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Attorney for Plaintiff
XILINX, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION

XILINX, INC.,
Plaintiff,
v.

DETELLE RELAY KG, LLC,
ROLDAN BLOCK NY, LLC,
LATROSSE TECHNOLOGIES, LLC,
TR TECHNOLOGIES FOUNDATION LLC,
TAICHI HOLDINGS, LLC,
NOREGIN ASSETS N.V., LLC,
INTELLECTUAL VENTURE FUNDING
LLC,
Defendants.

Case No. 3:11-cv-04407-SI

**SECOND AMENDED COMPLAINT
FOR PATENT NON-INFRINGEMENT
AND INVALIDITY**

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 15(a)(1), Xilinx, Inc. ("Xilinx" or "Plaintiff"),
by and through its undersigned counsel, amends its Complaint against Detelle Relay KG, LLC,

1 Roldan Block NY, LLC, Latrosse Technologies, LLC, TR Technologies Foundation LLC,
 2 Taichi Holdings, LLC, Noregin Assets N.V., LLC, and Intellectual Venture Funding LLC, as
 3 follows:

4 **NATURE OF THE ACTION**

5 1. In this action, Xilinx seeks a declaration that certain products made, used, sold, or
 6 imported by Xilinx (“the Accused Products”) do not infringe several patents asserted by
 7 Defendants against Xilinx (“the Asserted Patents”). Xilinx also seeks a declaration of invalidity
 8 and non-infringement of the Asserted Patents.

9 **JURISDICTION AND VENUE**

10 2. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 *et seq.*,
 11 under the patent laws of the United States, Title 35 of the United States Code. This Court has
 12 subject-matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338, 1367, 2201, and 2202.

13 3. This Court has personal jurisdiction over Defendants by virtue of their sufficient
 14 minimum contacts with this forum as a result of the business they conduct within the State of
 15 California and within the Northern District of California.

16 4. Venue is proper in this district pursuant to 28 U.S.C. §§ 1391(b)-(c) and 1400(b).

17 **INTRADISTRICT ASSIGNMENT**

18 5. For purposes of intradistrict assignment pursuant to Civil Local Rules 3-2(c) and 3-
 19 5(b), this Intellectual Property Action is to be assigned on a district-wide basis.

20 **THE PATENTS-IN-SUIT**

21 6. The United States Patent and Trademark Office (the “USPTO”) issued United States
 22 Patent No. 5,524,251 (“the ’251 patent”), entitled “Microcomputer having ALU Performing Min
 23 and Max Operations,” on June 4, 1996. On June 3, 2011, the USPTO granted *ex parte*
 24 reexamination of all claims of the ’251 patent on the basis that a substantial new question of
 25 patentability exists as to those claims in light of prior art that was not previously before the
 26 USPTO. On August 18, 2011, the USPTO issued an Office Action rejecting all eleven (11)
 27 claims. On October 18, 2011, Detelle Relay KG, LLC (“Detelle”) filed a response adding ten
 28 (10) new claims. On November 18, 2011, the USPTO issued a Final Office Action rejecting

1 original claims 1, 10, and 11 and new claims 12 and 21, and confirming the other sixteen (16)
2 claims. On January 18, 2012, Detelle filed a response adding an additional eight (8) claims. On
3 February 1, 2012, the USPTO issued an Advisory Action maintaining the rejection of claims 1,
4 10-12, and 21 and refusing to enter the additional eight (8) claims.

5 7. The USPTO issued United States Patent No. 5,751,736 (“the ’736 patent”), entitled
6 “Testable Electronic System,” on May 12, 1998. On May 27, 2011, the USPTO granted *ex parte*
7 reexamination of all eight (8) claims of the ’736 patent on the basis that a substantial new
8 question of patentability exists as to those claims in light of prior art that was not previously
9 before the USPTO. On December 20, 2011, the USPTO issued an Office Action rejecting claims
10 1-4. On January 31, 2012, Roldan Block NY, LLC (“Roldan”) requested an extension until
11 March 5, 2012 to file a response.

12 8. The USPTO issued United States Patent No. 5,887,165 (“the ’165 patent”), entitled
13 “Dynamically Reconfigurable Hardware System for Real-time Control of Processes,” on March
14 23, 1999. On May 12, 2011, the USPTO granted *ex parte* reexamination of all eleven (11) claims
15 of the ’165 patent on the basis that a substantial new question of patentability exists as to those
16 claims in light of prior art that was not previously before the USPTO. On October 28, 2011, the
17 USPTO issued an Office Action rejecting all eleven (11) claims. On December 28, 2011,
18 Latrosse Technologies, LLC (“Latrosse”) filed a response amending four (4) claims and adding
19 nineteen (19) new claims.

20 9. The USPTO issued United States Patent No. 6,321,331 (“the ’331 patent”), entitled
21 “Real Time Debugger Interface for Embedded Systems,” on November 20, 2001. On April 8,
22 2011, the USPTO granted *ex parte* reexamination of claims 1-5, 11-15, and 19-22 (of 22 total
23 claims) of the ’331 patent on the basis that a substantial new question of patentability exists as to
24 those claims in light of prior art that was not previously before the USPTO. On July 29, 2011, the
25 USPTO issued an Office Action rejecting all the claims subject to the reexamination. On
26 September 27, 2011, TR Technologies Foundation LLC (“TRTF”) filed a response amending
27 three (3) claims and adding thirty-four (34) new claims. On November 2, 2011, the USPTO
28 issued a Final Office Action rejecting claims 26-32, 37-42, 45-49, and 56 and confirming claims

1 1-25, 33-36, 43, 44, and 50-55. On January 3, 2012, TRTF filed a response cancelling claim 37.
 2 On January 26, 2012, the USPTO issued an Advisory Action confirming claim 38 and
 3 maintaining the rejection of claims 26-32, 39-42, 45-49, and 56.

