

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN TWO-WAY GLOBAL
SATELLITE COMMUNICATION
DEVICES, SYSTEM AND
COMPONENTS THEREOF**

Inv. No. 337-TA-854

**ORDER NO. 21: INITIAL DETERMINATION TERMINATING INVESTIGATION
BASED ON ENTRY OF CONSENT ORDER**

(March 15, 2013)

On March 7, 2013, Respondents DeLorme Publishing Company, Inc. and DeLorme InReach, LLC ("DeLorme") filed a motion to terminate the Investigation based on a consent order (Motion Docket No. 854-019). DeLorme certified compliance with Ground Rule 3.2 and indicated that complainant BriarTek IP, LLC ("BriarTek") would not agree to the revised Consent Order without the insertion of more language as to the scope of the relief and the removal of the grace period, and that Commission Investigative Staff ("Staff") indicated that it would take a position after reviewing the motion. On March 13, 2013, BriarTek filed an opposition to the motion to terminate. On March 14, 2013, Staff filed a response supporting the motion to terminate.

Staff objects to the grace period as a matter of policy, but notes that because of the length of the grace period (expiring on April 1, 2013), for practical purposes the grace period has no impact on this Investigation. Because the grace period will have no practical impact and the motion and consent order stipulation comply with Commission Rule 210.21, Staff supports the motion to terminate. Staff says that it is not aware of any information suggesting that

termination of this Investigation on the basis of the Proposed Consent Order would be contrary to the public interest.

BriarTek raises two issues in opposition to the motion. First, BriarTek objects to the inclusion of the grace period as a matter of policy. BriarTek explains, however, that the grace period is unlikely to impact this Investigation and therefore does not oppose the grace period “as a practical matter.” Second, BriarTek objects to DeLorme’s failure to include language in the Consent Order Stipulation to address BriarTek’s request for a cease and desist order in the complaint. BriarTek says that DeLorme has an inventory of accused devices already in the United States and the consent order stipulation should address this inventory by stating that DeLorme will not “knowingly aid, abet, encourage, participate in, or induce importation into the United States, the sale for importation into the United States, or the sale, offer for sale, or use in the United States after importation” (BriarTek Opp. at 2) BriarTek argues that failing to include this additional language harms the public interest because it permits DeLorme to continue to infringe the ‘380 patent for devices that are already within the United States.

In accordance with Commission Rule 210.21(c), DeLorme submitted a “Consent Order Stipulation” and a “Proposed Consent Order,” both attached hereto as Exhibits A and B, respectively. Commission Rule 210.21(c)(3) sets forth certain requirements for the contents of a consent order stipulation. 19 C.F.R. § 210.21(c)(3). I find that the Consent Order Stipulation submitted by DeLorme complies with the requirements of Commission Rule 210.21(c)(3).

Specifically, DeLorme agrees that after April 1, 2013¹, it will not import into the United States, sell for importation into the United States, or sell or offer for sale within the United States

¹ While BriarTek and Staff oppose the provision that delays compliance until April 1, 2013, they both note correctly that the requested grace period will have no practical impact in this case. Moreover, there is precedent for including grace periods in Consent Orders. *Certain Base Stations & Wireless Microphones*, Inv. No. 337-TA-653, Order No.

after importation any two-way global satellite communication devices, system, and components thereof, that infringe claims 1, 2, 5, 10-12, and 34 of U.S. Patent No. 7,991,380 (“the ‘380 patent”) until the expiration, invalidation, and/or unenforceability of the ‘380 patent or except under consent or license from Complainant, its successors or assignees. (Consent Order Stipulation ¶ 1) DeLorme agrees, pursuant to Commission Rule 210.21(c)(3)(i)(A):

- (1) to an admission of the Commission’s *in rem*,² *in personam*, and subject matter jurisdiction (Consent Order Stipulation ¶ 2),
- (2) to an express waiver of all rights to seek judicial review or otherwise challenge or contest the validity of the Consent Order (Consent Order Stipulation ¶ 3),
- (3) to cooperate with and not seek to impede by litigation or other means the Commission’s efforts to gather information under subpart I of part 210 of Title 19 of the Code of Federal Regulations (Consent Order Stipulation ¶ 4), and
- (4) that the enforcement, modification, and revocation of the Consent Order will be carried out pursuant to subpart I of part 210 of Title 19 of the Code of Federal Regulations, incorporating by reference the Commission’s Rules of Practice and Procedure. (Consent Order Stipulation ¶ 5).

Because this is an intellectual property-based investigation, the Consent Order Stipulation also contains a statement, pursuant to Commission Rule 210.21(c)(3)(i)(B), that:

- (1) the Consent Order shall not apply with respect to any claim of any intellectual property right that has expired or been found or adjudicated invalid or unenforceable by the Commission or a court or agency of competent jurisdiction,

17 (Jan. 29, 2009); see also *Certain Digital Photo Frames and Image Display Devices and Components Thereof*, Inv. No. 337-TA-807, Order No. 46 (September 5, 2012).

