

1 Timothy Saulsbury (CA SBN 281434)
MORRISON & FOERSTER LLP
2 425 Market Street
San Francisco, CA 94105
3 Telephone: (415) 268-7000
Facsimile: (415) 268-7522
4 Email: TSaulsbury@mofo.com

5 Yuka Teraguchi (CA SBN 260541)
MORRISON & FOERSTER LLP
6 Shin-Marunouchi Building, 29th Floor
5-1, Marunouchi 1-Chome, Chiyoda-ku
7 Tokyo, Japan, 100-6529
Telephone: 81-3-3214-6522
8 Facsimile: 81-3-3214-6512
Email: YTeraguchi@mofo.com

10 Attorneys for Plaintiff
RENASAS ELECTRONICS AMERICA INC.

Regan Rundio (TX SBN 24122087)
(*pro hac vice* forthcoming)
MORRISON & FOERSTER LLP
300 Colorado Street Suite 1800
Austin, TX 78701
Telephone: (512) 617-0650
Facsimile: (737) 910-0730
Email: RRundio@mofo.com

Caleb Woods (District of Columbia 1780872)
(*pro hac vice* forthcoming)
MORRISON & FOERSTER LLP
2100 L Street, NW Suite 900
Washington, D.C., 20037
Telephone: (202) 887-1500
Facsimile: (202) 887-0763
Email: CalebWoods@mofo.com

11
12 UNITED STATES DISTRICT COURT
13 NORTHERN DISTRICT OF CALIFORNIA

16 RENASAS ELECTRONICS AMERICA INC.,
17 Plaintiff,
18 v.
19 MONTEREY RESEARCH, LLC
20 Defendant.

Case No.
**COMPLAINT FOR
DECLARATORY JUDGMENT
OF NON-INFRINGEMENT OF
U.S. PATENT NOS. 6,243,300,
7,679,968, 7,089,133, AND
7,825,688**

DEMAND FOR JURY TRIAL

1 Plaintiff Renesas Electronics America Inc. (“REA”), for its Complaint against Defendant
2 Monterey Research, LLC (“Monterey”), alleges as follows:

3 **NATURE OF THE ACTION**

4 1. This is a declaratory judgment action arising under the Declaratory Judgment Act,
5 28 U.S.C. § 2201 et seq. and the Patent Laws of the United States, 35 U.S.C. § 1 et seq. REA
6 seeks a declaration of non-infringement of United States Patents Nos.: 6,243,300 (“the ’300
7 patent”), 7,679,968 (“the ’968 patent”), 7,089,133 (“the ’133 patent”), and 7,825,688 (“the ’688
8 patent”) (together, the “Patents-in-Suit”).

9 **THE PARTIES**

10 2. Plaintiff REA is a corporation organized and existing under the laws of California,
11 with a place of business at 6024 Silver Creek Valley Rd., San Jose, California 95138. REA is an
12 industry leader in microcontrollers, analog, power, and SoC products.

13 3. Defendant Monterey is a corporation organized and existing under the laws of
14 Delaware, with a principal place of business at 2880 Lakeside Drive, Suite 320, Santa Clara,
15 California 95054.

16 4. Monterey claims to be the owner by assignment of all right, title and interest in the
17 Patents-in-Suit.

18 **JURISDICTION AND VENUE**

19 5. This action arises under the Declaratory Judgment Act, 28 U.S.C. §§ 2201-2202,
20 and under the patent laws of the United States, 35 U.S.C. §§ 1 *et seq.*

21 6. This Court has subject matter jurisdiction over this action under 28 U.S.C.
22 §§ 1331, 1338(a), 2201(a), and 2202.

23 7. As described in more detail below, an immediate, real, and justiciable controversy
24 exists between REA and Monterey as to whether REA is infringing or has infringed the Patents-
25 in-Suit.

26 8. Monterey is subject to personal jurisdiction in this District because its principal
27 place of business is in this District, it directed patent enforcement activity against REA in this
28 District, and REA’s claims for relief arise from and/or relate to that activity.

1 9. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b)-(c).

2 **PATENTS-IN-SUIT**

3 10. The '300 Patent, entitled "Substrate Hole Injection for Neutralizing Spillover
4 Charge Generated During Programming of a Non-Volatile Memory Cell," issued on June 5, 2001.
5 Advanced Micro Devices, Inc. is listed as the owner by assignment on the face of the patent. A
6 true and correct copy of the '300 patent is attached as Exhibit A.

