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

In the Matter of

**CERTAIN MOTORIZED SELF-
BALANCING VEHICLES**

**Investigation No. 337-TA-1000
(Remand)**

COMMISSION OPINION

On October 16, 2018, the U.S. Court of Appeals for the Federal Circuit issued an order and mandate in *Razor USA LLC v. ITC*, Appeal No. 2017-2591, an appeal from the Commission’s July 28, 2017 final determination in the above-identified investigation, remanding the investigation to the Commission for further proceedings consistent with its ruling. During the appeal, the U.S. Patent and Trademark Office (“PTO”) reissued the patent that was asserted in the investigation. The reissue patent amended or cancelled all of the asserted original claims and added new claims. In light of the Notice of Allowance for the reissue patent, the Commission moved to dismiss the Federal Circuit appeal as moot under 35 U.S.C. § 252, arguing that the original claims had been surrendered and that the reissue claims were not “substantially identical” to the original claims on appeal. The appellants opposed the motion, and then filed two continuation applications of the original reissue application, eventually arguing to the Court that the existence of these pending continuation applications meant that the original claims had not been surrendered, thus avoiding mootness. The appellants also argued that the reissue claims were substantially identical to the original claims on appeal, thus preserving the pending cause of action. In remanding the case after the reissue patent issued, the Court deemed it appropriate for the Commission to have the first opportunity to determine “whether post-investigation events have rendered the case moot or whether the case may

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continue either on the original patent claims or reissued claims and to conduct any additional proceedings as necessary.” *See Razor USA LLC v. ITC*, Remand Order at 4 (Oct. 16, 2018).

On November 13, 2018, the Commission ordered the parties to provide briefing as to the issues to be resolved in the remand proceeding and whether the matter should be referred to the administrative law judge (“ALJ”). Comm’n Order (Nov. 13, 2018). On September 19, 2019, after having considered the briefing it had previously ordered, the Commission issued an order requesting that the parties provide written responses regarding specific questions concerning the effect of the patent reissue. Comm’n Order (Sept. 19, 2019).

Having considered the record of this proceeding, including the briefing of the parties, the Commission determines on remand to terminate the investigation as moot because the original claims of the patent-in-suit, U.S. Patent No. 8,738,278 (“the ’278 patent”), have been surrendered and the reissue claims of the reissue patent, US Patent No. RE46,964 (“the RE’964 patent”), are not substantially identical to the original claims for the reasons set forth below.

I. BACKGROUND

The Commission instituted this investigation, *Certain Motorized Self-Balancing Vehicles*, on May 26, 2016, based on a complaint filed on behalf of Razor USA LLC of Cerritos, California, and Inventist, Inc. and Shane Chen, both of Camas, Washington (collectively, “Razor”). 81 Fed. Reg. 33548-49 (May 26, 2016). The complaint alleged, *inter alia*, violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, by reason of infringement of claims 1-9 of the ’278 patent. The Commission’s notice of investigation named twenty-eight respondents. The Office of Unfair Import Investigations (“OUII”) also participated in the investigation. Nine respondents (“the active respondents”) remained active in the investigation after every other respondent had been terminated from the investigation based on a consent order, good cause, or else had been found in default. These active respondents

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were Hangzhou Chic Intelligent Co., Ltd. (“Chic”) of Hangzhou, China; Swagway, LLC (“Swagway”) of South Bend, Indiana; Modell’s Sporting Goods, Inc. (“Modell’s”) of New York City, New York; Powerboard a.k.a. Optimum Trading Co. (“Powerboard”) of Hebron, Kentucky; United Integral, Inc. dba Skque Products of Irwindale, California; Alibaba Group Holding Ltd. of Causeway Bay, Hong Kong and Alibaba.com Ltd. of Hangzhou, China (collectively, “Alibaba”); Jetson Electric Bikes LLC (“Jetson”) of New York City, New York; and Newegg, Inc. (“Newegg”) of City of Industry, California. On the same day the Commission instituted the investigation, Razor sought reissue of the asserted ’278 patent with the PTO.¹ Among the amendments sought was an amendment to the last paragraph of claim 1 changing “second foot placement section” in that paragraph to read “second sensor.” Razor’s complaint did not indicate that it intended to seek reissue of the ’278 patent.

On May 26, 2017, the presiding ALJ (Chief Judge Bullock) issued his final initial determination (“ID”), finding no violation of section 337 as to remaining asserted claims 1-3 and 5-8 of the ’278 patent. The ID found that none of the active respondents’ accused products infringe the ’278 patent claims because none of them met the “from the second foot placement section” limitation of the last paragraph of independent claim 1, but that the defaulting respondents’ accused product did infringe the patent claims. The ID also found that the technical prong of the domestic industry requirement was not satisfied because none of the domestic industry products met that limitation. ID at 32-37, 41-43; *see also* Notice of Errata to

¹ Respondent Chic moved to terminate or stay the investigation pending reissue proceedings, but the ALJ denied that motion. *See* Order No. 13 (July 28, 2016). Chic did not seek interlocutory review of the ALJ’s decision. On July 19, 2016, while briefing of Chic’s motion was proceeding, Razor requested that the PTO suspend examination of the reissue application pursuant to MPEP § 1442.02 (“Concurrent Litigation”). The PTO docket refers to this request as a “Miscellaneous Incoming Letter.” *See* JX-3.016-17. Examination was suspended until September 29, 2017, when it was resumed at Razor’s request. *See* “Letter Requesting Suspension of Action” (Sept. 29, 2017).

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the Final ID (June 5, 2017). The ID therefore found no violation of section 337 with respect to the active and defaulting respondents. *Id.* The ID noted that the first preliminary amendment of the claims of the '278 patent in the reissue application indicated that the last paragraph of claim 1 “erroneously ended with the term ‘second foot placement section’ instead of ‘second sensor.’” *Id.* at 36 (citing JX-3.044). The ID stated that if the claim was written in the amended form, the evidence would show that this limitation would be met by both the accused products and Razor’s domestic industry products. *Id.*

Razor, OUII, and certain respondents petitioned for review of the ID. On July 28, 2017, the Commission determined to review (1) the ID’s finding that the Commission has no jurisdiction over Alibaba, and (2) the ID’s analysis of infringement by the defaulting respondents. *See* Comm’n Notice of Review (July 28, 2017). On review, the Commission determined to (1) take no position on the ID’s finding that it has no jurisdiction over Alibaba; and (2) vacate the ID’s infringement finding as to the defaulting respondents as moot in view, *inter alia*, of the domestic industry determination. *Id.* at 3-4. The Commission determined not to review the remainder of the ID and therefore issued its final determination of no Section 337 violation and terminated the investigation. *Id.*

On September 22, 2017, Razor appealed the Commission’s final determination to the Federal Circuit. *See* Appeal No. 17-2591. On September 29, 2017, Razor requested the PTO to resume examination of its reissue application. During the appeal, the PTO issued a notice of allowance for the reissue application. The notice of allowance indicated that all original claims would be amended or cancelled in the reissue patent in the manner discussed below. The Commission moved to dismiss the appeal as moot under 35 U.S.C. § 252, arguing that, once the reissue patent issued, the original claims would be surrendered and that the reissue claims were not “substantially identical,” such that any existing causes of action would be extinguished by

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operation of the statute. *See* ECF No. 54. The Commission also requested a stay of the appeal pending disposition of its motion. *Id.* Intervenor/respondent Chic filed a response in support of the Commission’s motion. *See* ECF No. 55. On May 18, 2018, Razor filed a response opposing the Commission’s motion. *See* ECF No. 58. On May 22 and June 15, 2018 respectively, Razor filed continuation reissue applications with the PTO.² On May 25, 2018, the Commission filed its reply. *See* ECF No. 60. On June 29, 2018, the Court issued an order holding the Commission’s motion in abeyance pending issuance of the reissue patent and directing the parties to inform the Court when the reissue patent issued. *See* ECF No. 61.

