each of them, have infringed and continue to infringe the '190 patent by knowingly contributing to the
26 infringement of and/or inducing infringement by others of the '190 patent in this judicial district and
27 elsewhere in the United States.

28 104. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants'

1 infringement of the '190 patent has been willful, deliberate and in conscious disregard of HSI's rights,
2 making this an exceptional case within the meaning of 35 U.S.C. § 285.

3 105. HSI is informed and believes, and thereon alleges, the Toshiba Counterdefendants will
4 continue to infringe the '190 patent unless enjoined by this Court.

5 106. The Toshiba Counterdefendants' infringement of the '190 patent has caused, and
6 continues to cause, damage to HSI in an amount to be proven at trial.

7 **PRAYER FOR RELIEF**

8 WHEREFORE, HSI prays for judgment in its favor and against the Toshiba
9 Counterdefendants as follows:

10 1. Declaring that United States Patent Nos. 4,718,019; 5,031,111 (including claims issued in
11 Reexamination Certificate 4297); 5,422,311; 5,509,995; 5,512,519; 5,663,102; 5,807,728; 5,861,334;
12 5,869,404; 6,207,997; and 6,330,190 and all claims therein are valid and enforceable;

13 2. Declaring that Toshiba Corporation, Toshiba America, Inc., Toshiba America Information
14 Systems, Inc., Toshiba America Consumer Products, L.L.C., Toshiba America Electronic
15 Components, Inc., Toshiba America Medical Systems, Inc., and Toshiba America Business Solutions,
16 Inc. have infringed United States Patent Nos. 4,718,019; 5,031,111 (including claims issued in
17 Reexamination Certificate 4297); 5,422,311; 5,509,995; 5,512,519; 5,663,102; 5,807,728; 5,861,334;
18 5,869,404; 6,207,997; and 6,330,190;

19 3. Preliminarily and permanently enjoining Toshiba Corporation, Toshiba America, Inc.,
20 Toshiba America Information Systems, Inc., Toshiba America Consumer Products, L.L.C., Toshiba
21 America Electronic Components, Inc., Toshiba America Medical Systems, Inc., and Toshiba America
22 Business Solutions, Inc. their officers, agents, employees, and those acting in privity with them, from
23 further infringement, contributory infringement or inducing infringement of United States Patent Nos.
24 4,718,019; 5,031,111 (including claims issued in Reexamination Certificate 4297); 5,422,311;
25 5,509,995; 5,512,519; 5,663,102; 5,807,728; 5,861,334; 5,869,404; 6,207,997; and 6,330,190;

26 4. Awarding the profits and other damages (including, but not limited, to a reasonable royalty)
27 arising out of said infringement of United States Patent Nos. 4,718,019; 5,031,111 (including claims
28 issued in Reexamination Certificate 4297); 5,422,311; 5,509,995; 5,512,519; 5,663,102; 5,807,728;

1 5,861,334; 5,869,404; 6,207,997; and 6,330,190, including trebled damages, to HSI, together with
2 prejudgment and post-judgment interest, in an amount according to proof;

3 5. Decreeing this to be an "exceptional case" within the meaning of 35 U.S.C. § 285 and
4 awarding reasonable attorney fees to HSI; and

5 6. Awarding HSI such other costs and further relief as the Court deems just and proper.

6 DATED: December 13, 2004

Respectfully submitted,

7 TOWNSEND and TOWNSEND and CREW LLP

8

9 By: /S/ Daniel J. Furniss

10 Daniel J. Furniss
Theodore G. Brown, III
Susan M. Spaeth

11

12 THELEN REID & PRIEST LLP
Kenneth L. Nissly
Susan van Keulen

13

14 Attorneys for Defendant/Counterclaimant
HYNIX SEMICONDUCTOR INC., and Defendant
HYNIX SEMICONDUCTOR AMERICA INC.

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DEMAND FOR JURY TRIAL

Defendants and Counterclaimant hereby demand a jury trial on all issues so triable.

