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UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN GAS SPRING NAILER
PRODUCTS AND COMPONENTS
THEREOF**

**Inv. No. 337-TA-1082
(Modification Proceeding)**

RECOMMENDED DETERMINATION

Chief Administrative Law Judge Charles E. Bullock

(July 2, 2021)

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I. INTRODUCTION

A. Procedural History

On March 5, 2020, the Commission issued a limited exclusion order (“LEO”) and a cease and desist order (“CDO”) in the original investigation. The LEO prohibits the unlicensed entry of gas spring nailer products and components thereof that: (1) infringe one or more of claims 1, 10, and 16 of U.S. Patent No. 8,387,718 (“the ’718 Patent”); and (2) are manufactured abroad by or on behalf of, or imported by or on behalf of, Respondent Hitachi Koki U.S.A., Ltd., now known as Koki Holdings America Ltd.¹ (“Koki”) or any of its affiliated companies, parents, subsidiaries, licensees, or other related business entities, or their successors or assigns. *See* EDIS Doc. No. 704131 (Mar. 5, 2020). The CDO: (1) was directed at Koki; and (2) orders Koki to cease and desist from importing, selling, offering for sale, marketing, advertising, distributing, transferring (except for exportation), and soliciting U.S. agents for distributors for, and aiding and abetting other entities in the importation, sale for importation, sale after importation, transfer (except for exportation), or distribution of gas spring nailer products and components thereof that infringe one or more of claims 1, 10, and 16 of the ’718 Patent. *See* EDIS Doc. No. 704132 (Mar. 5, 2020).

On June 30, 2020, pursuant to 19 C.F.R. Part 177, the U.S. Customs and Border Protection (“CBP”) issued a ruling that Koki redesigns were outside of the scope of the LEO. RX-1001C. Subsequently, on August 17, 2020, Complainant Kyocera Senco Brands, Inc. (“Kyocera”) petitioned the Commission for a modification proceeding to “determine whether [Koki’s] allegedly redesigned gas spring nailer infringes the claims of [the ’718 Patent] that are the subject of the Limited Exclusion Order (‘LEO’) and Cease-and-Desist Order (‘CDO’) issued in the above-captioned investigation” (the “Petition”). EDIS Doc. No. 717497 at 1. On August 27, 2020, Koki

¹ Koki Holdings America Ltd. was formerly known during the original investigation as Hitachi Koki U.S.A., Ltd. *See Certain Gas Spring Nailer Prods. & Components Thereof*, Inv. No. 337-TA-1082, Initial Determination (“ID”) at 3 (Jun. 7, 2019).

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filed its opposition. EDIS Doc. No. 718325. On September 2, 2020, Kyocera filed a motion for leave to file a reply in support of the Petition. EDIS Doc. No. 718687. On September 9, 2020, Koki filed an opposition to Kyocera's motion for leave. EDIS Doc. No. 719212.

In an order issued on September 16, 2020, the Commission instituted the present modification proceeding "to determine whether Koki's redesigned products infringe asserted claims 1, 10, or 16 of the '718 patent, and are therefore covered by the LEO directed against Koki's infringing products and the CDO issued against Koki, both issued on March 5, 2020, by the Commission in this investigation." EDIS Doc. No. 719853 at 2 (Sept. 16, 2020). The Commission further ordered:

3. The petition for a modification proceeding is referred to the Chief Administrative Law Judge ("ALJ") for assignment of a presiding ALJ to make findings and issue a recommended determination ("RD") after publication of notice of this order in the Federal Register.

4. The presiding ALJ will set a target date for completion of the modification proceeding and will issue the RD within the earliest practicable time after publication of institution in the Federal Register, but no later than 60 days prior to the target date.

Id. at 3. On September 17, 2020, the modification proceeding was assigned to the undersigned and its institution was published in the Federal Register on September 22, 2020. 85 Fed. Reg. 59,543-

44. On October 22, 2020, the Commission issued a revised order adding the following provision:

4. The Commission notes that Koki has alleged that Kyocera intends to raise certain arguments in connection with claim construction that Koki has stated are waived and are otherwise without merit. Koki has asserted that should such arguments be allowed, Koki should have the opportunity to raise related counter-arguments (*e.g.*, estoppel and invalidity). In instituting the proceeding, the Commission has not ruled on what Kyocera or Koki should be allowed to argue, and leaves such decisions to be made by the ALJ in the first instance, should such issues arise.

EDIS Doc. No. 722903 at 3 (Oct. 22, 2020).

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On October 14, 2020, Koki filed a petition for writ of mandamus at the U.S. Court of Appeals for the Federal Circuit seeking termination of this proceeding. On October 20, 2020, Koki then filed a motion for temporary stay of this modification proceeding pending the Federal Circuit’s decision on its petition for writ of mandamus. The undersigned denied that motion on October 27, 2020. *See* Order No. 38 (Oct. 27, 2020). The Federal Circuit denied Koki’s petition for writ of mandamus on November 25, 2020. *In re Koki Holdings Am. Ltd.*, 830 Fed. Appx. 320, 322 (Fed. Cir. 2020).

