

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

In the Matter of

**CERTAIN ELECTRONIC DIGITAL
MEDIA DEVICES AND COMPONENTS
THEREOF**

Investigation No. 337-TA-796

**NOTICE OF COMMISSION DETERMINATION TO REVIEW A REMAND INITIAL
DETERMINATION; SCHEDULE FOR FILING WRITTEN SUBMISSIONS ON
CERTAIN ISSUES UNDER REVIEW AND ON REMEDY, BONDING, AND THE
PUBLIC INTEREST**

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 remand initial determination (“RID”) issued by the presiding administrative law judge (“ALJ”) on March 26, 2013 in its entirety. The Commission requests certain briefing from the parties on the issues under review, as indicated in this notice. The Commission also requests briefing from the parties and the public on the issues of remedy, bonding, and the public interest.

FOR FURTHER INFORMATION CONTACT: Cathy Chen, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-2392. 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 August 5, 2011, based on a complaint filed by Apple Inc. (“Apple”) of Cupertino, California. *76 Fed. Reg.* 47610 (Aug. 5, 2011). 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 electronic digital media devices and components thereof by reason of infringement of certain claims of U.S. Patent Nos. 7,479,949 (“the ’949 patent”); RE 41,922 (“the ’922 patent”); 7,863,533 (“the ’533 patent”); 7,789,697 (“the ’697 patent”); 7,912,501 (“the ’501 patent”); D558,757 (“the D’757 patent”); and D618,678 (“the D’678 patent”) (collectively, “the Asserted Patents”). The complaint further alleges the existence of a domestic industry. The respondents named in the Commission’s notice of investigation are Samsung Electronics Co, Ltd. of the Republic of Korea; Samsung Electronics America, Inc. of Ridgefield Park, New Jersey; and Samsung Telecommunications America, LLC of Richardson, Texas (collectively, “Samsung”). A Commission investigative attorney (“IA”) participated in the investigation.

On May 3, 2012, the ALJ issued an ID partially terminating the investigation with respect to all claims of the ’533 patent; claims 1-3, 11, 12, 15, 16 and 21-27 of the ’697 patent; and claim 3 of the ’949 patent (Order No. 17) (not reviewed by the Commission, May 3, 2012).

On October 24, 2012, the ALJ issued his final ID in this investigation finding a violation of section 337 in connection with the claim of the D’678 patent; claims 1, 4-6 and 10-20 of the ’949 patent; claims 29, 30 and 33-35 of the ’922 patent; and claims 1-4 and 8 of the ’501 patent. The ALJ found no violation of section 337 in connection with the claim of the D’757 patent; claims 31 and 32 of the ’922 patent; and claims 13 and 14 of the ’697 patent. The ALJ also found that the asserted claims of the Asserted Patents were not shown to be invalid. The ALJ further found that a domestic industry in the United States exists that practices the Asserted Patents, except for the ’697 patent. On November 7, 2012, the ALJ issued his recommended determination on remedy and bonding.

Apple and Samsung filed timely petitions for review of various portions of the final ID, as well as timely responses to the petitions. The IA filed only a response to the petitions for review. On December 3, 2012, Apple and Samsung filed public interest comments pursuant to Commission rule 210.50(a)(4). That same day, non-party Google filed a submission in response to the Notice of Request for Statements on the Public Interest. *See 77 Fed. Reg.* 68829-30 (Nov. 16, 2012).

On January 23, 2013, the Commission determined to review the final ID in its entirety, and remand the investigation to the ALJ with respect to certain issues related to the ’922 patent and the ’501 patent, as set forth in the Remand Order. *78 Fed. Reg.* 6130 (Jan. 29, 2013). In light of the remand, briefing on the reviewed issues and on remedy, bonding, and the public interest were postponed until the Commission’s consideration of the RID.

On March 26, 2013, the ALJ issued his RID. The RID found that claims 34 and 35 of the ’922 patent are infringed by the text-selection feature of the accused products and that claim 3 of the ’501 patent is not infringed by the accused products represented by the Transform SPH-M920. On April 9, 2013, Apple and Samsung petitioned for review of the RID. The IA did not petition for review of the RID. On April 17, 2013, Apple, Samsung and the IA filed their respective responses to the petitions for review.

Having reviewed the evidence of record and the parties' submissions, the Commission has determined to review the RID in its entirety.

In connection with its review of the final ID and the RID, the parties are invited to brief only the discrete issues enumerated below, with reference to the applicable law and the evidentiary record. The parties are not to brief other issues on review, which are adequately presented in the parties' existing filings.