7 11. The '968 Patent, entitled "Enhanced Erasing Operation for Non-Volatile
8 Memory," issued on March 16, 2010. Spansion LLC is listed as the owner by assignment on the
9 face of the patent. A true and correct copy of the '968 patent is attached as Exhibit B.

10 12. The '133 Patent, entitled "Method and Circuit for Providing a System Level Reset
11 Function for an Electronic Device," issued on August 8, 2006. Cypress Semiconductor Corp. is
12 listed as the owner by assignment on the face of the patent. A true and correct copy of the '133
13 patent is attached as Exhibit C.

14 13. The '688 Patent, entitled "Programmable Microcontroller Architecture (Mixed
15 Analog/Digital)," issued on November 2, 2010. Cypress Semiconductor Corp. is listed as the
16 owner by assignment on the face of the patent. A true and correct copy of the '688 patent is
17 attached as Exhibit D.

18 14. On information and belief, the Patents-in-Suit were subsequently assigned to
19 Monterey. A true and correct copy of the Assignments of Assignors' Interests for the Patents-in-
20 Suit is attached as Exhibit E.

21 **MONTEREY'S ENFORCEMENT OF ITS PATENT PORTFOLIO**
22 **AND THREATS AGAINST RENESAS**

23 15. Monterey is a subsidiary of IP Value Management, a patent monetization
24 company. IP Value boasts that Monterey owns over 1,500 worldwide patents and pending
25 applications that originated from Cypress Semiconductor, Spansion, and other major
26 semiconductor companies.¹ These patents relate to "memory, computing architecture,

27 _____
28 ¹ Portfolios, IP Value, *available at*: <https://www.ipvalue.com/portfolios> (last visited Aug 15, 2024). A true and correct copy of IP Value's website is attached as Exhibit F.

1 communication and network architecture, processors, microcontrollers, semiconductors, and
2 power management.”²

3 16. Monterey is an aggressive asserter of its patent portfolio, engaging in ceaseless
4 litigation against many major semiconductor companies. Indeed, over the last five years,
5 Monterey has been involved in over twelve lawsuits involving patents in the same patent family
6 as, or otherwise similar to, the Patents-in-Suit. *See, e.g., Monterey Research, LLC v. Qualcomm*
7 *Inc.*, No. 1:19-cv-02083 (D. Del), No. 6:21-cv-00936 (W.D. Tex.); *Monterey Research, LLC v.*
8 *Nanya Tech. Corp.*, No. 1:19-cv-02090 (D. Del.); *Monterey Research, LLC v. Advanced Micro*
9 *Devices, Inc.*, No. 1:19-cv-02149 (D. Del.), Nos. 6:21-cv-00839 & -00840 (W.D. Tex.); *Monterey*
10 *Research, LLC v. STMicroelectronics N.V.*, No. 1:20-cv-00089 (D. Del.); *Monterey Research,*
11 *LLC v. Marvell Tech. Grp. Ltd.*, No. 1:20-cv-00158 (D. Del.); *Monterey Research, LLC v.*
12 *Broadcom Inc.*, Nos. 6:21-cv-00541 & -00542 (W.D. Tex.); and *Monterey Research, LLC v.*
13 *Toshiba Am. Elec. Components, Inc.*, No. 6:23-cv-00340 (W.D. Tex.). Thus, Monterey has
14 enforced its patents against companies headquartered in this District, including Broadcom Inc.,
15 Marvell Semiconductor, Inc., and Nanya Technology Corporation, U.S.A.

16 17. Monterey has expressly accused REA of infringing the Patents-in-Suit. On or
17 about August 7, 2018, Monterey sent a letter to REA and Renesas Electronics Corporation
18 (“REL”; collectively with REA, “Renesas”) alleging that certain Renesas products infringe
19 the ’300 and ’968 patents. The letter was addressed to the President and Vice President &
20 General Counsel of REA at REA’s place of business in this District as well as the President and
21 CEO of REL in Japan. Monterey’s August 7, 2018 letter included a table entitled “List of
22 Monterey Research LLC owned Patents Infringed by Renesas.” In the table, Monterey alleged
23 that Renesas’s H8SX microcontrollers and Renesas products containing embedded flash memory
24 manufactured using its 40 nm process or 28 nm process infringe the ’300 patent. Monterey also
25 alleged that Renesas’s microcontrollers with 90nm 1-Transistor MONOS embedded flash
26

27 ² *Id.*
28

1 memory and other products manufactured using its 90 nm process or smaller infringe the '968
2 patent.