On November 6, 2020, the undersigned set a procedural schedule for this modification proceeding, which included fact and expert discovery, a briefing schedule, and a Recommended Determination deadline of March 29, 2021. Order No. 40 (Nov. 6, 2020). While neither party requested a hearing in this proceeding, both parties sought to submit new witness testimony beyond that originally presented in the underlying investigation, thereby necessitating limited *de bene esse* depositions and associated extensions in the procedural schedule. Accordingly, the undersigned amended the procedural schedule, and extended the target date to August 31, 2021 and the Recommended Determination deadline to July 2, 2021.²

B. The Redesigned Products

The products at issue are the following model numbers: NT1850DE(S), NT1865DM(S), NT1865DMA(S), NR1890DC(S), NR1890DR(S), and NR3675DD (collectively, the “Redesigned Products”). *See* CX-1000C at 11-12; CIB at 2 n.2; RIB at 10.

² For convenience, the briefs submitted by the Parties are referred to hereafter as:

CIB	Complainant’s Initial Brief
CRB	Complainant’s Reply Brief
RIB	Respondent’s Initial Brief
RRB	Respondent’s Reply Brief

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II. RELEVANT LAW

A. Claim Construction

“An infringement analysis entails two steps. The first step is determining the meaning and scope of the patent claims asserted to be infringed. The second step is comparing the properly construed claims to the device accused of infringing.” *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*) (internal citations omitted), *aff’d*, 517 U.S. 370 (1996). Claim construction is a “matter of law exclusively for the court.” *Id.* at 970-71. “The construction of claims is simply a way of elaborating the normally terse claim language in order to understand and explain, but not to change, the scope of the claims.” *Embrex, Inc. v. Serv. Eng’g Corp.*, 216 F.3d 1343, 1347 (Fed. Cir. 2000).

Claim construction focuses on the intrinsic evidence, which consists of the claims themselves, the specification, and the prosecution history. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (*en banc*); *see also Markman*, 52 F.3d at 979. As the Federal Circuit has explained, courts must analyze each of these components to determine the “ordinary and customary meaning of a claim term” as understood by a person of ordinary skill in the art at the time of the invention. *Phillips*, 415 F.3d at 1313. “Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language.” *Bell Atl. Network Servs., Inc. v. Covad Commc’ns Grp., Inc.*, 262 F.3d 1258, 1267 (Fed. Cir. 2001).

“It is a ‘bedrock principle’ of patent law that ‘the claims of a patent define the invention to which the patentee is entitled the right to exclude.’” *Phillips*, 415 F.3d at 1312 (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1115 (Fed. Cir. 2004)). “Quite apart from the written description and the prosecution history, the claims themselves provide substantial guidance as to the meaning of particular claim terms.” *Id.* at 1314; *see also Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1331 (Fed. Cir. 2001)

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(“In construing claims, the analytical focus must begin and remain centered on the language of the claims themselves, for it is that language that the patentee chose to use to ‘particularly point[] out and distinctly claim[] the subject matter which the patentee regards as his invention.’”). The context in which a term is used in an asserted claim can be “highly instructive.” *Phillips*, 415 F.3d at 1314. Additionally, other claims in the same patent, asserted or unasserted, may also provide guidance as to the meaning of a claim term. *Id.*

The specification “is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.” *Id.* at 1315 (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). “[T]he specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor’s lexicography governs.” *Id.* at 1316. “In other cases, the specification may reveal an intentional disclaimer, or disavowal, of claim scope by the inventor.” *Id.* As a general rule, however, the particular examples or embodiments discussed in the specification are not to be read into the claims as limitations. *Id.* at 1323. In the end, “[t]he construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be . . . the correct construction.” *Id.* at 1316 (quoting *Renishaw PLC v. Marposs Societa’ per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998)).

In addition to the claims and the specification, the prosecution history should be examined, if in evidence. *Id.* at 1317; *see also Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 913 (Fed. Cir. 2004). The prosecution history can “often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips*, 415 F.3d at 1317; *see also Chimie v. PPG Indus., Inc.*, 402 F.3d 1371, 1384 (Fed. Cir. 2005) (“The purpose of consulting the prosecution history in construing a claim is to ‘exclude

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any interpretation that was disclaimed during prosecution.”).

When the intrinsic evidence does not establish the meaning of a claim, then extrinsic evidence (*i.e.*, all evidence external to the patent and the prosecution history, including dictionaries, inventor testimony, expert testimony, and learned treatises) may be considered. *Phillips*, 415 F.3d at 1317. Extrinsic evidence is generally viewed as less reliable than the patent itself and its prosecution history in determining how to define claim terms. *Id.* at 1317.

B. Infringement

To prove direct infringement in a section 337 investigation, one must establish by a preponderance of the evidence that one or more claims of the patent read on the accused device literally or under the doctrine of equivalents. *Spansion, Inc. v. Int'l Trade Comm'n*, 629 F.3d 1331, 1349 (Fed. Cir. 2010). Patent infringement must be proven by a preponderance of the evidence, which “requires proving that infringement was more likely than not to have occurred.” *Warner-Lambert Co. v. Teva Pharm. USA, Inc.*, 418 F.3d 1326, 1341 n.15 (Fed. Cir. 2005).

