

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

**In the Matter of**

**CERTAIN OPTOELECTRONIC DEVICES,  
COMPONENTS THEREOF, AND  
PRODUCTS CONTAINING THE SAME**

**Inv. No. 337-TA-669**

**ORDER NO. 12: DENYING RESPONDENT EMCORE'S MOTION FOR  
RECONSIDERATION OF ORDER NO. 9**

(November 12, 2009)

On October 14, 2009, respondent Emcore Corporation ("Emcore") filed a motion for reconsideration of Order No. 9 where the ALJ denied Emcore's request to supplement its Notice of Prior Art. (Motion Docket No. 669-018.) On October 26, 2009, complainants Avago Technologies Fiber IP (Singapore) Pte. Ltd., Avago Technologies General IP (Singapore) Pte. Ltd. and Avago Technologies Ltd. (collectively, "Avago" or "Complainants") filed a response opposing the motion. No other responses were received.

On November 2, 2009, Emcore filed a motion for leave to file a reply to clarify its position and to correct misstatements of law and fact made by Avago. (Motion Docket No. 669-024.) On November 4, 2009, Avago filed a response opposing the motion for leave to file a reply. The motion for leave to file a reply is hereby DENIED.

In general, requests for reconsideration are allowed to correct a clear error of fact or law, to prevent manifest injustice, to address newly discovered evidence not available at the time of the ruling, or to account for an intervening change in the law. *See e.g., Certain Network Interface Cards and Access Points for Use in Direct Sequence Spread*

*Spectrum Wireless Local Area Networks and Products Containing Same*, Inv. No. 337-TA-455, Order No. 69, at 2-3 (U.S.I.T.C., January 17, 2002); *Certain Digital Cameras and Component Parts Thereof*, Inv. No. 337-TA-593, Order No. 8 (U.S.I.T.C., August 16, 2007). A request for reconsideration “must be confined to new questions raised by the contested determination or the action to be taken thereunder -- questions upon which the moving party had no previous opportunity to submit arguments.” See *Certain Probe Card Assemblies, Components Thereof, and Certain Tested DRAM and NAND Flash Memory Devices and Products Containing Same*, Inv. No. 337-TA-621, Order No. 23 (U.S.I.T.C., October 21, 2008) (quoting *Certain Electric Power Tools, Battery Cartridges, and Battery Chargers Contents*, Inv. No. 337-TA-284, U.S.I.T.C. Pub. No. 2389 (June 1991), Comm’n. Op., at 4-5 (February 20, 1990)) (emphasis added).

Here, Emcore argues that reconsideration of Order No. 9 is warranted to correct errors of law and fact, namely (1) the erroneous conclusion that Emcore’s omission of the Masahiro application from its Notice of Prior Art was intentional and (2) the erroneous conclusion that Emcore lacked good cause. In its motion, Emcore seeks to “correct” the ALJ’s “erroneous” conclusion as to the factual circumstances surrounding Emcore’s omission of the Masahiro application from its Notice of Prior Art. In its original motion seeking to supplement its Notice of Prior Art, Emcore argued that its failure to include the Masahiro application was based on the fact that it did not have a certified translation of the application and, as such, could not determine whether the Masahiro application was prior art. In the instant motion, Emcore argued that its failure to include the Masahiro application in the Notice of Prior Art was “unintentional and inadvertent” because the omission stemmed from a clerical error in recording the application number

for the Masahiro application, which ultimately lead to Emcore's failure to include it in its Notice of Prior Art. Emcore further argues that since the Masahiro application was cited in the prosecution history of the '229 Patent, then it certainly cannot be any "surprise" to Avago or prejudicial, especially since Avago has been on notice of Emcore's intent since the filing of the original motion to supplement and the use of the prior art during inventor depositions. Emcore argues that the failure to include Masahiro application in this investigation would "indirectly" hurt the public interest.

