

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

In the Matter of

**CERTAIN ROAD CONSTRUCTION
MACHINES AND COMPONENTS
THEREOF**

**Investigation No. 337-TA-1088
(Rescission)**

**NOTICE OF COMMISSION DECISION TO INSTITUTE A RESCISSION
PROCEEDING; PERMANENT RESCISSION OF A SEIZURE AND FORFEITURE
ORDER; TERMINATION OF THE RESCISSION PROCEEDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to institute a proceeding to determine whether to permanently rescind the Commission's seizure and forfeiture order ("SFO") of January 14, 2020 (corrected January 23, 2020) issued against Wirtgen America, Inc. ("Wirtgen America"). The SFO is permanently rescinded. The rescission proceeding is terminated.

FOR FURTHER INFORMATION CONTACT: Houda Morad, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW, Washington, DC 20436, telephone (202) 708-4716. 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 <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 on November 29, 2017, based on a complaint, as supplemented, filed by Caterpillar Inc. of Peoria, Illinois and Caterpillar Paving Products, Inc. of Minneapolis, Minnesota (collectively, "Caterpillar"). See 82FR 56625-26 (Nov. 29, 2017). The complaint, as supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337) ("section 337"), based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain road construction machines and components thereof by reason of infringement of certain claims of U.S. Patent Nos. 7,140,693 ("the '693 patent"); 9,045,871; and 7,641,419. See *id.* The notice of investigation identifies the following respondents: Wirtgen GmbH of Windhagen, Germany; Joseph Vögele AG of Ludwigshafen,

Germany; Wirtgen Group Holding GmbH of Windhagen, Germany; and Wirtgen America of Antioch, Tennessee (collectively, “Wirtgen”). *See id.* The Office of Unfair Import Investigations is not a party to this investigation. *See id.*

On June 27, 2019, the Commission found a violation of section 337 in the above-identified investigation based on the infringement of claim 19 of the ’693 patent and issued a limited exclusion order against the infringing articles and a cease and desist order (collectively, “the remedial orders”) against Wirtgen America. The United States Customs and Border Protection (“Customs”) subsequently excluded six Wirtgen redesigned series 1810 machines in December 2019. Based on such exclusion, the Commission issued the subject SFO on January 14, 2020 (corrected January 23, 2020). On March 13, 2020, Wirtgen filed an appeal from the SFO (“the SFO appeal”) to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”).

On January 30, 2020, Wirtgen filed a civil action against Customs and related U.S. government parties (collectively, “the U.S. government”) in the U.S. Court of International Trade (“CIT”) under 28 U.S.C. 1581(a) and (i). The Commission moved to intervene to contest the CIT’s exercise of jurisdiction, and the CIT denied the Commission’s motion. The CIT exercised jurisdiction under section 1581(a) over the U.S. government’s objections and granted summary judgment for Wirtgen as to the excluded entries of the redesigned machines at issue. The CIT also ordered Customs to release the machines for entry into the United States no later than Thursday, May 21, 2020. On July 14, 2020, the U.S. government appealed the CIT’s decision to the Federal Circuit (“the CIT appeal”).

On May 21, 2020, arguing that the predicate for the SFO had been invalidated by the CIT, Wirtgen filed an emergency motion to stay or temporarily rescind the SFO pending resolution of any CIT appeal. On June 10, 2020, the Commission determined to deny Wirtgen’s motion to stay, but granted Wirtgen’s motion for temporary rescission of the SFO, thus temporarily suspending the SFO until such time as the CIT’s decision is modified, stayed, or overturned. On June 15, 2020, the Commission filed a motion to stay the SFO appeal pending reinstatement of the SFO by the Commission or resolution of any CIT appeal by the Federal Circuit. On July 29, 2020, the Federal Circuit granted the Commission’s motion to stay the SFO appeal until the suspension of the SFO is lifted or until final disposition of the CIT appeal.

Concurrently, on January 16, 2020, the Commission instituted a modification proceeding to determine whether Wirtgen’s redesigned series 1810 machines infringe claim 19 of the ’693 patent. On August 31, 2020, the Commission determined that Wirtgen’s redesigned machines do not infringe and issued modified remedial orders exempting the redesigned machines from the scope of the orders. Caterpillar did not appeal the Commission’s non-infringement determination to the Federal Circuit, and therefore, the Commission’s non-infringement determination is now final. Consequently, on November 5, 2020, the U.S. government moved to dismiss the CIT appeal. On December 4, 2020, the Federal Circuit dismissed the CIT appeal.

In view of the Federal Circuit’s dismissal of the CIT appeal, the Commission has determined to institute a rescission proceeding and to permanently rescind the SFO. The rescission proceeding is hereby terminated.

The Commission's vote for this determination took place on December 7, 2020.

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: December 7, 2020