Literal infringement is a question of fact. *Finisar Corp. v. DirecTV Grp., Inc.*, 523 F.3d 1323, 1332 (Fed. Cir. 2008). Literal infringement requires proof that the accused device contains each limitation of the asserted claim(s). If any claim limitation is absent, there is no literal infringement of that claim as a matter of law. *Bayer AG v. Elan Pharm. Research Corp.*, 212 F.3d 1241, 1247 (Fed. Cir. 2000).

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III. CHANGED CONDITIONS OF FACT OR LAW UNDER COMMISSION RULE 210.76(a)(1)³

The Commission's Rules provide that:

Whenever any person believes that changed conditions of fact or law, or the public interest, require that an exclusion order, cease and desist order, or consent order be modified or set aside, in whole or in part, such person may request, pursuant to section 337(k)(1) of the Tariff Act of 1930, that the Commission make a determination that the conditions which led to the issuance of an exclusion order, cease and desist order, or consent order no longer exist. The Commission may also on its own initiative consider such action.

19 C.F.R. § 210.76(a)(1). The Commission may grant relief “on the basis of new evidence or evidence that could not have been presented at the prior proceeding or on grounds that would permit relief from a judgment or order under the Federal Rules of Civil Procedure. 19 C.F.R. § 210.76(a)(2).

Kyocera submits that Koki's disclosure of the Redesigned Products after issuance of the remedial orders, and after the CBP's ruling that the Redesigned Products are not subject to exclusion under the limited exclusion order, establish the changed conditions of fact under Rule 210.76(a)(1). CIB at 17. Kyocera argues that the Redesigned Products could not have been addressed in the underlying investigation because they were not disclosed until after the remedial orders were issued. *Id.* at 19-20. In addition, Kyocera claims that “the Federal Circuit confirmed that the LEO (and CDO) ‘was not expressly limited to the adjudicated products’ and could cover

³ The undersigned rejects Koki's argument that the Commission lacks statutory authority to conduct this modification proceeding. Koki argues that the “sole and avowed purpose of the presently instituted modification proceeding is to consider whether to issue a broader modified exclusion order that explicitly covers the Redesigned Accused Products despite a finding by CBP that the current exclusion order does not cover Koki's Redesigned Accused Products.” RIB at 12-13. However, as the Federal Circuit has confirmed, “[t]he Commission's limited exclusion order here was not expressly limited to the adjudicated products but rather prohibits the ‘unlicensed entry of gas spring nailer products and components thereof that infringe one or more of claims 1, 10, and 16 of the '718 patent.’” *In re Koki*, 830 Fed. Appx. at 322. The Federal Circuit also stated that “Koki cites no precedent of this court, nor are we aware of one, that has held that an exclusion order cannot cover unadjudicated products.” *Id.* Here, the Commission is not considering whether to issue a broader modified exclusion order as Koki suggests. Rather, the Commission instituted this modification proceeding “to determine whether Koki's redesigned products infringe asserted claims 1, 10, or 16 of the '718 patent, and are therefore covered by the LEO directed against Koki's infringing products and the CDO issued against Koki.” See EDIS Doc. No. 719853 at 2.

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the Redesigned Products without the issuance of ‘a broader modified exclusion order.’” *Id.* at 18.

Koki argues that a modification proceeding is inappropriate and not the “proper vehicle” for the relief sought by Kyocera. RIB at 14. According to Koki, “either the Redesigned Accused Products do not infringe and Kyocera is not entitled to its requested modification, or the Redesigned Accused Products do infringe and the Commission will, in the context of a modification proceeding, be unable to find that the conditions that led to the exclusion order no longer exist.” *Id.*

As noted above, the LEO issued on March 5, 2020. Koki began selling the Redesigned Products in May 2020. CX-1000C at 11-12. Because the Redesigned Products were sold after issuance of the LEO, they could not have been considered in the underlying investigation. The undersigned therefore finds that this constitutes changed conditions of fact under Commission Rule 210.76(a)(1).

IV. U.S. PATENT NO. 8,387,718

A. Overview

The ’718 Patent, entitled “Method for Controlling a Fastener Driving Tool Using a Gas Spring,” issued on March 5, 2013 to Richard L. Leimbach, Shane Adams, Thomas W. Clark, Michael V. Petrocelli, and Teresa Petrocelli. The ’718 Patent generally relates to “linear fastener driving tools, and, more particularly, [is] directed to portable tools that drive staples, nails, or other linearly driven fasteners.” JX-0004 at 1:17-19. “The invention is specifically disclosed as a gas spring linear fastener driving tool, in which a cylinder filled with compressed gas is used to quickly force a piston through a driving stroke movement, while also driving a fastener into a workpiece.” *Id.* at 1:19-23.

