

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

In the Matter of

**CERTAIN SEMICONDUCTOR CHIPS WITH
MINIMIZED CHIP PACKAGE SIZE AND
PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-605

**NOTICE OF COMMISSION DECISION TO REQUEST ADDITIONAL BRIEFING ON
REMEDY AND TO EXTEND THE TARGET DATE**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to request additional briefing on remedy and to extend the target date to May 20, 2009, in the above captioned investigation.

FOR FURTHER INFORMATION CONTACT: Megan M. Valentine, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-2301. Copies of non-confidential 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. General information concerning the Commission may also be obtained by accessing its Internet server at <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>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on May 21, 2007, based on a complaint filed by Tessera, Inc. of San Jose, California against Spansion, Inc. and Spansion, LLC, both of Sunnyvale, California; QUALCOMM, Inc. of San Diego, California; AT1 Technologies of Thornhill, Ontario, Canada; Motorola, Inc. of Schaumburg, Illinois ("Motorola"); STMicroelectronics N.V. of Geneva, Switzerland; and Freescale Semiconductor, Inc. of Austin, Texas. *72 Fed. Reg.* 28522 (May 21, 2007). The complaint alleges violations of section 337 in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain semiconductor chips with minimized chip package size or products containing same by reason of infringement of one or more claims of U.S. Patent Nos. 5,852,326, and 6,433,419.

On December 1, 2008, the presiding administrative law judge ("ALJ") issued his final ID

finding no violation of section 337 by Respondents. The ID included the ALJ's recommended determination on remedy and bonding. In his ID, the ALJ found that Respondents' accused products do not infringe the asserted claims the '326 patent or the asserted claims of the '419 patent. The ALJ additionally found that the asserted claims of the '326 and '419 patents are not invalid for failing to satisfy the enablement requirement or the written description requirement of 35 U.S.C. § 112 ¶ 1. The ALJ further found that the asserted claims of the '326 and '419 patents are not invalid as indefinite of 35 U.S.C. § 112 ¶ 2. The ALJ also found that the asserted claims of the '326 and '419 patents are not invalid under 35 U.S.C. § 102 for anticipation or under 35 U.S.C. § 103 for obviousness. Finally, the ALJ found that an industry in the United States exists with respect to the '326 and '419 patents as required by 19 U.S.C. § 1337(a)(2) and (3). In his recommended determination, the ALJ recommended that, should the Commission determine that a violation exists, a limited exclusion order ("LEO") would be properly directed to Respondents' accused chip packages and to the downstream products of Motorola, a named respondent.

On January 30, 2009, the Commission determined to review the final ID in part and requested briefing on the issues it determined to review, remedy, the public interest, and bonding. 74 *Fed. Reg.* 6175-6 (Feb. 5, 2009). The Commission determined to review: 1) the ALJ's finding that Respondents' accused devices do not infringe the asserted claims the '326 and '419 patents; 2) the ALJ's finding that Tessera has waived any argument that the accused products indirectly infringe the '419 patent; 3) the ALJ's finding that Motorola's invention of the 1989 68HC11 OMPAC chip ("OMPAC") does not anticipate the asserted patents under 35 U.S.C. § 102(b); and 4) the ALJ's finding that the Motorola's OMPAC invention does not anticipate the asserted patents under 35 U.S.C. § 102(g). *Id.* The Commission determined not to review the remaining issues decided in the ID.

On February 23, 2009, the parties filed initial written submissions regarding the issues on review, remedy, the public interest, and bonding. On March 5, the parties filed response submissions. Several respondents in co-pending investigation *Certain Semiconductor Chips with Minimized Chip Package Size and Products Containing Same*, Inv. No. 337-TA-649, also filed reply briefs on remedy, the public interest, and bonding. In its initial submission on remedy, Tessera requested that the Commission issue a "tailored" general exclusion order ("GEO") should the Commission determine that there is a violation of Section 337. *See* Complainant Tessera, Inc.'s Brief on the Issues of Remedy, the Public Interest and Bonding (Public Version) (March 5, 2009) ("Tessera Remedy Br.") (available on EDIS). Tessera also requested that, should the Commission determine that the current record is not adequate to support issuance of a GEO, the Commission should issue immediately the LEO recommended by the ALJ and then conduct further proceedings regarding the availability of a tailored GEO. *See* Tessera Remedy Br. at 5-6. The Commission investigative attorney ("IA") concurred. *See* Response of Office of Unfair Import Investigations to Complainant's and Respondents' Briefs on Issues Under Review and on Remedy, the Public Interest, and Bonding (Public Version) (March 16, 2009) (available on EDIS) at 33-34.

The Commission requests additional briefing regarding the appropriateness of Tessera's proposed remedy. Specifically the Commission is particularly interested in responses to the following questions:

1. Please address whether Tessera is entitled to a GEO under 19 U.S.C. § 1337(d)(2).
2. Please address whether the Commission has the authority under the statute to issue a "tailored GEO," which would ostensibly reach only specified downstream products and manufacturers while subjecting a complainant to the additional requirements of 19 U.S.C. § 1337(d)(2).
3. Please address whether the Commission has the authority to issue two different exclusion orders at two different times, specifically whether the Commission can issue an LEO immediately and then issue a GEO at a later date.

The Commission has also determined that the target date be extended to May 20, 2009.

WRITTEN SUBMISSIONS: Parties to the investigation, interested government agencies, and any other interested parties are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should address the questions posed by the Commission above, as well as the recommended determination by the ALJ on remedy and bonding.

The written submissions must be filed no later than close of business on Friday, April 10, 2009. Reply submissions must be filed no later than the close of business on Monday, April 20, 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 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* 19 C.F.R. § 210.6. 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 section 210.42 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.42).

By order of the Commission.

/s/
Marilyn R. Abbott
Secretary to the Commission

Issued: March 26, 2009