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

FORCE MOS TECHNOLOGY, CO., LTD., **Plaintiff,** **v.** **ASUSTEK COMPUTER, INC.,** **Defendant.**	**Civil Action No. 2:22-cv-00460-JRG** **JURY TRIAL DEMAND**

DEFENDANT/COUNTERCLAIM-PLAINTIFF'S ANSWER, AFFIRMATIVE DEFENSES, AND COUNTERCLAIMS

Defendant/Counterclaim-Plaintiff ASUSTek Computer, Inc. ("ASUS" or "Defendant" or "Counterclaim-Plaintiff"), by and through its counsel, hereby files its Answer, Affirmative Defenses, and Counterclaims ("Answer and Counterclaims") to the Complaint for Patent Infringement ("Complaint") filed by Plaintiff/Counterclaim-Defendant Force MOS Technology, Co., Ltd. ("Force MOS" or "Plaintiff" or "Counterclaim-Defendant"). Except as expressly admitted, ASUS denies each and every allegation in Plaintiff's Complaint. ASUS reserves the right to amend or supplement this Answer and Counterclaims to include additional defenses and counterclaims that are discovered during the course of this lawsuit. ASUS's specific responses to the numbered allegations are set forth below. To the extent any headings in the Complaint constitute an express or implied allegation, ASUS denies all the allegations contained in those headings.

THE PARTIES

1. ASUS lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 1 and, on that basis, denies them.

2. ASUS admits it is a corporation organized and existing under the laws of Taiwan, with a principal place of business at No. 15, Li-Te Road, Beitou District Taipei 112, Taiwan. ASUS denies that it may be served pursuant to the provisions of the Hague Convention. ASUS denies all other express or implied allegations set forth in paragraph 2.

JURISDICTION AND VENUE

3. Paragraph 3 of the Complaint states legal conclusions to which no response is required. To the extent a response is required, ASUS admits that Plaintiff's pleading purports to be a complaint for patent infringement but denies that Plaintiff is entitled to any relief or damages. ASUS denies all other express or implied allegations set forth in paragraph 3.

4. Paragraph 4 of the Complaint states legal conclusions to which no response is required. To the extent a response is required, ASUS admits that this Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331 and 1338. ASUS denies all other express or implied allegations set forth in paragraph 4.

5. Paragraph 5 of the Complaint states legal conclusions to which no response is required. ASUS denies all other express or implied allegations set forth in paragraph 5.

6. Denied.

7. Denied.

8. Denied.

9. Denied.

10. Paragraph 10 of the Complaint states legal conclusions to which no response is required. To the extent a response is required, ASUS denies the allegations in paragraph 10 and denies that venue in this District is convenient and reserves the right to seek transfer to a more appropriate or convenient forum. ASUS denies all other express or implied allegations set forth in paragraph 10.

11. Denied.

THE '634 PATENT

12. In response to paragraph 12 of the Complaint, ASUS admits that U.S. Patent No. 7,629,634 (the "'634 Patent") is titled, "Trenched Mosfet with Trenched Source Contact." ASUS lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 12 and, on that basis, denies them. ASUS denies all other express or implied allegations set forth in paragraph 12.

13. ASUS lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 13 and, on that basis, denies them.

14. Denied.

15. Denied.

16. Denied.

17. Denied.

18. Denied.

19. Denied.

20. ASUS admits that paragraph 20 of the Complaint purports to recite elements of Claim 1 of the '634 Patent. ASUS denies all other express or implied allegations set forth in paragraph 20.

THE '346 PATENT

21. In response to paragraph 21 of the Complaint, ASUS admits that U.S. Patent No. 7,847,346 (the "'346 Patent") is titled, "Trenched Mosfet with Trench Source Contact Having Copper Wire Bonding." ASUS lacks sufficient knowledge or information to form a belief as to the truth of the remaining allegations in paragraph 21 and, on that basis, denies them. ASUS denies all other express or implied allegations set forth in paragraph 21.

22. ASUS lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 22 and, on that basis, denies them.

23. Denied.

24. Denied.

25. Denied.

26. Denied.

27. Denied.

28. Denied.

29. ASUS admits that paragraph 29 of the Complaint purports to recite elements of Claim 1 of the '346 Patent. ASUS denies all other express or implied allegations set forth in paragraph 29.

