

**PATENT LITIGATION AT THE ITC: A PRACTITIONER'S GUIDE
(FALL 2023)**

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Office hours by appointment

Course Description

This course provides an in-depth examination of the U.S. International Trade Commission and its adjudication of patent litigation disputes under Section 337 of the Tariff Act of 1930. The course will focus on all aspects of litigation at the ITC, from the institution of an investigation under Section 337 through the Commission's review of an Administrative Law Judge's decision, as well as key Federal Circuit decisions relevant to the ITC. Students will learn the unique procedures of the ITC, as well as consider policy considerations and the practical application of U.S. patent law in ITC investigations. Patent Law I is a prerequisite for this course.

Grading

This course is a writing course. There will be two (2) written assignments over the course of the semester, due at dates indicated in the syllabus or provided in class. Your final grade for the course will be based on the written assignments, each worth 45%, and class participation, which will be worth 10% of your final grade.

Learning Outcomes:

By the end of the course, students should be able to:

- Critically assess ITC holdings based on a sound understanding of ITC jurisprudence and policies
- Understand the pros and cons of litigating patent cases at the ITC versus District Courts or the PTAB

Course Schedule and Assignments

Classes 1 and 2: Introduction (08/24/2023 and 08/31/2023)

- Current 19 U.S.C. § 1337
- *Kinik v. ITC*, 362 F.3d 1359, 1359-1363 (Fed. Cir. 2004)
- *Amgen v. ITC*, 902 F.2d 1532 (Fed. Cir. 1990)
- *Certain Electronic Devices with Image Processing Systems*, Inv. No. 337-TA-724, Comm. Op. (Dec. 21, 2011) (Section II.A)
- *Certain Three-Dimensional Cinema Systems and Components Thereof*, 337-TA-939 Comm. Op. at 49-58 (Aug. 23, 2016) (IPR and Preemption)
- Current ITC Rules (for general awareness)

Class 3: The Complaint (09/07/2023)

- *Certain Wireless Devices with 3G Capabilities & Components Thereof*, Inv. No. 337-TA-800, Notice of Institution (Aug. 25, 2011)
- *Certain Wireless Devices with 3G Capabilities & Components Thereof*, Inv. No. 337-TA-800, Complaint (July 26, 2011) (SKIM complaint and exhibits)
- 28 U.S.C. § 1659 (district court stay)
- 19 C.F.R. § 210.19 (third-party intervention)
- *Certain Mircoelectromechanical Systems (“MEMS Devices”) and Products Containing the Same*, Inv. No. 337-TA-876, Order No. 6, (May 21, 2013)
- *Certain Audio Processing Hardware and Software and Products Containing the Same*, Inv. No. 337-TA-949, ID, Order No. 8 (June 11, 2015)
- *Certain Audio Processing Hardware, Software, and Prods. Containing the Same*, Inv. No. 337-TA-1026, Comm'n Op. at 8-36 (Apr. 18, 2018)
- *Certain Graphics Processor and Products Containing the Same*, Inv. No. 337-TA-1099, Order No. 18 (May 10, 2018) (terminating patent due to expiration date)

Class 4: Discovery (09/14/2023)

- *Certain Blu-ray Disc Players, Components Thereof & Prods. Containing Same*, Inv. No. 337-TA-824, Order No. 36 (Dec. 5, 2012) (duty of candor)
- *Certain Electronic Devices for Capturing & Transmitting Images, & Components Thereof*, Inv. No. 337-TA-831, Order No. 22 (Aug. 23, 2012) (scope of discovery)
- *Certain Electronic Devices, Including Mobile Phones, Tablet Computers, and Components Thereof*, Inv. No. 337-TA-1038, Order No. 14 at 5 (Apr. 17, 2017) (future products)
- *Certain Wind and Solar-Powered Light Posts and Street Lamps*, Inv. No. 337-TA-736, Order No. 9 (April 13, 2011) (subpoena enforcement)

Class 5: Practical Discovery Skills and Depositions (09/21/2023)

- Deposition Fact Pattern and practicum

Classes 6 and 7: Domestic Industry (09/28/2023 and 10/05/2023)