² Pursuant to Order No. 20, DeLorme has corrected its statement on *in rem* jurisdiction to address all products within the scope of the notice of investigation, and admits that the Commission has *in rem* jurisdiction over the accused two-way global satellite communication devices, system, and components thereof that are at issue in this Investigation.

provided that such finding or judgment has become final and non-reviewable (Consent Order Stipulation ¶ 6); and

- (2) DeLorme will not seek to challenge the validity of the '380 patent in any administrative or judicial proceeding to enforce the Consent Order. (Consent Order Stipulation ¶ 7)

In addition to the foregoing provisions required by Commission Rule 210.21(c)(3), the Consent Order Stipulation includes a statement, authorized by Commission Rule 210.21(c)(3)(i)(C), that the signing of the Consent Order Stipulation does not constitute an admission by DeLorme that an unfair act has been committed. (Consent Order Stipulation ¶ 8)

BriarTek's arguments in opposition to the motion to terminate are not persuasive. On the facts of this case, I find that a Consent Order that includes an approximately two week grace period, ending on a date specific, and not dependent upon the occurrence of an uncertain event in the future, which date specific is prior to the target date set in the investigation for which the consent order is requested, is proper. The resources of the parties and the Commission are conserved by avoiding the final preparation and conduct of a one week hearing which could not achieve a result more favorable to the Complainant. I have previously permitted a grace period to be included in an opposed consent order stipulation in an investigation with similar facts.

Certain Digital Photo Frames and Image Display Devices and Components Thereof, Inv. No. 337-TA-807, Order No. 46 (September 5, 2012). Additionally, I find that the approximately two week grace period requested here will have no practical impact because this Initial Determination is unlikely to become final until after the grace period has expired. (See 19 C.F.R. § 210.42(h)(3).)

BriarTek's arguments regarding the requested cease and desist language are also not persuasive. First, as noted *supra*, the Consent Order Stipulation complies with Commission Rule 210.21(c)(3). Second, BriarTek's concerns regarding DeLorme's inventory already within the United States are adequately addressed by the Consent Order Stipulation as filed. The Consent Order Stipulation provides, in pertinent part, that:

DeLorme will not import into the United States, sell for importation into the United States, or ***sell or offer for sale within the United States after importation*** any two-way global satellite communication devices, system, and components thereof, that infringe claims 1, 2, 5, 10–12, and 34 of the '380 Patent after April 1, 2013, until the expiration, invalidation, and/or unenforceability of the '380 Patent or except under consent or license from Complainant, its successors or assignees.

(Consent Order Stipulation ¶ 1 (emphasis added).) Thus, DeLorme has stated that it will not “sell or offer for sale within the United States after importation” any two-way global satellite communication devices, system, and components thereof that infringe claims 1, 2, 5, 10–12, and 34 of the '380 Patent. As a result, to the extent DeLorme's inventory within the United States was imported (as BriarTek contends), and includes two-way global satellite communication devices, system, and components thereof that infringe any of the asserted claims of the '380 Patent (as BriarTek contends), the Consent Order Stipulation already provides BriarTek with the relief it seeks.

Commission Rule 210.50(b)(2) provides that in the case of a proposed termination by settlement agreement or consent order, the parties may file statements regarding the impact of the proposed termination on the public interest, and the administrative law judge may hear argument, although no discovery may be compelled, with respect to issues relating solely to the public interest. 19 C.F.R. § 210.50(b)(2). In any initial determination terminating an investigation by settlement agreement or consent order, the administrative law judge is directed to consider and make appropriate findings regarding the effect of the proposed settlement on the

public health and welfare, competitive conditions in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers. *Id.*

Upon review of the pleadings filed in connection with the motion for termination, I am not aware of any information indicating that termination of this Investigation on the basis of the consent order is contrary to the public health and welfare, competitive conditions in the U.S. economy, the production of like or directly competitive articles in the United States, or U.S. consumers. The termination of the Investigation, such as that proposed by the motion, is generally in the public interest, which favors settlement to avoid needless litigation and to conserve public resources. BriarTek's arguments on public interest are based upon its arguments regarding the failure to include "cease and desist" language in the Consent Order Stipulation. As explained *supra*, BriarTek's arguments regarding the requested "cease and desist" language are not persuasive. Therefore, I find that termination of this Investigation is in the public interest and does not impose any undue burdens on the public health and welfare, competitive conditions in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers.


ORDER

Accordingly, it is my Initial Determination that Motion No. 854-019 is hereby GRANTED and Inv. No. 337-TA-854 is therefore terminated in its entirety. This Initial Determination, along with supporting documentation, is hereby certified to the Commission.

