

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, DC

In the Matter of

**CERTAIN SINGLE-MOLECULE
NUCLEIC ACID SEQUENCING
SYSTEMS AND REAGENTS,
CONSUMABLES, AND SOFTWARE
FOR USE WITH SAME**

Investigation No. 337-TA-1032

**NOTICE OF COMMISSION DETERMINATION NOT TO REVIEW
AN INITIAL DETERMINATION GRANTING AN UNOPPOSED MOTION TO
AMEND THE COMPLAINT AND NOTICE OF INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined not to review an initial determination (“ID”) (Order No. 6) granting an unopposed motion to add allegations of violation of section 337 through the sale for importation, importation, or sale after importation into the United States of articles that infringe certain claims of U.S. Patent No. 9,542,527.

FOR FURTHER INFORMATION CONTACT: Lucy Grace D. Noyola, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, SW, Washington, DC 20436, telephone 202-205-3438. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, SW, Washington, DC 20436, telephone 202-205-2000. General information concerning the Commission may also be obtained by accessing its Internet server (<https://www.usitc.gov>). The public record for this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal on 202-205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on December 8, 2016, based on a complaint filed by Pacific Biosciences of California, Inc. of Menlo Park, California (“PacBio”). 81 FR 88703-04 (Dec. 8, 2016). The complaint alleges violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. 1337, in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain single-molecule nucleic acid sequencing systems and reagents, consumables, and software for use with same by reason of infringement of certain claims of U.S.

Patent No. 9,404,146 (“the ’146 patent”). *Id.* at 88704. The notice of investigation named as respondents Oxford Nanopore Technologies Ltd. of Oxford, United Kingdom; Oxford Nanopore Technologies, Inc. of Cambridge, Massachusetts; and Metrichor, Ltd. of Oxford, United Kingdom (collectively, “Respondents”). *Id.* The Office of Unfair Import Investigations (“OUII”) also was named as a party to the investigation. *Id.*

On February 3, 2017, PacBio filed a motion to amend the complaint and notice of investigation to add allegations of violation of section 337 through the sale for importation, importation, or sale after importation into the United States of articles that infringe claims 1 and 3-11 of U.S. Patent No. 9,542,527 (“the ’527 patent”). Specifically, PacBio sought to add allegations that Respondents directly infringe, contributorily infringe, and/or induce the infringement of the asserted claims of the ’527 patent. Respondents and OUII did not oppose the motion.

On February 21, 2017, the presiding administrative law judge (“ALJ”) issued an ID, Order No. 6, granting the motion to amend the complaint and notice of investigation. The ALJ found good cause for the amendment. The ALJ found that PacBio could not have asserted the ’527 patent when it filed the original complaint because the ’527 patent was issued after institution of the investigation, and that PacBio sought to add the allegations relating to the ’527 patent soon after its issuance. The ALJ also found that the amendment would not prejudice the public interest or the parties. The ALJ found that (1) the ’527 patent involves the same technology as the ’146 patent; (2) the ’527 and ’146 patents are related, claim priority to the same provisional application, name the same inventors, and share a substantially identical specification; and (3) PacBio represents that the accused products and domestic industry products for the ’527 and ’146 patents are identical, obviating the need for excessive additional discovery. The ALJ also found that the amendment was in the public interest because litigating the ’527 and ’146 patents in separate investigations would waste judicial and public resources. No petitions for review of the ID were filed.

The Commission has determined not to review the subject ID.

The authority for the Commission’s determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337), and in part 210 of the Commission’s Rules of Practice and Procedure (19 C.F.R. part 210).

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: March 22, 2017