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1. Asserted Claims

At issue are claims 1, 10, and 16 of the '718 patent, which read as follows:

1. A method for controlling a fastener driving tool, said method comprising: (a) providing a fastener driving tool that includes: (i) a housing; (ii) a system controller; (iii) a safety contact element; (iv) a user-actuated trigger; (v) a fastener; (vi) a prime mover that moves a lifter member which moves a driver member away from an exit end of the mechanism; and (vii) a fastener driving mechanism that moves said driver member toward said exit end of the mechanism, said fastener driving mechanism including: (A) a hollow cylinder comprising a cylindrical wall with a movable piston therewithin, said hollow cylinder containing a displacement volume created by a stroke of said piston, and (B) a main storage chamber that is in fluidic communication with said displacement volume of the cylinder, wherein said main storage chamber and said displacement volume are initially charged with a pressurized gas; (b) selecting, by a user, an operating mode of said driving cycle to be one of: a “bottom firing mode,” and a “restrictive firing mode;” wherein: (i) if said restrictive firing mode is selected, said tool will operate if said safety contact element has been actuated before said trigger actuator has been operated; and (ii) if said bottom firing mode is selected, said tool will operate if both: (A) said trigger actuator has been operated, and (B) said safety contact element has been actuated, in either sequence; (c) initiating a driving cycle by pressing said exit end against a workpiece and actuating said trigger, thereby causing said fastener driving mechanism to force the driver member to move toward said exit end and drive a fastener into said workpiece; and (d) actuating said prime mover, thereby moving said lifter member and causing said driver member to move away from said exit end toward a ready position.

10. A method for controlling a fastener driving tool, said method comprising: (a) providing a fastener driving tool that includes: (i) a housing; (ii) a system controller; (iii) a safety contact element; (iv) a user-actuated trigger; (v) a fastener; (vi) a prime mover that moves a lifter member which moves a driver member away from an exit end of the mechanism; and (vii) a fastener driving mechanism that moves said driver member toward said exit end of the mechanism, said fastener driving mechanism including: (A) a hollow cylinder comprising a cylindrical wall with a movable piston therewithin, said hollow cylinder containing a displacement volume created by a stroke of said piston, and (B) a main storage chamber that is in fluidic communication with said displacement volume of the cylinder, wherein said main storage chamber and said displacement volume are charged with a pressurized gas during all portions of an operating cycle; (b) selecting, by a user, an operating mode of said driving cycle to be one of: a “bottom firing mode,” and a “restrictive firing mode;” wherein: (i) if said restrictive firing mode is selected, said tool will operate if said safety contact element has been actuated before said trigger actuator has been operated; and (ii) if said bottom firing mode is selected, said tool will operate if both: (A) said trigger actuator has been operated, and (B) said safety contact element has been actuated, (c) initiating a driving cycle by pressing said exit end against a workpiece and actuating said trigger, thereby causing said fastener driving mechanism to force the driver member to move toward said exit end and drive a fastener into said workpiece; and (d) actuating said prime mover, thereby moving said lifter member and causing said driver member to move away from said exit end toward a ready position.

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16. A method for controlling a fastener driving tool, said method comprising: (a) providing a fastener driving tool that includes: (i) a housing; (ii) a system controller; (iii) a safety contact element; (iv) a user-actuated trigger; (v) a fastener; (vi) a prime mover that moves a lifter member which moves a driver member away from an exit end of the mechanism; and (vii) a fastener driving mechanism that moves said driver member toward said exit end of the mechanism, said fastener driving mechanism including: (A) a hollow cylinder comprising a cylindrical wall with a movable piston therewithin, said hollow cylinder containing a displacement volume created by a stroke of said piston, and (B) a main storage chamber that is in fluidic communication with said displacement volume of the cylinder, wherein said main storage chamber and said displacement volume are charged with a pressurized gas during all portions of an operating cycle; (b) selecting, by a user, an operating mode of said driving cycle to be one of: a “bottom firing mode,” and a “restrictive firing mode;” wherein: (i) if said restrictive firing mode is selected, said tool will operate if said safety contact element has been actuated before said trigger actuator has been operated; and (ii) if said bottom firing mode is selected, said tool will operate if both: (A) said safety contact element has been actuated, and (B) said trigger actuator has been operated, (c) initiating a driving cycle by pressing said exit end against a workpiece and actuating said trigger, thereby causing said fastener driving mechanism to force the driver member to move toward said exit end and drive a fastener into said workpiece; and (d) actuating said prime mover, thereby moving said lifter member and causing said driver member to move away from said exit end toward a ready position.

JX-0004, cls. 1, 10, 16.

B. Claim Construction⁴

In the original investigation, the undersigned construed certain terms in the '718 patent. *See* Order No. 9 (May 3, 2018). For the purposes of this modification proceeding, the undersigned instructed the parties that they “shall only be permitted to present claim construction arguments regarding claim terms that were not previously construed in the original investigation.” *See* Order No. 39 at 1 (Oct. 27, 2020); Order No. 40 at 1 (Nov. 6, 2020); *see also Certain Road Constr. Machs. & Components Thereof*, Inv. No. 337-TA-1088, Comm’n Op. at 8-9 (Aug. 31, 2020) (“Section 337(k) places no restriction on the Commission’s authority to conduct claim construction as part of its modification proceeding.”).