Pursuant to 19 C.F.R. § 210.42(h), this Initial Determination shall become the determination of the Commission unless a party files a petition for review of the Initial Determination pursuant to 19 C.F.R. § 210.43(a), or the Commission, pursuant to 19 C.F.R.

§ 210.44, orders, on its own motion, a review of the Initial Determination or certain issues herein.

SO ORDERED.



Robert K. Rogers, Jr.
Administrative Law Judge

EXHIBIT A

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

**Before the Honorable Robert K. Rogers, Jr.
Administrative Law Judge**

In the Matter of

**CERTAIN TWO-WAY GLOBAL
SATELLITE COMMUNICATION
DEVICES, SYSTEM AND
COMPONENTS THEREOF**

Inv. No. 337-TA-854

**CONSENT ORDER STIPULATION BY RESPONDENTS DELORME PUBLISHING
COMPANY, INC. AND DELORME INREACH, LLC**

WHEREAS, the United States International Trade Commission (“Commission” or “ITC”) on September 21, 2012 (77 Fed. Reg. 58579–58580) instituted the above-captioned Investigation (“Investigation”) under Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and section 210.10 of the Commission’s Rules of Practice and Procedure, 19 C.F.R. § 210.10, based upon allegations contained in a complaint filed by Complainant BriarTek IP, LLC (“BriarTek” or “Complainant”) on August 17, 2012, which alleged unlawful activities in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain two-way global satellite communication devices, system, and components thereof by DeLorme Publishing Company, Inc. and DeLorme InReach, LLC (collectively, “DeLorme”) that are alleged to infringe claims 1, 2, 5, 10–12, and 34 of U.S. Patent No. 7,991,380 (the “380 Patent”).

WHEREAS, in order to terminate this Investigation and avoid the associated costs and inconveniences, DeLorme is willing to accept entry of the Consent Order submitted concurrently

with this stipulation by the Commission and agrees to all waivers and other provisions as required by 19 C.F.R. § 210.21; and

WHEREAS, DeLorme agrees to all terms set forth in the Consent Order.

IT IS HEREBY STIPULATED by DeLorme as follows:

1. Upon entry of the proposed Consent Order, DeLorme will not import into the United States, sell for importation into the United States, or sell or offer for sale within the United States after importation any two-way global satellite communication devices, system, and components thereof, that infringe claims 1, 2, 5, 10–12, and 34 of the '380 Patent after April 1, 2013, until the expiration, invalidation, and/or unenforceability of the '380 Patent or except under consent or license from Complainant, its successors or assignees.

2. The Commission has *in rem* jurisdiction over the accused two-way global satellite communication devices, system, and components thereof that are at issue in this Investigation, the Commission has *in personam* jurisdiction over DeLorme for purposes of this Stipulation and proposed Consent Order, and the Commission has subject matter jurisdiction in this Investigation.

3. DeLorme expressly waives all rights to seek judicial review or otherwise challenge or contest the validity of the Consent Order entered pursuant to this Stipulation.

4. DeLorme will cooperate with and will not seek to impede by litigation or other means the Commission's efforts to gather information under subpart I of the Commission's Rules of Practice and Procedure, 19 C.F.R., Chapter II, Subchapter C, Part 210.

5. The enforcement, modification, and revocation of the Consent Order will be carried out pursuant to subpart I of 19 C.F.R., Chapter II, Subchapter C, Part 210, incorporating by reference the Commission's Rules of Practice and Procedure.

6. The Consent Order shall not apply with respect to any claim of any intellectual property right that has expired or been found or adjudicated invalid or unenforceable by the Commission or a court or agency of competent jurisdiction, provided that such finding or judgment has become final and non-reviewable.

7. DeLorme will not seek to challenge the validity or enforceability of the '380 Patent in any administrative or judicial proceeding to enforce the Consent Order.

8. The signing of this Consent Order Stipulation and the Consent Order are for settlement purposes only and does not constitute admission by DeLorme that an unfair act has been committed.

9. There are no agreements, written or oral, express or implied, between Complainant and DeLorme concerning the subject matter of this Investigation.

10. The Consent Order Stipulation and Consent Order are in the public interest.

IN WITNESS WHEREOF duly authorized representatives of DeLorme have caused this Stipulation to be executed as of the date indicated below.

DELORME PUBLISHING COMPANY, INC.

Dated: March 5, 2013

By:

Sarah S. Kramlich

Name: Sarah S. Kramlich

Title: VP Finance & Operations

DELORME INREACH, LLC

Dated: March 5, 2013

By:

Sarah S. Kramlich

Name: Sarah S. Kramlich

Title: VP Finance & Operations

EXHIBIT B

UNITED STATES INTERNATIONAL TRADE COMMISSION

WASHINGTON, D.C.