DATED: December 13, 2004

Respectfully submitted,

TOWNSEND and TOWNSEND and CREW LLP

By: /S/ Daniel J. Furniss

Daniel J. Furniss
Theodore G. Brown, III
Susan M. Spaeth

THELEN REID & PRIEST LLP
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6 Attorneys for Plaintiff/Counterdefendant
TOSHIBA CORPORATION

7
8 UNITED STATES DISTRICT COURT
9 NORTHERN DISTRICT OF CALIFORNIA

10 TOSHIBA CORPORATION,

11 Plaintiff,

12 v.

13 HYNIX SEMICONDUCTOR INC., and
14 HYNIX SEMICONDUCTOR AMERICA
INC.

15 Defendants.

CASE NO. C-04-04708 VRW

**PLAINTIFF/COUNTERDEFENDANT
TOSHIBA CORPORATION'S REPLY TO
DEFENDANT/COUNTERCLAIMANT HYNIX
SEMICONDUCTOR INC.'S
COUNTERCLAIMS**

16 HYNIX SEMICONDUCTOR INC.,

17 Counterclaimant,

18 v.
19

20 TOSHIBA CORPORATION, TOSHIBA
AMERICA, INC., TOSHIBA AMERICA
21 INFORMATION SYSTEMS, INC.,
TOSHIBA AMERICA CONSUMER
22 PRODUCTS, L.L.C., TOSHIBA
AMERICA ELECTRONIC
23 COMPONENTS, INC., TOSHIBA
24 AMERICA MEDICAL SYSTEMS, INC.,
and TOSHIBA AMERICA BUSINESS
25 SOLUTIONS, INC.

26 Counterdefendants.
27
28

1 Plaintiff/Counterdefendant TOSHIBA CORPORATION ("TOSHIBA") answers
2 Defendant/Counterclaimant Hynix Semiconductor Inc.'s ("HSI") counterclaims as follows:

3 **THE PARTIES**

4 1. On information and belief, TOSHIBA admits the allegations of paragraph 1.

5 2. TOSHIBA admits the allegations of paragraph 2.

6 3. The allegations of paragraph 3 are not directed to TOSHIBA, and on that basis
7 TOSHIBA does not provide a response.

8 4. The allegations of paragraph 4 are not directed to TOSHIBA, and on that basis
9 TOSHIBA does not provide a response.

10 5. The allegations of paragraph 5 are not directed to TOSHIBA, and on that basis
11 TOSHIBA does not provide a response.

12 6. The allegations of paragraph 6 are not directed to TOSHIBA, and on that basis
13 TOSHIBA does not provide a response.

14 7. The allegations of paragraph 7 are not directed to TOSHIBA, and on that basis
15 TOSHIBA does not provide a response.

16 8. The allegations of paragraph 8 are not directed to TOSHIBA, and on that basis
17 TOSHIBA does not provide a response.

18 9. TOSHIBA avers that the definitional statement set forth in paragraph 9 does not
19 necessitate a response.

20 **JURISDICTION AND VENUE**

21 10. TOSHIBA admits that HSI purports to bring these counterclaims pursuant to 35
22 U.S.C. § 101, *et seq.* TOSHIBA further admits that jurisdiction is proper in this Court pursuant to
23 28 U.S.C. §§ 1331 and 1338. TOSHIBA further admits that venue is proper in this Court.

24 11. TOSHIBA admits that this Court has personal jurisdiction over TOSHIBA because
25 TOSHIBA has submitted to jurisdiction herein by commencing this action. Except as so
26 admitted, TOSHIBA denies the allegations contained in paragraph 11.

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1 12. The allegations of paragraph 12 are not directed to TOSHIBA, and on that basis
2 TOSHIBA does not provide a response.

3 13. The allegations of paragraph 13 are not directed to TOSHIBA, and on that basis
4 TOSHIBA does not provide a response.

5 14. The allegations of paragraph 14 are not directed to TOSHIBA, and on that basis
6 TOSHIBA does not provide a response.

7 15. The allegations of paragraph 15 are not directed to TOSHIBA, and on that basis
8 TOSHIBA does not provide a response.