⁴ Koki argues that Dr. Pratt’s testimony on issues that require the perspective of a person of ordinary skill in the art should be given no weight. RIB at 24-25. The undersigned has already addressed Koki’s arguments regarding Dr. Pratt’s testimony and thus, rejects Koki’s attempt to reargue this issue. *See* Order No. 28 at 3, 5-6 (Oct. 24, 2018); Order No. 52 at 1-2 (Apr. 7, 2021).

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1. “selecting, by a user, an operating mode of said driving cycle to be one of: a ‘bottom firing mode,’ and a ‘restrictive firing mode’”

The term “selecting, by a user, an operating mode of said driving cycle to be one of: a ‘bottom firing mode,’ and a ‘restrictive firing mode’” appears in claims 1, 10, and 16 of the ’718 Patent. The parties disagree on the claim construction of this term and have proposed the following constructions:

KYOCERA	KOKI
Selecting, by a user, an operating mode of said driving cycle to be a “bottom firing mode;” <i>or</i> selecting, by a user, an operating mode of said driving cycle to be a “restrictive firing mode”	Plain and ordinary meaning, which requires that both modes be available for there to be an implicit or explicit “selecting”

CIB at 24; RIB at 21-22.

Kyocera asserts that if a product allows one of the two modes to be selected, then the limitation is met. CIB at 24; CRB at 7. Kyocera argues that nothing in the context of the claim or specification requires that both a restrictive firing mode and a bottom firing mode be physically available for selection. CIB at 24-25; CRB at 8 (asserting that if both modes were required, they would have been included in the “providing” limitation rather than the “selecting” step). Kyocera contends that Dr. Vallee agreed that the specification does not require a bottom firing mode. CIB at 25.

Koki argues that the word “selecting” means that there must be at least two options for a user to select from. RIB at 19. Koki therefore contends that one of ordinary skill would read “selecting” to require that the restrictive firing mode and bottom firing mode be available in order for there to be a selection. *Id.* According to Koki, the specification describes a mode selector switch where a user can select between the restrictive fire mode and bottom firing mode. *Id.* at 20.

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The parties' dispute centers on whether the term "selecting, by a user, an operating mode of said driving cycle to be one of: a 'bottom firing mode,' and a 'restrictive firing mode'" requires both modes to be available. The undersigned finds that the plain and ordinary meaning of the word "selecting" means to make a choice. *See Phillips*, 415 F.3d at 1312-1313 ("[T]he words of a claim are 'generally given their ordinary and customary meaning.'"). The phrase "one of: a 'bottom firing mode,' and a 'restrictive firing mode'" articulates a group from which to make that choice. Thus, this limitation requires that a user make a choice between two things – a bottom firing mode and a restrictive firing mode.⁵ *See RX-1002* at Q/A 27. If both modes are not available, then a user cannot make a choice between those two modes. Kyocera alleges that "if a product allows one of those modes to be selected—even if the other available mode from which the user may select is not the other claimed mode—the literal step of 'selecting' has been performed and that limitation is met." CIB at 24. The undersigned disagrees. If a tool only allows one of those modes to be selected, then the user is not selecting "one of: a 'bottom firing mode,' and a 'restrictive firing mode.'"

In addition, while the specification does not necessarily require a bottom firing mode and a restrictive firing mode, this does not supersede the precise words of claims 1, 10 and 16, which do require both modes. *See MySpace, Inc. v. GraphOn Corp.*, 672 F.3d 1250, 1256 (Fed. Cir. 2012) ("An inventor is entitled to claim in a patent what he has invented, but no more. He can, however, claim less, to avoid prior art or for any other reason."). Moreover, while not dispositive, it is instructive that the specification describes the restrictive firing mode as an optional mode, but does not describe the bottom firing mode as optional. *See JX-0004* at 11:64-66; 14:56-61; 26:15-17,

⁵ This is consistent with the undersigned's infringement determination in the underlying investigation. *See Remand ID* at 19 (Oct. 28, 2019) ("If a user turns on the tool and the tool operates properly, the tool will have been set to either 'restrictive firing mode' or 'bottom firing mode,' and the user will have necessarily selected either 'restrictive firing mode' or 'bottom firing mode.'").

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29:38-43.

Accordingly, the undersigned finds that the term “selecting, by a user, an operating mode of said driving cycle to be one of: a ‘bottom firing mode,’ and a ‘restrictive firing mode’” should be given its plain and ordinary meaning, which requires both a bottom firing mode and a restrictive firing mode be available for selecting.

2. “wherein . . . if said bottom firing mode is selected . . .”

