

**UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF TEXAS  
MARSHALL DIVISION**

WI-LAN INC.,	§	
	§	
Plaintiff,	§	
v.	§	
	§	
ACER, INC., ACER AMERICA	§	Civil Action No. 2:07-CV-473 (TJW)
CORPORATION, APPLE, INC., DELL,	§	
INC., GATEWAY, INC.,	§	
HEWLETT-PACKARD COMPANY,	§	JURY TRIAL REQUESTED
LENOVO GROUP LTD., LENOVO	§	
(UNITED STATES) INC., SONY	§	
CORPORATION, SONY CORPORATION	§	
OF AMERICA, SONY ELECTRONICS,	§	
INC., SONY COMPUTER	§	
ENTERTAINMENT AMERICA, INC.,	§	
TOSHIBA CORPORATION, TOSHIBA	§	
AMERICA, INC., TOSHIBA AMERICA	§	
INFORMATION SYSTEMS, INC.,	§	
BROADCOM CORPORATION, INTEL	§	
CORPORATION, ATHEROS	§	
COMMUNICATIONS, INC, MARVELL	§	
SEMICONDUCTOR, INC., BEST BUY CO.,	§	
INC. and CIRCUIT CITY STORES, INC.,	§	
	§	
Defendants.	§	

**PLAINTIFF’S ANSWER TO DEFENDANT MARVELL SEMICONDUCTOR,  
INC.’S COUNTERCLAIMS IN RESPONSE TO WI-LAN’S  
SUPPLEMENTAL FIRST AMENDED COMPLAINT**

Plaintiff Wi-LAN Inc. (“Wi-LAN”) files this Answer to Defendant Marvell Semiconductor, Inc.’s (“Defendant”) Counterclaims filed December 4, 2009, in response to Wi-LAN’s Supplemental First Amended Complaint.

**THE PARTIES**

1. Upon information and belief, Wi-LAN admits the allegations in Paragraph 1 of the Counterclaim.

2. Wi-LAN admits the allegations in Paragraph 2 of the Counterclaim.

**JURISDICTION AND VENUE**

3. Answering the allegations in Paragraph 3, Wi-LAN admits that this Court has subject matter jurisdiction over Defendant's First, Second, Eighth and Ninth Counterclaims. Wi-LAN is without sufficient knowledge or information regarding Defendant's Third, Fourth, Fifth, Sixth, and Seventh Counterclaims to determine the propriety of subject matter jurisdiction and therefore denies that subject matter jurisdiction is proper.

4. Wi-LAN admits the allegations in Paragraph 4 of the Counterclaim.

**COUNT I**

**Declaratory Relief Regarding Non-Infringement**

5. Answering the allegations in Paragraph 5, Wi-LAN incorporates by reference paragraphs 1-4 as if fully set forth herein.

6. Wi-LAN denies the allegations in Paragraph 6 of the Counterclaim.

7. Wi-LAN admits the allegations in Paragraph 7 of the Counterclaim.

8. The allegations in Paragraph 8 of the Counterclaim contain conclusions of law to which no response is required. To the extent a response is required, Wi-LAN denies the allegations in Paragraph 8.

9. Answering the allegations in Paragraph 9, Wi-LAN admits that Defendant requests a declaration of the Court that Defendant's accused products do not infringe and have not infringed any valid claim of the '222 and '802 patents.

10. The allegations in Paragraph 10 of the Counterclaim contain conclusions of law to which no response is required. To the extent a response is required, Wi-LAN denies the allegations in Paragraph 10.

## **COUNT II**

### **Declaratory Relief Regarding Invalidity**

11. Answering the allegations in Paragraph 11, Wi-LAN incorporates by reference paragraphs 1-10 as if fully set forth herein.

12. Wi-LAN denies the allegations in Paragraph 12 of the Counterclaim.

13. Wi-LAN admits the allegations in Paragraph 13 of the Counterclaim.

14. Answering the allegations in Paragraph 14, Wi-LAN admits that Defendant requests a declaration of the Court that the '222 and '802 patents are invalid.

15. The allegations in Paragraph 15 of the Counterclaim contain conclusions of law to which no response is required. To the extent a response is required, Wi-LAN denies the allegations in Paragraph 15.

## **COUNT III**

### **Fraud**

16. Answering the allegations in Paragraph 16, Wi-LAN incorporates by reference paragraphs 1-15 as if fully set forth herein.

