

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN OPTICAL DISC DRIVES,
COMPONENTS THEREOF, AND
PRODUCTS CONTAINING THE SAME

Investigation No. 337-TA-897

**NOTICE OF COMMISSION DETERMINATION TO REVIEW AN INITIAL
DETERMINATION TERMINATING THE INVESTIGATION BASED ON
COMPLAINANT'S LACK OF STANDING AND ON REVIEW TO
MODIFY-IN-PART, VACATE-IN-PART, AND REMAND THE INVESTIGATION IN
PART TO THE PRESIDING ADMINISTRATIVE LAW JUDGE FOR FURTHER
PROCEEDINGS**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review the presiding administrative law judge's ("ALJ") initial determination ("ID") (Order No. 113) granting respondents' motion to terminate the above-referenced investigation based on the lack of standing of complainant Optical Devices, LLC of Peterborough, New Hampshire ("Optical"). The Commission modifies-in-part and vacates-in-part the subject ID and remands the investigation to the presiding ALJ for further proceedings consistent with its concurrently issued opinion and remand order.

FOR FURTHER INFORMATION CONTACT: Megan M. Valentine, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-2301. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <http://www.usitc.gov>. The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <http://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on October 25, 2013, based on a Complaint filed by Optical, as supplemented. *78 Fed. Reg.* 64009-10 (Oct. 25, 2013). The Complaint alleges violations 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 optical disc drives, components thereof, and products containing the same by reason of infringement of certain claims of U.S. Patent Nos. 6,904,007 (“the ’007 patent”); 7,196,979 (“the ’979 patent”); 8,416,651 (“the ’651 patent”); RE40,927 (“the ’927 patent”); RE42,913 (“the ’913 patent”); and RE43,681 the (’681 patent”). The Complaint further alleges the existence of a domestic industry. The Commission’s Notice of Investigation named as respondents Lenovo Group Ltd. of Quarry Bay, Hong Kong and Lenovo (United States) Inc., of Morrisville, North Carolina; LG Electronics, Inc. of Seoul, Republic of Korea and LG Electronics U.S.A., Inc. of Englewood Cliffs, New Jersey; Panasonic Corp. of Osaka, Japan and Panasonic Corporation of North America of Secaucus, New Jersey; Samsung Electronics Co., Ltd. of Seoul, Republic of Korea and Samsung Electronics America, Inc. of Ridgefield Park, New Jersey (collectively “Samsung”); and Toshiba Corporation of Tokyo, Japan and Toshiba America Information Systems, Inc. of Irvine, California (collectively “Respondents”). The Office of Unfair Import Investigations was not named as a party to the investigation.

The Commission later terminated the investigation as to the application of numerous claims of the asserted patents to various named respondents. *See* Notice of Commission Determination Not to Review an Initial Determination Granting Complainant’s Motions to Partially Terminate the Investigation as to Certain Patents (Aug. 8, 2014). The Commission also later terminated the investigation with respect to Samsung based on a settlement agreement. *See* Notice of Commission Determination to Grant a Joint Motion to Terminate the Investigation as to Respondents [Samsung] on the Basis of a Settlement Agreement (Sept. 2, 2014).

On May 6, 2014, Respondents, including Samsung, filed a motion to terminate the investigation for good cause based on Optical Devices’ lack of prudential standing to bring an infringement action with respect to the asserted patents. On May 16, 2014, Optical Devices filed a response in opposition. On June 3, 2014, Respondents, pursuant to Order No. 83, filed a reply in support of their motion. On June 10, 2014, Optical Devices filed a motion for leave to file a surreply in opposition to Respondent’s reply. On June 11, 2014, Respondents filed an opposition to Optical Devices’ motion for leave to file a surreply.

On October 20, 2014, the ALJ issued the subject ID, granting pursuant to section 210.21(a) of the Commission’s Rules of Practice and Procedure (19 C.F.R. § 210.21(a)) Respondents’ motion to terminate the investigation based on Optical Devices’ lack of prudential standing. Specifically, the ALJ found that Optical Devices does not hold all substantial rights to the subject patents and, therefore, lacks prudential standing to maintain an action for infringement without joinder of other necessary parties. The ALJ also granted Optical Devices’ motion for leave to file a surreply.

Having examined the record of this investigation, including the subject ID, the petitions for review, and the responses thereto, the Commission has determined to review the subject ID. On review, the Commission vacates the ALJ’s finding that Optical Devices lacks standing with respect to the ’007, ’979, and ’651 patents (collectively, “the Kadlec Patents”) and remands the investigation for further proceedings consistent with the Commission’s concurrently issued opinion and remand order. Further on review, the Commission finds based on modified

reasoning that Optical Devices lacks standing with respect to the '927, '913, and '681 patents (collectively, "the Wild Patents") and it would prejudice Respondents to allow Optical Devices to join other necessary parties to remedy its lack of standing at this time. The investigation is, hereby, terminated with respect to the Wild Patents.

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.



Lisa R. Barton
Secretary to the Commission

Issued: December 4, 2014

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **NOTICE** has been served upon the following parties as indicated, on **December 4, 2014**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
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THEREOF, AND PRODUCTS CONTAINING THE SAME**

Inv. No. 337-TA-897

Certificate of Service – Page 2

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