The term “wherein . . . if said bottom firing mode is selected . . .” appears in claims 1, 10, and 16 of the ’718 patent.⁶ The parties disagree on the claim construction of this term and have proposed the following constructions:

TERM	CLAIM	KYOCERA	KOKI
“wherein . . . if said bottom firing mode is selected, said tool will operate if both: (A) said trigger actuator has been operated, and (B) said safety contact element has been actuated, in either sequence”	1	If said bottom firing mode is selected, said tool will operate if: said trigger actuator has been operated and then said safety contact has been actuated, and will also operate if said safety contact element has been operated and then said trigger actuator has been operated	Kyocera’s proposed construction should be rejected because it improperly seeks to reconstrue the “bottom firing mode” term and because it is wrong on the merits.
“wherein . . . if said bottom firing mode is selected, said tool will operate if both: (A) said trigger actuator has been operated, and (B) said safety contact element has been actuated”	10	If said bottom firing mode is selected, said tool will operate if the trigger actuator has been operated and then said safety contact has been actuated; <i>or</i> if said bottom firing mode is selected, said tool will operate	
“wherein . . . if said bottom firing mode is selected, said tool will operate if both: (A) said safety contact element has been actuated, and (B) said trigger actuator has been operated”	16	if said safety contact element has been operated and then said trigger actuator has been operated	

⁶ While independent claims 1, 10, and 16 each include this limitation, the language varies slightly, as shown below. See JX-0004, cls. 1, 10, 16.

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CIB at 33; RRB at 15.

According to Kyocera, this term is largely identical in claims 1, 10, and 16, except that the phrase “in either sequence” of claim 1 is absent from claims 10 and 16. *Id.* at 29-30. Kyocera therefore argues that the doctrine of claim differentiation demands that the scope of claims 10 and 16 is broader than the scope of claim 1. *Id.* at 30. According to Kyocera, the absence of “in either sequence” in claims 10 and 16 “means that the tool need *not* operate in both sequences and instead need only operate in *one* of the two sequences to qualify as the recited ‘bottom firing mode.’” *Id.* (emphasis in original). Kyocera claims this is supported by the specification, which describes various modes of operation. *Id.* at 31. Kyocera argues that a nailer will meet this limitation in claims 10 and 16 if just one of the two possible “bottom firing mode” pathways is present, but claim 1 requires that the nailer have both of the possible pathways available so that the nailer will operate “in either sequence.” *Id.* at 31-32.

Koki argues that Kyocera is improperly attempting to reconstrue the “bottom firing mode” term. RRB at 12. Koki contends that the adopted construction for “bottom firing mode” requires “a mode in which the tool operates” and then specifies two forms of operation that must both be provided by that single claimed mode. *Id.* In addition, Koki asserts that claim differentiation is a limited tool that works best in the relationship between independent and dependent claims, which is not the situation presented by independent claims 1, 10, and 16. RRB at 13. In fact, Koki argues that claims 10 and 16 already differ from claim 1 due to the “main storage chamber” limitation. *Id.*; RIB at 18. Koki also disputes Kyocera’s position that the “in either sequence” language means that claim 1 must have a different scope than claims 10 and 16. RIB at 14.

The undersigned rejects Kyocera’s proposed construction of this term as an attempt to reconstrue the “bottom firing mode” term. The undersigned previously stated that “Kyocera may argue for a proposed claim construction for the ‘if said bottom firing mode is selected’ term, but

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only to the extent it does not conflict with the construction of or is an attempt to reconstrue the ‘bottom firing mode’ term.” Order No. 40 at 2 (emphasis added). The term “bottom firing mode” was previously construed as “a mode in which the tool operates if the trigger actuator is first operated and then the safety contact element is actuated and also operates if the safety contact element is first actuated and then the trigger actuator is operated.” Order No. 9 at 17. That construction was agreed upon by the parties for claims 1, 10, and 16, and ultimately adopted by the undersigned.⁷ *See id.* Based on this construction, the bottom firing mode can operate in two different ways. In other words, the construction identifies two different sets of conditions that, if satisfied, will operate the tool. Kyocera’s proposed construction for the “if said bottom firing mode is selected” term of claims 10 and 16, however, does not require that the tool operate under both sets of conditions. Rather, because Kyocera’s proposed construction includes the disjunctive “or,” it only requires that the tool operate under one set of conditions. This is in direct conflict with the undersigned’s construction of “bottom firing mode.”⁸ *See* Order No. 9 at 17.

C. Representative Products

Kyocera submits that for the purposes of infringement, Koki’s NT1850DE(S) nailer is representative of the Redesigned Products, just like the NT1850DE was representative of the products in the underlying investigation. CIB at 34. Kyocera contends that Koki has not alleged any difference between the original products and the Redesigned Products related to infringement except for the software change to the “bottom firing mode.” *Id.*

Koki contends that Kyocera’s expert, Dr. Pratt, only disassembled the NT1850DE(S), NT1865DM(S), NT1865DMA(S), NR1890DC(S), and NR1890DR(S) after submitting his expert

⁷ The construction of “bottom firing mode” was also adopted by the Commission. *See Certain Gas Spring Nailer Prods. & Components Thereof*, Inv. No. 337-TA-1082, Comm’n Op. at 28 (Mar. 5, 2020) (“The Commission adopts and affirms the portions of the ID and RID that are not inconsistent with this opinion.”).