9 16. The allegations of paragraph 16 are not directed to TOSHIBA, and on that basis
10 TOSHIBA does not provide a response.

11 17. The allegations of paragraph 17 are not directed to TOSHIBA, and on that basis
12 TOSHIBA does not provide a response.

13 **THE PATENTS**

14 18. TOSHIBA admits that on January 5, 1998, United States Patent No. 4,718,019 (the
15 "'019 patent") entitled *Electron Beam Exposure System and an Apparatus for Carrying Out a*
16 *Pattern Unwinder* was issued. TOSHIBA is without knowledge or information sufficient to form
17 a belief as to the remaining allegations of paragraph 18 and, on that basis, denies them.

18 19. On information and belief, TOSHIBA admits that HSI is the assignee and the
19 owner of all right, title, and interest in and to the '019 patent. TOSHIBA is without knowledge or
20 information sufficient to form a belief as to the remaining allegations of paragraph 19 and, on that
21 basis, denies them.

22 20. TOSHIBA admits that on July 9, 1991, United States Patent No. 5,031,111 ("the
23 '111 patent"), titled *Automated Circuit Design Method*, was issued. TOSHIBA is without
24 knowledge or information sufficient to form a belief as to the remaining allegations of paragraph
25 20 and, on that basis, denies them.

26 21. TOSHIBA admits that on March 27, 2001, Reexamination Certificate 4297 was
27 issued for the '111 patent. TOSHIBA is without knowledge or information sufficient to form a
28 belief as to the remaining allegations of paragraph 21 and, on that basis, denies them.

1 22. On information and belief, TOSHIBA admits that HSI is the assignee and the
2 owner of all right, title, and interest in and to the '111 patent. TOSHIBA is without knowledge or
3 information sufficient to form a belief as to the remaining allegations of paragraph 22 and, on that
4 basis, denies them.

5 23. TOSHIBA admits that on June 6, 1995, United States Patent No. 5,422,311 ("the
6 '311 patent"), titled *Method for Manufacturing a Conductor Layer in a Semiconductor Device*,
7 was issued. TOSHIBA is without knowledge or information sufficient to form a belief as to the
8 remaining allegations of paragraph 23 and, on that basis, denies them.

9 24. On information and belief, TOSHIBA admits that HSI is the assignee and owner
10 of all right, title and interest in and to the '311 patent. TOSHIBA is without knowledge or
11 information sufficient to form a belief as to the remaining allegations of paragraph 24 and, on that
12 basis, denies them.

13 25. TOSHIBA admits that on April 23, 1996, United States Patent No. 5,509,995 ("the
14 '995 patent"), titled *Process for Anisotropically Etching Semiconductor Material*, was issued.
15 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
16 allegations of paragraph 25 and, on that basis, denies them.

17 26. On information and belief, TOSHIBA admits that HSI is the assignee and the
18 owner of all right, title and interest in and to the '995 patent. TOSHIBA is without knowledge or
19 information sufficient to form a belief as to the remaining allegations of paragraph 26 and, on that
20 basis, denies them.

21 27. TOSHIBA admits that on April 30, 1996, United States Patent No. 5,512,519 ("the
22 '519 patent"), titled *Method of Forming a Silicon Insulating Layer in a Semiconductor Device*,
23 was issued. TOSHIBA is without knowledge or information sufficient to form a belief as to the
24 remaining allegations of paragraph 27 and, on that basis, denies them.

25 28. On information and belief, TOSHIBA admits that HSI is the assignee and the
26 owner of all right, title and interest in and to the '519 patent. TOSHIBA is without knowledge or
27 information sufficient to form a belief as to the remaining allegations of paragraph 28 and, on that
28 basis, denies them.

1 29. TOSHIBA admits that on September 2, 1997, United States Patent No. 5,663,102
2 ("the '102 patent"), titled *Method for Forming Multi-Layered Metal Wiring Semiconductor*
3 *Element Using CMP or Etch Back*, was issued. TOSHIBA is without knowledge or information
4 sufficient to form a belief as to the remaining allegations of paragraph 29 and, on that basis,
5 denies them.