4 10. The USPTO issued United States Patent No. 6,747,350 (“the ’350 patent”), entitled
 5 “Flip Chip Package Structure,” on June 8, 2004. On April 22, 2011, the USPTO granted *inter*
 6 *partes* reexamination of all 10 claims of the ’350 patent on the basis that a substantial new
 7 question of patentability exists as to those claims in light of prior art that was not previously
 8 before the USPTO, and issued an Office Action rejecting the claims. On June 22, 2011, Taichi
 9 Holdings, LLC (“Taichi”) filed a response adding twenty (20) new claims, which was rejected by
 10 the USPTO due to improper length. On November 14, 2011, Taichi filed an amended response
 11 including the twenty (20) new claims from their June 22, 2011 response. On December 14, 2011,
 12 Xilinx filed reply comments.

13 11. The USPTO issued United States Patent No. 6,768,497 (“the ’497 patent”), entitled
 14 “Elastic Presentation Space,” on July 27, 2004. On September 28, 2011, the USPTO granted
 15 *inter partes* reexamination of claims 1-22, 24-50, 52-74, and 76-99 (of 100 total claims) of the
 16 ’497 patent on the basis that a substantial new question of patentability exists as to those claims in
 17 light of prior art that was not previously before the USPTO, and on the same date the USPTO
 18 issued an Office Action rejecting all the claims subject to reexamination. On November 28,
 19 2011, Noregin Assets N.V., LLC (“Noregin”) filed a response adding forty-four (44) new claims.

20 12. The USPTO issued United States Patent No. 7,100,061 (“the ’061 patent”), entitled
 21 “Adaptive Power Control,” on August 29, 2006. An *inter partes* reexamination certificate was
 22 issued on August 4, 2009.

23 **THE PARTIES**

24 **Plaintiff**

25 13. Xilinx is a Delaware corporation with its principal place of business at 2100 Logic
 26 Drive, San Jose, California 95124. Xilinx is engaged in the business of designing, developing,
 27 and marketing complete programmable logic solutions, including advanced integrated circuits,
 28

1 software design tools, predefined system functions delivered as intellectual property cores, design
2 services, customer training, field engineering, and customer support.

3 **Defendants and Related Parties**

4 14. Upon information and belief, Intellectual Ventures, LLC (“Intellectual Ventures”)
5 and Intellectual Ventures Management, LLC (“IV Management”) are Washington limited liability
6 companies each with their principal place of business at 3150 139th Avenue SE, Building 4,
7 Bellevue, Washington 98005.

8 15. Upon information and belief, Intellectual Ventures and IV Management maintain
9 offices and employees within this District.

10 16. Upon information and belief, Intellectual Ventures and IV Management are in the
11 business of acquiring, licensing and/or enforcing patents and patent portfolios.

12 17. Upon information and belief, Defendant Detelle is a Delaware limited liability
13 company with a Registered Agent located at 2711 Centerville Road, Suite 400, Wilmington,
14 Delaware 19808. Detelle is the assignee of record with the USPTO of the ’251 patent.

15 18. Upon information and belief, Defendant Roldan is a Delaware limited liability
16 company with a Registered Agent located at 160 Greentree Drive, Suite 101, Dover, Delaware
17 19904. Roldan is the assignee of record with the USPTO of the ’736 patent.

18 19. Upon information and belief, Defendant Latrosse is a Delaware limited liability
19 company with a Registered Agent located at 2711 Centerville Road, Suite 400, Wilmington,
20 Delaware 19808. Latrosse is the assignee of record with the USPTO of the ’165 patent.

21 20. Upon information and belief, Defendant TRTF is a Delaware limited liability
22 company with a Registered Agent located at 2711 Centerville Road, Suite 400, Wilmington,
23 Delaware 19808. TRTF is the assignee of record with the USPTO of the ’331 patent.

24 21. Upon information and belief, Defendant Taichi is a Delaware limited liability
25 company with a Registered Agent located at 2711 Centerville Road, Suite 400, Wilmington,
26 Delaware 19808. Taichi is the assignee of record with the USPTO of the ’350 patent.

22. Upon information and belief, Defendant Noregin is a Delaware limited liability company with a Registered Agent located at 160 Greentree Drive, Suite 101, Dover, Delaware 19904. Noregin is the assignee of record with the USPTO of the '497 patent.

23. Upon information and belief, Defendant Intellectual Venture Funding, LLC ("IVF") is a Nevada limited liability company with a Registered Agent located at 2215-b Renaissance Drive, Las Vegas, NV 89119. IVF is the assignee of record with the USPTO of the '061 patent. IVF is a known affiliate of Intellectual Ventures and IV Management.

24. Upon information and belief Defendants Detelle, Roldan, Latrosse, TRTF, Taichi, Noregin, and IVF are each acting as holding companies for the respective Asserted Patents and their activities relating to those patents are being directed by Intellectual Ventures and/or IV Management. Defendants Detelle, Roldan, Latrosse, TRTF, Taichi, Noregin, and IVF are collectively referred to throughout this Complaint as the "IV Holding Companies."

Activities in California Relevant to the Action

25. Intellectual Ventures and IV Management were founded in 1999 and 2000, respectively, by Nathan Myhrvold, Edward Jung, Peter Detkin and Greg Gorder. Intellectual Ventures and IV Management have the same directors and management and otherwise appear to operate as a single entity.