On July 18, 2018, Razor filed a “Notice Regarding Status of Reissue Proceedings” in which Razor advised the Court that the reissue patent was scheduled to issue on July 24, 2018. *See* ECF No. 62. In that notice, Razor argued that such issuance would not result in surrender of the ’278 patent because of the pendency of the two continuation reissue applications. *Id.* (citing *Pfizer Inc. v. Apotex Inc.*, 731 F.Supp.2d 741 (N.D. Ill. 2010)). Razor also contended that the relevant language added to claim 1 is “simply another way of saying” what was recited in claim 2 of the original patent and thus the reissue claims were substantially identical to the original claims. *See* ECF No. 58 at 9. On July 24, 2018, the Commission filed a notice advising the Court that the reissue patent had issued that day. *See* ECF No. 65. The Commission also informed the Court that it regarded the arguments in Razor’s July 18, 2018 notice as an unauthorized sur-reply to the Commission’s motion. *Id.* On that same day, both the Commission and Chic filed motions seeking leave to file substantive responses to Razor’s July 18, 2018 notice, attaching their respective proposed responses. *See* ECF Nos. 64-1, 66-1. On

² *See* Ex. 1 to OUII’s Response to the Commission’s September 19, 2019 Order (Oct. 21, 2019).

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July 31, 2018, the Court granted both motions and provided Razor an opportunity to reply to the two responses. *See* ECF No. 67. On August 3, 2018, Razor filed its reply. *See* ECF No. 70.

On October 16, 2018, the Court remanded the investigation to the Commission for further proceedings consistent with its ruling. *See* Remand Order (ECF No. 71) at 4. Specifically, the Court deemed it appropriate for the Commission to have the first opportunity to determine “whether post-investigation events have rendered the case moot or whether the case may continue either on the original patent claims or reissued claims and to conduct any additional proceedings as necessary.” *Id.*

On November 13, 2018, the Commission issued an order requesting the parties to provide comments concerning what further proceedings are appropriate consistent with the Court’s order, including whether the matter should be referred to the ALJ. Comm’n Order (Nov. 13, 2018).

On November 27, 2018, Razor submitted comments, six respondents (Chic, Swagway, Modell’s, Jetson, Powerboard, and Newegg) filed a joint submission, and Alibaba filed a separate submission. On December 4, 2018, OUII submitted comments. On December 10, 2018, Razor and the six respondents submitted response comments.

On September 19, 2019, the Commission issued an order requesting the parties to provide written responses regarding certain questions concerning the effect of the patent reissue.

Specifically, the Commission posed these questions:

- (a) Whether any claims of the original ’278 patent were surrendered (and which ones) when the RE’964 reissue patent issued. In addressing this issue, the parties should address:
 - (1) Razor’s argument that the original claims have not been surrendered because of the pendency of the two continuation applications.
 - (2) Razor’s reliance on MPEP § 1460, and the cases cited therein.
 - (3) Whether Razor’s proposition that the original claims were not surrendered is consistent with the language of 35 U.S.C. §§ 251, 252.

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(4) *Pfizer Inc. v. Apotex Inc.*, 731 F.Supp.2d 741 (N.D. Ill. 2010) and the question of whether original claims may be surrendered on a claim-by-claim basis as they are reissued. In connection with this question, the Commission notes that reissue claims receive the same numbering as the original claims. See MPEP § 1455.

(5) If original claims may be surrendered on a claim-by-claim basis as they are reissued, would this mean that original claims 1 and 3-9 have been surrendered and replaced with reissue claims 1 and 3-9, with original claim 2 being cancelled?

(6) What is the relationship of reissue claim 10 and its dependent claims to the original claims? As additional claims, do they have prospective effect only? Should these claims be treated as reissues of original claims 1-9? Does the substantial identity test apply to claim 10 and its dependent claims?

(b) For each claim of the original '278 patent asserted in the investigation and which was at issue in Razor's appeal, identify and explain whether and why any claim of the RE'964 reissue patent is "substantially identical" to each such original patent claim.

(c) Based on your positions on (a) and (b), what further steps are necessary for the Commission to complete this remand in accordance with the Court's remand order.

Comm'n Order (Sept. 19, 2019).³ On October 21, 2019, Razor, Jetson, and OUII filed their initial submissions. On October 22, 2019, four other respondents (Chic, Swagway, Modell's, and Newegg) filed a joint submission. On November 11, 2019, the same four respondents filed a reply. On November 12, 2019, Razor and OUII each filed a reply. On November 18, 2019, Jetson filed what it styled as a reply to Razor's reply, but which also addressed Razor's initial submission. Jetson's latter submission was untimely as a response to Razor's initial submission and was unauthorized as a reply to Razor's reply. None of the other parties objected to Jetson's submission. The Commission has determined to accept that submission, but only as to the portion that responds to Razor's initial submission.

³ The "MPEP" is the MANUAL OF PATENT EXAMINING PROCEDURE (9th ed., Revision 08.2017, Jan. 2018).

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II. CLAIMS OF THE ORIGINAL AND REISSUE PATENTS; REISSUE PATENT PROSECUTION AND RELATED PROCEDURAL HISTORY

Claims 1-3 and 5-8 of the '278 patent were asserted at the time of the evidentiary hearing in the investigation. Claim 1 was an independent claim. The remaining claims were dependent claims. Asserted claims 1 and 2 of the '278 patent read:

1. A two-wheel, self-balancing vehicle device, comprising:
 - a first foot placement section and a second foot placement section that are coupled to one another and are independently movable with respect to one another;
 - a first wheel associated with the first foot placement section and a second wheel associated with the second foot placement section, the first and second wheels being spaced apart and substantially parallel to one another;
 - a first position sensor and a first drive motor configured to drive the first wheel, a second position sensor and a second drive motor configured to drive the second wheel; and
 - control logic that drives the first wheel toward self-balancing the first foot placement section in response to position data from the first sensor and that drives the second wheel toward self-balancing the second foot placement section in response to position data *from the second foot placement section*.
2. The device of claim 1, wherein the first foot placement section and the second foot placement section *are rotatably coupled to one another*.

JX-1 ('278 patent, 4:60-5:13) (emphasis added for relevant limitations).

On May 26, 2016, the same day the investigation was instituted and one day before the deadline to file a broadening reissue application,⁴ patentee/complainant Shane Chen ("Chen") filed an application for reissue of the '278 patent pursuant to 35 U.S.C. § 251 and 37 C.F.R. § 171. *See* JX-3. Razor had not informed the Commission that it intended to seek reissue of the '278 patent. Among the amendments sought were the following revisions to claim 1 (additions underlined, deletions bracketed):

⁴ *See* 35 U.S.C. § 251(d) ("No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.").

