

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN ROAD MILLING
MACHINES AND COMPONENTS
THEREOF**

Investigation No. 337-TA-1067

**ISSUANCE OF A LIMITED EXCLUSION ORDER AND TWO CEASE
AND DESIST ORDERS; TERMINATION OF INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to issue: (1) a limited exclusion order (“LEO”) prohibiting the unlicensed entry of infringing road-milling machines and components thereof covered by one or more of claim 29 of U.S. Patent No. 7,828,309 (“the ’309 patent”) or claims 2, 5, 16, or 23 of U.S. Patent No. 9,656,530 (“the ’530 patent”) that are manufactured abroad for or on behalf of, or imported by or on behalf of, any of Caterpillar Prodotti Stradali S.r.L. of Minerbio, Italy; Caterpillar Americas CV of Geneva, Switzerland; Caterpillar Paving Products, Inc. of Minneapolis, MN; and Caterpillar Inc. of Peoria, IL (“Caterpillar,” or “Respondents”) or any of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns; and (2) a cease and desist order (“CDO”) 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. The Commission has terminated this investigation.

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 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 <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission’s electronic docket (EDIS) at <https://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 under section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 (“section 337”), on August

25, 2017, based on a complaint filed by Wirtgen America, Inc. of Antioch, Tennessee (“Wirtgen”). 82 FR 40596-97 (Aug. 25, 2017). The complaint alleges a violation of section 337 by reason of infringement of certain claims of U.S. Patent Nos. 9,644,340 (“the ‘340 patent”); 9,624,628 (“the ‘628 patent”); 7,530,641 (“the ‘641 patent”); and the ‘309 and ‘530 patents. The complaint named Caterpillar Bitelli SpA of Minerbio, Italy (“Caterpillar Bitelli”) and Caterpillar as respondents. *Id.* at 40596. The Commission’s Office of Unfair Import Investigations was named as a party, but later withdrew from the investigation. Subsequently, the investigation was terminated as to respondent Caterpillar Bitelli. ALJ Order No. 11 dated December 19, 2017 (*unreviewed* January 18, 2018). The investigation was also terminated with respect to the ‘628 patent. ALJ Order No. 30 dated March 27, 2018 (*unreviewed* April 27, 2018).

The evidentiary hearing on the question of violation of section 337 was held April 20-24, 2018. The ALJ issued a final ID on violation on October 1, 2018. The ALJ found that a violation of section 337 has occurred in this investigation with respect to the ‘530 and ‘309 patents, and no violation of section 337 has occurred with respect to the ‘641 and ‘340 patent. The ALJ issued his recommended determination on remedy, the public interest and bonding on October 18, 2018. The ALJ recommended that if the Commission finds a violation of section 337 in the present investigation, the Commission should: (1) issue an LEO covering products that infringe the patent claims as to which a violation of section 337 has been found; (2) issue a CDO; and (3) require no bond during the period of Presidential review.

Both parties to the investigation filed timely petitions for review of various portions of the final ID, as well as timely responses to the petitions. The parties also timely filed their respective public interest statements pursuant to 19 CFR 210.50(a)(4). Responses from public were likewise received by the Commission pursuant to notice. 83 FR 53296-97 (Oct. 22, 2018).

On April 17, 2019, the Commission issued a notice in which it determined to review-in-part the final ID. *See* 84 FR 16882-84 (Apr. 23, 2019). In its notice, the Commission determined not to review any issues relating to the ‘340, ‘641, and ‘530 patents and reversed the finding of no invalidity as to claim 36 of the ‘309 patent. *See* 84 FR 16882-84 (Apr. 23, 2019). The Commission requested written submissions on remedy, the public interest, and bonding. *Id.* at 1683. On May 8, 2019, Wirtgen and Caterpillar filed their opening briefs in response to the notice, and on May 15 – their responsive briefs. No other submissions were received by the Commission.

Having examined the record in this investigation, including the parties’ submissions on remedy, the public interest, and bonding filed in response to the Commission Notice, the Commission has 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) a CDO directed against Caterpillar Paving Products, Inc. and Caterpillar Inc., and their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns.

The Commission has further determined that the public interest factors enumerated in subsections (d)(1) and (f)(1) (19 U.S.C. §§ 1337(d)(1), (f)(1)) do not preclude issuance of the above-referenced remedial orders. Additionally, the Commission has determined to impose a bond of fourteen (14) percent of entered value of the covered products during the period of Presidential review (19 U.S.C. § 1337(j)). The investigation is terminated.

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.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', written in a cursive style.

Lisa R. Barton
Secretary to the Commission

Issued: July 18, 2019