

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

TESSEMA DOSHO SHIFFERAW,

Plaintiff,

v.

EMSON USA, E. MISHAN & SONS,  
INC., ACADEMY, LTD. d/b/a  
ACADEMY SPORTS & OUTDOORS  
and AMAZON.COM, INC.

Defendants.

CIVIL ACTION NO. 2:09-CV-54

JURY TRIAL REQUESTED

**DEFENDANTS' ANSWER, AFFIRMATIVE DEFENSES,  
AND COUNTERCLAIMS TO PLAINTIFF'S COMPLAINT**

E. Mishan & Sons, Inc. ("Mishan"), Emson USA ("Emson")<sup>1</sup>, Academy, LTD d/b/a/ Academy Sports & Outdoors ("Academy") and Amazon.com, Inc. ("Amazon") for their Answer, Affirmative Defenses, and Counterclaims to the Amended Complaint of Tessema Dosho Shifferaw ("Tessema"), state as follows:

**PARTIES**

1. Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1 of the Complaint and therefore deny them.
2. Defendants deny the allegations set forth in paragraph 2 of the Complaint.
3. Defendant Mishan admits that it is a New York Corporation with its principal place of business in New York, New York. Defendant Mishan denies all

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<sup>1</sup> Although Plaintiff named "Emson USA" as a defendant, no such entity exists.

remaining allegations of paragraph 3 of the Complaint. The remaining defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations set forth in paragraph 3 of the Complaint, and therefore deny them.

4. Defendant Academy admits that it is a Texas Corporation, and that it is doing business in this Judicial District. Defendant Academy denies all remaining allegations of paragraph 4 of the Complaint. The remaining defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations set forth in paragraph 4 of the Complaint, and therefore deny them.

5. Defendant Amazon admits that it is a Delaware Corporation with its principal place of business in Seattle, Washington. Defendant Amazon denies all remaining allegations set forth in paragraph 5 of the Complaint. The remaining defendants are without sufficient knowledge or information to form a belief as to the truth of the allegations set forth in paragraph 5 of the Complaint, and therefore deny them.

**JURISDICTION AND VENUE**

6. Defendants admit that the Complaint purports to state a claim for patent infringement pursuant to Title 35 of the United States Code, including sections 271 and 281-285.

7. Defendants admit the allegations set forth in paragraph 7 of the Complaint.

8. Defendants Mishan, Emson, and Academy does not contest that venue is proper in this District. Defendants Mishan, Emson, and Academy deny each and every remaining allegation contained in paragraph 8 of the Complaint. Defendant Amazon is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 8 of the Complaint, and on this basis denies them.

Defendants further maintain that there are more convenient forums in which to proceed with this action.

9. Defendants do not contest the personal jurisdiction of this Court for this Action, but deny each and every remaining allegation contained in paragraph 9 of the Complaint.

10. Defendants Mishan, Emson, and Academy admit that they have sold a small number of abdominal exercise equipment in this District under the trade name “Ab Rocket<sup>®</sup>”. The vast majority of these devices, however, are sold outside of the State of Texas. To the extent already admitted in paragraph 8, defendants Mishan, Emson, and Academy does not contest that venue is proper in this jurisdiction. Defendants Mishan, Emson and Academy deny each and every remaining allegation contained in paragraph 10 of the Complaint. Defendant Amazon is without knowledge or information sufficient to form a belief as to the truth of the allegations set forth in paragraph 10 of the Complaint, and on this basis denies them.

11. To the extent already stated in paragraph 9, Defendants do not contest the personal jurisdiction of this Court for this Action, but deny each and every remaining allegation contained in paragraph 9 of the Complaint.

#### **GENERAL ALLEGATIONS**

12. Defendants admit that U.S. Patent No. 7, 137, 933 (“the '933 Patent”) is titled “Apparatus and Methods for Abdominal Muscle and Gluteal Muscle Exercise.” and that U.S. Patent No. 6, 716, 144 (“The '144 Patent”) is titled “Abdominal Exercise Machine.” Defendants further admit that Shifferaw is listed on the face of the '933 and '144 patents as the inventor. Defendants are without knowledge sufficient to form a

belief as to the truth of the remaining allegations set forth in paragraph 12 and on this basis denies them.

**COUNT I**

13. In response to paragraph 13 of the Complaint, Defendants repeat and incorporate by reference all above responses to the allegations of the Complaint as if fully set forth herein.

14. Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 14 of the Complaint and on this basis denies them.