ASUS

30. ASUS admits that it is a computer hardware and consumer electronics company founded in 1989. ASUS denies the remaining allegations in paragraph 30 of the Complaint.

31. Denied.

32. Denied.

33. Denied.

34. Denied.

35. Denied.

36. ASUS lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 36 and, on that basis, denies them.

37. Denied.

38. Denied.

39. ASUS lacks sufficient knowledge or information to form a belief as to the truth of the allegations in paragraph 39 and, on that basis, denies them.

COUNT I
(ALLEGED DIRECT PATENT INFRINGEMENT OF THE '634 PATENT)

40. ASUS incorporates by reference the statements and responses set forth in paragraphs 1-39 above with the same force and effect as though fully rewritten herein.

41. Denied.

42. Denied.

43. Denied.

44. Denied.

45. Denied.

46. Denied.

47. Denied.

48. Denied.

49. Denied.

50. Denied.

51. Denied.

52. Denied.

53. Denied.

54. Denied.

COUNT II
(ALLEGED INDUCED PATENT INFRINGEMENT OF THE '634 PATENT)

55. ASUS incorporates by reference the statements and responses set forth in paragraphs 1-54 above with the same force and effect as though fully rewritten herein.

56. Denied.

57. Denied.

58. Denied.

59. Denied.

60. Denied.

61. Denied.

62. Denied.

63. Denied.

COUNT III
(ALLEGED DIRECT INFRINGEMENT OF THE '346 PATENT)

64. ASUS incorporates by reference the statements and responses set forth in paragraphs 1-63 above with the same force and effect as though fully rewritten herein.

65. Denied.

66. Denied.

67. Denied.

68. Denied.

69. Denied.

70. Denied.

71. Denied.

72. Denied.

73. Denied.

74. Denied.

75. Denied.

76. Denied.

77. Denied.

COUNT IV
(ALLEGED INDUCED INFRINGEMENT OF THE '346 PATENT)

78. ASUS incorporates by reference the statements and responses set forth in paragraphs 1-77 above with the same force and effect as though fully rewritten herein.

79. Denied.

80. Denied.

81. Denied.

82. Denied.

83. Denied.

84. Denied.

85. Denied.

86. Denied.

JURY DEMAND

ASUS respectfully reserves the right to object to a jury trial on issues for which there is no right to trial by jury.

PRAYER FOR RELIEF

ASUS incorporates by reference the statements and responses set forth in paragraphs 1-86 above with the same force and effect as though fully rewritten herein. ASUS denies that Plaintiff is entitled to any relief in connection with the allegations in the Complaint, including, without limitation, the allegations of paragraphs (A) through (J) of the "Prayer for Relief" section. To the extent the "Prayer for Relief" section is interpreted to contain any express or implied allegations, ASUS denies them.

DEFENDANT/COUNTERCLAIM-PLAINTIFF'S AFFIRMATIVE DEFENSES

ASUS asserts the following affirmative defenses to the Complaint, without waiver, limitation, or prejudice, and without conceding that it bears the burden of proof as to any issue that would otherwise rest on Plaintiff. Defendant reserves all affirmative defenses under Rule 8(c) of the Federal Rules of Civil Procedure, the laws of the United States, and any other defenses at law or in equity that may exist now or that may be available in the future based on discovery and further factual investigation in this litigation.

FIRST AFFIRMATIVE DEFENSE
(Invalidity)

The claims of U.S. Patent No. 7,629,634 are invalid for failure to satisfy one or more of the requirements and/or conditions of patentability under the patent laws, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, and/or 112.

The claims of U.S. Patent No. 7,847,346 are invalid for failure to satisfy one or more of the requirements and/or conditions of patentability under the patent laws, including, but not limited to, 35 U.S.C. §§ 101, 102, 103, and/or 112.

SECOND AFFIRMATIVE DEFENSE
(Non-Infringement)

ASUS has not infringed and is not infringing, either literally or under the doctrine of equivalents, directly, indirectly, by inducement, contributorily, jointly, willfully, or in any other way, any valid or enforceable claim of U.S. Patent No. 7,629,634, and has not otherwise committed any acts in violation of 35 U.S.C. § 271.