**Before the Honorable Robert K. Rogers, Jr.
Administrative Law Judge**

In the Matter of

**CERTAIN TWO-WAY GLOBAL
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Inv. No. 337-TA-854

[PROPOSED] CONSENT ORDER

The United States International Trade Commission (“Commission” or “ITC”) on September 21, 2012 (77 Fed. Reg. 58579–58580) instituted the above-captioned Investigation (“Investigation”) under Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and section 210.10 of the Commission’s Rules of Practice and Procedure, 19 C.F.R. § 210.10, based upon allegations contained in a complaint filed by Complainant BriarTek IP, LLC (“BriarTek” or “Complainant”) on August 17, 2012, which alleged unlawful activities in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain two-way global satellite communication devices, system, and components thereof by DeLorme Publishing Company, Inc. and DeLorme InReach, LLC (collectively, “DeLorme”) that are alleged to infringe claims 1, 2, 5, 10–12, and 34 of U.S. Patent No. 7,991,380 (the “380 Patent”).

DeLorme has executed a Consent Order Stipulation in which it agrees to the entry of this Consent Order and to all waivers and other provisions as required by Commission Rule of

Practice and Procedure 210.21(c) (19 U.S.C. § 210.21(c)). DeLorme has filed a Motion for Termination of the Investigation based upon the Consent Order Stipulation.

IT IS HEREBY ORDERED THAT:

1. Upon entry of the proposed Consent Order, DeLorme will not import into the United States, sell for importation into the United States, or sell or offer for sale within the United States after importation any two-way global satellite communication devices, system, and components thereof, that infringe claims 1, 2, 5, 10–12, and 34 of the '380 Patent after April 1, 2013, until the expiration, invalidation, and/or unenforceability of the '380 Patent or except under consent or license from Complainant, its successors or assignees.

2. DeLorme shall be precluded from seeking judicial review or otherwise challenging or contesting the validity of this Consent Order.

3. DeLorme will cooperate with and will not seek to impede by litigation or other means the Commission's efforts to gather information under subpart I of the Commission's Rules of Practice and Procedure, 19 C.F.R., Chapter II, Subchapter C, Part 210.

4. The Consent Order shall not apply with respect to any claim of any intellectual property right that has expired or been found or adjudicated invalid or unenforceable by the Commission or a court or agency of competent jurisdiction, provided that such finding or judgment has become final and non-reviewable.

5. DeLorme will not seek to challenge the validity or enforceability of the '380 Patent in any administrative or judicial proceeding to enforce the Consent Order.

6. The entry of this Consent Order is for settlement purposes only and does not constitute admission by DeLorme that an unfair act has been committed.

7. This Investigation is terminated as to Respondents DeLorme Publishing Company, Inc. and DeLorme InReach, LLC with respect to the '380 Patent; provided, however, that enforcement, modification, or revocation of the Consent Order will be carried out pursuant to subpart I of the Commission's Rules of Practice and Procedure, 19 C.F.R., Chapter II, Subchapter C, Part 210, incorporating by reference the Commission's Rules of Practice and Procedure.

BY ORDER OF THE COMMISSION

**CERTAIN TWO-WAY GLOBAL
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Inv. No. 337-854

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **ORDER** was served upon **Brian Koo, Esq.**, Commission Investigative Attorney, and the following parties via first class mail delivery on

MAR 15 2013



Lisa R. Barton, Acting Secretary
U.S. International Trade Commission
500 E Street SW, Room 112A
Washington, D.C. 20436

FOR COMPLAINANT BRIARTEK IP, INC.:

John R. Fuisz, Esq.
THE FUISZ-KUNDU GROUP LLP
1455 Pennsylvania Avenue NW
Suite 400
Washington, DC 20004

() Via Hand Delivery
(☒) Via Overnight Mail
() Via First Class Mail
() Other: _____

**FOR RESPONDENTS DELORME PUBLISHING COMPANY, INC. and
DELORME INREACH LLC:**

Peter J. Brann, Esq.
BRANN & ISAACSON, LLP
184 Main Street
Fourth Floor
Box 3070
Lewiston, ME 04243

() Via Hand Delivery
(☒) Via Overnight Mail
() Via First Class Mail
() Other: _____

**CERTAIN TWO-WAY GLOBAL
SATELLITE COMMUNICATION
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PUBLIC CERTIFICATE OF SERVICE PAGE 2

PUBLIC MAILING LIST

Angela Ruby
LEXIS – NEXIS
9443 Springboro Pike
Miamisburg, OH 45342

☐ Via Hand Delivery
☐ Via Overnight Mail
☒ Via First Class Mail
☐ Other: _____

Kenneth Clair
THOMAS WEST
1100 Thirteenth Street NW, Suite 200
Washington, DC 20005

☐ Via Hand Delivery
☐ Via Overnight Mail
☒ Via First Class Mail
☐ Other: _____