26. In a recent complaint filed with the U.S. International Trade Commission, IV Management stated that it "oversees the entire family of companies known in the industry . . . as 'Intellectual Ventures.'" Certain Dynamic Random Access Memory and NAND Flash Memory Devices and Products Containing Same, Inv. No. 337-TA-___, USITC Docket No. 2829 (July 12, 2011), ¶ 7.

27. Together Intellectual Ventures and IV Management make up what has been called one of the world's largest patent holding companies. Intellectual Ventures and IV Management claim to own rights to more than 30,000 patents and intellectual property assets, which they acquire, group into portfolios, and market to investors through their private IP funds ("IP Funds").

28. Upon information and belief, Intellectual Ventures and IV Management own the IP in their portfolio through a network of holding companies, which Intellectual Ventures and IV

1 Management refer to as their “affiliates.” *See* Defendants’ Motion to Dismiss Xilinx’s Complaint
2 for Declaratory Judgment, ECF 39 at 3. Upon information and belief, Defendants Detelle,
3 Roldan, Latrosse, TRTF, Taichi, Noregin, and IVF are seven such affiliates or holding
4 companies.

5 29. Intellectual Ventures and/or IV Management maintain an office and employees
6 within this District. Upon information and belief, Mr. Joe Chernesky, a Vice President and
7 General Manager of Intellectual Ventures and IV Management’s Hardware Intellectual Property
8 group, and Mr. Mark Wilson, a Licensing Executive, both work at Intellectual Ventures and IV
9 Management’s Silicon Valley office.

10 30. In 2004, Xilinx was approached by representatives from Intellectual Ventures and/or
11 IV Management about becoming an investor in one of their IP Funds, Intellectual Ventures Fund
12 I (“Fund I”). During the course of the negotiations, representatives from Intellectual Ventures
13 and/or IV Management, including Peter Detkin and/or Gregory Gorder, communicated with
14 Xilinx by email and telephone, and attended in-person meetings with Xilinx in California.

15 31. In 2005, following extensive negotiations, Xilinx and various companies related to
16 Intellectual Ventures and IV Management executed several agreements pursuant to which Xilinx
17 became a limited partner of Fund I. Xilinx’s representatives executed the agreements in San Jose,
18 California on behalf of Xilinx.

19 32. In 2008, after several months of negotiations, again initiated by representatives from
20 Intellectual Ventures and/or IV Management, Xilinx became a non-managing member of
21 Intellectual Ventures Fund II (“Fund II”).

22 33. Also in 2008, Intellectual Ventures and/or IV Management, and their affiliate Fund
23 I, issued acquisition notices informing Xilinx that Fund I acquired an interest in the ’251, and
24 ’331 patents.

25 34. In 2009, Intellectual Ventures and/or IV Management, and their affiliate Fund II,
26 issued an acquisition notice informing Xilinx that Fund II acquired an interest in the ’497 and
27 ’736 patents

28 35. In 2010, Intellectual Ventures and/or IV Management, and their affiliate Fund II,

1 issued acquisition notices informing Xilinx that Fund II acquired an interest in the '061, '165, and
2 '350 patents.

3 36. In or about the summer of 2010, representatives from Intellectual Ventures and/or
4 IV Management contacted Xilinx to request Xilinx make additional investments in the Funds and
5 take licenses to certain patent portfolios belonging to the Funds which together contained over
6 500 patents. Representatives from Intellectual Ventures and/or IV Management refused to even
7 consider granting Xilinx licenses to individual patents, and Xilinx declined to pay for licenses to
8 the portfolios.

9 37. In December 2010, representatives from Intellectual Ventures and/or IV
10 Management again began to pressure Xilinx into making additional investments in Fund I and
11 Fund II. As part of its campaign, representatives from Intellectual Ventures and/or IV
12 Management, including Mr. Chernesky, sent Xilinx emails and met with Xilinx in person at
13 Xilinx's headquarters in San Jose and at Xilinx's counsel's offices in Palo Alto.

14 38. In an email dated December 7, 2010, Mr. Chernesky identified 16 patents (including
15 the Asserted Patents) that representatives from Intellectual Ventures and/or IV Management claim
16 are infringed by Xilinx products. Shortly thereafter, representatives from Intellectual Ventures
17 and/or IV Management provided Xilinx with claim charts that are identified as having been
18 prepared by Intellectual Ventures and/or IV Management, and that purport to map Xilinx's
19 Accused Products with claim terms of some of the Asserted Patents, including the '251, '736,
20 '165, '331, '350, and '497 patents. The cover sheet for each of the claim charts prominently
21 displayed the Intellectual Ventures' logo used by IV Management, included a copyright notice to
22 "Intellectual Ventures Management, LLC (IV)," and that purport to map claim terms of the
23 Asserted Patents on Xilinx's Accused Products.

24 39. None of the claim charts indicate that the charted patent was owned or was being
25 asserted by any other party, including any of the IV Holding Companies. On information and
26 belief, the claim charts were prepared by representatives from Intellectual Ventures and/or IV
27 Management and provided to Xilinx. On information and belief, by accusing Xilinx of infringing
28 the Asserted Patents and demanding that Xilinx enter into a license to various patent portfolios,

representatives from Intellectual Ventures and/or IV Management were acting as though they had the right to enforce the Asserted Patents against Xilinx. On information and belief the representatives of Intellectual Ventures and/or IV Management were acting as agents of the IV Holding Companies, or were otherwise acting on behalf of the IV Holding Companies as the owners of the Asserted Patents.