6 30. On information and belief, TOSHIBA admits that HSI is the assignee and the
7 owner of all right, title and interest in and to the '102 patent. TOSHIBA is without knowledge or
8 information sufficient to form a belief as to the remaining allegations of paragraph 30 and, on that
9 basis, denies them.

10 31. TOSHIBA admits that on September 15, 1998, United States Patent No. 5,807,728
11 ("the '728 patent"), titled *Thin Film Transistor for Antistatic Circuit and Method for Fabricating*
12 *the Same*, was issued. TOSHIBA is without knowledge or information sufficient to form a belief
13 as to the remaining allegations of paragraph 31 and, on that basis, denies them.

14 32. On information and belief, TOSHIBA admits that HSI is the assignee and owner
15 of all right, title, and interest in and to the '728 patent. TOSHIBA is without knowledge or
16 information sufficient to form a belief as to the remaining allegations of paragraph 32 and, on that
17 basis, denies them.

18 33. TOSHIBA admits that on January 19, 1999, United States Patent No. 5,861,334
19 ("the '334 patent"), titled *Method for Fabricating Semiconductor Device Having a Buried*
20 *Channel*, was issued. TOSHIBA is without knowledge or information sufficient to form a belief
21 as to the remaining allegations of paragraph 33 and, on that basis, denies them.

22 34. On information and belief, TOSHIBA admits that HSI is the assignee and the
23 owner of all right, title, and interest in and to the '334 patent. TOSHIBA is without knowledge or
24 information sufficient to form a belief as to the remaining allegations of paragraph 34 and, on that
25 basis, denies them.

26 35. TOSHIBA admits that on February 9, 1999, United States Patent No. 5,869,404
27 ("the '404 patent"), titled *Method for Forming Contact Hole of Semiconductor Device*, was
28 issued. TOSHIBA is without knowledge or information sufficient to form a belief as to the

1 remaining allegations of paragraph 35 and, on that basis, denies them.

2 36. On information and belief, TOSHIBA admits that HSI is the assignee and the
3 owner of all right, title, and interest in and to the '404 patent. TOSHIBA is without knowledge or
4 information sufficient to form a belief as to the remaining allegations of paragraph 36 and, on that
5 basis, denies them.

6 37. TOSHIBA admits that on March 27, 2001, United States Patent No. 6,207,997
7 ("the '997 patent"), titled *Thin Film Transistor for Antistatic Circuit and Method for Fabricating*
8 *the Same*, was issued. TOSHIBA is without knowledge or information sufficient to form a belief
9 as to the remaining allegations of paragraph 37 and, on that basis, denies them.

10 38. On information and belief, TOSHIBA admits that HSI is the assignee and the
11 owner of all right, title, and interest in and to the '997 patent. TOSHIBA is without knowledge or
12 information sufficient to form a belief as to the remaining allegations of paragraph 38 and, on that
13 basis, denies them.

14 39. TOSHIBA admits that on December 11, 2001, United States Patent No. 6,330,190
15 ("the '190 patent"), titled *Semiconductor Structure for Flash Memory Enabling Low Operating*
16 *Potentials*, was issued. TOSHIBA is without knowledge or information sufficient to form a
17 belief as to the remaining allegations of paragraph 39 and, on that basis, denies them.

18 40. On information and belief, TOSHIBA admits that HSI is the assignee and the owner
19 of all right, title, and interest in and to the '190 patent. TOSHIBA is without knowledge or
20 information sufficient to form a belief as to the remaining allegations of paragraph 40 and, on that
21 basis, denies them.

22 **FIRST COUNTERCLAIM**

23 **(Infringement of the '019 patent)**

24 41. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
25 if fully set forth herein.

26 42. TOSHIBA denies the allegations of paragraph 42 directed to TOSHIBA.
27 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
28 allegations of paragraph 42 and, on that basis, denies them.

1 43. TOSHIBA denies the allegations of paragraph 43 directed to TOSHIBA.
2 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
3 allegations of paragraph 43 and, on that basis, denies them.