- Economic Prong (Class 6 – 09/30/2021)
 - *Certain Probe Card Assemblies, Components Thereof And Certain Tested Dram And Nand Flash Memory Devices And Products Containing Same*, Inv. No. 337-TA-621, Comm. Op., at 193-196 (Jun. 29, 2009)
 - *Certain Multimedia Display and Navigation Devices & Systems, Components Thereof, & Prods. Containing Same*, Inv. No. 337-TA-694, Comm. Op., at 1-25 (Aug. 8, 2011) (portfolio licensing)
 - *Certain Ground Fault Circuit Interrupters & Prods. Containing Same*, 337-TA-739, Comm. Op., at 70-80 (June 8, 2012) (allocation)
 - *InterDigital Communications., LLC v. ITC*, 707 F.3d 1295 (Fed. Cir. 2013) (denying rehearing *en banc* and holding 337(a)(3)(C) can be satisfied without products practicing licensed patents)
 - *Motiva, LLC v. ITC*, 716 F.3d 596 (Fed. Cir. 2013) (affirming that filing date of complaint is relevant date for determining economic prong and finding litigation costs not sufficient on facts)

- *Microsoft v. ITC*, 731 F.3d 1354 (Fed. Cir. 2013) (complainant must provide evidence that its substantial domestic investment relates to an actual article that practices the patent)
- *Certain Integrated Circuit Chips and Products Containing the Same*, Inv. No. 337-TA-859, Comm. Op. (Aug. 22, 2014) (domestic industry portions, especially regarding nexus requirement)
- *Lelo, Inc. v. ITC*, 786 F.3d 879 (Fed. Cir. 2015)
- *Certain Solid State Storage Drives, Stacked Electronics Components, And Products Containing Same*, Inv. No. 337-TA-1097, Comm. Op. (Jun. 29, 2018)
- *LED Lighting Devices, LED Power Supplies, and Components Thereof*, 337-TA-1081, Order No. 54 (July 24, 2018) (significance)
- *Certain Carburetors and Products Containing Such Carburetors*, Inv. No. 337-TA-1123, Comm. Op. (Oct. 28, 2019) (minimum investment threshold)
- *Certain Television Sets, Television Receivers, Television Tuners, and Components Thereof*, Inv. No. 337-TA-910, Comm. Op. at 73-74 (Oct. 30, 2015) (sales and marketing)
- *Hyosung TNS Inc. v. ITC*, 926 F.3d 1353 (Fed. Cir. 2019)
- Technical Prong (Class 7 – 10/05/2023)
 - *Certain Semiconductor Chips with Minimized Chip Package Size & Prods. Containing Same*, Inv. No. 337-TA-432, Order No. 13, ID (Jan. 24, 2001) (DI claim can be different from infringement claim)
 - *Certain Computers and Computer Peripheral Devices, and Components Thereof, and Products Containing Same*, Inv. No. 337-TA-841, Comm. Op., (Jan. 9, 2014) (even for licensing-based domestic industries, complainants must show the existence of articles protected by the Asserted Patents; read dissenting view on domestic industry)
 - *Certain Video Graphics Display Controllers and Products Containing Same*, Inv. No. 337-TA-412, ID, at 1-24, (May 17, 1999) (DI product practices valid claim of asserted patent)

- *Certain Soft-Edged Trampolines and Components Thereof*, Inv. No. 337-TA-908, Comm. Op., May 1, 2015 at 49-54 (tech prong and invalid claims)

DISTRIBUTE DI SUMMARY DETERMINATION FACT PATTERN AT CLASS 6

Classes 8 and 9: Summary Determination, Importation, Infringement (10/12/2023 and 10/19/2023)