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1. A two-wheel, self-balancing vehicle device, comprising:

a first foot placement section and a second foot placement section that are coupled to one another and are independently movable with respect to one another; and

a first wheel associated with the first foot placement section and a second wheel associated with the second foot placement section, the first and second wheels being spaced apart and substantially parallel to one another;

a first position sensor and a first drive motor configured to drive the first wheel, a second position sensor and a second drive motor configured to drive the second wheel; and

[control logic that drives] wherein the first wheel is driven toward self-balancing the first foot placement section in response to position data from the first sensor and [that drives] the second wheel is driven toward self-balancing the second foot placement section in response to position data from the second [foot placement section] sensor

JX-3.038 (PTO Prosecution History May 26, 2016). Chen explained (in relevant part) that “Claim 1 as published in the ’278 patent erroneously ended with the term ‘second foot placement section’ instead of ‘second sensor.’ This is corrected [in the application].” *Id.* at JX-3.044.

The reissue application also presented new claims 10-24.

On July 14, 2016, respondent Chic moved to terminate or stay the investigation in view of the reissue application, arguing that the reissue prosecution could finish before this investigation ended, and therefore once the broadened patent claims issued (replacing the original narrower claims), the proceedings before the Commission could then continue, which would conserve time, money, and judicial resources. Both Razor and OUII opposed the motion. On July 19, 2016, prior to responding to the stay motion, Razor requested the PTO to suspend examination of the reissue application pursuant to MPEP § 1442.02. On July 28, 2016, the ALJ issued an order (Order No. 13) denying Chic’s motion. *See* Order No. 13, *supra*. Chic did not seek interlocutory review of the ALJ’s denial of its motion.

On September 29, 2017, while the Commission’s final determination was on appeal to the Federal Circuit, Razor requested the PTO to resume examination of the reissue application.

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See PTO Prosecution History (“Letter Requesting Suspension of Action”) (Sept. 29, 2017). In a second preliminary amendment, the patentee revised the language of claims 1 through 9 back to the language in the ’278 patent as originally issued. See Preliminary Amendment, Sept. 29, 2017, at 4-5, 8.⁵ The patentee amended new claims 10-18 to track the original claims of the ’278 patent, except that the reference to “second foot placement section” at the end of independent claim 10 was replaced with “second sensor.” *Id.* at 6; *see id.* at 8 (“The undersigned respectfully draws the Examiner’s attention to the fact that claims 1 and 10 are identical except that claim 1 concludes with ‘second foot placement section’ and claim ten concludes with ‘second sensor.’”); *id.* (“[E]xcept for indications of claim dependency, claims 11-18 are respectively identical to claims 2-9.”). With this amendment, the patentee also cancelled new claims 19-24. *Id.* at 7.

The examiner rejected all claims of the reissue patent application as anticipated by prior art, *i.e.*, Kakinuma (U.S. Pre-Grant Publication 2006/0260857).⁶ See Non-Final Rejection, Dec. 22, 2017.⁷ Following this rejection and the patentee’s response, the patentee agreed to the examiner’s amendments to claim 1, and corresponding amendments to claim 10:

1. A two-wheel, self-balancing vehicle device, comprising:
a first foot placement section and a second foot placement section that are coupled to one another and are independently [movable with respect to one another] rotatable along an axis passing through a first wheel and a second wheel;

⁵ See Ex. H to Respondents’ Written Submission Pursuant to the Commission’s September 19, 2019 Order (Oct. 22, 2019).

⁶ In its response to the PTO rejection, the patentee also discussed Ishii (US Pre-Grant Publication 2008/0147281), which the patentee noted shares a common inventor with Kakinuma, cites Kakinuma as a “related reference,” and describes Kakinuma as disclosing “substantially the same” invention. See Ex. G to Respondents’ Written Submission Pursuant to the Commission’s September 19, 2019 Order (Oct. 22, 2019) at 8-9.

⁷ See Ex. I to Respondents’ Written Submission Pursuant to the Commission’s September 19, 2019 Order (Oct. 22, 2019).

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[a] said first wheel associated with the first foot placement section and [a] said second wheel associated with the second foot placement section, the first and second wheels being spaced apart and substantially parallel to one another;

a first position sensor and a first drive motor configured to drive the first wheel, a second position sensor and a second drive motor configured to drive the second wheel; and

control logic that drives the first wheel toward self-balancing the first foot placement section in response to position data from the first sensor and that drives the second wheel toward self-balancing the second foot placement section in response to position data from the second foot placement section.

See Examiner Initiated Interview Summary (Apr. 27, 2018); Examiner’s Amend. and Reasons for Patentability (Apr. 17, 2018) at 2-3.⁸ The patentee further agreed to cancel claims 2 and 11, which contained the language “wherein the first foot placement section and the second foot placement section are rotatably coupled to one another.” Examiner’s Amend. and Reasons for Patentability at 2-3. With those amendments, the PTO examiner allowed claims 1, 3-10, and 12-18. *Id.* The reissue patent, the RE’964 patent, issued on July 24, 2018.⁹

As noted *supra*, after the Commission moved to dismiss Razor’s appeal and prior to issuance of the reissue patent, Razor filed two continuation reissue applications, Appl. Nos. 15/986,713 and 16/000,535.¹⁰ One of these continuation reissue applications (No. 15/986,713) was the subject of a notice of abandonment mailed by the PTO on June 10, 2019. *See* ’713 Prosecution History, Notice of Abandonment (June 10, 2019)). The other continuation reissue

⁸ *See* Ex. 4 to OUII’s Response to the Commission’s September 19, 2019 Order (Oct. 21, 2019) at last page; Ex. D to Respondents’ Written Submission Pursuant to the Commission’s September 19, 2019 Order (Oct. 22, 2019).

⁹ *See* Ex. E to Respondents’ Written Submission Pursuant to the Commission’s September 19, 2019 Order (Oct. 22, 2019).

¹⁰ *See* Ex. 1 to OUII’s Response to the Commission’s September 19, 2019 Order (Oct. 21, 2019).

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application (No. 16/000,535) remains pending. *See* '535 Prosecution History, PTO Final Rejection (Dec. 28, 2020).

III. RELEVANT STATUTES AND RELATED LAW

The question to be resolved in this remand is whether the PTO's issuance of the reissue patent has resulted in the surrender of any of the original claims of the '278 patent and, if so, whether any of the reissue claims are substantially identical to the corresponding surrendered original claims. If all of the claims of the '278 patent asserted in this investigation have been surrendered and none of the corresponding reissue claims are substantially identical to the original claims, there are no enforceable claims left in the investigation, rendering the investigation moot.¹¹ The relevant statutory framework and secondary authority on this issue are discussed below.

A. Reissue Statutes – 35 U.S.C. §§ 251, 252

Two statutory provisions govern this question. The first, 35 U.S.C. § 251 (Reissue of Defective Patents) states, in relevant part, that:

(a) In General. — Whenever any patent is, through error, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Director shall, on the *surrender* of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

¹¹ As part of its briefing before the Commission, Razor requested a remand to the ALJ to seek leave to amend the complaint. *See* Razor's Response to the Commission's November 13, 2018 Order at 1, 3 (Nov. 27, 2018). Razor's request is addressed *infra*, Section IV.C.