⁸ It is irrelevant whether Kyocera’s proposed construction of this term as to claim 1 is consistent with the construction of “bottom firing mode” because the construction of “bottom firing mode” was construed to be the same for claims 1, 10, and 16. *See* Order No. 9 at 17.

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report and thus, his expert report did not “provide any analysis to support his contention that the components in the original NT1850DE are representative of components in any of the other Redesigned Products, or that they even operate in the same way.” RIB at 23. Moreover, Koki argues that Dr. Pratt never inspected the NR3675DD during discovery and did not provide any opinion that it is identical to any other accused product that he inspected. *Id.*

In the original investigation, the undersigned found that the NT1850DE was representative of the original products. ID at 15. Koki has not identified any significant differences between the original products and the Redesigned Products relevant to infringement other than the Contact Actuation Mechanism mode. *See* CX-1000C at 17-18; *see also* RIB at 10. This is further supported by Koki’s Ruling Request to the CBP, which again, only points to the fact that the second form of operation in the Contact Actuation Mechanism mode of the Redesigned Products was eliminated. *See* CX-1017C at 5. In addition, the Instruction and Safety Manuals provide sufficient evidence of that change in the Contact Actuation Mechanism mode. *See* CX-1017C at 5; CX-1001 at 24-25 (Instruction and Safety Manual for NT1865DMA(S), NT1865DM(S), and NT1850DE(S)); CX-1002 at 23-24 (Instruction and Safety Manual for NR1890DC(S) and NR1890DR(S)); CX-1003 at 22 (Instruction and Safety Manual for NR3675DD); *see also* RIB at 10. Thus, the undersigned finds that Kyocera has presented sufficient evidence to establish that the NT1850DE(S) is representative of the NT1865DM(S), NT1865DMA(S), NR1890DC(S), NR1890DR(S), and NR3675DD.

D. Infringement

Kyocera asserts that the Redesigned Products meet every limitation of claims 1, 10, and 16. CIB at 35-36. Koki argues that the Redesigned Products do not meet the “selecting” limitation or the “wherein . . . if said bottom firing mode is selected . . .” limitation. RIB at 28-34. Koki does

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not dispute that the Redesigned Products meet the remaining limitations.⁹ *Id.* at 27.

Independent claims 1, 10, and 16 include the limitation “selecting, by a user, an operating mode of said driving cycle to be one of: a ‘bottom firing mode,’ and a ‘restrictive firing mode.’” JX-0004, cls. 1, 10, 16.

Kyocera asserts that the Redesigned Products meet the “selecting” step because the user can choose between two modes – the Full Sequential Actuation Mechanism mode and the Contact Actuation Mechanism mode. CIB at 36-37. According to Kyocera, the Full Sequential Actuation Mechanism is the same as in the original products where the Commission adopted the undersigned’s determination that it was the claimed “restrictive firing mode.” *Id.* at 37. Kyocera therefore contends that a user who selects the Full Sequential Actuation Mechanism mode meets the “selecting” step. *Id.* Kyocera argues that it is irrelevant whether the alternative mode meets the construction of “bottom firing mode.” *Id.*; CRB at 7. In addition, Kyocera contends that the selection could be between the claimed restrictive firing mode and additional “unclaimed modes.”¹⁰ CIB at 26.

Koki contends that Kyocera’s infringement argument is premised on its construction that a “bottom firing mode” is not required. RIB at 28. Because Kyocera’s construction is incorrect and it is undisputed that the Redesigned Products do not have a “bottom firing mode,” Koki argues that the Redesigned Products do not meet this limitation. *Id.*; RRB at 15. Koki disputes the “selecting” can be among claimed and unclaimed modes because then the selected mode would not be “one of: a ‘bottom firing mode,’ and a ‘restrictive firing mode,’” as required by the claims.

⁹ Koki, however, reiterates its argument that “Kyocera has failed to prove that any of the Redesigned Products are representative of the original NT1850DE nailer . . . and therefore has not provide [*sic*] that any of the claim elements are met.” RIB at 27-28.

¹⁰ Kyocera also argues that for claims 10 and 16, the Redesigned Products meet the “selecting” limitation because the Contact Actuation Mechanism meets the “wherein . . . if said bottom firing mode is selected . . .” limitation. *See* CIB at 39. However, as noted above in Section IV.B.2, Kyocera’s proposed construction for the “wherein . . . if said bottom firing mode is selected . . .” limitation was rejected. Accordingly, Kyocera’s infringement arguments as to that limitation are similarly rejected.

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RRB at 15-16.