15. On information and belief, Defendants deny the allegations set forth in paragraph 15 of the Complaint.

16. Defendants deny the allegations set forth in paragraph 16 of the Complaint.

17. Defendants deny the allegations set forth in paragraph 17 of the Complaint.

18. Defendants deny the allegations set forth in paragraph 18 of the Complaint.

19. Defendants deny the allegations set forth in paragraph 19 of the Complaint.

20. Defendants deny the allegations set forth in paragraph 20 of the Complaint.

21. Defendants deny the allegations set forth in paragraph 21 of the Complaint.

22. Defendants deny the allegations set forth in paragraph 22 of the Complaint.

23. Defendants deny the allegations set forth in paragraph 23 of the Complaint.

24. Defendants deny the allegations set forth in paragraph 24 of the Complaint.

**RESPONSE TO DEMAND FOR JURY TRIAL**

25. Paragraph 25 does not state any allegations to which Defendants are required to respond.

**RESPONSE TO PRAYER FOR RELIEF**

26. Defendants deny that Shifferaw is entitled to any relief whatsoever from them.

**AFFIRMATIVE DEFENSES**

27. As separate affirmative defenses to the Complaint, Defendants allege as follows:

**FIRST AFFIRMATIVE DEFENSE**

**(Non-Infringement)**

28. Defendants repeat and incorporate by reference paragraphs 1 - 26 as if fully set forth herein.

29. Defendants have not infringed, either directly, indirectly, literally or under the doctrine of equivalents, any claim of either the '933 or '144 patent.

**SECOND AFFIRMATIVE DEFENSE**

**(Invalidity)**

30. Defendants repeat and incorporate by reference paragraphs 1 - 28 as if fully set forth herein.

31. On information and belief, the '933 and '144 patents are invalid for failure to comply with one or more provisions of the Patent Laws of the United States, 35 U.S.C. §§ 101, *et seq.*, including, without limitation, 35 U.S.C. §§ 102, 103, and 112.

**THIRD AFFIRMATIVE DEFENSE**

**(Laches)**

32. Defendants repeat and incorporate by reference paragraphs 1 - 30 as if fully set forth herein.

33. On information and belief, Plaintiff has been aware of the accused products for years.

34. On information and belief, and despite this knowledge, Plaintiff has delayed in bringing a patent lawsuit against Defendants.

35. On information and belief, this delay is unreasonable and unexcused.

36. Plaintiff's delay has materially prejudiced Defendants.

37. Any damages that Plaintiff claims are therefore barred in whole or in part by the doctrine of Laches.

**COUNTERCLAIMS**

38. Defendants counterclaim against Plaintiff as follows:

## THE PARTIES

39. Counterclaimant E. Mishan & Sons, Inc. ("Mishan")<sup>2</sup> is a New York corporation having its principal place of business at 230 Fifth Avenue, New York, New York, 10001.

40. Counterclaimant Academy, Ltd., d/b/a Academy Sports and Outdoors is a domestic limited partnership organized under the laws of Texas, having an office and place of business at 1800 North Mason Road, Katy, Texas.

41. Counterclaimant Amazon.com, Inc. is a corporation organized under the laws of Delaware, with a principal place of business in Seattle, Washington.

42. Counterclaim-Plaintiffs are informed and believe and on this basis allege that Counterclaim-Defendant Tessema Dosho Shifferaw ("Shifferaw") is an individual residing in California.

## JURISDICTION AND VENUE

43. This Court has personal jurisdiction over Counterclaim-Defendant for these Counterclaims, as Counterclaim-Defendant has submitted to the jurisdiction of this Court by filing its Complaint.

44. These Counterclaims arise under the Declaratory Judgment Act, 28 U.S.C. §§ 2201 and 2202, and under the Patent Laws of the United States, 35 U.S.C. § 1, *et seq.* This Court has jurisdiction over the subject matter of these Counterclaims under 28 U.S.C. §§ 1331 and 1338(a).

45. Venue in this Court is proper under 28 U.S.C. § 1391(b) and (c).

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<sup>2</sup> In the event the Court finds that Emson USA is a legal entity, "Mishan" also includes Emson USA.

## **FIRST COUNTERCLAIM**

### **(Declaratory Judgment of Non-Infringement of the '933 Patent)**

46. Counterclaim-Plaintiffs reallege and incorporate by reference the allegations in paragraphs 37 through 44, inclusive, as though fully set forth in this paragraph.

47. In its Complaint, Counterclaim-Defendant alleges that it is the owner of United States Patent No. 7,137,933 ("933 patent"). Counterclaim-Defendant alleges that Counterclaim-Plaintiffs have infringed, contributed to the infringement of and induced others to infringe the '933 Patent. In the Answer, Counterclaim-Plaintiffs deny that they have infringed, contributed to the infringement of, or induced others to infringe any valid claim of the '933 Patent. Accordingly, there exists a substantial and continuing justiciable controversy between Counterclaim-Defendant and Counterclaim-Plaintiffs as to the noninfringement of the '933 patent.

48. Counterclaim-Plaintiffs request that the Court enter a declaratory judgment that Counterclaim-Plaintiffs have not infringed, contributed to the infringement of or induced others to infringe any claim of the '933 patent.



## **SECOND COUNTERCLAIM**

### **(Declaratory Judgment of Invalidity of the '933 Patent)**

49. Counterclaim-Plaintiffs reallege and incorporate by reference the allegations in paragraphs 37 through 47, inclusive, as though fully set forth in this paragraph.

