

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN MEMORY MODULES AND
COMPONENTS THEREOF**

Investigation No. 337-TA-1089

**NOTICE OF COMMISSION DETERMINATION TO REVIEW AND VACATE
AN INITIAL DETERMINATION, AND TO REMAND THE INVESTIGATION
TO THE ADMINISTRATIVE LAW JUDGE**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review and vacate an initial determination (“ID”) contained in Order No. 13, issued by the presiding administrative law judge (“ALJ”) on April 12, 2018.

FOR FURTHER INFORMATION CONTACT: Robert Needham, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, SW., Washington, D.C. 20436, telephone (202) 708-5468. 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, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server (<http://www.usitc.gov>). The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <http://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 4, 2017, based on a complaint filed by Netlist, Inc. (“Netlist”) of Irvine, California. 82 FR 57290-91. The complaint, as supplemented, 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 memory modules and components thereof that infringe certain claims of U.S. Patent Nos. 9,606,907 (“the ’907 patent”) and 9,535,623 (“the ’623 patent”). *Id.* The Commission’s notice of investigation named as respondents SK hynix Inc. of the Republic of Korea; SK hynix America Inc. of San Jose, California; and SK hynix memory solutions Inc. of San Jose, California (together, “SK hynix”). *Id.* at

57291. The Office of Unfair Import Investigations (“OUII”) is also participating in this investigation. *Id.*

On February 20, 2018, SK hynix moved for a summary determination of noninfringement of every asserted claim in this investigation based on claim preclusion and issue preclusion in view of the Commission’s final determination in *Certain Memory Modules and Components Thereof, and Products Containing the Same*, Inv. No. 337-TA-1023 (“the 1023 Investigation”). The 1023 Investigation determined that SK hynix did not infringe certain claims of the parent patents of the ’907 and ’623 patents, and SK hynix argued that claim preclusion and issue preclusion compelled a finding that SK hynix did not infringe the asserted claims of the ’907 and ’623 patents in this investigation.

On March 5, 2018, Netlist opposed the motion. That same day, OUII filed a response supporting a finding of noninfringement by reason of issue preclusion, but opposing a finding of noninfringement by reason of claim preclusion. On March 14, 2018, OUII filed a supplemental brief, and Netlist and SK hynix filed replies to the supplemental brief. On March 22, 2018, Netlist moved for leave to file a sur-reply to SK hynix’s reply.

On April 12, 2018, the ALJ issued the subject ID, granting a summary determination that SK hynix does not infringe any asserted claim by reason of issue preclusion. The ID does not construe any claim limitation, but concludes that the scope of relevant limitations of the asserted claims of the ’907 and ’623 patents are identical to the scope of corresponding relevant limitations of parent patents asserted in the 1023 Investigation. The ALJ also denied, as an order, the motion with respect to claim preclusion.

On April 23, 2018, Netlist petitioned for review of the ALJ’s findings on issue preclusion, and SK hynix filed a contingent petition for review of the ALJ’s findings on claim preclusion. On April 30, 2018, Netlist and SK hynix opposed each other’s petitions. That same day, OUII filed a response in opposition to both petitions.

Having examined the record of this investigation, including the ID, the petitions for review, and the responses thereto, the Commission has determined to review and vacate the ID. The Commission finds that the ALJ erred by finding that SK hynix did not infringe the asserted claims of the ’907 and ’623 patents without first resolving the parties’ relevant claim construction disputes. The Commission therefore remands the investigation to the ALJ for further proceedings.

The Commission rejects SK hynix’s contingent petition as procedurally improper. The denial of a motion for summary determination is made in an order, 19 CFR 210.42(c), which is not immediately reviewable by the Commission, 19 CFR 210.43(a)(1).

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', with a stylized flourish at the end.

Lisa R. Barton
Secretary to the Commission

Issued: May 29, 2018