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35 U.S.C. § 251(a) (emphasis added). The second, 35 U.S.C. § 252 (Effect of Reissue), expands on when original claims are surrendered, and the consequences of that surrender, stating in relevant part that:

The surrender of the original patent shall take effect upon the issue of the reissued patent, and every reissued patent shall have the same effect and operation in law, on the trial of actions for causes thereafter arising, as if the same had been originally granted in such amended form, but in so far as the claims of the original and reissue patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing, and the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.

35 U.S.C. § 252 (1999) (emphasis added). As section 252 states, the surrender of the original patent occurs simultaneously with the issuance of the reissue patent. “In sum, under . . . the reissue . . . statute, if the PTO confirms the original claim in identical form, a suit based on that claim may continue, but if the original claim is cancelled or amended to cure invalidity, the patentee’s cause of action is extinguished and the suit fails.” *Fresenius USA, Inc. v. Baxter Int’l, Inc.*, 721 F.3d 1330, 1340 (Fed. Cir. 2013).

The Federal Circuit explained that the term “identical” as used in original section 252 “means, at most, ‘without substantive change.’” *Westvaco Corp. v. Int’l Paper Co.*, 991 F.2d 735, 741 (Fed. Cir. 1993) (quoting *Seattle Box Co., Inc. v. Industrial Crating & Packing, Inc.*, 731 F.2d 818, 827 (Fed. Cir. 1984) (emphasis in original)). That standard did not change when section 252 was amended in 1999 to read “substantially identical.” See *R+L Carriers, Inc. v. Qualcomm, Inc.*, 801 F.3d 1346, 1349 (Fed. Cir. 2015) (indicating that the same definition applies to the “substantially identical” standard in section 252, amended in 1999). “[I]t is the scope of the claim that must be identical, not that identical words must be used.” *Slimfold Mfg. Co., Inc. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1115-16 (Fed. Cir. 1987). The Federal

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Circuit has held that when a rejected claim is amended to become allowable, there likely has been a substantive change in claim scope, though the question of substantive change is determined “not through any ‘*per se* rule,’ but in light of an overall examination of the written description, the prosecution history and the language of the respective claims.” *Laitram Corp. v. NEC Corp.*, 163 F.3d 1342, 1348 (Fed. Cir. 1998) (emphasis in original).¹²

Where there is only one reissue application and that application results in a reissue patent, determining when the claims of the original patent have been surrendered is straightforward: all claims of the original patent are surrendered on the date the reissue patent issues. However, multiple reissue applications as well as continuation and divisional reissue applications may be filed, which may create a scenario in which one or more reissue applications remains pending *after* an initial reissue patent issues. That is the circumstance of this case.

B. Case Law – *Pfizer Inc. v. Apotex Inc.*

Neither the Supreme Court nor the Federal Circuit appear to have addressed when or to what extent the claims of the original patent are surrendered in the event of multiple reissue applications. These circumstances did arise in *Pfizer Inc. v. Apotex Inc.*, 731 F. Supp. 2d 741 (N.D. Ill. 2010), the primary case upon which Razor relies. Pfizer sued Apotex for infringement of U.S. Patent No. 5,273,995 (“the ’995 patent”). While the Northern District of Illinois case was pending, the Federal Circuit in an unrelated case held claim 6 of the ’995 patent invalid under 35 U.S.C. § 112, ¶ 4 (*i.e.*, reciting subject matter outside of the claim on which it depended). *Id.* at 743-44. Pfizer filed two reissue applications, the first of which issued as U.S. Patent No. RE40,667 (“the RE’667 patent”) while the second remained pending. *Id.* at 744.

¹² While *Laitram* involved a reexamination, the same standard governs the substantial identity of claims following reissue and reexamination. *See, e.g., R+L Carriers*, 801 F.3d at 1349 (citing 35 U.S.C. § 307(b)).

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The RE'667 patent only included corrected claim 6 and two new claims, while the pending application included all of the original claims except claim 6, plus one new claim. *Id.*

Pfizer amended its complaint to allege infringement of the RE'667 patent, retaining the counts arising out of the original '995 patent. *Id.* at 743. Apotex moved to dismiss the complaint as to the original '995 patent, arguing that the plain language regarding surrender in sections 251 and 252 (“the surrender clauses”) requires surrender of the original patent in its entirety when the first reissue patent issues. *Id.* at 747. If this were the case, Pfizer would be deemed to have surrendered all claims of the '995 patent on issuance of the RE'667 patent, even though the original claims (except claim 6) were the subject of a pending reissue application. *Id.* at 748. Pfizer argued that the surrender of the original patent does not occur until the last reissue application issues or is otherwise terminated. *Id.* at 745.

The district court found sections 251 and 252 to be ambiguous on this point, but ultimately concluded that in the case of multiple reissue applications, issuance of the first reissue patent did not result in “full surrender” of the original patent, at least where original claims were still the subject of a pending second reissue application: “In sum, the reissue provisions read as a whole, the purpose underlying those provisions, the legislative history, and the Board of Patent Appeals and Interference’s reading of the statute, support Pfizer’s contention that full surrender of an original patent is not required upon the issuance of the first of multiple reissue patents.” *Id.* at 752. The *Pfizer* court explained that to hold otherwise would be inconsistent with the other clauses of the statute preserving the patentee’s rights in the original patent unless and until a reissue patent issues. *Id.* at 748 (“Granting Apotex’s motion to dismiss would cut off Pfizer’s rights under all claims of the '995 patent – save for claim 6 – thereby allowing the reissue procedure to destroy a portion of Pfizer’s property rights.”).

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Apart from the statutory language, Apotex argued that Pfizer's approach could not be squared with the doctrine of double patenting, which prohibits a patentee from obtaining a second patent on the same invention (statutory double patenting) or an obvious variation of it (judicially-created obviousness-type double patenting). *Id.* at 752-54. Apotex argued that because (amended) claim 6 of the RE'667 patent covered exactly the same subject matter as claim 6 of the original '995 patent, holding that issuance of the RE'667 patent (with its amended claim 6) did not result in surrender of the '995 patent (including original claim 6) would violate the statutory prohibition on double patenting of the same invention, *i.e.*, the invention of claim 6. Apotex also argued that new claims 13 and 14 of the RE'667 patent were obvious variations of original claims 11 and 12 of the '995 patent.

As to claim 6, the court found that there was no statutory double-patenting issue because original claim 6 had been found invalid and thus there was only one enforceable claim 6, the amended reissue claim 6 in the RE'667 reissue patent. *Id.* at 752. As to new claims 13 and 14 of the RE'667 patent, the court found that obviousness-type double patenting could be avoided by filing a terminal disclaimer that the '995 patent and RE'667 patent would be enforceable only if commonly owned. *Id.* at 752-54.