FIRST COUNT

(Declaratory Judgment of Non-Infringement of the '251 Patent)

(Against Defendant Detelle)

40. The allegations contained in paragraphs 1 through 39 are incorporated by reference as if fully set herein.

41. Defendant Detelle is the assignee of record with the USPTO of the '251 patent. Upon information and belief, Detelle is the owner and assignee of all rights, title, and interest in and under the '251 patent.

42. Representatives from Intellectual Ventures and/or IV Management, acting on behalf of and as the agent for Detelle, have accused Xilinx of infringing at least Claim 1 of the '251 patent through its manufacture, sale, offering for sale, use, and/or importation of certain integrated circuits allegedly containing an ARM dual-core Cortex™A9 MPCore Processor, and have asserted that Xilinx must take a license to the '251 patent to lawfully continue the manufacture, sale, offering for sale, use, and/or importation of such integrated circuits.

43. Xilinx has informed Defendants that Xilinx contends it has the right to engage in the manufacture, sale, offering for sale, use, and/or importation of these integrated circuits without a license to the '251 patent.

44. Under all the circumstances in this dispute, Defendants have, at a minimum, created a substantial, immediate, and real controversy between the parties as to the non-infringement of the '251 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants within the meaning of 28 U.S.C. § 2201.

45. Upon information and belief, Xilinx has not directly or indirectly infringed any valid and enforceable claim of the '251 patent, either literally or under the doctrine of equivalents

1 because none of its integrated circuits, including those Xilinx integrated circuits allegedly
2 containing an ARM dual-core Cortex™A9 MPCore Processor, including at least Xilinx's 28 nm
3 programmable logic products such as the 7 Series FPGAs, practice Claim 1 or any valid claim of
4 the '251 patent.

5 46. A judicial declaration of non-infringement of the '251 patent is necessary and
6 appropriate in order to resolve this controversy.

7 **SECOND COUNT**

8 **(Declaratory Judgment of Invalidity of the '251 Patent)**

9 **(Against Defendant Detelle)**

10 47. The allegations contained in paragraphs 1 through 46 are incorporated by reference
11 as if fully set herein.

12 48. Under all the circumstances in this dispute, Defendants have, at a minimum, created
13 a substantial, immediate, and real controversy between the parties as to the invalidity of the '251
14 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants
15 within the meaning of 28 U.S.C. § 2201.

16 49. Upon information and belief, the '251 patent is invalid because of its failure to
17 comply with one or more of the requirements of the patent laws of the United States, including,
18 without limitation, at least 35 U.S.C. §§ 102, 103, and/or 112.

19 50. At least Claims 1-11 of the '251 patent are invalid as anticipated and/or obvious over
20 multiple prior art references that were not before the patent examiner during the prosecution of
21 the '251 patent, including but not limited to U.S. Patent No. 4,774,688, and the Signetics, 68000
22 16-/32-Bit Microprocessor publication. Had the patent examiner known or been made aware of
23 these prior art references, the claims would not have been allowed and the '251 patent would not
24 have issued.

25 51. The USPTO has already determined that these references raise a substantial new
26 question of patentability of the '251 patent and has issued an Office Action rejecting all claims of
27 the patent.
28

1 52. At least Claims 1-11 of the '251 patent are not sufficiently enabled because the
2 specification does not "contain a written description of the invention, and the manner and process
3 of making and using it . . . to enable any person skilled in the art to which it pertains, or with
4 which it is most nearly connected, to make and use the same," as required by 35 U.S.C. § 112.
5 One such example of a non-enabled claim limitation is "multiplication and division operations."

6 53. Xilinx will provide additional and more detailed invalidity contentions as required
7 by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise
8 ordered by the Court.

9 54. A judicial declaration of invalidity of the '251 patent is necessary and appropriate in
10 order to resolve this controversy.

11 **THIRD COUNT**

12 **(Declaratory Judgment of Non-Infringement of the '736 Patent)**

13 **(Against Defendant Roldan)**

14 55. The allegations contained in paragraphs 1 through 54 are incorporated by reference
15 as if fully set herein.

16 56. Defendant Roldan is the assignee of record with the USPTO of the '736 patent.
17 Upon information and belief, Roldan is the owner and assignee of all rights, title, and interest in
18 and under the '736 patent.

19 57. Representatives from Intellectual Ventures and/or IV Management, acting on behalf
20 of and as the agent for Roldan, have accused Xilinx of infringing at least Claim 1 of the '736
21 patent through its manufacture, sale, offering for sale, use, and/or importation of certain
22 integrated circuits, including Xilinx's Spartan-6 FPGAs, and have asserted that Xilinx must take a
23 license to the '736 patent to lawfully continue the manufacture, sale, offering for sale, use, and/or
24 importation of such integrated circuits.

25 58. Xilinx has informed Defendants that Xilinx contends it has the right to engage in the
26 manufacture, sale, offering for sale, use, and/or importation of these integrated circuits without a
27 license to the '736 patent.
28

59. Under all the circumstances in this dispute, Defendants have, at a minimum, created a substantial, immediate, and real controversy between the parties as to the non-infringement of the '736 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants within the meaning of 28 U.S.C. § 2201.

60. Upon information and belief, Xilinx has not directly or indirectly infringed any valid and enforceable claim of the '736 patent, either literally or under the doctrine of equivalents because none of its integrated circuits, including Xilinx's Spartan-6 FPGAs, practice Claim 1 or any valid claim of the '736 patent.