The ALJ finds Emcore's arguments unpersuasive. First, the ALJ notes the inconsistencies in Emcore's arguments. In its original motion (Motion Docket No. 669-007), Emcore argues that it could not make a timely determination as to whether it should include the Masahiro application in its Notice of Prior Art because it did not have a certified translation at that time. In the instant motion (Motion Docket No. 669-018), Emcore argues that its failure to timely include the Masahiro application was due to a clerical error, namely that an incorrect application number (which was not for the Masahiro application) led Emcore's attorneys to deem that reference irrelevant. Emcore's arguments are irreconcilable – the absence of a certified translation and an analysis of incorrect prior art are two separate and independent reasons for failing to include the Masahiro application in the Notice of Prior Art. These two independent reasons for a failure to include the Masahiro application in the Notice of Prior Art indicate that the failure to include the reference was less an issue of inadvertency than carelessness. Furthermore, such drastically different scenarios, without any explanation reconciling the two, significantly undercuts Emcore's credibility before the ALJ on this matter.


Second, the circumstances presented in the instant motion as representing the “inadvertent” failure to include the Masahiro application could have easily been explained in the original motion, *i.e.*, Emcore presented no reason for its failure to set forth the current explanation in the instant motion in its original motion. Rather, Emcore appears to have only decided *after* the ALJ denied Emcore’s request to supplement its Notice of Prior Art to truly “investigate” the circumstances surrounding the failure to include the Masahiro application. Given that these events occurred in June and July of this year, these are not “new circumstances” or “new evidence” that Emcore did not have the opportunity to argue before. Emcore’s failure to fully “investigate” the circumstances surrounding the omission in the first instance does not warrant reconsideration. Indeed, the “error” in this instance was all of Emcore’s own making.

As for Emcore’s arguments relating to the lack of prejudice to Avago, the ALJ finds that those same arguments make Emcore’s conduct even less excusable. As Emcore has repeatedly argued, the Masahiro application, along with a translation of the abstract, was included in the prosecution history of the ‘229 Patent. Thus, *both* Avago and Emcore were well aware from the institution of this investigation that the Masahiro application was a prior art reference in the prosecution history. As such, under either scenario argued by Emcore, its failure to include a prior art reference specifically cited in the prosecution history is even less excusable. Indeed, Emcore was well aware that the Masahiro application was prior art and that only the abstract was translated into English. The ALJ finds it hard to believe that a translation of a single Japanese document would take a full four months such that Emcore did not have a certified translation for its Notice of Prior Art and that such a translation was absolutely necessary for a reference that was

cited in the prosecution history.<sup>1</sup> Furthermore, given that the Masahiro application was previously cited prior art during the prosecution of the '229 Patent, Emcore arguably should have realized its failure to include this important reference in its Notice of Prior Art in a much more timely fashion. The burden lies with Emcore to provide notice to Avago as to the prior art references it intends to use in this investigation – that burden does not shift nor lessen by the mere fact that Avago should not have been “surprised.”

Therefore, based on the foregoing, the ALJ hereby DENIES Emcore’s request for reconsideration. Emcore shall not be permitted to use the certified translation of the Masahiro application in this investigation.<sup>2</sup>

**SO ORDERED.**



Theodore R. Essex  
Administrative Law Judge

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<sup>1</sup> As required by 19 C.F.R. § 210.12(c)(1), Avago included a certified copy of the prosecution history for the '227 Patent with its complaint. (*See* Complaint, Appendix B.) Thus, Emcore has been aware of the Masahiro application since March 2009.

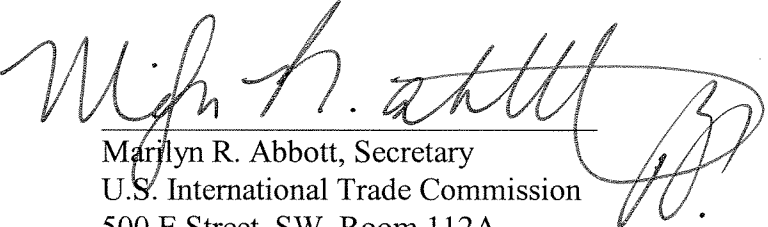
<sup>2</sup> To the extent that the Commission Investigative Staff (“Staff”) identified the file history prior art, which included the Masahiro application, that application along with its translated abstract may be used. There is no evidence before the ALJ that Staff provided its own certified translation of the entire Masahiro application or that it relied upon Emcore’s translation in discovery.

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**CERTIFICATE OF SERVICE**

I, Marilyn R. Abbott, hereby certify that the attached **ORDER 12** has been served by hand upon, the Commission Investigative Attorney, **Christopher G. Paulraj, Esq.** and the following parties as indicated on **June 23, 2010**.

  
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U.S. International Trade Commission  
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**CERTIFICATE OF SERVICE - PAGE 2**

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