

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

In the Matter of

**CERTAIN ROAD MILLING
MACHINES AND COMPONENTS
THEREOF**

**Investigation No. 337-TA-1067
(Remand)**

**NOTICE OF A COMMISSION REQUEST FOR WRITTEN SUBMISSIONS
PURSUANT TO A COURT REMAND**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to request written submissions following a remand from the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit").

FOR FURTHER INFORMATION CONTACT: Michael Liberman, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-3115. Copies of non-confidential documents filed in connection with this investigation may be viewed on the Commission's electronic docket (EDIS) at <https://edis.usitc.gov>. For help accessing EDIS, please email EDIS3Help@usitc.gov. General information concerning the Commission may also be obtained by accessing its Internet server at <http://www.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 August 25, 2017, based on a complaint filed by Wirtgen America, Inc. of Antioch, Tennessee ("Wirtgen" or "Complainant"). 82 FR 40595-96 (Aug. 25, 2017). The complaint alleges a violation of section 337 by reason of infringement of certain claims of U.S. Patent Nos. 7,530,641 ("the '641 patent"); 7,828,309 ("the '309 patent"); 9,624,628 ("the '628 patent"); 9,644,340 ("the '340 patent"); and 9,656,530 ("the '530 patent"). The notice of investigation named Caterpillar Bitelli SpA of Minerbio BO, Italy; Caterpillar Prodotti Stradali S.r.L. of Minerbio BO, Italy; Caterpillar Americas CV of Geneva, Switzerland; Caterpillar Paving Products, Inc. of Minneapolis, Minnesota; and Caterpillar Inc., of Peoria, Illinois (collectively, "Caterpillar," or "Respondents"). The Commission's Office of Unfair Import Investigations was named as a party, but later withdrew from the investigation.

On April 27, 2018, the Commission terminated the investigation as to the '628 patent based on withdrawal of complaint allegations as to that patent. *See* Order No. 30 (Mar. 27, 2018),

unreviewed by Notice (Apr. 27, 2018). On January 18, 2018, the Commission terminated respondent Caterpillar Bitelli SpA based on the withdrawal of the complaint as to that respondent. *See* Order No. 11 (Dec. 19, 2017), *unreviewed by* Notice (Jan. 18, 2018).

On October 1, 2018, the presiding administrative law judge (“ALJ”) issued a final initial determination (“ID”) finding that a violation of section 337 occurred in the importation into the United States, the sale for importation, or the sale within the United States after importation, of certain road milling machines and components thereof that infringed the ’309 and ’530 patents, but found no violation with respect to the ’641 and ’340 patents. *See* ID, Cover.

On April 17, 2019, the Commission determined to review in part the final ID. *See* 84 FR 16882-84 (Apr. 23, 2019). In particular, the Commission determined to review the final ID’s findings and analysis pertaining to the obviousness determinations with regard to claims 26, 35, and 36 of the ’309 patent and, on review, found those claims invalid as obvious under 35 U.S.C. 103. *Id.* at 16883. The Commission affirmed the final ID’s finding that asserted claims 10 and 29 of the ’309 Patent are not invalid. *Id.* at 16883. The Commission determined not to review any of the final ID’s finding relating to the ’340, ’641, and ’530 patents. *See id.*

On July 18, 2019, the Commission found a violation of section 337 as to the ’309 and ’530 patents and determined that the appropriate form of relief in this investigation is: (1) an LEO prohibiting the unlicensed entry of infringing road-milling machines and components thereof covered by one or more of claim 29 of the ’309 patent or claims 2, 5, 16, or 23 of the ’530 patent that are manufactured abroad for or on behalf of, or imported by or on behalf of, any of the Respondents or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns; and (2) CDOs directed against respondents Caterpillar Paving Products, Inc. and Caterpillar Inc., and their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns. *See* 84 FR 35690-91 (Jul. 24, 2019). The Commission determined that the remedial orders “should include an exception for service and repair.” *Comm’n Op.* at 14, 23 (July 18, 2019).

Both Complainant and Respondents timely appealed the Commission’s final determination with the United States Court of Appeals for the Federal Circuit. On October 21, 2019, the Court consolidated the two appeals. *See Caterpillar v. ITC* (2019-1911, -2445), Court Order at 2 (October 21, 2019).

On March 15, 2021, the Court issued a non-precedential decision affirming the Commission’s determination with respect to the ’530 and ’309 patents. *Caterpillar Prodotti Stradali S.R.L. v. International Trade Commission*, 2021 WL 960759 (Fed. Cir. 2021). The Court reversed and vacated the Commission’s finding, adopted from the final ID, that Wirtgen failed to prove the knowledge required for inducement, and remanded as to the ’641 patent for further proceedings. *Id.* at *5. The Court affirmed the Commission’s finding, adopted from the final ID, that Wirtgen had not shown use in the United States of any imported PM300 Series machine in a way that would infringe the asserted claims of the ’641 patent. *Id.* at *6. The Court’s mandate issued on May 6, 2021, returning jurisdiction to the Commission.

Pursuant to the Court’s remand, the Commission requests written submissions from the parties to address the specific further proceedings to be conducted on remand.

WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions regarding what further proceedings must be conducted to comply with the May 6, 2021 judgment of the U.S. Court of Appeals for the Federal Circuit in *Caterpillar Prodotti Stradali S.R.L. v. International Trade Commission*, 2021 WL 960759 (Fed. Cir. 2021).

Written submissions must be filed no later than the close of business on June 17, 2021. Reply submissions must be filed no later than the close of business on June 22, 2021. No further submissions on these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document electronically on or before the deadline stated above. The Commission's paper filing requirements in 19 C.F.R. 210.4(f) are currently waived. 85 FR 15798 (March 19, 2020). Submissions should refer to the investigation number ("Inv. No. 337-TA-1067") in a prominent place on the cover page and/or the first page. (See Handbook for Electronic Filing Procedures, http://www.usitc.gov/secretary/fed_reg_notices/rules/handbook_on_electronic_filing.pdf). Persons with questions regarding filing should contact the Secretary (202-205-2000).

Any person desiring to submit a document to the Commission in confidence must request confidential treatment. All such requests should be directed to the Secretary to the Commission and must include a full statement of the reasons why the Commission should grant such treatment. See 19 CFR 201.6. Documents for which confidential treatment by the Commission is properly sought will be treated accordingly. All information, including confidential business information and documents for which confidential treatment is properly sought, submitted to the Commission for purposes of this Investigation may be disclosed to and used: (i) by the Commission, its employees and Offices, and contract personnel (a) for developing or maintaining the records of this or a related proceeding, or (b) in internal investigations, audits, reviews, and evaluations relating to the programs, personnel, and operations of the Commission including under 5 U.S.C. Appendix 3; or (ii) by U.S. government employees and contract personnel,¹ solely for cybersecurity purposes. All nonconfidential written submissions will be available for public inspection at the Office of the Secretary and on EDIS.

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 Part 210 of the Commission's Rules of Practice and Procedure (19 CFR part 210).

By order of the Commission.



Lisa R. Barton
Secretary to the Commission

Issued: June 7, 2021

¹ All contract personnel will sign appropriate nondisclosure agreements.