

**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN PERSONAL COMPUTERS,
MONITORS, AND COMPONENTS
THEREOF**

Inv. No. 337-TA-519

ORDER

The Commission instituted this investigation on August 6, 2004, under section 337 of the Tariff Act of 1930, 19 U.S.C. §1337, based on a complaint filed by Gateway, Inc. of Poway, California (“Gateway”) alleging a violation of section 337 in the importation, sale for importation, and sale within the United States after importation of certain personal computers, monitors, and components thereof in connection with claims 1-3, 9-11, 13-14, 20-21, 27-28, 30-32, and 38-40 of U.S. Patent No. 5,881,318; claims 1-3, 5, 7-12, 14-29, 31-36, and 38 of U.S. Patent No. 5,192,999 (“the ‘999 patent”); and claims 1-2 and 4-6 of U.S. Patent No. 6,326,996. 69 *Fed. Reg.* 47956 (August 6, 2004). The complainant named Hewlett-Packard Company of Palo Alto, California (“Hewlett-Packard,” or “HP”) as respondent. Since its institution, the investigation was terminated as to certain patents and claims based on the withdrawal of allegations in the complaint. The issue that remains to be decided in this investigation is whether there is a violation of Section 337 based on infringement of one or more of claims 9-11 and 15-19 of the ‘999 patent.

On October 6, 2005, the presiding administrative law judge issued his final initial determination (“ID”) in which he found that there was no violation of section 337. All the parties to the investigation, including the Commission investigative attorney, filed timely petitions for review of various portions of the final ID,¹ and all parties filed timely responses to the petitions.

Having reviewed the record in this investigation, including the ID and the written submissions of the parties, the Commission hereby **ORDERS THAT:**

(1). The investigation is remanded in part to the presiding administrative law judge for further fact-finding and analysis as indicated:

- (a). To make the findings and undertake the analysis necessary to determine whether complainant has established induced infringement of claim 19 under the standards set forth in the ID at 17.
- (b). To support his finding of intent to deceive the U.S. Patent and Trademark Office (PTO) in connection with the failure of applicants to disclose the MPC 1 Specification during prosecution of the ‘999 patent.
- (c). To weigh his findings of materiality and intent concerning the applicants’ failure to disclose the MPC 1 Specification and the Turner reference to the PTO to determine if equity requires a finding of inequitable conduct, as required by the precedent of the U.S. Court of Appeals for the Federal Circuit, *e.g.*, *Dayco Products, Inc. v. Total Containment, Inc.*, 329 F.3d 1258, 1362-63 (Fed. Cir. 2003); *Ulead Systems, Inc. v. Lex Computer & Management Corp.*, 351 F.3d 1139 (Fed. Cir. 2003).

¹HP’s petition is contingent upon a Commission determination to review the ALJ’s inequitable conduct findings. HP’s Petition at 1.

2. The administrative law judge is directed to make his remand findings and determinations based on the existing record.
3. The administrative law judge shall issue his findings in accordance with this Order within twenty-one (21) days of issuance of this Order.
4. The parties may file main comments on the administrative law judge's findings and determinations within five (5) business days after service of the remand findings and determinations. Response comments may be filed within five (5) business days after service of the main comments.
5. The Secretary to the Commission shall serve a copy of this Order upon each party to the investigation and publish notice thereof in the *Federal Register*.

By order of the Commission.

/s/
Marilyn R. Abbott
Secretary to the Commission

Issued: December 1, 2005