In the course of reaching its conclusion on double patenting, the district court considered the MPEP's "apparent endorsement of partial surrender," *i.e.*, the court's understanding that the PTO had adopted a policy that in the case of multiple reissue patents, individual claims of the original patent are surrendered whenever they are reissued. *Id.* at 754 (citing MPEP 8th ed., Rev. 7, § 1451 (2008) ("[o]nce a claim in the patent has been reissued, it does not exist in the original patent; thus, it cannot be reissued from the original patent in another reissue application")). Alternatively, the court stated "the MPEP may simply be read as recognizing the long-held understanding that once a claim has been reissued, the original claim is dead." *Id.* at

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754 n.7 (citing *Seattle Box*, 731 F.2d at 827). Pfizer had raised partial surrender as an alternative to its argument that surrender of the original patent did not occur until the last of any continuation reissue applications was granted or abandoned. *Id.* at 753. However, the district court found that while the PTO's policy of partial surrender would obviate statutory double patenting concerns as between an original patent and a correspondingly numbered reissue claim, partial surrender would not obviate the obviousness-type double patenting issue raised by new claims of a reissue patent.¹³ *Id.*

To sum up, the district court in *Pfizer* held that the issuance of reissue patent RE'667, with its amended original claim 6 and its new claims 13 and 14, did not result in full surrender of the '995 patent, with its other original claims that had not yet reissued, because those claims were the subject of a still-pending continuation reissue application. To require surrender of the '995 patent would result in surrender of those original claims that had not yet reissued, a result the district court found contrary to statute. The district court recognized the PTO's policy of partial surrender as based on the MPEP and, alternatively, on *Seattle Box*. The district court could have applied partial surrender to achieve the result it did, but did not do so. There was no occasion for the court to determine whether any reissue claim was "substantially identical" to original claim 6. In the present case, the reissue patent reissued or cancelled all original claims; there are no original claims in the pending continuation reissue application. Thus, the factual basis for the *Pfizer* court's rationale is absent here.

¹³ The court did not explain why this must be the case. However, it is easy to see that partial surrender would not work because claims 13 and 14 of the reissue patent were new claims in the reissue, not reissues of original claims 11 and 12. This meant that the only way to avoid obviousness-type double patenting as between original claims 11 and 12 and reissue claims 13 and 14 would be a terminal disclaimer.

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C. Administrative Guidance– MPEP and BPAI Materials

The *Pfizer* decision is cited by MPEP § 1460, which explains:

In the situation where multiple reissue applications are filed, the original patent is surrendered when at least one reissued patent has been granted *and there are no pending applications for reissue of the original patent.* *Pfizer Inc. v. Apotex Inc.*, 731 F. Supp.2d 741, 748 (N.D. Ill. 2010). 35 U.S.C. § 252 mandates that “[t]he surrender of the original patent shall take effect upon the issue of the reissued patent.” After that point in time, the original patent ceases to exist, and no subsequent applications for its reissue can be made. *See Peck v. Collins*, 103 U.S. 660, 663-64 (1880) (surrender of a patent extinguishes it, and the patentee thereafter has no rights except those in the reissued patent). If, however, a continuation reissue application were filed prior to the issuance of the first reissue patent, then the surrender of the original patent would be delayed until the issuance (or abandonment) of the continuation reissue application. *See Ex Parte Bayles*, Commissioner’s Decision, 176 O.G. 750 (1912) (grant of first reissue application does not bar copending reissue application for reissue of the original patent).

MPEP § 1460 (9th ed. Rev. 10.2019 (June 2020)) (emphasis added). The MPEP is a publication of the U.S. Patent and Trademark Office and is intended as a guide to examiners in their examination of patent applications. It binds only the PTO. *See, e.g., Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1425 (Fed. Cir. 1988); *see also Cleveland Clinic Found. v. True Health Diagnostics LLC*, 760 F. App’x 1013, 1020 (Fed. Cir. 2019) (noting that PTO guidance on patent eligibility does not bind the Court). Of the three cases cited in MPEP § 1460, *Razor* relies only on *Pfizer*, the inapplicability of which is discussed above.

Razor also relies on *Ex parte Okamoto*, No. 2000-0132, 2006 WL 2523548 (B.P.A.I. Oct. 21, 2002) (unpublished), in which the Board of Patent Appeals and Interferences (“BPAI”), reversing the examiner, stated that an original patent is not surrendered until all pending continuation or divisional reissue applications are disposed of. No issue was raised or decided as to when individual claims of the original patent were surrendered. The BPAI in *Okamoto*

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stated that its holding was “implicit” in the Federal Circuit’s decision in *In re Graff*, 111 F.3d 874, 876 (Fed. Cir. 1997), where that Court held that an applicant who had filed an original reissue application could also file a continuation of that application with broadened new claims, and permitted the original reissue application to issue as a reissue patent with the original claims or claims that were of the same scope as the original claims. No issue was raised or decided in *Graff* as to when the claims of the original patent were surrendered. Indeed, all of the original claims were issued in the reissue patent without amendment, except for one the Court deemed to be of the same scope as the original claim it replaced. *Id.* at 875-76.

IV. DISCUSSION

This case presents an issue not considered or disposed of by the cases cited by the parties, *i.e.*, what, if any, original claims are surrendered when a reissue patent is issued and a continuation reissue application is pending at the time of issue of that reissue patent. The Commission interprets section 252 to require that each original claim be surrendered when its corresponding reissue claim is issued. Applying that approach, we must first determine what, if any, claims of the original patent have been surrendered. If any have been surrendered, we must then determine whether the corresponding reissue claim is substantially identical to that original claim. As discussed below, we find that all asserted claims have been surrendered and none of the reissued claims are substantially identical to the original claims. We also deny Razor’s request for leave to amend its complaint.

A. All Claims of the ’278 Patent Have Been Surrendered

Razor argues that all of the claims of the ’278 patent *and* all of the claims of the RE’964 patent are currently enforceable because there remains pending a continuation reissue

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application, citing *Pfizer*.¹⁴ Fundamentally, this proposition is inconsistent with the reissue statutes. The first sentence of section 252 reiterates the surrender provision of section 251: “The surrender of the original patent shall take effect upon the issue of the reissued patent.” The repetition of this point reflects its significance. To hold otherwise would mean that the original claims and corresponding reissue claims would both be enforceable while any additional reissue applications were pending. That outcome would be inconsistent with section 252 and governing case law, specifically, *Seattle Box, supra*.

Section 252 does not contemplate the simultaneous enforceability of original claims and their corresponding reissue claims. Rather, a reissue claim does not become enforceable until the original claim is surrendered, *i.e.*, the two events are conditioned on each other. They cannot simultaneously exist under section 252. Razor’s theory would render the first sentence of section 252 meaningless. Razor’s theory is also inconsistent with the Federal Circuit’s holding in *Seattle Box* that once original claims are reissued, “[t]he original claims are dead.” *Seattle Box*, 731 F.2d at 827.

This statutory principle does not vary or disappear where multiple reissue applications are involved. While the surrender clauses appear to contemplate a single reissue patent, the statute and case law provide for multiple reissue applications. 35 U.S.C. § 251(b), *In re Graff, supra*. Razor’s suggestion that no surrender takes place until all reissue applications are resolved would read out the simultaneous surrender-upon-issuance of the reissue patent aspect of sections 251 and 252. Furthermore, such a concept would have no relevance here, since all the original claims have been reissued or cancelled.