1. Is the "material or apparatus" used in practicing the patented methods asserted in the '949 patent that is relevant to a substantial noninfringing use analysis the "combination of source code and hardware elements relied upon by Dr. Balakrishnan in his witness statement," as argued by Apple (Apple Pet. at 50-51)? To the extent that it is, what evidence in the record shows that the "combination of source code and hardware elements" is adapted for use in an infringement of the '949 patent and that it does not have any substantial noninfringing use?
2. Is the "material or apparatus" used in practicing the patented methods asserted in the '922 patent that is relevant to a substantial noninfringing use analysis the "combination of source code and hardware elements relied upon by Dr. Balakrishnan in his witness statement," as argued by Apple (Apple Pet. at 50-51)? To the extent that it is, what evidence in the record shows that the "combination of source code and hardware elements" is adapted for use in an infringement of the '922 patent and that it does not have any substantial noninfringing use?
3. Please comment on the requirement, if any, that the "material or apparatus" relevant to a substantial noninfringing use analysis must be "separate and distinct" from all other functions of a larger product in view of *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301 (Fed. Cir. 2009); *i4i Ltd. P'ship v. Microsoft Corp.*, 598 F.3d 831 (Fed. Cir. 2010); *Fujitsu Ltd. v. Netgear Inc.*, 620 F.3d 1321 (Fed. Cir. 2010); and any other pertinent legal authorities. To the extent there is such a requirement, what evidence in the record shows that each "combination of source code and hardware elements relied upon by Dr. Balakrishnan in his witness statement" with respect to the '949 and the '922 patents is a "separate and distinct" feature of the Browser or Gallery application that warrants treating it separately in analyzing contributory infringement.
4. Please discuss and cite the evidence of record, if any, that shows a third party performed each and every step of asserted claims 29-35 of the '922 patent.
5. Please discuss and cite the evidence of record, if any, that shows Samsung actively and knowingly aided and abetted another's direct infringement of claims 29-35 of the '922 patent.
6. Please discuss and cite the evidence of record, if any, that shows Samsung actively and knowingly aided and abetted another's direct infringement of claims 11-16 of

the '949 patent.

7. Does the intrinsic evidence mandate a narrow construction of the “feature of interest” limitation in claims 31 and 32 of the '922 patent that excludes control elements in the translucent image? What impact, if any, do the additions in the specification made by reissue have on the construction of the claims added during reissue? In particular, please comment on the applicability of the embodiment disclosing a translucent keyboard to the construction of the “feature of interest” limitation. *See* JX-0004 at 3:12-22 and FIGS. 19-21c. What evidence in the record, if any, supports construing control characters or functional buttons on a keyboard as a “feature of interest” in the context of the '922 patent?
8. What evidence in the record supports or does not support whether a person of ordinary skill in the art would understand from the '697 patent disclosure that a “signal path” exists even in the absence of a plug in the receptacle? To the extent the “signal path” exists even in the absence of a plug in the receptacle, what record evidence shows that the detection circuitry is “coupled to the detect contact and the first receptacle contact” as recited in claim 12 of the '697 patent when the claimed detection circuitry detects that “the signal path is a low or a high impedance path”?
9. Please comment on Samsung’s argument that Apple’s Petition as to the '697 patent relies on a newly proffered claim construction argument that construes the claim limitation “to detect that the signal path is a low or a high impedance path” in claim 12 to require “circuitry that detects that the signal path is a low impedance path only.” *See* Samsung Resp. at 83-84.
10. Assuming *arguendo* that Apple’s proposed construction of the claimed detection circuitry limitation is adopted (*see* Apple Pet. at 69-76), what record evidence shows that this limitation is disclosed or suggested in the prior art of record, including in the JP published unexamined application HII-288766 (“Kawano”) and the YP-T7J portable media player?

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 respondent(s) 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. When 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. In particular, the Commission is interested in the following issues,

with reference to the applicable law, the existing evidentiary record, and if necessary, additional sworn testimony or expert declarations:

1. How would remedial orders barring the entry and further distribution of the Samsung articles alleged to infringe the asserted claims of the Asserted Patents affect the public interest as identified in 19 U.S.C. §§ 1337(d)(1) and (f)(1)?
2. In what ways, if any, should a remedy with respect to infringement of one or more of the Asserted Patents be specifically tailored to avoid harm to the public interest, as identified in 19 U.S.C. §§ 1337(d)(1) and (f)(1)?

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 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. (Dec. 1994) .

When 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 *Fed. Reg.* 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. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed if a remedy is ordered.

WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions on the issues identified in this notice. Parties to the investigation, interested government agencies, and any other interested persons are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should address the recommended determination by the ALJ on remedy and bonding with respect to the Asserted Patents. Complainant and the IA are also requested to submit proposed remedial orders for the Commission's consideration. Complainant is further requested to state the date that the patents expire and the HTSUS numbers under which the accused products are imported. The written submissions and proposed remedial orders must be filed no later than close of business on Tuesday, June 11, 2013. Initial submissions by the parties are limited to 100 pages, not including submissions related to remedy, bonding, and the public interest. Reply submissions must be filed no later than the close of business on Wednesday, June 19, 2013. All reply submissions are limited to 60 pages, not including submissions related to remedy, bonding, and the public interest. 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 C.F.R. 210.4(f)). Submissions should refer to the investigation number ("Inv. No. 337-TA-796") 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_electronic_filing.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 C.F.R. § 201.6. Documents for which confidential treatment by the Commission is properly sought will be treated accordingly. A redacted non-confidential version of the document must also be filed simultaneously with the any confidential filing. 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 C.F.R. Part 210).

By order of the Commission.

/s/
William R. Bishop
Supervisory Hearings and Information Officer

Issued: May 28, 2013