4 44. TOSHIBA denies the allegations of paragraph 44 directed to TOSHIBA.
5 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
6 allegations of paragraph 44 and, on that basis, denies them.

7 45. TOSHIBA denies the allegations of paragraph 45 directed to TOSHIBA.
8 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
9 allegations of paragraph 45 and, on that basis, denies them.

10 46. TOSHIBA denies the allegations of paragraph 46 directed to TOSHIBA.
11 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
12 allegations of paragraph 46 and, on that basis, denies them.

13 **SECOND COUNTERCLAIM**

14 **(Infringement of the '111 patent)**

15 47. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
16 if fully set forth herein.

17 48. TOSHIBA denies the allegations of paragraph 48 directed to TOSHIBA.
18 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
19 allegations of paragraph 48 and, on that basis, denies them.

20 49. TOSHIBA denies the allegations of paragraph 49 directed to TOSHIBA.
21 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
22 allegations of paragraph 49 and, on that basis, denies them.

23 50. TOSHIBA denies the allegations of paragraph 50 directed to TOSHIBA.
24 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
25 allegations of paragraph 50 and, on that basis, denies them.

26 51. TOSHIBA denies the allegations of paragraph 51 directed to TOSHIBA.
27 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
28 allegations of paragraph 51 and, on that basis, denies them.

1 52. TOSHIBA denies the allegations of paragraph 52 directed to TOSHIBA.
2 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
3 allegations of paragraph 52 and, on that basis, denies them.

4 **THIRD COUNTERCLAIM**

5 **(Infringement of the '311 patent)**

6 53. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
7 if fully set forth herein.

8 54. TOSHIBA denies the allegations of paragraph 54 directed to TOSHIBA.
9 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
10 allegations of paragraph 54 and, on that basis, denies them.

11 55. TOSHIBA denies the allegations of paragraph 55 directed to TOSHIBA.
12 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
13 allegations of paragraph 55 and, on that basis, denies them.

14 56. TOSHIBA denies the allegations of paragraph 56 directed to TOSHIBA.
15 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
16 allegations of paragraph 56 and, on that basis, denies them.

17 57. TOSHIBA denies the allegations of paragraph 57 directed to TOSHIBA.
18 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
19 allegations of paragraph 57 and, on that basis, denies them.

20 58. TOSHIBA denies the allegations of paragraph 58 directed to TOSHIBA.
21 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
22 allegations of paragraph 58 and, on that basis, denies them.

23 **FOURTH COUNTERCLAIM**

24 **(Infringement of the '995 patent)**

25 59. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
26 if fully set forth herein.

27 60. TOSHIBA denies the allegations of paragraph 60 directed to TOSHIBA.
28 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining

1 allegations of paragraph 60 and, on that basis, denies them.

2 61. TOSHIBA denies the allegations of paragraph 61 directed to TOSHIBA.
3 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
4 allegations of paragraph 61 and, on that basis, denies them.

5 62. TOSHIBA denies the allegations of paragraph 62 directed to TOSHIBA.
6 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
7 allegations of paragraph 62 and, on that basis, denies them.

8 63. TOSHIBA denies the allegations of paragraph 63 directed to TOSHIBA.
9 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
10 allegations of paragraph 63 and, on that basis, denies them.

11 64. TOSHIBA denies the allegations of paragraph 64 directed to TOSHIBA.
12 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
13 allegations of paragraph 64 and, on that basis, denies them.

14 **FIFTH COUNTERCLAIM**

15 **(Infringement of the '519 patent)**

16 65. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
17 if fully set forth herein.

18 66. TOSHIBA denies the allegations of paragraph 66 directed to TOSHIBA.
19 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
20 allegations of paragraph 66 and, on that basis, denies them.

21 67. TOSHIBA denies the allegations of paragraph 67 directed to TOSHIBA.
22 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
23 allegations of paragraph 67 and, on that basis, denies them.