¹⁴ If proceedings on the currently pending continuation reissue application end, either because of the issuance of a reissue patent thereunder or because of withdrawal of the continuation application, then, even under Razor’s theory, all original claims will have been surrendered.

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Partial, or claim-by-claim surrender is the only approach that gives effect to all statutory clauses and purposes. Under this approach, an original claim is only surrendered when a reissue patent issues with a correspondingly numbered claim. *See* MPEP § 1455. This is consistent with the language and purpose of the surrender clauses of sections 251 and 252 because surrender of the original claim occurs simultaneously with the issuance of the corresponding reissue claim, such that the original claim and its corresponding reissue are not enforceable at the same time. Partial surrender is also consistent with the abatement and continuation clauses of section 252. The abatement clause states that “in so far as the claims of the original and reissued patents are substantially identical, such surrender shall not affect any action then pending nor abate any cause of action then existing.” 35 U.S.C. § 252 ¶ 1. The continuation clause provides that “the reissued patent, to the extent that its claims are substantially identical with the original patent, shall constitute a continuation thereof and have effect continuously from the date of the original patent.” *Id.* Under partial surrender, an original claim is enforceable and thus an action based on that claim is not affected until the corresponding reissue claim is issued. At that point, the action on the original claim may be continued under the corresponding reissue claim, but only if the reissue claim is substantially identical to the original claim. Likewise, if the reissue claim is not substantially identical, then “any cause of action then existing” as to the corresponding original claim is abated. We therefore find that partial surrender applies to the patent claims at issue here.

We do not view this approach as inconsistent with the reasoning of the *Pfizer* court. In that case, only original claim 6 had reissued, and the remaining original claims remained the subject of a pending reissue application as of Apotex’s motion to dismiss the complaint. There was no potential for simultaneous enforcement of the original and reissued claims: only claim 6 had reissued, but the original claim 6 had been previously invalidated by the Federal Circuit.

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The court simply did not have to consider this issue. Moreover, use of the partial surrender approach in *Pfizer* would have led to the same outcome: only claim 6 had been reissued, so all other claims of the original patent would have been enforceable while the second reissue application was pending. While the *Pfizer* court had no reason to apply the partial surrender approach, its analysis of the statute and its purposes supports the partial surrender approach in the context presented here. *See, e.g.*, 731 F. Supp. 2d at 748-49.

The original '278 patent contained claims 1-9. Original claim 2 was cancelled in the reissue, and thus cannot be enforced in pending litigation.¹⁵ The RE'964 reissue patent contains reissue claims 1 and 3-9, and new claims 10-18. Under the partial surrender approach, this means that claims 1 and 3-9 of the '278 patent have been surrendered. The next question is whether the corresponding reissue claims are “substantially identical” to the original claims. As discussed below, they are not.

B. None of the Reissue Claims Is “Substantially Identical” to the Original Claims

Partial surrender means that original claims 1 and 3-9 “are dead” and cannot be enforced. Reissue claims 1 and 3-9 can be enforced as from the date of the original investigation, but only if they are substantially identical to original claims 1 and 3-9. If they are not substantially identical, they can only be enforced from the date of issue of the RE'964 reissue patent. New claims 10 and 12-18 can only be enforced from the date of the RE'964 reissue patent because they do not correspond to any original claims and could not have been asserted in the investigation as originally instituted based on Razor's complaint. Further, as noted in *Seattle Box*: “With respect to new or amended claims, an infringer's liability commences only from the

¹⁵ *See Fresenius*, 721 F.3d at 1339 (“As with the reissue statute, the language and legislative history of the reexamination statute show that Congress expected reexamination to take place concurrent with litigation, and that cancellation of claims during reexamination would be binding in concurrent infringement litigation.”).

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date the reissue patent is issued.” *Seattle Box*, 731 F.3d at 827. The only question remaining is whether the reissue claims are “substantially identical” to the original claims.

Unlike surrender, substantial identity is a well-developed area of the law. Applying settled Federal Circuit law demonstrates there is no substantial identity in this case.

Before applying that law, there is a threshold question raised by the parties’ remand submissions: what reissue claims should be compared to the original claims? OUII states that the original claims have not been surrendered, but also states that none of the reissue claims, including the new claims, is substantially identical to the original claims and that the new claims have prospective effect only. *See* OUII’s Response to the Commission’s September 19, 2019 Order at 2, 13-14. Respondents argue that all original claims have been surrendered, that none of the corresponding reissue claims is substantially identical to the original claims, and that even if the new claims are treated as reissues of the original claims, they are not substantially identical to the original claims and have only prospective effect. *See* Respondents’ Response to the Commission’s September 19, 2019 Order at 9-20.

Section 252 provides that the substantial identity test applies between original claims and reissue claims. The Federal Circuit’s seminal case on identity, *Seattle Box*, forecloses its applicability to new reissue claims:

The statute permits, however, the claims of the reissue patent to reach back to the date the original patent issued, *but only if* those claims are identical with claims in the original patent. With respect to new or amended claims, an infringer’s liability commences only from the date the reissue patent is issued.

Seattle Box, 731 F.3d at 827 (emphasis original).

For its part, Razor argues that the substantial identity test is not applicable to these circumstances, that if it is to be performed, it should be by an administrative law judge, and that in performing that test we should compare claim 1 of the RE’964 patent to claim 2 of the ’278

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patent and find that those two claims are substantially identical. *See* Razor’s Response to the Commission’s September 19, 2019 Order at 11-15; Razor’s Reply at 5-15. Razor overlooks that the substantial identity test is performed to determine whether a particular reissue claim should be treated as a continuation of the original claim under section 252. In this case, Razor argues that claim 1 should be continued in the reissue. This requires a comparison between reissue claim 1 and original claim 1. Further, whatever the scope of comparison that might be permissible generally, it would be illogical to compare any claim of the RE’964 patent to claim 2 of the ’278 patent because that claim was cancelled during prosecution of the RE’964 patent. The purpose of the abatement and continuation clauses is to ensure that the “patentee’s rights under the original patent continue after reissue insofar as the claims of the original and reissue patents are identical.” *Pfizer*, 731 F. Supp. 2d at 748 (quoting 4A Donald S. Chisum, CHISUM ON PATENTS § 15.01 (2010)). Razor elected to terminate its rights to claim 2 when it cancelled that claim during prosecution of the first reissue application. *See Fresenius*, 721 F.3d at 1339-40. Razor has no more rights under claim 2 that can be continued by any claim of the reissue patent. *Id.* Accordingly, the only claims to which the “substantial identity” test applies are claims 1 and 3-9 of the RE’964 patent as compared to claims 1 and 3-9 of the ’278 patent. Ultimately, as discussed below, all reissue claims here contain a limitation that was not present in the original claims, a limitation that was added to overcome prior art so that none of the reissue claims is substantially identical to the original claims, no matter how the comparison is made.