17. Wi-LAN admits the allegations in Paragraph 17 of the Counterclaim.

18. Answering the allegations in Paragraph 18, Wi-LAN admits that the IEEE is a professional association and leading developer of technical standards. Wi-LAN admits that IEEE members include engineers, scientists and allied professionals whose technical interests relate to electrical and computer sciences, engineering and related

disciplines. Wi-LAN is without sufficient knowledge or information to form a belief regarding the remaining allegations in Paragraph 18 and therefore denies such allegations.

19. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 19 and therefore denies such allegations.

20. Answering the allegations in Paragraph 20, Wi-LAN denies that the current version of the IEEE's Standards Board Bylaws include the provisions quoted in Paragraph 20 of the Counterclaim. Wi-LAN is without sufficient knowledge or information to form a belief regarding the remaining allegations in Paragraph 20 and therefore denies such allegations.

21. Answering the allegations in Paragraph 21, Wi-LAN admits that the IEEE formed the 802.11 working group in 1990. Wi-LAN admits that the IEEE 802.11 standard is entitled "Wireless LAN Medium Access Control (MAC) and Physical Layer (PHY) Specifications" and concerns wireless local area networking ("wireless LAN").

22. Answering the allegations in Paragraph 22, Wi-LAN is without sufficient knowledge or information to form a belief regarding the time of formation of the 802.11a and 802.11b task groups and therefore denies such allegations. Wi-LAN admits the remaining allegations in Paragraph 22 of the Counterclaim.

23. Wi-LAN denies the allegations in Paragraph 23 of the Counterclaim.

24. Wi-LAN denies the allegations in Paragraph 24 of the Counterclaim.

25. Wi-LAN admits the allegations in Paragraph 25 of the Counterclaim.

26. Wi-LAN admits the allegations in Paragraph 26 of the Counterclaim.

27. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 27 and therefore denies such allegations.

28. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 28 and therefore denies such allegations.

29. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 29 and therefore denies such allegations.

30. Answering the allegations in Paragraph 30, Wi-LAN admits that on July 7, 1998, Wi-LAN submitted a letter to Mr. Victor Hayes, Chair of the IEEE 802.11 committee, referencing “Standards Recommendation Relating to Technology Being Proposed by Lucent Technologies and Harris Semiconductor for Inclusion in the IEEE P802.11b (Multicode) Standards Project” in the subject line. The letter stated that “it is prepared to license its existing patents directed to and necessary for the practice of the referenced Multicode Technology, if Lucent and Harris’ proposals are adopted by the IEEE, on fair, reasonable and non-discriminatory terms and conditions to qualified applicants in accordance with the IEEE Patent Policy.” Wi-LAN denies all remaining allegations set forth in Paragraph 30.

31. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 31 and therefore denies such allegations.

32. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 32 and therefore denies such allegations.

33. Wi-LAN admits the allegations in Paragraph 33 of the Counterclaim.

34. Answering the allegations in Paragraph 34, Wi-LAN admits that on September 10, 1998, Wi-LAN filed an application to reissue U.S. Patent No. 5,555,268.

Wi-LAN admits that this patent application later issued as the '802 patent. Wi-LAN admits that it alleges that certain claims of the '802 patent are infringed by certain products having wireless capability compliant with the IEEE 802.11 standards. Wi-LAN denies all remaining allegations set forth in Paragraph 34.

35. Answering the allegations in Paragraph 35, Wi-LAN admits that on September 14, 1998, Wi-LAN submitted a letter to Mr. Victor Hayes, Chair of the IEEE 802.11 committee, stating in part that "Wi-LAN Inc. hereby withdraws its previous IP statement dated July 9, 1998 to the extent that it implied that Wi-LAN existing US patent on multicode technology, US patent # 5,555,268, or another pending patent are necessary for the implementation of devices incorporating the IEEE802.11b draft standard." Wi-LAN denies all remaining allegations set forth in Paragraph 35.

36. Answering the allegations in Paragraph 36, Wi-LAN admits that the IEEE 802.11 working group met in November 1998 in Albuquerque, New Mexico. Wi-LAN admits that Mr. Zaghoul and Mr. Knudsen attended the meeting of the working group. Wi-LAN admits that the meeting minutes for the 802.11b task group state "270-r1 WLAN IP statement (They no longer feel that they have any IP related to standard)." Wi-LAN denies all remaining allegations set forth in Paragraph 36.