24 68. TOSHIBA denies the allegations of paragraph 68 directed to TOSHIBA.
25 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
26 allegations of paragraph 68 and, on that basis, denies them.

27 69. TOSHIBA denies the allegations of paragraph 69 directed to TOSHIBA.
28 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining

1 allegations of paragraph 69 and, on that basis, denies them.

2 70. TOSHIBA denies the allegations of paragraph 70 directed to TOSHIBA.
3 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
4 allegations of paragraph 70 and, on that basis, denies them.

5 **SIXTH COUNTERCLAIM**

6 **(Infringement of the '102 patent)**

7 71. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
8 if fully set forth herein.

9 72. TOSHIBA denies the allegations of paragraph 72 directed to TOSHIBA.
10 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
11 allegations of paragraph 72 and, on that basis, denies them.

12 73. TOSHIBA denies the allegations of paragraph 73 directed to TOSHIBA.
13 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
14 allegations of paragraph 73 and, on that basis, denies them.

15 74. TOSHIBA denies the allegations of paragraph 74 directed to TOSHIBA.
16 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
17 allegations of paragraph 74 and, on that basis, denies them.

18 75. TOSHIBA denies the allegations of paragraph 75 directed to TOSHIBA.
19 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
20 allegations of paragraph 75 and, on that basis, denies them.

21 76. TOSHIBA denies the allegations of paragraph 76 directed to TOSHIBA.
22 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
23 allegations of paragraph 76 and, on that basis, denies them.

24 **SEVENTH COUNTERCLAIM**

25 **(Infringement of the '728 patent)**

26 77. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
27 if fully set forth herein.

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1 78. TOSHIBA denies the allegations of paragraph 78 directed to TOSHIBA.
2 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
3 allegations of paragraph 78 and, on that basis, denies them.

4 79. TOSHIBA denies the allegations of paragraph 79 directed to TOSHIBA.
5 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
6 allegations of paragraph 79 and, on that basis, denies them.

7 80. TOSHIBA denies the allegations of paragraph 80 directed to TOSHIBA.
8 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
9 allegations of paragraph 80 and, on that basis, denies them.

10 81. TOSHIBA denies the allegations of paragraph 81 directed to TOSHIBA.
11 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
12 allegations of paragraph 81 and, on that basis, denies them.

13 82. TOSHIBA denies the allegations of paragraph 82 directed to TOSHIBA.
14 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
15 allegations of paragraph 82 and, on that basis, denies them.

16 **EIGHTH COUNTERCLAIM**

17 **(Infringement of the '334 patent)**

18 83. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
19 if fully set forth herein.

20 84. TOSHIBA denies the allegations of paragraph 84 directed to TOSHIBA.
21 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
22 allegations of paragraph 84 and, on that basis, denies them.

23 85. TOSHIBA denies the allegations of paragraph 85 directed to TOSHIBA.
24 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
25 allegations of paragraph 85 and, on that basis, denies them.

26 86. TOSHIBA denies the allegations of paragraph 86 directed to TOSHIBA.
27 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
28 allegations of paragraph 86 and, on that basis, denies them.

1 87. TOSHIBA denies the allegations of paragraph 87 directed to TOSHIBA.
2 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
3 allegations of paragraph 87 and, on that basis, denies them.

4 88. TOSHIBA denies the allegations of paragraph 88 directed to TOSHIBA.
5 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
6 allegations of paragraph 88 and, on that basis, denies them.

7 **NINTH COUNTERCLAIM**

8 **(Infringement of the '404 patent)**

9 89. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
10 if fully set forth herein.

11 90. TOSHIBA denies the allegations of paragraph 90 directed to TOSHIBA.
12 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
13 allegations of paragraph 90 and, on that basis, denies them.

14 91. TOSHIBA denies the allegations of paragraph 91 directed to TOSHIBA.
15 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
16 allegations of paragraph 91 and, on that basis, denies them.

17 92. TOSHIBA denies the allegations of paragraph 92 directed to TOSHIBA.
18 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
19 allegations of paragraph 92 and, on that basis, denies them.