61. A judicial declaration of non-infringement of the '736 patent is necessary and appropriate in order to resolve this controversy.

FOURTH COUNT

(Declaratory Judgment of Invalidity of the '736 Patent)

(Against Defendant Roldan)

62. The allegations contained in paragraphs 1 through 61 are incorporated by reference as if fully set herein.

63. Under all the circumstances in this dispute, Defendants have, at a minimum, created a substantial, immediate, and real controversy between the parties as to the invalidity of the '736 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants within the meaning of 28 U.S.C. § 2201.

64. Upon information and belief, the '736 patent is invalid because of its failure to comply with one or more of the requirements of the patent laws of the United States, including, without limitation, at least 35 U.S.C. §§ 102, 103, and/or 112.

65. At least Claims 1-8 of the '736 patent are invalid as anticipated and/or obvious over multiple prior art references that were not before the patent examiner during the prosecution of the '736 patent, including but not limited to U.S. Patent Nos. 4,947,357 and 5,748,497; the European Patent Application 0578386A2, 1/12/1994, L. Whetsel, Int. Cl. G06F 13/40; and the publication J. Hirst et al., "Infinite Versions Of Some Problems From Finite Complexity Theory," Cornell University Library, March 10, 1995. Had the patent examiner known or been made

1 aware of these prior art references, the claims would not have been allowed and the '736 patent
2 would not have issued.

3 66. The USPTO has already determined that these references raise substantial new
4 questions of patentability of the '736 patent.

5 67. At least Claims 1-8 of the '736 patent are not sufficiently definite to "distinctly
6 claim[] the subject matter which the applicant regards as his invention," as required by 35 U.S.C.
7 § 112. One such example of a claim limitation that is indefinite under § 112 is "an identifier."

8 68. Xilinx will provide additional and more detailed invalidity contentions as required
9 by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise
10 ordered by the Court.

11 69. A judicial declaration of invalidity of the '736 patent is necessary and appropriate in
12 order to resolve this controversy.

13 **FIFTH COUNT**

14 **(Declaratory Judgment of Non-Infringement of the '165 Patent)**

15 **(Against Defendant Latrosse)**

16 70. The allegations contained in paragraphs 1 through 69 are incorporated by reference
17 as if fully set herein.

18 71. Defendant Latrosse is the assignee of record with the USPTO of the '165 patent.
19 Upon information and belief, Latrosse is the owner and assignee of all rights, title, and interest in
20 and under the '165 patent.

21 72. Representatives from Intellectual Ventures and/or IV Management, acting on behalf
22 of and as the agent for Latrosse, have accused Xilinx of infringing at least Claim 1 of the '165
23 patent through its manufacture, sale, offering for sale, use, and/or importation of certain
24 integrated circuits, including the Xilinx Virtex-5 ML50x evaluation platforms, and have asserted
25 that Xilinx must take a license to the '165 patent to lawfully continue the manufacture, sale,
26 offering for sale, use, and/or importation of such evaluation platforms.

73. Xilinx has informed Defendants that Xilinx contends it has the right to engage in the manufacture, sale, offering for sale, use, and/or importation of these evaluation platforms without a license to the '165 patent.

74. Under all the circumstances in this dispute, Defendants have, at a minimum, created a substantial, immediate, and real controversy between the parties as to the non-infringement of the '165 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants within the meaning of 28 U.S.C. § 2201.

75. Upon information and belief, Xilinx has not directly or indirectly infringed any valid and enforceable claim of the '165 patent, either literally or under the doctrine of equivalents because none of its evaluation platforms, including the Xilinx Virtex-5 ML50x evaluation platforms, practice Claim 1 or any valid claim of the '165 patent.

76. A judicial declaration of non-infringement of the '165 patent is necessary and appropriate in order to resolve this controversy.

SIXTH COUNT

(Declaratory Judgment of Invalidity of the '165 Patent)

(Against Defendant Latrosse)

77. The allegations contained in paragraphs 1 through 76 are incorporated by reference as if fully set herein.

78. Under all the circumstances in this dispute, Defendants have, at a minimum, created a substantial, immediate, and real controversy between the parties as to the invalidity of the '165 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants within the meaning of 28 U.S.C. § 2201.

79. Upon information and belief, the '165 patent is invalid because of its failure to comply with one or more of the requirements of the patent laws of the United States, including, without limitation, at least 35 U.S.C. §§ 102, 103, and/or 112.

80. At least Claims 1-11 of the '165 patent are invalid as anticipated and/or obvious over multiple prior art references that were not before the patent examiner during the prosecution of the '165 patent, including but not limited to U.S. Patent Nos. 5,859,878; 5,559,450; 5,815,415;

1 and 5,784,648. Had the patent examiner known or been made aware of these prior art references,
2 the claims would not have been allowed and the '165 patent would not have issued.

3 81. The USPTO has already determined that these references raise a substantial new
4 question of patentability of the '165 patent.

5 82. At least Claims 1-9 of the '165 patent are not sufficiently definite to "distinctly
6 claim[] the subject matter which the applicant regards as his invention," as required by 35 U.S.C.
7 § 112. One such example of a claim limitation that is indefinite under § 112 is "independently of
8 the real-time control of the external device."

9 83. Xilinx will provide additional and more detailed invalidity contentions as required
10 by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise
11 ordered by the Court.

12 84. A judicial declaration of invalidity of the '165 patent is necessary and appropriate in
13 order to resolve this controversy.

14 **SEVENTH COUNT**

15 **(Declaratory Judgment of Non-Infringement of the '331 Patent)**

16 **(Against Defendant TRTF)**

17 85. The allegations contained in paragraphs 1 through 84 are incorporated by reference
18 as if fully set herein.