ASUS has not infringed and is not infringing, either literally or under the doctrine of equivalents, directly, indirectly, by inducement, contributorily, jointly, willfully, or in any other way, any valid or enforceable claim of U.S. Patent No. 7,847,346, and has not otherwise committed any acts in violation of 35 U.S.C. § 271.

THIRD AFFIRMATIVE DEFENSE
(Failure to State a Claim for Relief)

The Complaint fails to state a claim upon which relief can be granted.

FOURTH AFFIRMATIVE DEFENSE
(Waiver and/or Prosecution History Estoppel)

Plaintiff's claims are barred in whole or in part by reason of waiver and/or prosecution history estoppel. Plaintiff waived and/or is estopped from contending that any claim of the U.S. Patent No. 7,629,634 (the "'634 Patent") covers the accused products or processes by virtue of statements and admissions made by the named inventors and/or patent counsel during prosecution and proceedings before the USPTO. For example, Plaintiff is estopped for construing any claim of the '634 Patent to be infringed or to have been infringed, either literally or by application of the doctrine of equivalents, by any product made, used, imported, sold, or offered for sale by ASUS in view of prior art and/or because of admission, representations, and/or statements made to the Patent Office during prosecution of any application leading to the issuance of the '634 Patent or any related patent, because of disclosures or language in the specifications of the '634 Patent, and/or because of limitation in the claims of the '634 Patent.

Plaintiff's claims are barred in whole or in part by reason of waiver and/or prosecution history estoppel. Plaintiff waived and/or is estopped from contending that any claim of the U.S. Patent No. 7,847,346 (the "'346 Patent") covers the accused products or processes by virtue of statements and admissions made by the named inventors and/or patent counsel during prosecution and proceedings before the USPTO. For example, Plaintiff is estopped for construing any claim of the '346 Patent to be infringed or to have been infringed, either literally or by application of the doctrine of equivalents, by any product made, used, imported, sold, or offered for sale by ASUS in view of prior art and/or because of admission, representations, and/or statements made to the Patent Office during prosecution of any application leading to the issuance of the '346 Patent or

any related patent, because of disclosures or language in the specifications of the '346 Patent, and/or because of limitation in the claims of the '346 Patent.

FIFTH AFFIRMATIVE DEFENSE
(Limitation on Damages)

To the extent Plaintiff and/or any predecessors in interest or any licensees to U.S. Patent No. 7,629,634 and U.S. Patent No. 7,847,346 (collectively, the "Patents-in-Suit") failed to properly mark any of their relevant products or materials as required by 35 U.S.C. § 287, or otherwise failed to give proper notice that ASUS's actions allegedly infringed the Patents-in-Suit, ASUS is not liable to Plaintiff for the acts alleged to have been performed before ASUS received actual notice that the accused products were allegedly infringed the Patents-in-Suit.

SIXTH AFFIRMATIVE DEFENSE
(No Injunctive Relief / Adequate Remedy at Law)

Plaintiff is not entitled to injunctive relief because any injury to Plaintiff is not immediate or irreparable, Plaintiff has an adequate remedy at law for any claims it asserts, and/or policy concerns weigh against injunctive relief.

SEVENTH AFFIRMATIVE DEFENSE
(No Exceptional Case)

The Complaint fails to establish, and ASUS denies, that this case is an exceptional case under 35 U.S.C. § 285.

EIGHTH AFFIRMATIVE DEFENSE
(No Willful Infringement)

Plaintiff's claims for enhanced damages under 35 U.S.C. § 284 are barred because Plaintiff has failed to meet, and cannot meet as a matter of law, the requirements for willful infringement.

RESERVATION OF ADDITIONAL DEFENSES

ASUS reserves the right to assert additional defenses that become apparent during discovery, including, but not limited to, the defenses of unclean hands, patent misuse, waiver, equitable estoppel, and inequitable conduct.

