

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

In the Matter of

**CERTAIN SHORT-WAVELENGTH
LIGHT EMITTING DIODES, LASER
DIODES AND PRODUCTS
CONTAINING SAME**

Inv. No. 337-TA-640

**NOTICE OF COMMISSION DETERMINATION TO REVIEW AN INITIAL
DETERMINATION GRANTING COMPLAINANT'S MOTION FOR SUMMARY
DETERMINATION ON THE DOMESTIC INDUSTRY REQUIREMENT**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review an initial determination ("ID") (Order No. 72) of the presiding administrative law judge ("ALJ") granting complainant's motion for summary determination on the domestic industry requirement.

FOR FURTHER INFORMATION: Michael Liberman, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone 202-205-3152. Copies of the ID and all other nonconfidential 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. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on 202-205-1810. 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>.

SUPPLEMENTARY INFORMATION: On March 25, 2008, the Commission instituted an investigation under section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337, based on a complaint filed by Gertrude Neumark Rothschild of Hartsdale, New York ("Rothschild"), alleging a violation of section 337 in the importation, sale for importation, and sale within the United States after importation of certain short-wavelength light emitting diodes, laser diodes and products containing same that infringe certain claims of U.S. Patent No. 5,252,499 ("the 499 patent"). 73 *Fed. Reg.* 1575 (March 25, 2008). The complainant named numerous entities as respondents.

On April 13, 2009, complainant Rothschild moved for summary determination that her substantial investment in exploitation, licensing and enforcement of the '499 patent, satisfies the domestic industry requirement. Respondents Toshiba Corporation and Panasonic Corporation ("Panasonic") jointly opposed the motion. The Commission investigative attorney ("the IA") also opposed the motion. No other party responded to the motion. On April 28, 2009, complainant moved for leave to file a reply to "correct" and respond to certain assertions made in the oppositions.

On May 8, 2009, the presiding administrative law judge ("the ALJ") (Judge Luckern) granted complainant's motions. On May 18, 2009, and May 19, 2009, respectively, respondent Panasonic and the IA filed petitions for review of Order No. 72. On May 26, 2009, complainant filed a response to the petitions. On the same day, the IA filed a response to complainant's petition.

Having examined the record in this investigation, including the ALJ's ID, the petitions for review, and the responses thereto, the Commission has determined to review Order No. 72.

On review, the Commission requests briefing based on the evidentiary record, in response to the following questions:

- (1) Do the statutory provisions of section 337 and the pertinent legislative history and the case law support the ALJ's determination that complainant's payments made to outside counsel for exploiting and licensing the '499 patent qualify as an "investment" under § 337(a)(3)(C)?
- (2) Does the record indicate the extent of the investment made and royalties received in connection with the license(s) granted prior to litigation as opposed to licenses entered into in order to settle litigation? If so, then are investments and royalties associated with licenses entered into prior to litigation entitled to more weight in our analysis?
- (3) In determining whether an investment in licensing is sufficient to satisfy § 337(a)(3)(C), does it matter whether the investment is performed by in-house employees on the one hand or outside counsel on the other?
- (4) For purposes of determining whether the investment in licensing in this investigation is sufficient to satisfy § 337(a)(3)(C), is it relevant that the party asserting the intellectual property right is an individual inventor?

WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions on the issues under review. The submissions should be concise and thoroughly referenced to the record in this investigation. The written submissions must be filed no later than the close of business on June 26, 2009. Reply submissions must be filed no later than the close of business on July 10, 2009. No further submissions on these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document and 12 true copies thereof on or before the deadlines stated above with the Office of the Secretary. Any person desiring to submit a document (or portion thereof) to the Commission in confidence must request confidential treatment unless the information has already been granted such treatment during the proceedings. All such requests should be directed to the Secretary of the Commission and must include a full statement of the reasons why the Commission should grant such treatment. *See* section 201.6 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 201.6. Documents for which confidential treatment by the Commission is sought will be treated accordingly. All nonconfidential written submissions will be available for public inspection at the Office of the Secretary.

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 sections 210.42-46 of the Commission's Rules of Practice and Procedure (19 C.F.R. §§ 210.42-46).

By order of the Commission.

/s/
Marilyn R. Abbott
Secretary to the Commission

Issued: June 11, 2009