20 93. TOSHIBA denies the allegations of paragraph 93 directed to TOSHIBA.
21 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
22 allegations of paragraph 93 and, on that basis, denies them.

23 94. TOSHIBA denies the allegations of paragraph 94 directed to TOSHIBA.
24 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
25 allegations of paragraph 94 and, on that basis, denies them.

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TENTH COUNTERCLAIM

(Infringement of the '997 patent)

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3 95. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
4 if fully set forth herein.

5 96. TOSHIBA denies the allegations of paragraph 96 directed to TOSHIBA.
6 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
7 allegations of paragraph 96 and, on that basis, denies them.

8 97. TOSHIBA denies the allegations of paragraph 97 directed to TOSHIBA.
9 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
10 allegations of paragraph 97 and, on that basis, denies them.

11 98. TOSHIBA denies the allegations of paragraph 98 directed to TOSHIBA.
12 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
13 allegations of paragraph 98 and, on that basis, denies them.

14 99. TOSHIBA denies the allegations of paragraph 99 directed to TOSHIBA.
15 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
16 allegations of paragraph 99 and, on that basis, denies them.

17 100. TOSHIBA denies the allegations of paragraph 100 directed to TOSHIBA.
18 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
19 allegations of paragraph 100 and, on that basis, denies them.

ELEVENTH COUNTERCLAIM

(Infringement of the '190 patent)

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22 101. TOSHIBA incorporates by reference the responses to paragraphs 1 through 40 as
23 if fully set forth herein.

24 102. TOSHIBA denies the allegations of paragraph 102 directed to TOSHIBA.
25 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
26 allegations of paragraph 102 and, on that basis, denies them.

27 103. TOSHIBA denies the allegations of paragraph 103 directed to TOSHIBA.
28 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining

1 allegations of paragraph 103 and, on that basis, denies them.

2 104. TOSHIBA denies the allegations of paragraph 104 directed to TOSHIBA.
3 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
4 allegations of paragraph 104 and, on that basis, denies them.

5 105. TOSHIBA denies the allegations of paragraph 105 directed to TOSHIBA.
6 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
7 allegations of paragraph 105 and, on that basis, denies them.

8 106. TOSHIBA denies the allegations of paragraph 106 directed to TOSHIBA.
9 TOSHIBA is without knowledge or information sufficient to form a belief as to the remaining
10 allegations of paragraph 106 and, on that basis, denies them.

11 **HSI'S PRAYER FOR RELIEF**

12 TOSHIBA denies that any basis exists for relief in this case as requested by HSI.

13 **AFFIRMATIVE DEFENSES**

14 107. The '019 patent, the '111 patent, the '311 patent, the '995 patent, the '519 patent,
15 the '102 patent, the '728 patent, the '334 patent, the '404 patent, the '997 patent and the '190
16 patent are referred to collectively herein as the "HSI Patents."

17 For its further and separate affirmative defenses to HSI's counterclaims, TOSHIBA
18 alleges as follows:

19 **FIRST AFFIRMATIVE DEFENSE**

20 **(Failure to State a Claim)**

21 108. HSI's counterclaims and each and every one of its allegations fail to state a claim
22 upon which any relief may be granted.

23 **SECOND AFFIRMATIVE DEFENSE**

24 **(Invalidity)**

25 109. TOSHIBA is informed and believes, and thereon alleges, that each of the HSI
26 Patents is invalid, in whole or in part, because it fails to comply with the provisions of 35 U.S.C.
27 §§ 101, 102, 103 and/or 112, and each of HSI's counterclaims is therefore barred in whole or in
28 part.

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THIRD AFFIRMATIVE DEFENSE

(Non-Infringement)

110. TOSHIBA does not infringe any valid claims of any of the HSI Patents in the manner described in the counterclaims, or in any other manner.

111. To the extent the claims are interpreted to cover any accused device of TOSHIBA, each of the HSI Patents is invalid.

FOURTH AFFIRMATIVE DEFENSE

(Unclean Hands)

112. TOSHIBA is informed and believes, and thereon alleges, that HSI is barred from obtaining any relief sought in its counterclaims because of the doctrine of unclean hands.

