

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

In the Matter of)
)
CERTAIN ENCAPSULATED)
INTEGRATED CIRCUIT DEVICES AND)
PRODUCTS CONTAINING SAME)
)
)

Inv. No. 337-TA-501

NOTICE OF COMMISSION FINAL DETERMINATION OF NO VIOLATION OF SECTION 337; 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 that there is no violation of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), in the above-captioned investigation. The Commission has terminated the investigation.

FOR FURTHER INFORMATION CONTACT: Michael Liberman, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone 202-205-3112. 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 (<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 under section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337 ("section 337"), on December 19, 2003, based on a complaint filed by Amkor Technology, Inc. ("Amkor") alleging a violation of section 337 in the importation, sale for importation, and sale within the United States after importation of certain encapsulated integrated circuit devices and products containing same in connection with several claims of three patents owned by Amkor, *i.e.*, U.S. Patent Nos. 6,433,277 ("the '277 patent"); 6,630,728 ("the '728 patent"); and 6,455,356 ("the '356 patent"). The complainant

named Carsem (M) Sdn Bhd; Carsem Semiconductor Sdn Bhd; and Carsem, Inc. (collectively, “Carsem”) as respondents.

On November 18, 2004, the ALJ issued a final initial determination (“Final ID”) finding no violation of section 337, as well as a recommended determination on remedy and bond. After reviewing the Final ID in its entirety, the Commission on March 31, 2005, modified the ALJ’s claim construction and remanded the investigation to the ALJ with instructions “to conduct further proceedings and make any new findings or changes to his original findings that are necessitated by the Commission’s new claim construction.” Commission Order ¶ 8 (March 31, 2005). On November 9, 2005, the ALJ issued a remand initial determination (“Remand ID”), in which he found a violation of section 337 with regard to six claims of one asserted patent, but found no violation in connection with the claims of the two other asserted patents.

Completion of this investigation has been delayed because of difficulty in obtaining from third-party ASAT, Inc. (“ASAT”) certain documents that Carsem asserted were critical for its affirmative defenses. The Commission’s efforts to enforce a February 11, 2004, subpoena *duces tecum* and *ad testificandum* directed to ASAT resulted in a July 1, 2008, order and opinion of the U.S. District Court for the District of Columbia granting the Commission’s second enforcement petition.

On July 1, 2009, after ASAT had complied with the subpoena, the Commission issued a notice and order remanding this investigation to the ALJ to consider the ASAT documents and extending the target date for completion of this investigation. On September 10-11, 2009, a hearing was held to address Carsem’s invalidity defenses based on the ASAT documents. On October 30, 2009, the ALJ issued a supplemental ID (“First Supplemental ID”) reaffirming his finding of a violation of section 337.

On December 16, 2009, the Commission issued a notice of its decision to review the First Supplemental ID. On February 18, 2010, the Commission issued a Notice and Order reversing the ALJ’s finding that ASAT’s invention is not prior art to Amkor’s asserted patents, and remanding the investigation to the ALJ to make necessary findings in light of the Commission’s determination. In order to allow sufficient time to complete the investigation, the Commission extended the target date for completion of the investigation to July 20, 2010, and directed the ALJ to issue his findings by March 22, 2010.

On February 24, 2010, Amkor filed a petition for clarification (and in the alternative reconsideration) of the Commission’s February 18, 2010, Notice and Order. On March 3, 2010, and March 8, 2010, respectively, the IA and Carsem filed responses opposing Amkor’s request. On March 9, 2010, Amkor filed a motion to strike Carsem’s opposition to Amkor’s petition for clarification, alleging it was untimely. On March 11, 2010, Carsem opposed Amkor’s motion to strike.

On March 22, 2010, the ALJ issued a Supplemental ID (“Second Supplemental ID”) in which he found that the ‘277 and ‘728 patents were invalid in view of ASAT prior art and

determined that there was no violation of Section 337 in the present investigation.

Amkor and Carsem filed their initial comments seeking review of various portions of the Second Supplemental ID. Carsem's request for review is conditioned on the Commission's decision to review the Second Supplemental ID. All the parties also filed their timely response comments.

The Commission has examined the record in this investigation, including the ALJ's Remand ID and Second Supplemental ID. The Remand ID found that a violation of Section 337 had occurred with respect to certain claims of the '277 patent, but not with respect to the '728 or '356 patents. Remand ID at 111-113. More specifically, the Remand ID found that: (1) Carsem infringed the asserted claims of the '277 patent, Amkor practiced claim 21 of the '277 patent, and claims 2, 3, 4, 21, 22, and 23 of the '277 patent had not been shown to be invalid; (2) Carsem infringed claims 1, 2, and 7 of the '728 patent but did not infringe claims 3, 4, and 8 of the same patent, Amkor practiced claim 1 of the '728 patent, and all of the asserted claims of the '728 patent had been shown to be invalid; and (3) Carsem did not infringe the asserted claims of the '356 patent, Amkor did not practice claim 13 of the '356 patent, and none of the asserted claims of the '356 patent had been shown to be invalid. *Id.*

The ALJ's Second Supplemental ID found that: (1) claims 21-23 of the '277 patent are invalid as anticipated by the ASAT invention; (2) claims 1-4, 7, 17, 18, and 20 of the '277 patent, as well as claims 1-4, 7, and 8 of the '728 patent, are invalid as obvious in view of various combinations of the prior art references involving the ASAT invention; and (3) the asserted claims of the '356 patent are not invalid in view of the ASAT invention. Second Supplemental ID at 37. As a result of these findings, the Second Supplemental ID "modif[ied] the Initial Determination in the 2005 Remand ID to find no violation of Section 337 of the Tariff Act of 1930, as amended, in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain encapsulated integrated circuit devices and products contains same in connection with claims 1-4, 7, 17, 18, 20, 21-23 of the U.S. Patent No. 6,433,277, claims 1-4, 7, and 8 of U.S. Patent No. 6,630,728 and claims 1, 2, 13 and 14 of U.S. Patent No. 6,455,356." Second Supplemental ID at 38.

The Commission has examined the parties' respective comments and responses thereto, and has determined not to review the findings made in the Remand ID and in the Second Supplemental ID. As a result, the Commission has determined that there is no violation of section 337 in this investigation. The Commission has also denied Amkor's request for clarification and motion to strike. The Commission has terminated the investigation, and an opinion supporting the Commission's determination will be issued.

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 sections 210.41-.42, 210.50 of the Commission's Rules of Practice and Procedure (19 CFR § 210.41-.42, 210.50).

By order of the Commission.

/s/

William R. Bishop
Acting Secretary to the Commission

Issued: July 20, 2010