19 86. Defendant TRTF is the assignee of record with the USPTO of the '331 patent. Upon
20 information and belief, TRTF is the owner and assignee of all rights, title, and interest in and
21 under the '331 patent.

22 87. Representatives from Intellectual Ventures and/or IV Management, acting on behalf
23 of and as the agent for TRTF, have accused Xilinx of infringing at least Claim 21 of the '331
24 patent through its manufacture, sale, offering for sale, use, and/or importation of certain
25 integrated circuits allegedly containing an ARM dual-core Cortex™A9 MPCore Processor, and
26 have asserted that Xilinx must take a license to the '331 patent to lawfully continue the
27 manufacture, sale, offering for sale, use, and/or importation of such integrated circuits.
28

88. Xilinx has informed Defendants that Xilinx contends it has the right to engage in the manufacture, sale, offering for sale, use, and/or importation of these integrated circuits without a license to the '331 patent.

89. Under all the circumstances in this dispute, Defendants have, at a minimum, created a substantial, immediate, and real controversy between the parties as to the non-infringement of the '331 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants within the meaning of 28 U.S.C. § 2201.

90. Upon information and belief, Xilinx has not directly or indirectly infringed any valid and enforceable claim of the '331 patent, either literally or under the doctrine of equivalents because none of its integrated circuits allegedly containing an ARM dual-core Cortex™A9 MPCore Processor, including at least Xilinx's 28 nm programmable logic products such as the 7 Series FPGAs practice Claim 21 or any valid claim of the '331 patent.

91. A judicial declaration of non-infringement of the '331 patent is necessary and appropriate in order to resolve this controversy.

EIGHTH COUNT

(Declaratory Judgment of Invalidity of the '331 Patent)

(Against Defendant TRTF)

92. The allegations contained in paragraphs 1 through 91 are incorporated by reference as if fully set herein.

93. Under all the circumstances in this dispute, Defendants have, at a minimum, created a substantial, immediate, and real controversy between the parties as to the invalidity of the '331 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants within the meaning of 28 U.S.C. § 2201.

94. Upon information and belief, the '331 patent is invalid because of its failure to comply with one or more of the requirements of the patent laws of the United States, including, without limitation, at least 35 U.S.C. §§ 102, 103, and/or 112.

95. At least Claims 1-5, 11-15, and 19-22 of the '331 patent are invalid as anticipated and/or obvious over multiple prior art references that were not before the patent examiner during

the prosecution of the '331 patent, including but not limited to U.S. Patent Nos. 5,996,092 and 5,361,348, and the IBM PowerPC 403GA User's Manual, Second Edition, published March 1995. Had the patent examiner known or been made aware of these prior art references, the claims would not have been allowed and the '331 patent would not have issued.

96. The USPTO has already determined that these references raise a substantial new question of patentability of the '331 patent, and has issued an Office Action rejecting Claims 1-5, 11-15, and 19-22 of the '331 patent.

97. At least Claims 1-22 of the '331 patent are not sufficiently definite to "distinctly claim[] the subject matter which the applicant regards as his invention," as required by 35 U.S.C. § 112. One such example of a claim limitation that is indefinite under § 112 is "cause register means."

98. Xilinx will provide additional and more detailed invalidity contentions as required by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise ordered by the Court.

99. A judicial declaration of invalidity of the '331 patent is necessary and appropriate in order to resolve this controversy.

NINTH COUNT

(Declaratory Judgment of Non-Infringement of the '350 Patent)

(Against Defendant Taichi)

100. The allegations contained in paragraphs 1 through 99 are incorporated by reference as if fully set herein.

101. Defendant Taichi is the assignee of record with the USPTO of the '350 patent. Upon information and belief, Taichi is the owner and assignee of all rights, title, and interest in and under the '350 patent.

102. Representatives from Intellectual Ventures and/or IV Management, acting on behalf of and as the agent for Taichi, have accused Xilinx of infringing at least Claim 1 of the '350 patent through its manufacture, sale, offering for sale, use, and/or importation of certain integrated circuits, including Xilinx FPGA products assembled in a flip-chip BGA package, and

1 have asserted that Xilinx must take a license to the '350 patent to lawfully continue the
2 manufacture, sale, offering for sale, use, and/or importation of such integrated circuits.

3 103. Xilinx has informed Defendants that Xilinx contends it has the right to engage in the
4 manufacture, sale, offering for sale, use, and/or importation of these integrated circuits without a
5 license to the '350 patent.

6 104. Under all the circumstances in this dispute, Defendants have, at a minimum, created
7 a substantial, immediate, and real controversy between the parties as to the non-infringement of
8 the '350 patent. A valid and justiciable controversy has arisen and exists between Xilinx and
9 Defendants within the meaning of 28 U.S.C. § 2201.

10 105. Upon information and belief, Xilinx has not directly or indirectly infringed any valid
11 and enforceable claim of the '350 patent, either literally or under the doctrine of equivalents
12 because none of its integrated circuits, including Xilinx FPGA products assembled in a flip-chip
13 BGA package, including at least the Virtex-5 FPGAs, practice Claim 1 or any valid claim of the
14 '350 patent.

15 106. A judicial declaration of non-infringement of the '350 patent is necessary and
16 appropriate in order to resolve this controversy.

17 **TENTH COUNT**

18 **(Declaratory Judgment of Invalidity of the '350 Patent)**

19 **(Against Defendant Taichi)**

20 107. The allegations contained in paragraphs 1 through 106 are incorporated by reference
21 as if fully set herein.