3 18. On or about March 1, 2022, Monterey sent a letter to Renesas alleging that certain
4 Renesas products infringe the '133 and '688 patents. The letter was addressed to the President
5 and Vice President & General Counsel of REA at REA's place of business in this District as well
6 as the President and CEO of REL in Japan. In the letter, Monterey stated that "Monterey has
7 identified additional products of Renesas and its subsidiaries . . . which incorporate and use
8 technologies covered by Monterey patents" and pointed to a table listing those patents and
9 products. In the table, Monterey alleged that Renesas's M16C family microcontrollers, RA
10 Series, RX Family, RX700 Series, and RL78/F15 chips infringe the '133 patent. Monterey also
11 alleged that Renesas's RH850 devices infringe the '688 patent. Monterey further reiterated that
12 Renesas products incorporating an embedded flash memory with a MONOS-based macro infringe
13 the '968 patent.

14 19. On April 10, 2024, Monterey brought suit against REL, Denso Corporation, and
15 Denso International America, Inc., in the U.S. District Court for the Eastern District of Texas,
16 alleging infringement of each of the Patents-in-Suit. *Monterey Research, LLC. v. Renesas Elec.*
17 *Corp.*, No. 2:24-cv-00238 (E.D. Tex.) (the "Texas Suit"). REL is REA's parent corporation, and
18 the two Denso defendants are customers of REL and/or REA.

19 20. In the Texas Suit, Monterey alleged that the defendants "directly and/or through
20 subsidiaries or intermediaries, have committed and continue to commit acts of infringement."
21 Specifically, Monterey alleged that Renesas's RH850 devices and other Renesas products
22 incorporating embedded flash memory devices made using Renesas's 40 nm and 28 nm processes
23 infringe the '300 patent. Monterey also alleged that Renesas RX600 family devices and other
24 Renesas products incorporating embedded flash memory devices made using Renesas's 90 nm,
25 40 nm, and 28 processes infringe the '968 patent. Monterey further alleged that Renesas's M16C
26 family microcontrollers, RA 6 Series, RX and RL series microcontrollers, such as the RL78
27 microcontrollers, and products incorporating such microcontrollers infringe the '133 patent.
28 Lastly, Monterey alleged that Renesas's RH850 devices infringe the '688 patent.

1 21. REA sells, offers to sell, has sold, and/or has offered to sell the RH850, M16C,
 2 RL78, and certain other accused Renesas devices in the United States.

3 22. Monterey’s letter writing campaign and history of litigation against REA’s
 4 competitors, parent company, and customers constitute affirmative enforcement conduct by
 5 Monterey, establishing a substantial controversy of sufficient immediacy and reality regarding
 6 whether REA infringes any claim of the Patents-in-Suit.

7 **COUNT I**

8 **(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE ’300 PATENT)**

9 23. REA restates and incorporates by reference the allegations in the preceding
 10 paragraphs of this Complaint as if fully set forth herein.

11 24. As set forth above, Monterey identified the ’300 patent in its correspondence with
 12 REA and asserts that Renesas’s RH850 devices infringe one or more claims of the ’300 patent.

13 25. REA, however, has not infringed and does not infringe any claim of the ’300
 14 patent, either directly or indirectly, literally or under the doctrine of equivalents.

15 26. REA does not infringe the claims of the ’300 patent because REA’s RH850
 16 devices and other accused devices do not meet at least the limitation that the infringing products
 17 be “multi-bit flash electronically erasable programmable read only memory (EEPROM) cells” as
 18 described by the ’300 patent. More specifically, the RH850 devices and other accused devices
 19 are single-bit flash EEPROM cells.

20 27. Monterey’s litigious history, the infringement allegations by Monterey against
 21 REA, and REA’s denial of infringement have created a substantial, immediate, and real
 22 controversy between the parties as to the non-infringement of the ’300 patent. A valid and
 23 justiciable controversy has arisen and exists between Monterey and REA within the meaning of
 24 28 U.S.C. § 2201.

25 28. A judicial determination of non-infringement is necessary and appropriate so that
 26 REA may ascertain its rights regarding the ’300 patent.

27 **COUNT II**

28 **(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE ’968 PATENT)**

1 29. REA restates and incorporates by reference the allegations in the preceding
2 paragraphs of this Complaint as if fully set forth herein.

