

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

In the Matter of)

CERTAIN ENCAPSULATED)
INTEGRATED CIRCUIT DEVICES AND)
PRODUCTS CONTAINING SAME)

Inv. No. 337-TA-501

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**NOTICE OF COMMISSION DETERMINATION TO REMAND THE INVESTIGATION
TO THE PRESIDING ADMINISTRATIVE LAW JUDGE AND TO EXTEND THE
TARGET DATE FOR COMPLETION OF THE INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to remand the above-captioned investigation to the presiding administrative law judge ("ALJ") and to extend the target date for completion of the investigation to September 1, 2009.

FOR FURTHER INFORMATION CONTACT: Clara Kuehn, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone 202-205-3012. 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 under section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337 ("section 337"), on December 19, 2003, based on a complaint filed by Amkor Technology, Inc. ("Amkor") alleging a violation of section 337 in the importation, sale for importation, and sale within the United States after importation of certain encapsulated integrated circuit devices and products containing same in connection with several claims of three U.S. patents owned by Amkor. The complainant named Carsem (M) Sdn Bhd; Carsem Semiconductor Sdn Bhd; and Carsem, Inc. (collectively, "Carsem") as respondents.

The Commission has been unable to complete this investigation because of ongoing efforts to enforce a Commission subpoena to obtain certain documents that Carsem asserts are critical for certain of its defenses. On June 7, 2004, the presiding administrative law judge (“ALJ”) issued Order No. 63 granting Carsem’s motion to certify to the Commission a request for judicial enforcement of a subpoena *duces tecum* and *ad testificandum*, which was issued on February 11, 2004, and directed to ASAT, Inc. (“ASAT”), a non-party to this investigation. On August 11, 2004, the Commission filed a petition in the United States District Court for the District of Columbia (“the District Court”) seeking to enforce the subpoena. The District Court granted the petition on December 1, 2004, and ordered ASAT to comply with the subpoena. *United States Int’l Trade Comm’n v. ASAT, Inc.*, 355 F. Supp. 2d 67 (D.D.C. 2004). On January 26, 2005, ASAT filed an appeal of the District Court’s decision with the United States Court of Appeals for the D.C. Circuit (“the D.C. Circuit”).

Meanwhile, on November 18, 2004, the ALJ issued a final initial determination (“Final ID”) finding no violation of section 337. After reviewing the Final ID in its entirety, the Commission on March 31, 2005, modified the ALJ’s claim construction and remanded the investigation to the ALJ.

On June 10, 2005, the D.C. Circuit issued its decision in the ASAT subpoena enforcement matter. *See United States Int’l Trade Comm’n v. ASAT, Inc.*, 411 F.3d 245 (D.C. Cir. 2005). While the D.C. Circuit upheld the jurisdiction and venue of the District Court, it held *inter alia*, that “the ALJ’s factual findings and the record are insufficient to support a determination as a matter of law that ASAT, Inc. has control of the subpoenaed documents.” *See ASAT*, 411 F.3d at 252-56. Accordingly, the D.C. Circuit reversed the D.C. District Court’s decision to enforce the subpoena. *Id.* at 256. However, the D.C. Circuit stated that the Commission may instruct the ALJ “to reopen the record to allow further evidence and, based on modified findings by the ALJ, to bring a separate petition for enforcement . . .” *Id.*

On July 1, 2005, Carsem filed a “Motion for Leave to Reopen the Record to Permit Evidence and Briefing Regarding ASAT, Inc.’s Control over the Documents of its Parent and Affiliate Companies.” On July 26, 2005, the Commission granted Carsem’s motion and issued an order remanding the matter to the ALJ to receive additional evidence and to make further findings consistent with the June 10, 2005, opinion of the D.C. Circuit on the question of whether ASAT has the requisite control over the subpoenaed documents. Commission Order of July 26, 2005 at 4. On September 8, 2005, the ALJ issued Order No. 102, finding that ASAT has the requisite control of the subpoenaed documents. On November 17, 2005, the Commission filed a second petition for enforcement of the subpoena with the District Court.