22 108. Under all the circumstances in this dispute, Defendants have, at a minimum, created
23 a substantial, immediate, and real controversy between the parties as to the invalidity of the '350
24 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants
25 within the meaning of 28 U.S.C. § 2201.

26 109. Upon information and belief, the '350 patent is invalid because of its failure to
27 comply with one or more of the requirements of the patent laws of the United States, including,
28 without limitation, at least 35 U.S.C. §§ 102, 103, and/or 112.

110. At least Claims 1-10 of the '350 patent are invalid as anticipated and/or obvious over multiple prior art references that were not before the patent examiner during the prosecution of the '350 patent, including but not limited to U.S. Patent Nos. 7,126,218 ("the '218 patent"). Had the patent examiner known or been made aware of these prior art references, the claims would not have been allowed and the '350 patent would not have issued.

111. The USPTO has already determined that the '218 patent reference raises a substantial new question of patentability of the '350 patent and has issued an Office Action rejecting all claims of the patent.

112. At least Claims 1-10 of the '350 patent are not sufficiently definite to "distinctly claim[] the subject matter which the applicant regards as his invention," as required by 35 U.S.C. § 112. One such example of a claim limitation that is indefinite under § 112 is "extending part."

113. Xilinx will provide additional and more detailed invalidity contentions as required by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise ordered by the Court.

114. A judicial declaration of invalidity of the '350 patent is necessary and appropriate in order to resolve this controversy.

ELEVENTH COUNT

(Declaratory Judgment of Non-Infringement of the '497 Patent)

(Against Defendant Noregin)

115. The allegations contained in paragraphs 1 through 114 are incorporated by reference as if fully set herein.

116. Defendant Noregin is the assignee of record with the USPTO of the '497 patent. Upon information and belief, Noregin is the owner and assignee of all rights, title, and interest in and under the '497 patent.

117. Representatives from Intellectual Ventures and/or IV Management, acting on behalf of and as the agent for Noregin, have accused Xilinx of infringing at least Claim 76 of the '497 patent through its manufacture, sale, offering for sale, use, and/or importation of the Xilinx FPGA Editor that allegedly practices methods for applying detail-in-context viewing to online and

1 electronic presentations of viewable media, and have asserted that Xilinx must take a license to
2 the '497 patent to lawfully continue the manufacture, sale, offering for sale, use, and/or
3 importation of the Xilinx FPGA Editor.

4 118. Xilinx has informed Defendants that Xilinx contends it has the right to engage in the
5 manufacture, offering for sale, use, and/or importation of the Xilinx FPGA Editor without a
6 license to the '497 patent.

7 119. Under all the circumstances in this dispute, Defendants have, at a minimum, created
8 a substantial, immediate, and real controversy between the parties as to the non-infringement of
9 the '497 patent. A valid and justiciable controversy has arisen and exists between Xilinx and
10 Defendants within the meaning of 28 U.S.C. § 2201.

11 120. Upon information and belief, Xilinx has not directly or indirectly infringed any valid
12 and enforceable claim of the '497 patent, either literally or under the doctrine of equivalents
13 because the Xilinx FPGA Editor does not practice Claim 76 or any valid claim of the '497 patent.

14 121. A judicial declaration of non-infringement of the '497 patent is necessary and
15 appropriate in order to resolve this controversy.

16 **TWELTH COUNT**

17 **(Declaratory Judgment of Invalidity of the '497 Patent)**

18 **(Against Defendant Noregin)**

19 122. The allegations contained in paragraphs 1 through 121 are incorporated by reference
20 as if fully set herein.

21 123. Under all the circumstances in this dispute, Defendants have, at a minimum, created
22 a substantial, immediate, and real controversy between the parties as to the invalidity of the '497
23 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants
24 within the meaning of 28 U.S.C. § 2201.

25 124. Upon information and belief, the '497 patent is invalid because of its failure to
26 comply with one or more of the requirements of the patent laws of the United States, including,
27 without limitation, at least 35 U.S.C. §§ 102, 103, and/or 112.
28

125. At least Claims 1-22, 24-50, 52-74, and 76-99 of the '497 patent are invalid as anticipated and/or obvious over multiple prior art references that were not before the patent examiner during the prosecution of the '497 patent, including but not limited to U.S. Patent Nos. 5,630,103; 5,615,384; 6,018,704; 4,821,210; and 6,407,747; and the International Patent Application WO 00/25267, published on May 4, 2000. Had the patent examiner known or been made aware of these prior art references and others, the claims would not have been allowed and the '497 patent would not have issued.

126. The USPTO has already determined that these references raise a substantial new question of patentability of the '497 patent, and has issued an Office Action rejecting Claims 1-22, 24-50, 52-74, and 76-99 of the '497 patent.

127. At least Claims 1-100 of the '497 patent are not sufficiently definite to "distinctly claim[] the subject matter which the applicant regards as his invention," as required by 35 U.S.C. § 112. One such example of a claim limitation that is indefinite under § 112 is "lens surface."

128. Xilinx will provide additional and more detailed invalidity contentions as required by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise ordered by the Court.

129. A judicial declaration of invalidity of the '497 patent is necessary and appropriate in order to resolve this controversy.

THIRTEENTH COUNT

(Declaratory Judgment of Non-Infringement of the '061 Patent)

(Against Defendant IVF)

130. The allegations contained in paragraphs 1 through 129 are incorporated by reference as if fully set herein .

131. Defendant IVF is the assignee of record with the USPTO of the '061 patent. Upon information and belief, IVF is the owner and assignee of all rights, title, and interest in and under the '061 patent.