- Importation
 - *Certain Electronic Devices, Including Wireless Communication Devices, Portable Music & Data Processing Devices, & Tablet Computers*, Inv. No. 337-TA-794, Order No. 85 (June 1, 2012) (also used for Summary Determination) (denying MSD of importation because infringement not shown)
 - *Certain Electronic Devices with Image Processing Systems, Components Thereof, & Associated Software*, Inv. No. 337-TA-724, Comm. Op., at*1-20 (Dec. 21, 2011) (also used for Method Claims) (purpose of importation requirement and interplay with jurisdiction)
 - *Certain Trolley Wheel Assemblies*, Inv. No. 337-TA-161, USITC Pub. 1605 at 7-8 (Nov. 1984) (“the ‘importation or sale’ requirement has been met by the importation of the [single] sample wheel”).
 - *Comcast Corp. v. ITC*, 951 F.3d 1301 (Fed. Cir. March 2, 2020) (infringement occurring after importation and role of importer).
 - *Cisco Sys., Inc. v. ITC*, 873 F.3d 1354 (Fed. Cir. 2017) (software analysis)
- Infringement
 - *Certain Inkjet Ink Cartridges with Printheads & Components Thereof*, Inv. No. 337-TA-723, Comm. Op. (Dec. 1, 2011) (inducement to infringe)
 - *Suprema, Inc. v. ITC*, 796 F.3d 1338 (Fed. Cir. 2015) (*en banc*) (timing of direct infringement in induced infringement claims)

- *Clear Correct Operating, LLC v. ITC*, 810 F.3d 1283 (Fed. Cir. 2015) (rehearing *en banc* denied at 819 F.3d 1334 (Fed. Cir. 2016))
- *Certain High-Density Fiber Optic Equipment and Components Thereof*, Inv. No. 337-TA-1194, Parties’ and Staff’s briefing in response to Commission Determination to Review, Question 1 (requested May 24, 2021).
- *Global-Tech Appliances, Inc. v. SEB. S.A.*, 131 S. Ct. 2060 (2011)

**DOMESTIC INDUSTRY SUMMARY DETERMINATION
BRIEFING DUE OCTOBER 20, 2023 BY 5 PM ET**

Classes 10 and 11: Remedy, Bonding and Enforcement (10/26/2023 and 11/02/2023)

- *Philip Morris Products S.A. v. ITC* (Fed. Cir. March 31, 2023) (public interest)
- *Certain Personal Data and Mobile Communications Devices & Related Software*, Inv. No. 337-TA-710, Comm. Op. at 66-85 (Dec. 29, 2011) (discussing LEO, PI factors, and bonding)
- *Certain Personal Data and Mobile Communications Devices & Related Software*, Inv. No. 337-TA-710, Additional Views of Commissioner Pinkert on Remedy and the Public Interest (Dec. 29, 2011) (same as above)
- *Kyocera v. ITC*, 545 F.3d 1340 (Fed. Cir. 2008) (holding LEO cannot apply to downstream products)
- *Spansion, Inc. v. ITC*, 629 F.3d 1331 (Fed. Cir. 2010) (balancing benefit of protecting IPR against PI factors)
- *Certain Baseband Processor Chips & Chipsets, Transmitter & Receiver (Radio) Chips, Power Control Chips, & Prods. Containing Same, Including Cellular Telephone Handsets*, Inv. No. 337-TA-543, Comm. Op., at 1-24 (June 19, 2007)
- Executive Office of the President, The United States Trade Representative, Letter to the Honorable Irving A. Williamson Re: *Certain Electronic Devices, Including Wireless Communication Devices, Portable Music and Data Processing Devices, and Tablet Computers*, Inv. No. 337-TA-794

- *Certain Robotic Vacuum Cleaning Devices and Components Thereof Such as Spare Parts*, Inv. No. 337-TA-1057, Recommended Determination on Remedy and Bond at 4-9 (June 25, 2018) (inventory)
- *Funai Electric Co. v. CBP*, 645 F. Supp. 2d 1351 (CIT 2009)
- *Hyundai Electronics Industries. Co. v. ITC*, 899 F.2d 1204 (Fed. Cir. 1990) (certification requirements)
- *Vastfame Camera, Ltd. v. ITC*, 386 F.3d 1108 (Fed. Cir. 2004) (non-parties affected by GEO)
- *Corning Gilbert Inc. v. United States*, Slip Op. 13-15 (CIT Feb. 1, 2013)

DISTRIBUTE MILS FACT PATTERNS AT END OF CLASS 11

Class 12: Guest Speaker (11/09/2023)

Class 13: Review/Make-Up as necessary (11/16/2021)

MILS DEADLINE – FRIDAY, NOVEMBER 17 AT 5 PM ET