FIFTH AFFIRMATIVE DEFENSE

(Damage Limitation)

113. TOSHIBA is informed and believes, and thereon alleges, that any counterclaim for damages for patent infringement by HSI is limited by 35 U.S.C. §§ 286 and/or 287.

SIXTH AFFIRMATIVE DEFENSE

(Waiver)

114. TOSHIBA is informed and believes, and thereon alleges, that HSI is barred from obtaining any relief sought in its counterclaims because of the doctrine of waiver.

SEVENTH AFFIRMATIVE DEFENSE

(Laches)

115. TOSHIBA is informed and believes, and thereon alleges, that HSI is barred from obtaining any relief sought in its counterclaims because of the doctrine of laches.

EIGHTH AFFIRMATIVE DEFENSE

(Equitable Estoppel)

116. TOSHIBA is informed and believes, and thereon alleges, that HSI is barred from obtaining any relief sought in its counterclaims because of the doctrine of equitable estoppel.

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NINTH AFFIRMATIVE DEFENSE

(Good Faith)

117. TOSHIBA has acted in good faith and without malice, and did not and does not directly infringe, induce infringement by others and/or contribute to infringement by others of any valid claims of any of the HSI Patents.

TENTH AFFIRMATIVE DEFENSE

(File History Estoppel)

118. TOSHIBA is informed and believes, and thereon alleges, that HSI is estopped by actions taken in the Patent and Trademark Office from claiming infringement of the HSI Patents.

ELEVENTH AFFIRMATIVE DEFENSE

(Prosecution History Estoppel)

119. TOSHIBA is informed and believes, and thereon alleges, that by reason of proceedings in the Patent and Trademark Office during the prosecution of the applications that resulted in the HSI Patents, as shown by their file histories, and by reason of the amendment, cancellation or abandonment of claims, and the admissions and other statements made therein by or on behalf of the patentee, HSI is estopped to claim constructions of the HSI Patents that would cause any valid claim thereof to cover or include any process or product sold or offered for sale by TOSHIBA.

TWELFTH AFFIRMATIVE DEFENSE

(Supplemental Defenses)

120. TOSHIBA hereby gives notice that it intends to rely on such other defenses and affirmative defenses as might become available or apparent during the course of discovery and thus reserves the right to amend this reply and serve such defenses or affirmative defenses and to otherwise supplement the foregoing affirmative defenses. TOSHIBA hereby adopts any defenses and affirmative defenses of its co-defendants to the extent they are applicable to the claims brought against it.

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TOSHIBA'S PRAYER FOR RELIEF

WHEREFORE, TOSHIBA prays for judgment as follows:

1. A judgment declaring that United States Patent Nos. 4,718,019; 5,031,111 (including claims issued in Reexamination Certificate 4297); 5,422,311; 5,509,995; 5,512,519; 5,663,102; 5,807,728; 5,861,334; 5,869,404; 6,207,997; and 6,330,190 are invalid and unenforceable;

2. A judgment declaring that TOSHIBA has not infringed and does not infringe, in any manner or in any way, any valid claim of United States Patent Nos. 4,718,019; 5,031,111 (including claims issued in Reexamination Certificate 4297); 5,422,311; 5,509,995; 5,512,519; 5,663,102; 5,807,728; 5,861,334; 5,869,404; 6,207,997; and 6,330,190;


3. A judgment that this is an "exceptional" case and TOSHIBA is therefore entitled to its reasonable attorneys' fees incurred in this action pursuant to 35 U.S.C. § 285;

4. A judgment that TOSHIBA is entitled to its costs incurred in this action;

5. Such other and further equitable and legal relief as the Court or a jury deems just and proper.

Dated: January 3, 2005

DLA PIPER RUDNICK GRAY CARY US LLP

By 
MARK FOWLER
RONALD L. YIN
ALAN LIMBACH
VINCENT LAM
Attorneys for Plaintiff/Counterdefendant
TOSHIBA CORPORATION