37. Wi-LAN denies the allegations in Paragraph 37 of the Counterclaim.

38. Answering the allegations in Paragraph 38, Wi-LAN admits that on July 7, 1998, Wi-LAN submitted a letter to Mr. Victor Hayes, Chair of the IEEE 802.11 committee, referencing "Standards Recommendation Relating to Technology Being Proposed by Lucent Technologies and NTT for Inclusion in the IEEE P802.11a (OFDM) Standards Project" in the subject line. The letter stated that "it is prepared to license its

existing patents directed to and necessary for the practice of the referenced OFDM Technology, if Lucent and NTT's proposal is adopted by the IEEE, on fair, reasonable and non-discriminatory terms and conditions to qualified applicants in accordance with the IEEE Patent Policy." Wi-LAN is without sufficient knowledge or information to form a belief regarding the remaining allegations in Paragraph 38 and therefore denies such allegations.

39. Answering the allegations in Paragraph 39, Wi-LAN admits that on November 9, 1998, Wi-LAN submitted a letter to Mr. Victor Hayes, Chair of the IEEE 802.11 committee, referencing "Standards Recommendation Relating to the IEEE P802.11a (OFDM) Draft Standards" in the subject line. The letter stated that "Wi-LAN Inc. hereby declares that it is prepared to license its existing and future patents directed to and necessary for the practice of the referenced OFDM Technology, if the IEEE802.11a Draft Standard is adopted by the IEEE, on fair, reasonable and non-discriminatory terms and conditions to qualified applicants in accordance with the IEEE Patent Policy." Wi-LAN is without sufficient knowledge or information to form a belief regarding the remaining allegations in Paragraph 39 and therefore denies such allegations.

40. Answering the allegations in Paragraph 40, Wi-LAN admits that on November 29, 2000, Wi-LAN submitted a letter to Mr. Stuart Kerry, Chair of the IEEE 802.11 committee, referencing "Standards Recommendation Relating to the IEEE P802.11b Task Group G (OFDM) Draft Standards" in the subject line. The letter stated that "Wi-LAN Inc. hereby declares that it is prepared to license its existing and future patents directed to and necessary for the practice of the referenced OFDM Technology, if the IEEE802.11b Task Group G Draft Standard is adopted by the IEEE, on fair,

reasonable and non-discriminatory terms and conditions to qualified applicants in accordance with the IEEE Patent Policy.” Wi-LAN is without sufficient knowledge or information to form a belief regarding the remaining allegations in Paragraph 40 and therefore denies such allegations.

41. Wi-LAN denies the allegations in Paragraph 41 of the Counterclaim.

42. Wi-LAN denies the allegations in Paragraph 42 of the Counterclaim.

43. Wi-LAN denies the allegations in Paragraph 43 of the Counterclaim.

44. Wi-LAN denies the allegations in Paragraph 44 of the Counterclaim.

45. Wi-LAN denies the allegations in Paragraph 45 of the Counterclaim.

#### **COUNT IV**

##### **Constructive Fraud**

46. Answering the allegations in Paragraph 46, Wi-LAN incorporates by reference paragraphs 1-45 as if fully set forth herein.

47. Wi-LAN denies the allegations in Paragraph 47 of the Counterclaim.

48. Wi-LAN denies the allegations in Paragraph 48 of the Counterclaim.

49. Wi-LAN denies the allegations in Paragraph 49 of the Counterclaim.

50. Wi-LAN denies the allegations in Paragraph 50 of the Counterclaim.

#### **COUNT V**

##### **Negligent Misrepresentation**

51. Answering the allegations in Paragraph 51, Wi-LAN incorporates by reference paragraphs 1-50 as if fully set forth herein.

52. Wi-LAN denies the allegations in Paragraph 52 of the Counterclaim.

53. Wi-LAN denies the allegations in Paragraph 53 of the Counterclaim.

54. Wi-LAN denies the allegations in Paragraph 54 of the Counterclaim.

55. Wi-LAN denies the allegations in Paragraph 55 of the Counterclaim.

## COUNT VI

### Promissory Estoppel

56. Answering the allegations in Paragraph 56, Wi-LAN incorporates by reference paragraphs 1-55 as if fully set forth herein.

