

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN CRAWLER CRANES AND
COMPONENTS THEREOF**

Investigation No. 337-TA-887

**NOTICE OF THE COMMISSION'S DETERMINATION TO EXTEND THE TARGET DATE;
REQUEST FOR WRITTEN SUBMISSIONS**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to extend the target date until February 13, 2015, and solicit additional briefing from the parties in the above-captioned investigation.

FOR FURTHER INFORMATION CONTACT: Amanda Pitcher Fisherow, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-2737. 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 (<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 July 17, 2013, based on a complaint filed by Manitowoc Cranes, LLC of Manitowoc, Wisconsin. 78 *Fed. Reg.* 42800-01 (July 17, 2013). The complaint alleges violations of subsection (a)(1)(B) of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 ("section 337") in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain crawler cranes and components thereof, by reason of infringement of U.S. Patent Nos. 7,546,928 ("the '928 patent") and 7,967,158, and that an industry in the United States exists or is in the process of being established as required by subsection (a)(2) of section 337. The complaint further alleges violations of section 337 by reason of trade secret misappropriation, the threat or effect of which is to destroy or substantially injure an industry in the United States or to prevent the establishment of such an industry under section 337(a)(1)(A). The Commission's notice of investigation named Sany Heavy Industry Co., Ltd. of Changsha, China, and Sany America, Inc. of Peachtree City, Georgia as respondents. The Office of Unfair Import Investigations was also named as a party.

On July 11, 2014, the ALJ issued his final initial determination (“ID”) finding a violation of section 337 with respect to claims 1, 2, 5, 8, and 23-26 of the ’928 patent and misappropriation of Trade Secret Nos. 1, 6, 14, and 15. The ALJ further found no violation of section 337 with respect to claims 6, 10, and 11 of the ’928 patent, claim 1 of the ’158 patent, and Trade Secret Nos. 3 and 4.

On July 28, 2014, OUII, Manitowoc, and Sany each filed petitions for review. On August 5, 2014, the parties replied to the respective petitions for review.

On September 19, 2014, the Commission determined to review the ID and solicited briefing from the parties on questions concerning violation, remedy, bonding, and the public interest. 79 *Fed. Reg.* 57566-68 (“Notice of Review”). The Commission determined to review the ALJ’s findings with respect to: (1) importation of the accused products; (2) infringement of the asserted patents; (3) estoppel; (4) the technical prong of the domestic industry requirement; and (5) the asserted trade secrets. The parties provided initial submission to the Commission’s questions on October 1, 2014 and responsive submissions on October 8, 2014.

Having reviewed the parties’ submissions in response to the Notice of Review, the Commission has determined that further briefing is necessary. The parties are requested to brief their positions on only the following issues:

1. Discuss any act, based on record evidence, that establishes whether there is direct infringement in the United States under 35 U.S.C. § 271(a) of claims 23-26 of the ’928 patent for the SCC8500 crane with the original UltraLift package.
2. Assuming the contract documented in exhibit CX-0278C reflects a sale of the SCC8500 crane with the original UltraLift package, does the CX-0278C contract, and any related activities (*e.g.*, contract negotiations, etc.), constitute a “sale” or “offer for sale” under 35 U.S.C. § 271(a) of the SCC8500 crane with the original UltraLift package in the United States? *See, e.g., Halo Electronic, Inc. v. Pulse Electronics, Inc.*, __F.3d__, 2014 WL 5352367 (Fed. Cir. 2014).
3. Does the contract documented in exhibit CX-0348C include the original UltraLift package? Assuming that the CX-0348C contract includes the original UltraLift package, was the contract, and any related activities, a “sale” or “offer for sale” under 35 U.S.C. § 271(a) of the SCC8500 crane with the original UltraLift package in the United States? *See e.g., Halo Electronic, Inc. v. Pulse Electronics, Inc.*, __F.3d__, 2014 WL 5352367 (Fed. Cir. 2014).
4. Regarding the asserted method claims of the ‘928 and ‘158 patents, please respond to the following questions and include a discussion of relevant case law and citations to the evidentiary record:
 - (A) The specific evidence that demonstrates the direct infringement required by applicable legal authority to support a finding of indirect infringement; and
 - (B) An explanation of whether such evidence is direct or circumstantial, what weight it should be given in view of the totality of the evidence and how it supports your position.

Further in responding to the above questions, in particular, please discuss, *inter alia*, the following exemplary authorities and any other relevant authorities, including Commission precedent, and whether that authority supports a finding of a violation of section 337 for these asserted method claims: *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 342 (1961) (“The determinative question, therefore, comes down to whether the car owner would infringe the combination patent by replacing the wornout fabric element of the patented convertible top on his car, or even more specifically, whether such a replacement by the car owner is infringing ‘reconstruction’ or permissible ‘repair.’”); *Lucent Technologies, Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1320 (Fed. Cir. 2009) (“In order to succeed on a claim of contributory infringement, in addition to proving an act of direct infringement, . . .”) (citations omitted); *Mirror Worlds, LLC v. Apple, Inc.*, 692 F.3d 1351, 1360 (Fed. Cir. 2012) (“Inducement of infringement requires that there be a showing of an underlying act of direct infringement.”) (citation omitted); *Toshiba Corp. v. Imation Corp.*, 681 F.3d 1358, 1364 (Fed. Cir. 2012) (“To satisfy the direct infringement requirement, the patentee ‘must either point to specific instances of direct infringement or show that the accused device necessarily infringes the patent in suit.’ *ACCO Brands, Inc. v. ABA Locks Mfr. Co.*, 501 F.3d 1307, 1313 (Fed.Cir.2007) (citing *Dynacore*, 363 F.3d at 1275–76).”); *Exergen Corp. v. Wal-Mart Stores, Inc.*, 575 F.3d 1312, 1321-22 (Fed. Cir. 2009) (“[i]nducement requires a threshold finding of direct infringement. Because Exergen presented no evidence of any ‘specific instance of direct infringement,’ Exergen was required to show that ‘the accused device necessarily infringes the patent in suit.’ . . . Exergen relied on instructions and drawings accompanying SAAT’s infrared thermometers as circumstantial evidence that customers would necessarily infringe the ‘685 patent. *See Moleculon Research Corp. v. CBS, Inc.*, 793 F. 2d 1261, 1272 (Fed. Cir. 1986) (holding that sales of product with instructions to use product in an infringing manner may constitute circumstantial evidence that customers would use the product in the manner directed).”) (citations omitted); *Certain Electronic Digital Media Devices and Components Thereof*, Investigation No. 337-TA-796, Comm’n Op., at *36-37 (Sept. 6, 2013) (“The Federal Circuit has found circumstantial evidence sufficient to prove direct infringement when the evidence shows that the accused products were intended to be used only to practice the infringing method and that method was explicitly taught, for example, by product manuals.”)(citations omitted).

WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions on the issues identified in this notice. The written submissions must be filed no later than close of business on Friday, December 12, 2014. Reply submissions must be filed no later than the close of business on Friday, December 19, 2014. No further submissions on these issues will be permitted unless otherwise ordered by the Commission. The page limit for the parties’ initial submissions on the questions posed by the Commission is 40 pages. The parties reply submissions, if any, are limited to 25 pages.

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-887”) 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.

Therefore, the Commission extends the target date to February 13, 2015.

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.

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: December 3, 2014