3 30. As set forth above, Monterey identified the '968 patent in its correspondence with
4 REA and asserts that Renesas's RX600 devices infringe one or more claims of the '968 patent.

5 31. REA, however, has not infringed and does not infringe any claim of the '968
6 patent.

7 32. REA does not infringe the claims of the '968 patent because REA's RX600
8 devices and other accused devices do not meet at least the limitation of "applying a positive
9 voltage to a well of the memory cell array when the negative voltage reaches a predetermined
10 voltage," as required by claim 1 of the '968 patent. More specifically, the RX600 devices and
11 other accused devices do not apply a negative voltage to a word line of the memory cell array
12 before applying a positive voltage to a well of the memory cell array during an erasing operation
13 of the memory cell array.

14 33. Monterey's litigious history, the infringement allegations by Monterey against
15 Renesas, and REA's denial of infringement have created a substantial, immediate, and real
16 controversy between the parties as to the non-infringement of the '968 patent. A valid and
17 justiciable controversy has arisen and exists between Monterey and REA within the meaning of
18 28 U.S.C. § 2201.

19 34. A judicial determination of non-infringement is necessary and appropriate so that
20 Renesas may ascertain its rights regarding the '968 patent.

21 **COUNT III**

22 **(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '133 PATENT)**

23 35. REA restates and incorporates by reference the allegations in the preceding
24 paragraphs of this Complaint as if fully set forth herein.

25 36. As set forth above, Monterey identified the '133 patent in its correspondence with
26 REA and asserts that Renesas's RL78 microcontrollers infringe one or more claims of the '133
27 patent.
28

1 37. REA, however, has not infringed and does not infringe any claim of the '133
2 patent.

3 38. REA does not infringe the claims of the '133 patent because REA's RL78
4 microcontrollers and other accused devices do not meet at least the limitation of "a second reset
5 function comprising using a tunable monitor of said supply voltage" as required by claim 1 of the
6 '133 patent. More specifically, the RL78 microcontrollers and other accused devices do not
7 perform the second reset function.

8 39. Monterey's litigious history, the infringement allegations by Monterey against
9 REA, and REA's denial of infringement have created a substantial, immediate, and real
10 controversy between the parties as to the non-infringement of the '133 patent. A valid and
11 justiciable controversy has arisen and exists between Monterey and Renesas within the meaning
12 of 28 U.S.C. § 2201.

13 40. A judicial determination of non-infringement is necessary and appropriate so that
14 REA may ascertain its rights regarding the '133 patent.

15 **COUNT IV**

16 **(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '688 PATENT)**

17 41. REA restates and incorporates by reference the allegations in the preceding
18 paragraphs of this Complaint as if fully set forth herein.

19 42. As set forth above, Monterey identified the '688 patent in its correspondence with
20 REA and asserts that Renesas's RH850 devices infringe one or more claims of the '688 patent.

21 43. REA, however, has not infringed and does not infringe any claim of the '688
22 patent.

23 44. REA does not infringe the claims of the '688 patent because REA's RH850
24 devices and other accused devices do not meet at least the limitation of "a bus coupling analog
25 input/output data and digital input/output data" as required by claim 1 of the '688 patent. More
26 specifically, the RH850 devices and other accused devices do not have a bus for transmitting both
27 analog and digital data.
28

1 45. Monterey's litigious history, the infringement allegations by Monterey against
2 REA, and REA's denial of infringement have created a substantial, immediate, and real
3 controversy between the parties as to the non-infringement of the '688 patent. A valid and
4 justiciable controversy has arisen and exists between Monterey and REA within the meaning of
5 28 U.S.C. § 2201.

6 46. A judicial determination of non-infringement is necessary and appropriate so that
7 REA may ascertain its rights regarding the '688 patent.

8
9 **PRAYER FOR RELIEF**

10 WHEREFORE, REA respectfully requests the following relief:

- 11 A. Judgment that REA has not infringed and does not infringe any claim of the
12 Patents-in-Suit;
13 B. Judgment in favor of REA and against Monterey on REA's claims; and
14 C. Such further and additional relief as the Court deems just and proper.

15 **JURY DEMAND**

16 REA demands a jury trial on all issues and claims so triable.
17

18
19 Dated: September 3, 2024

20 MORRISON & FOERSTER LLP
21 TIMOTHY C. SAULSBURY

22 By: /s/ Timothy C. Saulsbury
23 Timothy C. Saulsbury

24 Attorneys for Plaintiff
25 RENESAS ELECTRONICS
26 AMERICA INC.
27
28