

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

**In the Matter of**

**CERTAIN CARTRIDGES FOR  
ELECTRONIC NICOTINE DELIVERY  
SYSTEMS AND COMPONENTS THEREOF**

**Investigation No. 337-TA-1141**

**NOTICE OF A COMMISSION DETERMINATION TO REVIEW IN PART AN INITIAL  
DETERMINATION (ORDER NO. 39) GRANTING A MOTION TO PARTIALLY  
TERMINATE THE INVESTIGATION BY WITHDRAWING CERTAIN PATENT  
CLAIMS**

**AGENCY:** U.S. International Trade Commission.

**ACTION:** Notice.

**SUMMARY:** Notice is hereby given that the U.S. International Trade Commission (the “Commission”) has determined to review in part an initial determination (“ID”) (Order No. 39) to partially terminate the investigation by withdrawing certain patent claims.

**FOR FURTHER INFORMATION CONTACT:** Carl P. Bretscher, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW, Washington, DC 20436, telephone (202) 205-2382. 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 SW, Washington, DC 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server (<https://www.usitc.gov>). The public record for this investigation may be viewed on the Commission’s Electronic Docket Information System (“EDIS”) (<https://edis.usitc.gov>). Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission’s TDD terminal, telephone (202) 205-1810.

**SUPPLEMENTARY INFORMATION:** On December 27, 2018, the Commission instituted the present investigation based on a complaint filed by Juul Labs, Inc. (“Juul”) of San Francisco, California. 83 FR 66746-747 (Dec. 27, 2018). The complaint alleges a violation of 19 U.S.C. 1337, as amended (“Section 337”), in the importation, sale for importation, and sale in the United States after importation of certain cartridges used in electronic nicotine delivery systems and components thereof that allegedly infringe one or more of the asserted claims of U.S. Patent Nos. 10,058,129 (“the ’129 patent”); 10,104,915 (“the ’915 patent”); 10,111,470 (“the ’470 patent”); 10,117,465 (“the ’465 patent”); and 10,117,466 (“the ’466 patent”). *Id.* The complaint also alleges the existence of a domestic industry. *Id.* The notice of investigate named 23 respondents. *Id.* The Office of Unfair Import Investigations (“OUII”) was also named as a party. *Id.*

The Commission has since found four respondents to be in default (“the Defaulting Respondents”). Order No. 26 (May 3, 2019), *not rev’d*, Comm’n Notice (May 31, 2019). The Commission also partially terminated the investigation with respect to certain other respondents due to settlement agreements or consent orders. *See, e.g.*, Order No. 34 (June 14, 2019), *not rev’d*, Comm’n Notice (July 10, 2019); Order No. 30 (May 15, 2019), *not rev’d*, Comm’n Notice (June 12, 2019); Order No. 25 (April 18, 2019), *not rev’d*, Comm’n Notice (May 15, 2019); Order Nos. 19-21 (April 10, 2019), *not rev’d*, Comm’n Notice (May 7, 2019); Order Nos. 15, 16 (March 12, 2019), *not rev’d*, Comm’n Notice (Mar. 26, 2019); Order Nos. 13, 14 (Feb. 28, 2019), *not rev’d*, Comm’n Notice (Mar. 26, 2019).

As a result, nine of the 23 respondents originally named in the notice of investigation remain actively involved in the investigation at this time: Shenzhen Yibo Tech. Co. of Shenzhen City, China; Ziip Lab Co. of Shenzhen City, China; Ziip Lab S.A. of Maldonado, Uruguay; Maduro Distributors, Inc. (“Maduro”) of Maplewood, MN; Twist Vapor Franchising LLC of Tampa, Florida; Vape4U LLC of Montclair, California; Vaperz LLC (“Vaperz”) of Frankfurt, Illinois; Vaportronix, LLC (“Vaportronix”) of Aventura, Florida; and Vapor 4 Life Holdings, Inc. of Northbrook, Illinois (collectively, the “Active Respondents”). *See* 83 FR 66746-47.

On August 14, 2019, the presiding administrative law judge (“ALJ”) issued an ID (Order No. 38) entering summary determination that: (1) the importation requirement has been satisfied for each accused product; (2) the accused products infringe, directly or indirectly, each of the asserted claims of the ’129, ’915, ’470, ’465, and ’466 patents, with the exception that Vaperz’s JC01 cartridge infringes only the ’915 patent and Maduro is not accused of infringing the ’129 patent; and (3) Juul has satisfied the domestic industry requirement with respect to each asserted patent. Order No. 38 at 26-28. No party petitioned for review of Order No. 38. On September 16, 2019, the Commission issued a notice of its determination not to review Order No. 38. Comm’n Notice (Sept. 16, 2019) (*not reviewing* Order No. 38).

On August 26, 2019, Juul filed a motion to partially terminate the investigation by withdrawing asserted claims 2, 5, 6, 8, 13, 16-20, and 22 of the ’129 patent; claims 2, 3, 5, 6, and 9-19 of the ’465 patent; claims 4-8, 12, 14, 16, 17, 19, and 21-23 of the ’466 patent; claims 2-4, 7, and 11 of the ’470 patent; and all of the asserted claims of the ’915 patent against the Active Respondents but not the Defaulting Respondents. On August 28, 2019, OUII filed a response in support of Juul’s motion. No other responses were filed.

On September 11, 2019, the ALJ issued the subject ID (Order No. 39) granting Juul’s motion to partially terminate the investigation by withdrawing the aforementioned patent claims against the Active Respondents. ID at 1-2. The ID finds that: (i) Juul’s motion complies with 19 CFR 210.21(a)(1) regarding partial termination of an investigation; (ii) there are no extraordinary circumstances that would prevent termination of the subject claims; and (iii) the motion is supported by OUII. *Id.* at 2.

The ID also finds that by withdrawing the specified claims against the Active Respondents, the ID “effectively vacates the findings of Order No. 38 [*i.e.*, the previous entry of summary determination of importation, infringement, and domestic industry] with respect to the claims that have been withdrawn.” *See id.* at 2-3 n. 3. According to the ID, the following claims remain asserted against the Active Respondents: claims 1, 3, 7, and 12 of the ’129 patent; claims

1, 4, 7, and 20 of the '465 patent; claims 1, 10, 18, and 20 of the '466 patent; and claims 1, 8, and 10 of the '470 patent. *Id.* at 2-3. No party filed a petition to review the subject ID.

The Commission has determined to review the subject ID in part with respect to the ID's finding that Order No. 39 effectively vacates Order No. 38's entry of summary determination of importation, infringement, and domestic industry with respect to the withdrawn claims. *See* Order No. 39 at 2-3 n.3. Order No. 38 has already become the determination of the Commission by virtue of the Commission's decision not to review Order No. 38. *See* 19 CFR 210.42(h). Accordingly, the Commission strikes footnote 3 of Order No. 39. The Commission's review does not affect any other findings in Order No. 39, including the withdrawal of the claims specified therein or the remaining claims that, at this time, are still being asserted against the Active Respondents.

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: October 4, 2019