

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN WINDSCREEN WIPERS
AND COMPONENTS THEREOF

Inv. No. 337-TA-964

Order No. 12

Respondents Valeo North America, Inc. and Delmex de Juarez S. de R.L. de C.V. (collectively, “Valeo”) filed a motion seeking to terminate this investigation based on “Complainant Trico Products Corporation’s (‘Trico’) lack of standing to bring this action for enforcement of U.S. Patent Nos. 6,836,925 (the ‘925 patent’) and 6,799,348 (the ‘348 patent’).” Motion Docket No. 964-007, at 1. Trico opposed the motion. Subsequently, Valeo filed a motion seeking leave to file a reply, and Trico filed a motion seeking leave to file a surreply. Motion Docket Nos. 964-010, 964-012. Motion Nos. 964-010 and 964-012 for leave are granted.

The Commission’s jurisdiction in this investigation depends on whether or not Trico has standing to enforce the asserted ’925 and ’348 patents. *See SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1325 (Fed. Cir. 2010) (“The question of standing to assert a patent claim is jurisdictional . . .”). The requirement that a complainant in an ITC investigation have standing to bring an enforcement suit for infringement applies to this investigation just as it would to a district court case. *See id.* at 1326.

A party holding exclusionary rights in a patent has constitutional standing to sue alleged infringers. *See Intellectual Property Development, Inc. v. TCI Cablevision of Cal., Inc.*, 248 F.3d 1333, 1346-47 (Fed. Cir. 2001). In order to sue alleged infringers without joining additional parties as plaintiffs, a plaintiff with constitutional standing must also satisfy the prudential standing requirement by possessing all substantial rights in the asserted patent. *See id.* at 1348. If a party has constitutional standing to enforce a patent, but does not possess all substantial rights in the patent, it lacks prudential standing and must join the owner of the remaining rights as co-plaintiff. *See id.* at 1347-48. In other words, a defect in prudential standing can only be cured if the party owning the remaining rights to the asserted patent is joined as a party. *See id.*

A complainant in a section 337 investigation pending before the Commission bears the burden to prove it has standing. *Certain Mobile Devices and Related Software*, Inv. No. 337-TA-750, Initial Determination at 185 (Jan. 13, 2012) (citing *Sicom Sys., Ltd. v. Agilent Techs., Inc.*, 427 F.3d 971, 975-76 (Fed. Cir. 2005)), *aff'd in relevant part*, Notice of Comm'n Decision to Review in Part and on Review to Affirm a Final Determination Finding No Violation of Section 337 (Mar. 16, 2012). Thus, as the complainant, Trico bears the burden of proof to show it has standing to pursue this infringement action against Valeo. While the burden of persuasion remains at all times with Trico, once Trico has satisfied its initial burden of production showing it is the owner of the asserted patents, the burden of production shifts to Valeo to rebut such a showing. *See id.*

At the time it filed the complaint in this investigation, Trico provided the Commission with copies of the recorded assignments for the asserted patents pursuant to Commission Rule 210.12, which requires that intellectual property based complaints “include a showing that at

least one complainant is the owner or exclusive licensee of the subject intellectual property.” *See* Complaint Ex. 3 (recorded assignments for the ’925 patent); Complaint Ex. 4 (recorded assignments for the ’348 patent); 19 C.F.R. § 210(a)(7). Indeed, Valeo does not dispute that the named inventor of the ’925 patent assigned his rights in the application that ultimately issued as that patent to Trico, or that the named inventors of the ’348 patent assigned their respective rights in the application that ultimately issued as that patent to Trico. *See* Mot. at 2; Mot. Ex. 1 (certified record of the ’925 patent assignment); Mot. Ex. 2 (certified record of the ’348 patent assignment). The parties therefore do not dispute that Trico has constitutional standing to assert the ’925 and ’348 patents before the Commission.

The parties do dispute, however, whether Trico has prudential standing to assert the patents in suit. Specifically, Valeo argues that [] and thus Trico did not own all substantial rights in the ’925 and ’348 patents when it filed the complaint in this investigation asserting infringement of such patents.” Mot. at 10-11. Valeo argues that []” *Id.* at 11; *see* Mot.

Ex. 4 ([]). In particular, Valeo identifies [], among others, as evidence showing that “[

].” *See* Mot. at 11. Valeo therefore requests that this investigation be terminated, inasmuch as Trico lacks prudential standing to assert the ’925 and ’348 patents []. *See id.* at 12-13.

In opposition to the pending motion, Trico argues:

Respondents acknowledge that the inventors listed on the '925 and '348 patents properly assigned their rights to Trico. (Motion to Terminate at 2). The *only* other fact relevant to the standing analysis is that Trico never executed any written agreement that transferred any of its rights in these patents to anyone else. The chain of title to the '925 and '348 patents ends with Trico. Period. Respondents offer no evidence to the contrary.

Opp'n at 1 (emphasis original).

Trico argues that it was not a party to the [] cited by Valeo: "Since Trico could not have assigned away or licensed patent rights in an agreement to which it was not a party, the Respondents' descriptions of the [] in their [motion] do not bear on the standing analysis." Opp'n at 2. In particular, it is argued that "the Patent Act establishes that patent rights may be transferred *only* via written instrument," and that Valeo failed to "identify a written instrument—executed by Trico (as patent owner)—in which Trico defined some bundle of rights and expressed an intention to transfer those rights to []." *See id.* at 2 (emphasis original), 3. Trico further argues:

Though the [] is irrelevant to the present analysis, it is worth noting—merely as an aside—that [] never represents in [] it has acquired the Trico patents. Respondents try to read this meaning [], but in so doing, they strain [] to absurdity. For example, []

].

Opp'n at 4-5.

Having considered the arguments of the parties set forth in the motion papers and the exhibits submitted therewith, it is determined that Valeo has failed to rebut Trico's *prima facie* showing that it has standing to assert the '925 and '348 patents in this investigation.

Specifically, the documentary evidence demonstrates that the named inventors of the asserted

patents assigned their rights to these patents to Trico. No documentary evidence has been offered to establish that Trico transferred any of these rights to []. Moreover, the provisions of the [] do not alter the terms of the patent assignments such that Trico no longer has standing to assert the patents in suit.

Accordingly, Motion No. 964-007 to terminate the investigation is denied.



David P. Shaw
Administrative Law Judge

Issued: January 14, 2016

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER NO. 12** has been served upon the following parties as indicated, on JAN 14 2016.



Lisa R. Barton, Secretary
U.S. International Trade Commission
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Washington, DC 20436

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