As discussed *supra* in Section II, the claims of the ’278 patent were presented in their original form in the reissue application when the examiner rejected the claims as anticipated by the prior art (Kakinuma). Non-Final Rejection, December 22, 2017, pp. 3-11. The examiner stated that Kakinuma disclosed the limitation of original claim 2 as follows: “FIGS 9-10

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illustrate a rotational coupling frame 17 which rotatably couples the foot placement sections 11R and 11L. FIGS 14A and 14B illustrate another type of rotational link 69.” *Id.* at 5. Thus, as the examiner found, these cited disclosures in Kakinuma show rotatable coupling between the two foot placement sections, though the rotation of the coupling is in a direction transverse to the direction of the rotation of the wheels. *See* Non-Final Rejection at 5 (citing Kakinuma, Figs. 9-10, 14). However, there is no limitation in original claim 2 as to the direction of the rotation of the coupling.

In its response, the patentee challenged the examiner’s contentions as they related to independent claim 1 and new independent claim 10, arguing that Kakinuma did not teach that the foot placement sections were “independently movable with respect to one another” as required by claim 1. Patentee Response to Office Action, at 7-12. Razor did not make any argument specific to the examiner’s rejection of original claim 2 over Kakinuma, but instead relied on its response to the examiner’s rejection of claim 1. On April 17, 2018, patentee conducted a telephone interview with the examiner at the request of the examiner. The examiner’s interview summary states that the parties “Agreed upon Examiner’s Amendment as attached to Notice of Allowance Office Action.” The examiner’s amendment revised claims 1 and 10 to their forms as in the RE’964 patent, and cancelled dependent claims 2 and 11. Examiner’s Amendment and Reasons for Patentability (Apr. 17, 2018). Specifically, the first paragraph of claim 1 was amended as follows:

a first foot placement section and a second foot placement section that are coupled to one another and are independently [movable with respect to one another] rotatable along an axis passing through a first wheel and a second wheel;

Id. at 2, 4. The first paragraph of claim 10 was amended to read similarly to claim 1. *Id.* at 3-4.

In the Reasons for Patentability, the examiner stated that the amendments to claims 1 and 10

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“distinguishes [sic] from Kakinuma et al. (US Pre-Grant Publication 2006/020857) and Ishii et al. (US Pre-Grant Publication 2008/0147281).” *Id.* at 3-4. For reference, the first paragraph of the independent claims¹⁶ under consideration are replicated below:

	'278 patent, claim 1, ¶ 1	RE'964 patent, claim 1, ¶ 1 RE'964 patent, claim 10, ¶ 1
Final Text	a first foot placement section and a second foot placement section that are coupled to one another and are independently movable with respect to one another	a first foot placement section and a second foot placement section that are coupled to one another and are independently rotatably coupled along an axis passing through a first wheel and a second wheel
Comparison to '278 patent, claim 1, ¶ 1	N/A	a first foot placement section and a second foot placement section that are coupled to one another and are independently [movable with respect to one another] <i>rotatably coupled along an axis passing through a first wheel and a second wheel</i>

It is plainly evident that reissue claim 1 is not substantially identical to original claim 1. Original claim 1 covered devices in which the first and second foot placement sections are coupled and independently movable with respect to one another, with no requirement that they be rotatably coupled along an axis passing through a first and second wheel. As discussed above, original claim 2 required that the first and second foot placement sections be rotatably coupled to each other, but neither original claim 1, nor original claim 2, provided that such rotation be “along an axis passing through a first and second wheel.” This limitation was added to distinguish all the reissue claims from Kakinuma. *See* Examiner Initiated Interview Summary (Apr. 27, 2018); Examiner’s Amend. & Reasons for Patentability (Apr. 17, 2018) at 2-3.

¹⁶ The remaining claims of the '278 patent, *i.e.*, claims 3-9, depend from independent claim 1, and the remaining claims of the RE'964 patent, *i.e.*, claims 3-9 and 11-17, depend from either independent claim 1 or independent claim 10. *See* JX-1; Ex. E to Respondents’ Written Submission Pursuant to the Commission’s September 19, 2019 Order (Oct. 22, 2019).

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Under *Laitram*, the law is clear that an amendment is substantive if it results in “a rejected claim [becoming] allowable” in view of “the written description, the prosecution history, and the language of the respective claims.” *See Laitram*, 163 F.3d at 1348. Razor argues that this limitation was described in the specification. While a description in the specification is necessary to support a claim amendment, the disclosure in the specification is not the claim. Essentially, Razor is arguing that the disclosure of the specification be read into the claim, which is not permissible. *See, e.g., GE Lighting Solutions, LLC v. AgiLight, Inc.*, 750 F.3d 1304, 1310 (Fed. Cir. 2014). Moreover, even if it was the patentee’s intent to include a limitation it considered part of the claim scope, “the patentee’s intent in making the amendment is not determinative or controlling in determining claim scope.” *Presidio Components, Inc. v. American Technical Ceramics Corp.*, 875 F.3d 1369, 1378-80 (Fed. Cir. 2017). And here, the amendment was proposed by the PTO examiner to overcome the rejection over Kakinuma. The Examiner’s Amendment and Reasons for Patentability expressly states that the claims have been put in a condition for allowance because this amendment distinguishes the prior art.

Nor does it require any complex claim construction to determine that claims 1 and 10 of the RE’964 are narrower than claim 1 of the ’278 patent given that the RE’964 claims add the requirement that the device have an axis passing through the first and second wheels (among other limitations). *See Presidio*, 875 F.3d at 1378. It is well-established that a “determination of whether the scope of a reissue claim is identical with the scope of the original claim is a question of law,” which the Commission may decide itself.¹⁷ *See Westvaco Corp. v. Int’l Paper*

¹⁷ Also, this course of action is consistent with the Commission’s practice of deciding the issues on court remand itself rather than remanding to an ALJ, when the matter to be decided is a legal question that does not require additional fact-finding and is unrelated to the claims and issues presented below. *See, e.g., Certain Digital Models, Digital Data, & Treatment Plans, Inv. No. 337-TA-833, Comm’n Notice*, 2016 WL 10679760 (Sept. 23, 2016); *Certain Light-Emitting*

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Co., 991 F.2d 735, 741 (Fed. Cir. 1993). Accordingly, the reissue claims are not “substantially identical” to the original claims.

Thus, the Commission investigation may not continue under the original claims or the reissue claims. The original claims of the ’278 patent have been surrendered and neither the corresponding nor the new claims of the RE’964 patent are substantially identical to the original claims. *See, e.g., Fresenius*, 721 F.3d at 1340 (“[I]f the original claim is cancelled or amended to cure invalidity, the patentee’s cause of action is extinguished and the suit fails.”). Indeed, the new claims have prospective effect only and new independent claim 10 contains an additional amendment in its last paragraph replacing “second foot placement section” with “second sensor.” This additional amendment is another substantive amendment; the substantive nature of this amendment is confirmed by Razor’s argument that the amendment would have made a difference in the ALJ’s infringement determination. *See* Razor’s Response to the Commission’s November 13, 2018 Order at 2 (Nov. 27, 2018).