On November 9, 2005, the ALJ issued a Remand ID and a recommended determination on remedy and bond. He found a violation of section 337 with regard to four claims of one patent, but found no violation in connection with the claims of the two other asserted patents. All the parties to the investigation filed comments and response comments on the Remand ID.

On January 9, 2006, respondent Carsem filed a motion to extend the target date in the investigation. On February 9, 2006, the Commission issued an Order granting in part Carsem's motion "to the extent that the target date for completion of this investigation is extended to a date that is three (3) months after completion of the pending ASAT, Inc. subpoena enforcement proceeding in the U.S. District Court for the District of Columbia." Order of February 9, 2006 at 4.

In an Opinion and Order signed July 1, 2008, the District Court granted the Commission's petition for an order to enforce the subpoena to ASAT. On September 5, 2008, ASAT filed a notice of appeal with the D.C. Circuit appealing the District Court's Order.

On September 30, 2008, the Commission extended the target date for completion of the investigation to February 2, 2009. On December 31, 2008, ASAT moved to voluntarily dismiss its appeal. On January 9, 2009, the D.C. Circuit issued its order of dismissal.

On January 21, 2009, Carsem filed a motion to extend the target date and to remand the investigation to the ALJ. On January 28, 2009, the Commission extended the target date for completion of the investigation to May 1, 2009. On February 2, 2009, the Commission investigative attorney ("IA") and Amkor each filed responses to Carsem's motion. On February 5, 2009, Carsem withdrew its motion to extend the target date and to remand the investigation.

On April 20, 2009, Carsem filed a renewed motion to extend the target date and to remand the investigation to the ALJ. Both Amkor and the IA filed responses to the motion. Subsequently, Carsem filed a motion for leave to file a reply to Amkor's response.

On April 28, 2009, the Commission determined to extend the target date for completion of the above-captioned investigation to July 1, 2009, to permit completion of briefing on Carsem's motion to remand.

The Commission has determined to (1) remand the investigation to the presiding administrative law judge in accordance with its order issued concurrently herewith; (2) grant Carsem's motion for leave to file a reply to Amkor's response to its motion for remand; and (3) extend the target date for completion of this investigation to September 1, 2009.

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.



Marilyn R. Abbott
Secretary to the Commission

Issued: July 1, 2009

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

In the Matter of)

CERTAIN ENCAPSULATED)
INTEGRATED CIRCUIT DEVICES AND)
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Inv. No. 337-TA-501

ORDER

The Commission instituted this investigation under section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337 (“Section 337”), on December 19, 2003, based on a complaint filed by Amkor Technology, Inc. (“Amkor”) alleging a violation of section 337 in the importation, sale for importation, and sale within the United States after importation of certain encapsulated integrated circuit devices and products containing same in connection with several claims of three U.S. patents owned by Amkor. The complainant named Carsem (M) Sdn Bhd; Carsem Semiconductor Sdn Bhd; and Carsem, Inc. (collectively, “Carsem”) as respondents.

The Commission has been unable to complete this investigation because of ongoing efforts to enforce a Commission subpoena to obtain certain documents that Carsem asserts are critical for certain of its defenses. On June 7, 2004, the presiding administrative law judge (“ALJ”) issued Order No. 63 granting Carsem’s motion to certify to the Commission a request for judicial enforcement of a subpoena *duces tecum* and *ad testificandum*, which was issued on February 11, 2004, and directed to ASAT, Inc. (“ASAT”), a non-party to this investigation. On August 11, 2004, the Commission filed a petition in the United States District Court for the District of Columbia (“the District Court”) seeking to enforce the subpoena. The District Court

granted the petition on December 1, 2004, and ordered ASAT to comply with the subpoena. *United States Int'l Trade Comm'n v. ASAT, Inc.*, 355 F. Supp. 2d 67 (D.D.C. 2004). On January 26, 2005, ASAT filed an appeal of the District Court's decision with the United States Court of Appeals for the D.C. Circuit ("the D.C. Circuit").

