

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C. 20436

In the Matter of

**CERTAIN MOBILE
COMMUNICATIONS AND COMPUTER
DEVICES AND COMPONENTS
THEREOF**

Investigation No. 337-TA-704

**NOTICE OF COMMISSION DETERMINATION TO REVIEW AN INITIAL
DETERMINATION GRANTING-IN-PART RESPONDENTS' MOTION FOR
SUMMARY DETERMINATION THAT THE CLAIM 1 OF U.S. PATENT NO. 5,455,599
PATENT IS INVALID AND ON REVIEW TO AFFIRM THE INITIAL
DETERMINATION WITH MODIFICATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review the presiding administrative law judge's ("ALJ") initial determination ("ID") (Order No. 52) granting-in-part respondents' motion for summary determination that the claim 1 of U.S. Patent No. 5,455,599 patent is invalid, and on review, to affirm the ID, with modification.

FOR FURTHER INFORMATION CONTACT: Megan M. Valentine, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-2301. 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 <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 February 24, 2010, based on a complaint filed by Apple Inc., f/k/a Apple Computer, Inc. of Cupertino, California ("Apple"). 75 *Fed. Reg.* 8399-400. The complaint, as amended and 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 mobile communications and computer devices and

components thereof by reason of infringement of certain claims of U.S. Patent Nos. 5,379,431; 5,455,599 (“the ‘599 patent”); 5,519,867; 5,915,131; 5,920,726; 5,969,705; 6,343,263; 6,424,354; and RE39,486. The complaint further alleges the existence of a domestic industry. The Commission’s notice of investigation named Nokia Corporation of Espoo, Finland and Nokia Inc. of White Plains, NY (collectively “Nokia”) as respondents.

On August 5, 2010, Nokia moved for summary determination that claim 1 of the ‘599 patent and its dependent claims are invalid for indefiniteness. In particular, Nokia noted that on July 13, 2010, the ALJ issued Markman Order No. 18, in which the ALJ held that claim 1 of the ‘599 patent was invalid for indefiniteness under 35 U.S.C. § 112 because the ‘599 patent does not set forth sufficient structure to support the term “means for connecting the graphic device object to the grafport object to output graphic information on the one of the one or more graphic devices under the control of the graphic object.” On August 16, 2010, Apple opposed the motion. Also on August 16, 2010, the Commission investigative staff (“IA”) supported the motion with respect to the invalidity of claim 1 of the ‘599 patent and its dependent claims.

On October 18, 2010, the ALJ issued the subject ID, granting-in-part Nokia’s motion for summary determination with respect to finding that claims 1-3 and 6-10 of the ‘599 patent are invalid. On October 26, 2010, Apple filed a petition for review of the ALJ’s initial determination. On November 2, 2010, Nokia and the IA filed responses to the petition for review. Apple filed a Corrected Petition for Review on November 3, 2010. Nokia filed a Corrected Response on November 5, 2010.

For the following reasons, the Commission has determined to review the ID, and on review, to affirm the subject ID, with modification. The Commission finds that Nokia failed to present clear and convincing evidence, given the weight of the specification of the ‘599 patent and the testimony of the parties’ experts, to support a finding of invalidity under the subject ID’s rationale that the term “device” in col. 9:12-14 of the ‘599 patent cannot be read as “device object.” The Commission also finds, however, that the ‘599 patent specification lacks sufficient description of the “GetDevice” function, as described at col. 9:12-14 of the ‘599 patent, and therefore, finds the term to be indefinite. *See, Finistar Corp. v. DirectTV Group, Inc. et al.*, 523 F.3d 1323, 1340 (Fed. Cir. 2008); *Blackboard, Inc. v. Desire2Learn Inc.*, 574 F.3d 1371, 1383-85 (Fed. Cir. 2009); and *Aristocrat Techs. Australia Pty Ltd. v. Int’l Game Tech.*, 521 F.3d 1328, 1331-34 (Fed. Cir. 2008). The Commission, therefore, affirms the ALJ’s finding that claim 1 of the ‘599 patent and its dependent claims 2-3 and 6-10 are invalid for indefiniteness under 35 U.S.C. § 112 on alternate grounds.

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 section 210.42 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.42).

By order of the Commission.

/s/

Marilyn R. Abbott
Secretary to the Commission

Issued: November 19, 2010