

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN ROAD MILLING
MACHINES AND COMPONENTS
THEREOF**

Investigation No. 337-TA-1067

**NOTICE OF A COMMISSION DETERMINATION TO REVIEW IN PART A
FINAL INITIAL DETERMINATION; SCHEDULE FOR FILING WRITTEN
SUBMISSIONS ON REMEDY, THE PUBLIC INTEREST, AND BONDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission (“the Commission”) has determined to review in part the final initial determination (“ID”) issued by the presiding administrative law judge (“ALJ”) finding a violation of section 337 of the Tariff Act of 1930, as amended (“section 337”), in the above-referenced investigation on October 1, 2018.

FOR FURTHER INFORMATION CONTACT: Michael Liberman, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-3115. 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, S.W., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <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 under section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 (“section 337”), on August 25, 2017, based on a complaint filed by Wirtgen America, Inc. of Antioch, Tennessee (“Wirtgen” or “Complainant”). 82 FR 40596-97 (Aug. 25, 2017). The complaint alleges a violation of section 337 by reason of infringement of certain claims of U.S. Patent Nos. 9,644,340 (“the ‘340 patent”); 9,624,628 (“the ‘628 patent”); 9,656,530 (“the ‘530 patent”); 7,530,641 (“the ‘641 patent”); and 7,828,309 (“the ‘309 patent”). The complaint named as respondents Caterpillar Bitelli SpA of Minerbio, Italy (“Caterpillar Bitelli”); Caterpillar Prodotti Stradali S.r.L. of Minerbio, Italy; Caterpillar Americas CV of Geneva, Switzerland; Caterpillar

Paving Products, Inc. of Minneapolis, MN; and Caterpillar Inc. of Peoria, IL (“Caterpillar” or “Respondents”). *Id.* at 40596. The Office of Unfair Import Investigations is named as a party in this investigation. *Id.* Subsequently, the investigation was terminated as to respondent Caterpillar Bitelli. The investigation was also terminated with respect to the ‘628 patent.

The evidentiary hearing on the question of violation of section 337 was held April 20-24, 2018. The ALJ issued a final ID on violation on October 1, 2018. The ID found that a violation of section 337 has occurred in this investigation with respect to the ‘530 and ‘309 patents, and no violation of section 337 has occurred with respect to the ‘641 and ‘340 patent. The Commission determined to extend the deadlines for determining whether to review the final ID and/or the target date of the investigation by notices dated February 21, 2019; February 4, 2019; and November 9, 2018. We note that these notices inadvertently misstated that the ALJ found no violation of section 337 in this investigation, and we hereby correct those misstatements. The ALJ issued his recommended determination (“RD”) on remedy, the public interest and bonding on October 18, 2018. The RD recommended that if the Commission finds a violation of section 337 in the present investigation, the Commission should: (1) issue a limited exclusion order (“LEO”) covering products that infringe the patent claims as to which a violation of section 337 has been found; (2) issue a cease and desist order (“CDO”); and (3) require no bond during the Presidential review period.

Both parties to the investigation filed timely petitions for review of various portions of the final ID, as well as timely responses to the petitions. The parties also timely filed their respective Public Interest Statements pursuant to 19 CFR 210.50(a)(4). Responses from the public were likewise received by the Commission pursuant to notice. *See* Notice of Request for Statements on the Public Interest (Oct. 16, 2018).

Having examined the record in this investigation, including the final ID, the petitions for review, and the responses thereto, the Commission has determined to review the final ID in part. In particular, the Commission has determined to review the ALJ’s findings and analysis pertaining to the obviousness determinations with regard to claims 26, 35, and 36 of the ‘309 patent, *see* ID at 107-111, 120-123, 124-128, 128-130, 130-136, and, on review, to state that these findings and analysis lead to the conclusion that claims 26, 35, and 36 are invalid as obvious. As a result, the Commission modifies the conclusion of law No. 18 on page 436 of the ID to read as follows: “18) Caterpillar has shown through clear and convincing evidence that asserted claim 36 of the ‘309 Patent is invalid as obvious under 35 U.S.C. § 103. Caterpillar has not shown through clear and convincing evidence that asserted claims 10 and 29 of the ‘309 Patent are invalid under 35 U.S.C. § 103.”

The Commission has determined not to review the remainder of the ID.

In connection with the final disposition of this investigation, the Commission may (1) issue an order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) issue one or more cease and desist orders that could result in the respondents being required to cease and desist from engaging in unfair acts in the importation and sale of such articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks

exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry either are adversely affecting it or are likely to do so. For background, see *Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337–TA–360, USITC Pub. No. 2843, Comm’n Op. at 7–10 (Dec. 1994).

If the Commission contemplates some form of remedy, it must consider the effects of that remedy upon the public interest. The factors the Commission will consider include the effect that an exclusion order and/or cease and desist orders would have on (1) the public health and welfare, (2) competitive conditions in the U.S. economy, (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation, and (4) U.S. consumers. The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

If the Commission orders some form of remedy, the U.S. Trade Representative, as delegated by the President, has 60 days to approve or disapprove the Commission’s action. See Presidential Memorandum of July 21, 2005, 70 FR 43251 (July 26, 2005). During this period, the subject articles would be entitled to enter the United States under bond, in an amount determined by the Commission and prescribed by the Secretary of the Treasury.

WRITTEN SUBMISSIONS: Parties to the investigation, interested government agencies, and any other interested parties are encouraged to file written submissions on the issues of remedy, the public interest and bonding. Such submissions should address the recommended determination on remedy, the public interest and bonding issued on October 18, 2018, by the ALJ. Complainants are also requested to submit proposed remedial orders for the Commission’s consideration.

Complainants are further requested to provide the expiration date of the ‘530 and ‘309 patents, the HTSUS numbers under which the accused articles are imported, and any known importers of the accused products. The written submissions and proposed remedial orders must be filed no later than the close of business on May 1, 2019. Reply submissions must be filed no later than the close of business on May 8, 2019. No further submissions on these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document electronically on or before the deadlines stated above and submit 8 true paper copies to the Office of the Secretary by noon the next day pursuant to section 210.4(f) of the Commission’s Rules of Practice and Procedure (19 CFR 210.4(f)). Submissions should refer to the investigation number (“Inv. No. 337–TA–1067”) in a prominent place on the cover page and/or the first page. (See Handbook for Electronic Filing Procedures, http://www.usitc.gov/secretary/fed_reg_notices/rules/handbook_on_electronicfiling.pdf). Persons with questions regarding filing should contact the Secretary (202–205–2000).

Any person desiring to submit a document to the Commission in confidence must request confidential treatment. All such requests should be directed to the Secretary to the Commission and must include a full statement of the reasons why the Commission should grant such

treatment. *See* 19 CFR 201.6. Documents for which confidential treatment by the Commission is properly sought will be treated accordingly. All information, including confidential business information and documents for which confidential treatment is properly sought, submitted to the Commission for purposes of this Investigation may be disclosed to and used: (i) by the Commission, its employees and Offices, and contract personnel (a) for developing or maintaining the records of this or a related proceeding, or (b) in internal investigations, audits, reviews, and evaluations relating to the programs, personnel, and operations of the Commission including under 5 U.S.C. Appendix 3; or (ii) by U.S. government employees and contract personnel, solely for cybersecurity purposes. All contract personnel will sign appropriate nondisclosure agreements. All non-confidential written submissions will be available for public inspection at the Office of the Secretary and on EDIS.

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 CFR part 210.

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', written in a cursive style.

Lisa R. Barton
Secretary to the Commission

Issued: April 17, 2019