Meanwhile, on November 18, 2004, the ALJ issued a final initial determination ("Final ID") finding no violation of section 337. After reviewing the Final ID in its entirety, the Commission on March 31, 2005, modified the ALJ's claim construction and remanded the investigation to the ALJ with instructions "to conduct further proceedings and make any new findings or changes to his original findings that are necessitated by the Commission's new claim constructions." Commission Order ¶ 8 (March 31, 2005). The Commission also ordered the ALJ to "reopen the record to admit any new evidence that is obtained as a result of the Commission's subpoena enforcement litigation . . . in the U.S. Court of Appeals for the District of Columbia, and to make any necessary findings concerning Carsem's affirmative defenses based on that evidence" and authorized him to "allow[] or order[] any discovery or taking [of] any evidence that he deems necessary to comply with this Order." *Id.* ¶¶ 9, 10. The Commission also set a schedule for the filing of comments and response comments by the parties on the findings made by the ALJ under the Order. *Id.* ¶ 12.

On June 10, 2005, the D.C. Circuit issued its decision in the ASAT subpoena enforcement matter. *See United States Int'l Trade Comm'n v. ASAT, Inc.*, 411 F.3d 245 (D.C. Cir. 2005). Although the D.C. Circuit affirmed that the District Court had jurisdiction over the subpoena enforcement proceeding, it held *inter alia*, that "the ALJ's factual findings and the

record are insufficient to support a determination as a matter of law that ASAT, Inc. has control of the subpoenaed documents.” *See ASAT*, 411 F.3d at 252-56. Accordingly, the D.C. Circuit reversed the D.C. District Court’s decision to enforce the subpoena. *Id.* at 256. However, the D.C. Circuit stated that the Commission may instruct the ALJ “to reopen the record to allow further evidence and, based on modified findings by the ALJ, to bring a separate petition for enforcement . . .” *Id.*

On July 1, 2005, Carsem filed a “Motion for Leave to Reopen the Record to Permit Evidence and Briefing Regarding ASAT, Inc.’s Control over the Documents of its Parent and Affiliate Companies.” On July 26, 2005, the Commission granted Carsem’s motion and issued an order remanding the matter to the ALJ to receive additional evidence and to make further findings consistent with the June 10, 2005, opinion of the D.C. Circuit on the question of whether ASAT has the requisite control over the subpoenaed documents. Commission Order of July 26, 2005 at 4. On September 8, 2005, the ALJ issued Order No. 102, finding that ASAT has the requisite control of the subpoenaed documents. On November 17, 2005, the Commission filed a second petition for enforcement of the subpoena with the District Court.

On November 9, 2005, the ALJ issued a Remand ID and a recommended determination on remedy and bond. He found a violation of section 337 with regard to four claims of one patent, but found no violation in connection with the claims of the two other asserted patents. The ALJ did not reopen the record to admit any new evidence as the subpoena enforcement proceedings had not yet concluded. All the parties to the investigation filed comments and response comments on the Remand ID.

On January 9, 2006, respondent Carsem filed a motion to extend the target date in the investigation. On February 9, 2006, the Commission issued an Order granting in part Carsem's motion "to the extent that the target date for completion of this investigation is extended to a date that is three (3) months after completion of the pending ASAT, Inc. subpoena enforcement proceeding in the U.S. District Court for the District of Columbia." Order of February 9, 2006 at 4.

In an Opinion and Order signed July 1, 2008, the District Court granted the Commission's petition for an order to enforce the subpoena to ASAT. On September 5, 2008, ASAT filed a notice of appeal with the D.C. Circuit appealing the District Court's Order.

On September 30, 2008, the Commission extended the target date for completion of the investigation to February 2, 2009. On December 31, 2008, ASAT moved to voluntarily dismiss its appeal. On January 9, 2009, the D.C. Circuit issued its order of dismissal.

