

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

In the Matter of

**CERTAIN ENCAPSULATED
INTEGRATED CIRCUIT DEVICES AND
PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-501

ORDER

The Commission instituted this investigation on December 19, 2003, based on a complaint filed by Amkor Technology, Inc. (“Amkor”) against Carsem (M) Sdn Bhd; Carsem Semiconductor Sdn Bhd; and Carsem, Inc. (collectively, “Carsem”). 68 *Fed. Reg.* 70836 (December 19, 2003). The complaint alleges violations of section 337 of the Tariff Act of 1930, 19 U.S.C. § 1337, in the importation, sale for importation, and sale within the United States after importation of certain encapsulated integrated circuit devices and products containing same by reason of infringement of certain claims of U.S. Patent Nos. 6,433,277; 6,630,728; and 6,455,356.

On November 18, 2004, the presiding administrative law judge (“ALJ”) issued a final initial determination (“ID”) in which he found that there was no violation of section 337. All parties to the investigation, including the Commission investigative attorney, filed petitions for review of various portions

of the final ID. On February 1, 2005, the Commission determined to review the final ID in its entirety. 70 *Fed. Reg.* 6454 (February 7, 2005).

On March 31, 2005, the Commission remanded the investigation to the ALJ for additional proceedings and findings in light of various claim construction determinations with regard to certain patent claims which were the subject of Commission review. Commission Order of March 31, 2005 (“Commission Order”); 70 *Fed. Reg.* 17468 (April 6, 2005). The Commission also directed the ALJ to reopen the evidentiary record to receive, and make findings based on, evidence concerning Carsem’s affirmative defenses that might become available after the U.S. Court Appeals for the District of Columbia Circuit ruled in *U.S. International Trade Commission v. ASAT, Inc.* (Appeal No. 05-5009) .

Commission Order, Para. 9. In that appeal, a non-party to the Commission’s investigation, ASAT, Inc., sought review of the December 1, 2004, order of the U.S. District Court for the District of Columbia enforcing the Commission’s subpoena seeking certain documents for use in that investigation. Specifically, ASAT, Inc. challenged enforcement on the grounds that the district court lacked subject matter and personal jurisdiction and was not the proper venue.

Alternatively, ASAT, Inc. argued that the district court erred in refusing to review whether ASAT, Inc. controlled the subpoenaed documents, which were in the possession of its foreign parent/affiliate companies, ASAT Holdings Ltd. and ASAT Limited.

The Commission directed the ALJ to issue his remand determination “within three (3) months after the U.S. Court of Appeals for the D.C. Circuit rules in the *ASAT* appeal” and extended the target date for completion of the investigation by seven months and twenty-one days, *i.e.*, until November 21, 2005. Commission Order, Paras. 11 and 13.

On June 10, 2005, the Court of Appeals issued its decision in Appeal No. 05-5009. The Court agreed with the Commission that the U.S. District Court for the District of Columbia had subject matter jurisdiction over the enforcement proceeding, was the proper venue for that proceeding, and had personal jurisdiction (via nationwide service of process) over ASAT, Inc. However, the Court found that the findings of the ALJ and the record were insufficient to support the conclusion that ASAT, Inc. had control of the subpoenaed documents, which were in the possession of its foreign parent/affiliate companies, ASAT Holdings and ASAT Limited. The Court therefore reversed the enforcement order of the district court. The Court left open the possibility of further proceedings before the ALJ to receive further evidence and make further findings on the issue of control by ASAT, Inc. to support a second enforcement petition, as well as the possibility of issuance of letters of request under the Hague Evidence Convention to ASAT Holdings and ASAT Limited.

On June 29, 2005, Amkor filed a letter directed to the Chairman of the Commission arguing for an end to any further proceedings with respect to the

Commission's subpoena to ASAT, Inc. On July 1, 2005, Carsem filed a motion for leave to reopen the record to permit evidence and briefing regarding ASAT, Inc.'s control over the documents in the possession of ASAT Holdings and ASAT Limited. In its motion, Carsem indicated that no further discovery would be necessary with respect to this question. On July 14, 2005, Amkor filed an opposition to Carsem's motion for leave to reopen the record. On that same day, the Commission investigative attorney filed a response in support of Carsem's motion. On July 18, 2005, Carsem filed a motion for leave to file a reply to Amkor's opposition, accompanied by a proposed reply.

Having reviewed the June 10, 2005, opinion of the U.S. Court of Appeals for the District of Columbia Circuit in *U.S. International Trade Commission v. ASAT, Inc.*, Appeal No. 05-5009, the submissions of the parties, and other relevant papers of record in this investigation, the Commission hereby **ORDERS THAT:**

1. The matter of the Commission's subpoena to ASAT, Inc. in this investigation is remanded to the ALJ to receive additional evidence and to make further findings (consistent with the June 10, 2005, opinion of the U.S. Court of Appeals for the District of Columbia Circuit in *U.S. International Trade Commission v. ASAT, Inc.*, Appeal No. 05-5009) on the question of whether ASAT, Inc. has the requisite control of the subpoenaed documents.

2. The ALJ will complete his proceedings with respect to whether ASAT, Inc. has control over the subpoenaed documents by September 9, 2005. If the ALJ concludes that Carsem has demonstrated that ASAT, Inc. has the requisite control over the subpoenaed documents, he will make the requisite findings on the record before him and certify his findings and the supporting record to the Commission no later than September 9, 2005. The Commission will then determine whether to proceed with a new enforcement petition in the district court.

3. The ALJ shall reopen the record to admit any new evidence that is obtained as a result of the Commission's subpoena (and any enforcement thereof) and make any necessary findings concerning Carsem's affirmative defenses based on that evidence.

4. The ALJ shall issue his final initial determination in this investigation no later than November 9, 2005. The target date for completion of this investigation is hereby extended to February 9, 2006.

5. Carsem's July 1, 2005, motion for leave to reopen the record is granted to the extent indicated above. Carsem's July 18, 2005, motion for leave to file a reply is granted.

6. The Secretary shall serve a copy of this Order upon each party to the investigation and upon ASAT, Inc.

By order of the Commission.

Marilyn R. Abbott
Secretary to the Commission

Issued: July 26, 2005