DEFENDANT/COUNTERCLAIM-PLAINTIFF'S COUNTERCLAIMS

As set forth above, Defendant/Counterclaim-Plaintiff ASUSTek Computer, Inc. ("Defendant" or "Counterclaim-Plaintiff" or "ASUS"), asserts the following Counterclaims against Plaintiff/Counterclaim-Defendant Force MOS Technology, Co., Ltd.

PARTIES

1. ASUSTek Computer, Inc. is a corporation organized and existing under the laws of Taiwan, with a principal place of business at No. 15, Li-Te Road, Beitou District, Taipei 112, Taiwan.

2. On information and belief based on paragraph 1 of the Complaint, Force MOS is a limited liability company organized and existing under the laws of Taiwan and located at 24F, No. 555, Siyuan Road, Xinzhuang District, New Taipei City, Taiwan (R.O.C.).

JURISDICTION AND VENUE

3. Counterclaim-Plaintiff incorporates by reference the statements and allegations set forth in paragraphs 1-2 with the same force and effect as though fully rewritten herein.

4. These counterclaims arise under the patent laws of the United States, Title 35 of the United States Code. Thus, this Court has subject matter jurisdiction over these counterclaims pursuant to at least 35 U.S.C. § 271 et seq., 28 U.S.C. §§ 1331, 1338, 1367, and 2201-02.

5. Plaintiff has consented to the personal jurisdiction of this Court at least by commencing the present action for patent infringement in this District, as set forth in its Complaint.

6. Without waiving Counterclaim-Plaintiff's argument that venue is inconvenient

under 28 U.S.C. § 1404(a), and based solely on Counterclaim-Defendant's filing of this case in this District and to the extent that this case is not transferred for inconvenient venue, venue for Counterclaim-Plaintiff's Counterclaims is proper in this District pursuant to at least 28 U.S.C. §§ 1391 and 1400.

BACKGROUND

7. Counterclaim-Plaintiff incorporates by reference the statements and allegations set forth in paragraphs 1-6 with the same force and effect as though fully rewritten herein.

8. Counterclaim-Defendant filed suit in this matter, asserting infringement by Counterclaim-Plaintiff of United States Patent Nos. 7,629,634 ("the '634 Patent") and 7,847,346 ("the '346 Patent") (collectively, the "Patents-in-Suit"). Counterclaim-Plaintiff denies that it infringes the Patents-in-Suit. Thus, an actual and justiciable controversy exists between Counterclaim-Plaintiff and Counterclaim-Defendant as to whether or not Counterclaim-Plaintiff infringes any valid claim of the Patents-in-Suit.

9. Pursuant to the Declaratory Judgments Act, 28 U.S.C. §§ 2201-2202, Counterclaim-Plaintiff is entitled to a declaratory judgment of non-infringement and invalidity of the claims of the Patents-in-Suit.

COUNTERCLAIM COUNT I: DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '634 PATENT

10. Counterclaim-Plaintiff incorporates by reference the statements and allegations set forth in paragraphs 1-9 with the same force and effect as though fully rewritten herein.

11. An actual controversy exists between Counterclaim-Plaintiff and Counterclaim-Defendant regarding the alleged infringement of the '634 Patent.

12. Counterclaim-Plaintiff has not infringed and is not infringing, either literally or under the doctrine of equivalents, any claim of the '634 Patent under any theory, including directly

(whether individually or jointly) or indirectly (whether contributorily or by inducement).

13. Counterclaim-Plaintiff is entitled to a declaratory judgment that it has not infringed and is not infringing, either literally or under the doctrine of equivalents, any claim of the '634 Patent under any theory, including directly (whether individually or jointly) or indirectly (whether contributorily or by inducement).

COUNTERCLAIM COUNT II: DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '346 PATENT

14. Counterclaim-Plaintiff incorporates by reference the statements and allegations set forth in paragraphs 1-13 with the same force and effect as though fully rewritten herein.

15. An actual controversy exists between Counterclaim-Plaintiff and Counterclaim-Defendant regarding the alleged infringement of the '346 Patent.

16. Counterclaim-Plaintiff has not infringed and is not infringing, either literally or under the doctrine of equivalents, any claim of the '346 Patent under any theory, including directly (whether individually or jointly) or indirectly (whether contributorily or by inducement).