132. Representatives from Intellectual Ventures and/or IV Management, acting on behalf of and as the agent for IVF, have accused Xilinx of infringing the '061 patent through its

1 manufacture, sale, use, and/or importation of certain integrated circuits that allegedly practice
2 methods for controlling power consumption in a computer processor, including Xilinx's FPGA
3 products, and have asserted that Xilinx must take a license to the '061 patent to lawfully continue
4 the manufacture, sale, use, and/or importation of such integrated circuits.

5 133. Xilinx has informed Defendants that Xilinx contends it has the right to engage in the
6 manufacture, sale, use, and/or importation of these integrated circuits without a license to the '061
7 patent.

8 134. Under all the circumstances in this dispute, Defendants have, at a minimum, created
9 a substantial, immediate, and real controversy between the parties as to the non-infringement of
10 the '061 patent. A valid and justiciable controversy has arisen and exists between Xilinx and
11 Defendants within the meaning of 28 U.S.C. § 2201.

12 135. Upon information and belief, Xilinx has not directly or indirectly infringed any valid
13 and enforceable claim of the '061 patent, either literally or under the doctrine of equivalents
14 because none of its integrated circuits, including Xilinx's Spartan-6 FPGAs, practice any valid
15 claim of the '061 patent.

16 136. Xilinx will provide additional and more detailed invalidity contentions as required
17 by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise
18 ordered by the Court.

19 137. A judicial declaration of non-infringement of the '061 patent is necessary and
20 appropriate in order to resolve this controversy.

21 **FOURTEENTH COUNT**

22 **(Declaratory Judgment of Invalidity of the '061 Patent)**

23 **(Against Defendant IVF)**

24 138. The allegations contained in paragraphs 1 through 137 are incorporated by reference
25 as if fully set herein.

26 139. Under all the circumstances in this dispute, Defendants have, at a minimum, created
27 a substantial, immediate, and real controversy between the parties as to the invalidity of the '061
28

1 patent. A valid and justiciable controversy has arisen and exists between Xilinx and Defendants
2 within the meaning of 28 U.S.C. § 2201.

3 140. Upon information and belief, the '061 patent is invalid because of its failure to
4 comply with one or more of the requirements of the patent laws of the United States, including,
5 without limitation, at least 35 U.S.C. §§ 102, 103, and/or 112.

6 141. At least, Claims 1, 3-15, 17-19, 23, 24, 26, 28-34, 36, 38-40, 42, and 44-68 of the
7 '061 patent are invalid as anticipated and/or obvious over multiple prior art references that were
8 not before the patent examiner during the prosecution of the '061 patent, including but not limited
9 to U.S. Patent Nos. 5,727,193 and 5,761,517. Had the patent examiner known or been made
10 aware of these prior art references and others, the claims would not have been allowed and the
11 '061 patent would not have issued under an *inter partes* reexamination certificate.

12 142. At least Claims 1, 3-7, 15, 17-19, 23, 24, 26, 28, 29, 39, 40, 42, 44-62, and 64-68 of
13 the '331 patent are not sufficiently definite to “distinctly claim[] the subject matter which the
14 applicant regards as his invention,” as required by 35 U.S.C. § 112. One such example of a claim
15 limitation that is indefinite under § 112 is “said determination made independently of instructions
16 to be executed by the processor.”

17 143. Xilinx will provide additional and more detailed invalidity contentions as required
18 by Patent Local Rules 3-3 and 3-5 in the time period prescribed by those Rules, or as otherwise
19 ordered by the Court.

20 144. A judicial declaration of invalidity of the '061 patent is necessary and appropriate in
21 order to resolve this controversy.

22 **PRAYER FOR RELIEF**

23 WHEREFORE, Xilinx requests that the Court enter judgment in its favor and against,
24 Detelle Relay KG, LLC, Roldan Block NY, LLC, Latrosse Technologies, LLC, TR Technologies
25 Foundation LLC, Taichi Holdings, LLC, Noregin Assets N.V., LLC, and Intellectual Venture
26 Funding LLC, and requests the following relief:

- 27 (A) An adjudication that the '251, '736, '165, '331, '350, '497, and '061
28 patents (collectively, the “Asserted Patents”) are not infringed by Xilinx’s

importation, use, offer for sale, and/or sale in the United States of the Accused Products, including the Spartan-6 FPGAs, the Virtex-5 ML50x evaluation platforms, the Virtex-5 FPGAs, the Xilinx FPGA Editor, and the 28 nm programmable logic products containing an ARM dual-core CortexTMA9 MPCore Processor such as the 7 Series FPGAs;

- (B) An adjudication that the Asserted Patents are invalid;
- (C) An adjudication in favor of Xilinx on each of Xilinx's claims;
- (D) An adjudication that this is an exceptional case, and an award of Xilinx's costs and attorneys' fees by Defendants pursuant to 35 U.S.C. § 285 or otherwise;
- (E) An adjudication that the Defendants are not entitled to any damages, an injunction, or any other relief; and
- (F) Such other relief as this Court deems just and proper.

DEMAND FOR JURY TRIAL

Pursuant to Federal Rule of Civil Procedure 38(b) and Northern District of California Local Rule 3-6(a), Plaintiff respectfully requests a jury trial on all issues triable thereby.

Dated: January 31, 2012

Respectfully submitted,

JONES DAY

By: /S/ Behrooz Shariati

Behrooz Shariati

Attorneys for Xilinx, Inc.

SVI-103142