C. Razor May Not Amend Its Complaint

We agree with Respondents and OUII that, at this point, Razor cannot simply amend its complaint to add the reissue patent. The question of whether to permit a party to amend its complaint is directed to the discretion of the tribunal. *See, e.g., Aatrix Software, Inc. v. Green Shades Software, Inc.*, 882 F.3d 1121, 1126 (Fed. Cir. 2018). Amendment may be denied on numerous grounds such as “undue delay, undue prejudice to the defendants, and futility of the amendment.” *Id.* (quoting *Mann v. Palmer*, 713 F.3d 1306, 1316 (11th Cir. 2013)). Razor,

Diodes & Prod., Inv. No. 337-TA-512, Comm’n Notice, 2008 WL 11388140, (Mar. 28, 2008); *Certain Zero-Mercury-Added Alkaline Batteries*, Inv. No. 337-TA-493, Comm’n Notice, 2007 WL 7289356, (Feb. 23, 2007).

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whose burden it is, has cited no authority to justify amending the complaint to add the reissue patent at this stage of the case.

The procedural posture of the investigation is key here. Razor could not have amended its complaint to add the claims of the RE'964 patent until the patent issued in July 2018—approximately one year *after* the Commission's final determination. None of the cases Razor cites involved amending a complaint to add a reissue patent after judgment has been entered on the original patent.^{18, 19} Moreover, reopening this investigation would not be as simple as asking the ALJ to make a new initial determination. Because the reissued claims are not “substantially identical” to the original claims, they are only enforceable from their date of issuance, and cannot be simply substituted for the original claims. The factual record closed before the RE'964 patent issued, meaning discovery would have to be reopened. In these circumstances, we find that good cause has not been shown to amend the complaint. *See* 19 C.F.R. § 210.14(b)(1).

V. CONCLUSION

For the reasons discussed herein, the Commission has determined to terminate the investigation for mootness.

¹⁸ OUII and Respondents suggest that Razor could seek to file a new complaint asserting the reissued claims. OUII Initial Comments at 3; Respondents' Initial Comments at 10-11. The Commission, however, does not now decide what action it may take should Razor file a complaint based on alleged violations of section 337 with respect to the reissue patent relating to the same or similar accused products.

¹⁹ Razor filed its complaint knowing that its patent was defective; indeed, it filed its reissue application on the day the Commission instituted this investigation based on that complaint. Razor then ensured that any reissue patent resulting from that application could not be part of this investigation by successfully opposing Chic's motion for a stay of the investigation pending the outcome of the reissue proceedings and requesting the PTO to suspend action on the reissue application, waiting until two months after the Commission issued its final determination to request the PTO to lift its suspension.

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By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: February 8, 2021

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **COMMISSION OPINION** has been served via EDIS upon the Commission Investigative Attorney, **Paul A. Gennari, Esq.**, and the following parties as indicated, on **February 8, 2021**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

On Behalf of Complainants Razor USA LLC, Inventist, Inc., and Shane Chen:

Jonathan J. Engler, Esq.
ADDUCI, MASTRIANI & SCHAUMBERG, L.L.P.
1133 Connecticut Avenue, N.W.
Washington, DC 20036
Email: engler@adduci.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification of Availability for Downloadal

On Behalf of Respondent Hangzhou Chic Intelligent Technology Co., Ltd.:

Michael Wilson, Esq.
MUNCK WILSON MANDALA, LLP
12770 Coit Road
Suite 600
Dallas, TX 75251
Email: mwilson@munckwilson.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification of Availability for Download

On Behalf of Respondent Modell's Sporting Goods, Inc. and Swagway LLC:

Lei Mei, Esq.
MEI & MARK LLP
818 18th Street NW, Suite 410
Washington, DC 20006
Email: mei@meimark.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification of Availability for Download

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On Behalf of Respondent Powerboard LLC a.k.a. Optimum Trading Co.:

L. Peter Farkas, Esq.
HALLORAN FARKAS + KITTLA, LLP
1101 30th Street NW, Suite 500
Washington, D.C. 20007
Email: pf@hfk.law

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification of Availability for Download

On Behalf of Respondent Newegg.com Inc.

Kent E. Baldauf, Jr., Esq.
THE WEBB LAW FIRM
One Gateway Center
420 Ft. Duquesne Boulevard, Suite 1200
Pittsburgh, PA 15222
Email: kbaldaufjr@webblaw.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
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On Behalf of Respondent Alibaba Group Holding Ltd. and Alibaba.com Ltd.:

Michael R. Franzinger, Esq.
SIDLEY AUSTIN LLP
1501 K Street, N.W.
Washington, D.C. 20005
Email: mfranzinger@sidley.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification of Availability for Download

On Behalf of Respondent Jetson Electric Bikes LLC:

Ezra Sutton, Esq.
EZRA SUTTON, P.A.
900 Route 9 North, Suite 201
Woodbridge, NJ 07095
Email: esutton@ezrasutton.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification of Availability for Download

Respondents:

United Integral, Inc. d/b/a Skque Products
10525 Venita Street
El Monte, CA 91731

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333 W. Garvey Ave. Ste B-128
Monterey Park, CA 91754

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675 W. Broadway
Glendale, CA 91204

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Genius Technologies a.k.a. Prime Capital
7 5 5 East 3 1st Street
Hastings, MN 55033

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GyroGlyder.com
1988 E. Alpine Ave.
Stockton, CA 95205

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

HoverTech
1600 Worldwide Blvd.
Hebron, KY 41048

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

InMotion Entertainment Group LLC
4801 Executive Park Court, Suite 100
Jacksonville, FL 32216

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
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Soibatian Corporation dba IO Hawk and dba Smart Wheels 1125 E.
Broadway #317
Glendale, CA 91205

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- Via First Class Mail
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Joy Hoverboard, a.k.a Huizhou Aoge Enterprize Co. Ltd. Huizhou City,
with its Pliasant Factory
Shuikou Subdistrict Office
Huizhou, 516005 China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Shenzhen Kebe Technology Co., Ltd.
4th Floor Building C, Honglianying T & S Zone
Sili Road 286, Longhua District
Shenzhen, China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Leray Group
3/F., HiChina Mansion
No.27 Gulouwai A venue, Dongcheng District Beijing 100120 China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

PhunkeeDuck, Inc.
250 Jericho Turnpike
Floral Park, NY 11001

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Shareconn International, Inc.
9A Unit Q 32 Dong Kang Qia Zi Jun
Buji Town, Shenzhen, Guangdong,
China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Shenzhen Chenduoxing Electronic Technology Ltd.
4/F, Block C1 1, Fuyuan Industrial City,
Jiuwei Xixiang, Bao' an Area, Shenzhen,
Guangdong, China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Certificate of Service – Page 5

Shenzhen Jomo Technology Co., Ltd.
Floor 4th and ?1\ Caiyue Bldg., Meilong Road
Bao'an District, Shenzhen City, 518112
China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Shenzhen R.M.T. Technology Co., Ltd.
Rm. 711, Shangcheng Business Mansion,
No. 73-1, Changjiangpu Road, He'ao,
Henggang Street, Longgang District
Shenzhen, Guangdong, China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Shenzhen Supersun Technology Co. Ltd., a.k.a. Aottom
Rm. 2308A, 2308B, International Cultural Building,
Futian Road, Futian District
Shenzhen, Guangdong, China

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Spaceboard USA
604 Oakmont Lane
Norcross, GA 30093

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Twizzle Hoverboard
18193 Valley Blvd.
La Puente, CA 917 44

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants

Uwheels
3007 N. Main St.
Santa Ana, CA 92705

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Service to Be Completed by Complainants