50. In its Complaint, Counterclaim-Defendant asserts that the '933 patent is valid and enforceable. In the Answer, Counterclaim-Plaintiffs allege that the '933 patent is invalid for failure to comply with one or more provisions of the Patent Laws of the United States, 25 U.S.C. §§ 101, *et seq.*, including, without limitation, 25 U.S.C. §§ 102, 103 and 112. Accordingly, there exists a substantial and continuing justiciable controversy between Counterclaim-Defendant and Counterclaim-Plaintiffs as to the validity or invalidity of the '933 patent.

51. Counterclaim-Plaintiffs request that the Court enter a declaratory judgment that the '933 patent is invalid for failure to comply with one or more provisions of the Patent Laws of the United States, 25 U.S.C. §§ 101, *et seq.*, including, without limitation, 25 U.S.C. §§ 102, 103 and 112.

## **THIRD COUNTERCLAIM**

### **(Declaratory Judgment of Non-Infringement of the '144 Patent)**

52. Counterclaim-Plaintiffs reallege and incorporate by reference the allegations in paragraphs 37 through 50, inclusive, as though fully set forth in this paragraph.

53. In its Complaint, Counterclaim-Defendant alleges that it is the owner of United States Patent No. 6,716,144 ("144 patent"). Counterclaim-Defendant alleges that

Counterclaim-Plaintiffs have infringed, contributed to the infringement of and induced others to infringe the '144 Patent. In the Answer, Counterclaim-Plaintiffs deny that they have infringed, contributed to the infringement of, or induced others to infringe any valid claim of the '144 Patent. Accordingly, there exists a substantial and continuing justiciable controversy between Counterclaim-Defendants and Counterclaim-Plaintiffs as to the noninfringement of the '144 patent.

54. Counterclaim-Plaintiffs request that the Court enter a declaratory judgment that Counterclaim-Plaintiffs have not infringed, contributed to the infringement of or induced others to infringe any claim of the '144 patent.

#### **FOURTH COUNTERCLAIM**

##### **(Declaratory Judgment of Invalidity of the '144 Patent)**

55. Counterclaim-Plaintiffs reallege and incorporate by reference the allegations in paragraphs 37 through 53, inclusive, as though fully set forth in this paragraph.

56. In its Complaint, Counterclaim-Defendant asserts that the '144 patent is valid and enforceable. In the Answer, Counterclaim-Plaintiffs allege that the '144 patent is invalid for failure to comply with one or more provisions of the Patent Laws of the United States, 25 U.S.C. §§ 101, *et seq.*, including, without limitation, 25 U.S.C. §§ 102, 103 and 112. Accordingly, there exists a substantial and continuing justiciable controversy between Counterclaim-Defendant and Counterclaim-Plaintiffs as to the validity or invalidity of the '144 patent.

57. Counterclaim-Plaintiffs request that the Court enter a declaratory judgment that the '144 patent is invalid for failure to comply with one or more provisions

of the Patent Laws of the United States, 25 U.S.C. §§ 101, *et seq.*, including, without limitation, 25 U.S.C. §§ 102, 103 and 112.

**PRAYER FOR RELIEF**

WHEREFORE, Counterclaim-Plaintiffs respectfully request the following relief:

- A. That Counterclaim-Defendant's Complaint be dismissed with prejudice, and that Counterclaim-Defendant take nothing by way of his Complaint;
- B. That a judgment be entered declaring that the '933 patent is invalid, and further declaring that the '933 patent has not been infringed by Counterclaim-Plaintiffs either literally or under the doctrine of equivalents, and further declaring that Counterclaim-Plaintiffs have not induced others to infringe and has not contributed to the infringement of the '933 patent either literally or under the doctrine of equivalents;
- C. That a judgment be entered declaring that the '144 patent is invalid, and further declaring that the '144 patent has not been infringed by Counterclaim-Plaintiffs either literally or under the doctrine of equivalents, and further declaring that Counterclaim-Plaintiffs have not induced others to infringe and has not contributed to the infringement of the '144 patent either literally or under the doctrine of equivalents;
- D. That Counterclaim-Plaintiffs be awarded their costs and disbursements in this action;
- E. That this case be declared as exceptional pursuant to 25 U.S.C. § 285 and that Counterclaim-Plaintiffs be awarded its reasonable attorneys' fees in this action; and
- F. That Counterclaim-Plaintiffs be granted such other relief and further relief as this Court deems just and proper.

**DEMAND FOR A JURY TRIAL**

Counterclaim-Plaintiffs hereby demand a trial by jury of all issues so triable in this Action.

Respectfully submitted,

By: /s/ Edward J. DeFranco (by Wesley Hill)

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ATTORNEYS FOR DEFENDANTS

**CERTIFICATE OF SERVICE**

The undersigned certifies that the foregoing document was filed electronically in compliance with Local Rule CV-5(a). As such, this motion was served on all counsel who are deemed to have consented to electronic service. Local Rule CV-5(a)(3)(A). Pursuant to Fed. R. Civ. P. 5(d) and Local Rule CV-5(d) and (e), all other counsel of record not deemed to have consented to electronic service were served with a true and correct copy of the foregoing by email, on this the 7th day of May, 2009.

/s/ Wesley Hill  
Wesley Hill