57. Answering the allegations in Paragraph 57, Wi-LAN admits that on September 14, 1998, Wi-LAN submitted a letter to Mr. Victor Hayes, the Chair of the IEEE 802.11 committee, stating that “Wi-LAN Inc. hereby withdraws its previous IP statement dated July 9, 1998 to the extent that it implied that Wi-LAN existing US patent on multicode technology, US patent # 5,555,268, or another pending patent are necessary for the implementation of devices incorporating the IEEE802.11b draft standard.” Wi-LAN admits that on November 9, 1998, Wi-LAN submitted a letter to Mr. Victor Hayes, the Chair of the IEEE 802.11 committee, referencing “Standards Recommendation Relating to the IEEE P802.11a (OFDM) Draft Standards” in the subject line. The letter stated that “Wi-LAN Inc. hereby declares that it is prepared to license its existing and future patents directed to and necessary for the practice of the referenced OFDM Technology, if the IEEE802.11a Draft Standard is adopted by the IEEE, on fair, reasonable and non-discriminatory terms and conditions to qualified applicants in accordance with the IEEE Patent Policy.” Wi-LAN admits that on November 29, 2000, Wi-LAN submitted a letter to Mr. Stuart Kerry, the Chair of the IEEE 802.11 committee, referencing “Standards Recommendation Relating to the IEEE P802.11b Task Group G (OFDM) Draft Standards” in the subject line. The letter stated that “Wi-LAN Inc. hereby

declares that it is prepared to license its existing and future patents directed to and necessary for the practice of the referenced ODFM Technology, if the IEEE802.11b Task Group G Draft Standard is adopted by the IEEE, on fair, reasonable and non-discriminatory terms and conditions to qualified applicants in accordance with the IEEE Patent Policy.” Wi-LAN denies all remaining allegations set forth in Paragraph 57.

58. Wi-LAN denies the allegations in Paragraph 58 of the Counterclaim.

59. Wi-LAN denies the allegations in Paragraph 59 of the Counterclaim.

60. Wi-LAN denies the allegations in Paragraph 60 of the Counterclaim.

## **COUNT VII**

### **Breach Of Contract**

61. Answering the allegations in Paragraph 61, Wi-LAN incorporates by reference paragraphs 1-60 as if fully set forth herein.

62. Wi-LAN denies the allegations in Paragraph 62 of the Counterclaim.

63. Wi-LAN denies the allegations in Paragraph 63 of the Counterclaim.

64. Wi-LAN denies the allegations in Paragraph 64 of the Counterclaim.

65. Wi-LAN denies the allegations in Paragraph 65 of the Counterclaim.

66. Wi-LAN denies the allegations in Paragraph 66 of the Counterclaim.

## **COUNT VIII**

### **Unclean Hands**

67. Answering the allegations in Paragraph 67, Wi-LAN incorporates by reference paragraphs 1-66 as if fully set forth herein.

68. Wi-LAN denies the allegations in Paragraph 68 of the Counterclaim.

**COUNT IX**

**Waiver**

69. Answering the allegations in Paragraph 69, Wi-LAN incorporates by reference paragraphs 1-68 as if fully set forth herein.

70. Wi-LAN denies the allegations in Paragraph 70 of the Counterclaim.

**PRAYER FOR RELIEF**

Wi-LAN denies that Defendant is entitled to the relief requested in subparagraphs (a)-(j) of the Counterclaim or any other relief.

**DEMAND FOR JURY TRIAL**

In accordance with Federal Rule of Civil Procedure 38 and Local Rule CV-38, Wi-LAN respectfully demands a jury trial of all issues triable to a jury in this action.

**DEFENSES**

**FIRST AFFIRMATIVE DEFENSE**

71. Each cause of action set forth in Defendant's counterclaim fails to state a claim upon which relief can be granted.

**SECOND AFFIRMATIVE DEFENSE**

72. Each cause of action set forth in Defendant's counterclaim is barred, in whole or in part, by the Defendant's lack of standing.

**THIRD AFFIRMATIVE DEFENSE**

73. Defendant's counterclaims are barred, in whole or in part, by the equitable defenses of estoppel, waiver, laches and/or unclean hands.

**FOURTH AFFIRMATIVE DEFENSE**

74. Defendant has failed to make reasonable efforts to mitigate its damages, if any.

**FIFTH AFFIRMATIVE DEFENSE**

75. Defendant's claims are subject to a set off based upon Defendant's and/or other parties' acts and wrongdoing.

**SIXTH AFFIRMATIVE DEFENSE**

76. Defendant's claim for constructive fraud is barred by the lack of a fiduciary duty between the Plaintiff and the Defendant.

**SEVENTH AFFIRMATIVE DEFENSE**

77. Defendant's claim for breach of contract fails for lack of occurrence of a condition precedent.

**EIGHTH AFFIRMATIVE DEFENSE**

78. Defendant's claim for breach of contract fails due to the occurrence of a condition subsequent.

**NINTH AFFIRMATIVE DEFENSE**

79. Each cause of action set forth in Defendant's counterclaim is barred by the applicable statute of limitations.

DATED: December 21, 2009.

Respectfully submitted,

**McKool Smith, P.C.**

/s/ Sam Baxter

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