On January 21, 2009, Carsem filed a motion to extend the target date and to remand the investigation to the ALJ. On January 28, 2009, the Commission extended the target date for completion of the investigation to May 1, 2009. On February 2, 2009, the Commission investigative attorney ("IA") and Amkor each filed responses to Carsem's motion.

On February 5, 2009, Carsem withdrew its motion to extend the target date and to remand the investigation.

On April 20, 2009, Carsem filed a renewed motion to remand the investigation to the ALJ to reopen the record and to extend the target date. On April 28, 2009, the Commission extended the target date to July 1, 2009, to permit completion of briefing and consideration of Carsem's

motion. Amkor and the IA filed responses to the motion. Carsem subsequently filed a motion for leave to file a reply to Amkor's response (which opposed the motion), attaching its proposed reply.

On June 19, 2009, Carsem filed a motion for leave to file a supplemental submission in support of its motion to remand. On June 22, 2009, Amkor opposed this motion.

Having reviewed the record in this investigation, the Commission hereby **ORDERS**

THAT:

1. This investigation is remanded to the ALJ to reopen the record to admit any new evidence that has been or is obtained as a result of the enforcement of the Commission's subpoena duces tecum to ASAT and which relates to the invalidity defenses for which the Commission's subpoena was obtained. The ALJ may permit such related discovery as he, in his discretion, deems appropriate and may admit any new evidence, which is otherwise admissible, that is obtained as a result of such related discovery.
2. The ALJ shall revise or supplement, as appropriate, his November 9, 2005, Remand ID, in light of the the supplemented record, making all necessary findings concerning Carsem's invalidity defenses for which the Commission's subpoena was obtained.
3. The ALJ shall issue his revised or supplemental ID no later than three months prior to the target date for completion of this investigation. The target date for completion of this investigation is extended to September 1, 2009, to give the ALJ an opportunity to issue a procedural schedule for the remand proceeding and to issue an initial determination further extending the target date as appropriate in view of the procedural schedule he establishes. The initial determination extending the target date must be issued by August 3, 2009, to permit Commission action thereon prior to the September 1, 2009, target date.
4. In addition to the ALJ's existing authority, the ALJ shall have the authority during the remand proceedings to address any issues of compliance with the Commission's subpoena duces tecum to ASAT that may arise, and if appropriate, may request that the Commission authorize initiation of contempt or other enforcement proceedings in the United States District Court for the District of Columbia, stating the grounds therefore.

5. Carsem's motion for leave to file a reply to Amkor's opposition to its motion for remand is granted.
6. Carsem's motion for leave to file a supplemental motion in support of its motion to remand is denied.
7. The Secretary shall serve a copy of this Order upon each party to the investigation and upon ASAT.

By order of the Commission.

A handwritten signature in black ink, appearing to read "Marilyn R. Abbott", written in a cursive style.

Marilyn R. Abbott
Secretary to the Commission

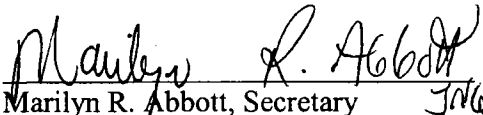
Issued: July 1, 2009

**CERTAIN ENCAPSULATED INTEGRATED CIRCUIT
DEVICES AND PRODUCTS CONTAINING SAME**

337-TA-501

CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF COMMISSION DETERMINATION TO REMAND THE INVESTIGATION TO THE PRESIDING ADMINISTRATIVE LAW JUDGE AND TO EXTEND THE TARGET DATE FOR COMPLETION OF THE INVESTIGATION** has been served by hand upon the Commission Investigative Attorney, David O. Lloyd, Esq., and the following parties as indicated, on July 1, 2009.


Marilyn R. Abbott, Secretary *Info*
U.S. International Trade Commission
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**ON BEHALF OF COMPLAINANT AMKOR
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**ON BEHALF CARSEM (M) Sdn Bhd,
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CARSEM INC.:**

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