17. Counterclaim-Plaintiff is entitled to a declaratory judgment that it has not infringed and is not infringing, either literally or under the doctrine of equivalents, any claim of the '346 Patent under any theory, including directly (whether individually or jointly) or indirectly (whether contributorily or by inducement).

COUNTERCLAIM COUNT III: DECLARATORY JUDGMENT OF INVALIDITY OF THE '634 PATENT

18. Counterclaim-Plaintiff incorporates by reference the statements and allegations set forth in paragraphs 1-17 with the same force and effect as though fully rewritten herein.

19. An actual controversy exists between Counterclaim-Plaintiff and Counterclaim-Defendant regarding the invalidity of the '634 Patent.

20. The claims of the '634 Patent are invalid for failure to meet the conditions and

requirements set forth in 35 U.S.C. §§ 101, 102, 103, and/or 112.

21. Counterclaim-Plaintiff is entitled to a declaratory judgment that the claims of the '634 Patent are invalid.

COUNTERCLAIM COUNT IV: DECLARATORY JUDGMENT OF INVALIDITY OF THE '346 PATENT

22. Counterclaim-Plaintiff incorporates by reference the statements and allegations set forth in paragraphs 1-21 with the same force and effect as though fully rewritten herein.

23. An actual controversy exists between Counterclaim-Plaintiff and Counterclaim-Defendant regarding the invalidity of the '346 Patent.

24. The claims of the '346 Patent are invalid for failure to meet the conditions and requirements set forth in 35 U.S.C. §§ 101, 102, 103, and/or 112.

25. Counterclaim-Plaintiff is entitled to a declaratory judgment that the claims of the '346 Patent are invalid.

PRAYER FOR RELIEF

WHEREFORE, ASUS respectfully requests that the Court enter a judgment in ASUS's favor against Plaintiff/Counterclaim-Defendant and issue an order that includes:

a) A declaration that ASUS has not infringed, and does not infringe, either directly, indirectly, or otherwise, any valid and enforceable claim of the '634 Patent;

b) A declaration that the claims of the '634 Patent are invalid, void, or unenforceable;

c) A declaration that ASUS has not infringed, and does not infringe, either directly, indirectly, or otherwise, any valid and enforceable claim of the '346 Patent;

d) A declaration that the claims of the '346 Patent are invalid, void, or unenforceable;

e) Judgment against Plaintiff/Counterclaim-Defendant and in favor of ASUS;

f) An order that Plaintiff/Counterclaim-Defendant take nothing from ASUS on each and

every claim asserted in the Complaint;

g) Dismissal of the Complaint with prejudice;

h) A declaration that this case is exceptional under 35 U.S.C. § 285 and an award to ASUS of its reasonable attorneys' fees incurred in this action;

i) An award to ASUS of its costs, expenses, and disbursements associated with this action; and

j) An award to ASUS of any further relief as the Court may deem just and proper.

DEMAND FOR JURY TRIAL

ASUS demands a trial by jury for all issues so triable.

Dated: February 27, 2023

Respectfully submitted,

/s/ *Mackenzie M. Martin*

Mackenzie M. Martin
Texas Bar No. 24066659
E-Mail: mackenzie.martin@bakermckenzie.com
Nicholas O. Kennedy
Texas Bar No. 24087841
E-Mail: nicholas.kennedy@bakermckenzie.com

BAKER & MCKENZIE LLP
1900 N. Pearl Street, Suite 1500
Dallas, TX 75201
Telephone: +1 214 978 3000
Facsimile: +1 214 978 3099

Dorian Ojemen
Texas Bar No. 24066659
E-Mail: dorian.ojemen@bakermckenzie.com

BAKER & MCKENZIE LLP
700 Louisiana, Suite 3000
Houston, Texas 77002
Telephone: +1 713 427 5000
Facsimile: +1 713 427 5099

Attorneys for ASUSTek Computer, Inc.

CERTIFICATE OF SERVICE

The undersigned certifies that on this 27 day of February, 2023, all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document through the Court's CM/ECF system under Local Rule CV-5.

/s/ *Mackenzie M. Martin*
Mackenzie M. Martin