

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

WI-LAN INC.,	§	
	§	
Plaintiff,	§	
v.	§	
	§	Civil Action No. 2:08-CV-247 (TJW)
RESEARCH IN MOTION CORPORATION,	§	
RESEARCH IN MOTION LTD.,	§	
MOTOROLA, INC., UTSTARCOM, INC.,	§	JURY TRIAL REQUESTED
LG ELECTRONICS MOBILECOMM	§	
U.S.A., AND LG ELECTRONICS, INC.,	§	
	§	
Defendants.	§	

**PLAINTIFF'S ANSWER TO DEFENDANT LG ELECTRONICS MOBILECOMM
U.S.A., INC.'S COUNTERCLAIMS**

Plaintiff Wi-LAN Inc. ("Wi-LAN") files this Answer to Defendant LG Electronics Mobilecomm U.S.A., Inc.'s ("LGEMU" or "Defendant") Counterclaims, filed September 18, 2009.

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 Defendant's counterclaim arises under 28 U.S.C. § 2201 and 2202 and the patent laws set forth in Title 35 of the United States Code. Wi-LAN denies all remaining allegations.

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

5. Wi-LAN admits the allegations in Paragraph 5 of the Counterclaim.

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

7. Wi-LAN admits that there is an actual case or controversy between the parties concerning the infringement, validity, and/or enforceability of the '802 and '222 patents.

8. Wi-LAN admits the allegations in Paragraph 8 of the Counterclaim.

9. Wi-LAN admits the allegations in Paragraph 9 of the Counterclaim.

10. Wi-LAN admits the allegations in Paragraph 10 of the Counterclaim.

COUNT ONE

Declaratory Judgment of Non-Infringement of U.S. Patent No. RE37,802

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

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

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

14. Wi-LAN admits the allegations in Paragraph 14 of the Counterclaim.

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 TWO

Declaratory Judgment of Invalidity of U.S. Patent No. RE37,802

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. Wi-LAN denies the allegations in Paragraph 18 of the Counterclaim.

19. Wi-LAN admits the allegations in Paragraph 19 of the Counterclaim.

20. The allegations in Paragraph 20 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 20.

COUNT THREE

Declaratory Judgment of Non-Infringement of U.S. Patent No. 5,282,222

21. Answering the allegations in Paragraph 21, Wi-LAN incorporates by reference paragraphs 1-20 as if fully set forth herein.

22. Wi-LAN admits the allegations in Paragraph 22 of the Counterclaim.

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

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

25. The allegations in Paragraph 25 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 25.

COUNT FOUR

Declaratory Judgment of Invalidity of U.S. Patent No. 5,282,222

26. Answering the allegations in Paragraph 26, Wi-LAN incorporates by reference paragraphs 1-25 as if fully set forth herein.

27. Wi-LAN admits the allegations in Paragraph 27 of the Counterclaim.

28. Wi-LAN denies the allegations in Paragraph 28 of the Counterclaim.

29. Wi-LAN admits the allegations in Paragraph 29 of the Counterclaim.

30. The allegations in Paragraph 30 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 30.

COUNT FIVE

Fraud

31. Answering the allegations in Paragraph 31, Wi-LAN incorporates by reference paragraphs 1-30 as if fully set forth herein.

32. Wi-LAN admits the allegations in Paragraph 32 of the Counterclaim.

33. Answering the allegations in Paragraph 33, 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 33 and therefore denies such allegations.

34. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 34 and therefore denies such allegations.

35. Answering the allegations in Paragraph 35, Wi-LAN denies that the current version of the IEEE's Standards Board Bylaws include the provisions quoted in Paragraph 35 of the Counterclaim. Wi-LAN is without sufficient knowledge or information to form a belief regarding the remaining allegations in Paragraph 35 and therefore denies such allegations.

36. Answering the allegations in Paragraph 36, 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").

37. Answering the allegations in Paragraph 37, 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 37 of the Counterclaim.

38. Wi-LAN denies the allegations in Paragraph 38 of the Counterclaim.

39. Wi-LAN denies the allegations in Paragraph 39 of the Counterclaim.

40. Wi-LAN admits the allegations in Paragraph 40 of the Counterclaim.

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

42. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 42 and therefore denies such allegations.

43. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 43 and therefore denies such allegations.

44. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 44 and therefore denies such allegations.

45. Answering the allegations in Paragraph 45, 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, in part, 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 45.

46. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 46 and therefore denies such allegations.

47. Wi-LAN is without sufficient knowledge or information to form a belief regarding the allegations in Paragraph 47 and therefore denies such allegations.

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

49. Answering the allegations in Paragraph 49, 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 49.

50. Answering the allegations in Paragraph 50, 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 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 50.

51. Answering the allegations in Paragraph 51, 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, in part, "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 51.

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

53. Answering the allegations in Paragraph 53, 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 53 and therefore denies such allegations.

54. Answering the allegations in Paragraph 54, 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 54 and therefore denies such allegations.

55. Answering the allegations in Paragraph 55, 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 55 and therefore denies such allegations.

56. Wi-LAN denies the allegations in Paragraph 56 of the Counterclaim.

57. Wi-LAN denies the allegations in Paragraph 57 of the Counterclaim.

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 SIX

Constructive Fraud

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.

COUNT SEVEN

Negligent Misrepresentation

66. Answering the allegations in Paragraph 66, Wi-LAN incorporates by reference paragraphs 1-65 as if fully set forth herein.

67. Wi-LAN denies the allegations in Paragraph 67 of the Counterclaim.
68. Wi-LAN denies the allegations in Paragraph 68 of the Counterclaim.
69. Wi-LAN denies the allegations in Paragraph 69 of the Counterclaim.
70. Wi-LAN denies the allegations in Paragraph 70 of the Counterclaim.

COUNT EIGHT

Promissory Estoppel

71. Answering the allegations in Paragraph 71, Wi-LAN incorporates by reference paragraphs 1-70 as if fully set forth herein.

72. Answering the allegations in Paragraph 72, 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 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 denies all remaining allegations in set forth in Paragraph 72.

73. Wi-LAN denies the allegations in Paragraph 73 of the Counterclaim.

74. Wi-LAN denies the allegations in Paragraph 74 of the Counterclaim.

75. Wi-LAN denies the allegations in Paragraph 75 of the Counterclaim.

COUNT NINE

Breach of Contract

76. Answering the allegations in Paragraph 76, Wi-LAN incorporates by reference paragraphs 1-75 as if fully set forth herein.

77. Wi-LAN denies the allegations in Paragraph 77 of the Counterclaim.

78. Wi-LAN denies the allegations in Paragraph 78 of the Counterclaim.

79. Wi-LAN denies the allegations in Paragraph 79 of the Counterclaim.

80. Wi-LAN denies the allegations in Paragraph 80 of the Counterclaim.

81. Wi-LAN denies the allegations in Paragraph 81 of the Counterclaim.

COUNT TEN

Unclean Hands

82. Answering the allegations in Paragraph 82, Wi-LAN incorporates by reference paragraphs 1-81 as if fully set forth herein.

83. Wi-LAN denies the allegations in Paragraph 83 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 Rule 38 of the Federal Rules of Civil Procedure and Local Rule CV-38, Plaintiff/Counterdefendant Wi-LAN respectfully demands a jury trial of all issues triable to a jury in this action.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

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

SECOND AFFIRMATIVE DEFENSE

85. 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

86. 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

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

FIFTH AFFIRMATIVE DEFENSE

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

SIXTH AFFIRMATIVE DEFENSE

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

SEVENTH AFFIRMATIVE DEFENSE

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

EIGHTH AFFIRMATIVE DEFENSE

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

NINTH AFFIRMATIVE DEFENSE

92. Defendant's claim for breach of contract and related claims fail for lack of privity.

TENTH AFFIRMATIVE DEFENSE

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

DATED: October 13, 2009

Respectfully submitted,

MCKOOL SMITH, P.C.

/s/ Sam Baxter

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ATTORNEYS FOR PLAINTIFF WILAN INC.

CERTIFICATE OF SERVICE

The undersigned hereby certifies that counsel of record who are deemed to have consented to electronic service are being served with a copy of this PLAINTIFF'S ANSWER TO DEFENDANT LG ELECTRONICS MOBILECOMM U.S.A., INC.'S COUNTERCLAIMS via the Court's CM/ECF system per Local Rule CV-5(a)(3).

Date: October 13, 2009

By: /s/ Sam Baxter