As explained above, the “selecting” term requires both a bottom firing mode and a restrictive firing mode be available for selecting. *See supra* at Section IV.B.1. In addition, the term “bottom firing mode” was construed as “a mode in which the tool operates if the trigger actuator is first operated and then the safety contact element is actuated and also operates if the safety contact element is first actuated and then the trigger actuator is operated.”¹¹ Order No. 9 at 17. Again, this construction identifies two different sets of conditions that, if satisfied, will operate the tool. Here, the parties agree that in the Redesigned Products, the second form of operation in the Contact Actuation Mechanism mode has been eliminated. *See CX-1017C* at 5; *CX-1024* at Q/A 84; *RIB* at 10. This means that in the Redesigned Products, the tool will not operate if the user first presses the push lever (*i.e.*, safety contact element) and then pulls the trigger (*i.e.*, trigger actuator). *See CX-1017C* at 5; *CX-1024* at Q/A 84. Instead, the Contact Actuation Mechanism mode in the Redesigned Products has been modified so that the tool will only operate if the trigger is pulled first and then the push lever is actuated. *See id.* Thus, the Redesigned Products do not have the claimed “bottom firing mode” and do not meet this claim limitation.

For these reasons, the undersigned finds that the Redesigned Products do not infringe claims 1, 10, or 16 of the '718 patent.¹²

¹¹ This construction is the same for claims 1, 10, and 16. *See* Order No. 9 at 17.

¹² Kyocera contends that the burden is on Koki to prove that the Redesigned Products do not infringe the '718 Patent. *CIB* at 21-23. Koki argues that there is no burden of proof with respect to claim construction and that Kyocera has failed to show that the burden of proof should be placed on Koki. *RRB* at 3-4. Here, the undersigned need not reach the issue of which party bears the burden of proof. Central to this modification proceeding is a claim construction issue, which does not depend on any allocation of burdens. *See Certain Road Constr. Machs.*, Inv. No. 337-TA-1088, Comm'n Op. at 10-11. Moreover, because the facts supporting the infringement determination are not in dispute, the present record demonstrates by a preponderance of the evidence that the Redesigned Products do not infringe, regardless of the allocation of the burden of proof.

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E. Invalidity

Koki asserts that if Kyocera's proposed constructions of the "selecting" term and "wherein" term are adopted, then the claims would be invalid under 35 U.S.C. § 112 for lack of written description because Kyocera's proposed constructions would eliminate the requirement of a "bottom firing mode" in the claims. RIB at 36. As explained above, the undersigned rejected Kyocera's proposed construction for both of those terms. *See supra* at Section IV.B. Thus, Koki's arguments regarding written description are moot.

F. Equitable Estoppel

Koki argues that Kyocera's allegations in this modification proceeding are barred under the doctrine of equitable estoppel based on Koki's reliance on (i) the parties' agreed-upon construction of the "bottom firing mode" term, and (ii) Kyocera's previous argument that the "selecting" step requires the availability of both the "bottom firing mode" and the "restrictive firing mode." RIB at 39. Again, as explained above, the undersigned did not change the construction of "bottom firing mode" and also found that the "selecting" term requires both a bottom firing mode and a restrictive firing mode be available for selecting. *See supra* at Section IV.B. Thus, Koki's arguments regarding equitable estoppel are moot.

V. CONCLUSION


Accordingly, it is the undersigned's recommended determination that the limited exclusion order and cease and desist order be modified so as to not apply to the Redesigned Products, which do not infringe asserted claims 1, 10, or 16 of the '718 Patent. This recommended determination is hereby certified to the Commission.

Within ten days of the date of this document, the parties must jointly submit a statement to Bullock337@usitc.gov stating whether they seek to have any portion of this document redacted from the public version. The parties shall attach to the statement a copy of a joint proposed public version

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of this document indicating with red brackets any portion asserted to contain confidential business information.¹³ To the extent possible, the proposed redacting should be made electronically, in a PDF of the issued order, using the “Redact Tool” within Adobe Acrobat, wherein the proposed redactions are submitted as “marked” but not yet “applied.” The parties’ submission concerning the public version of this document should not be filed with the Commission Secretary.

SO ORDERED.



Charles E. Bullock
Chief Administrative Law Judge

¹³ If the parties submit excessive redactions, they may be required to provide an additional written statement, supported by declarations from individuals with personal knowledge, justifying each proposed redaction and specifically explaining why the information sought to be redacted meets the definition for confidential business information set forth in Commission Rule 201.6(a). 19 C.F.R. § 201.6(a).

PUBLIC CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **Initial Determination** has been served upon the following parties as indicated, on **July 22, 2021**.



Lisa R. Barton, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112
Washington, DC 20436

On Behalf of Complainant Kyocera Senco Brands, Inc.:

Asha Allam, Esq.
ADDUCI, MASTRIANI & SCHAUMBERG, L.L.P.
1133 Connecticut Avenue, N.W., 12th Floor
Washington, DC 20036
Email: allam@adduci.com

- Via Hand Delivery
- Via Express Delivery
- Via First Class Mail
- Other: Email Notification of Availability for Download

On Behalf of Respondents Hitachi Koki U.S. A., Limited:

Paul Devinsky, Esq.
McDERMOTT WILL & EMERY LLP
500 North Capitol Street, NW
Washington, DC 20001
Email: pdevinsky@mwe.com

- Via Hand Delivery
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