

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

In the Matter of

**CERTAIN PROBE CARD ASSEMBLIES,
COMPONENTS THEREOF AND CERTAIN
TESTED DRAM AND NAND FLASH
MEMORY DEVICES AND PRODUCTS
CONTAINING SAME**

Investigation No. 337-TA-621

**NOTICE OF COMMISSION DETERMINATION TO REVIEW A FINAL INITIAL
DETERMINATION IN PART AND SET A SCHEDULE FOR FILING WRITTEN
SUBMISSIONS ON THE ISSUES UNDER REVIEW AND ON REMEDY, THE PUBLIC
INTEREST, AND BONDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to review in part the final initial determination (“ID”) issued by the presiding administrative law judge (“ALJ”) on June 29, 2009, in the above-captioned investigation.

FOR FURTHER INFORMATION CONTACT: Michael Liberman, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, SW, Washington, D.C. 20436, telephone (202) 205-3116. 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, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <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: This investigation was instituted on December 19, 2007, based on a complaint filed by FormFactor, Inc. (“FormFactor”) of Livermore, California. The complaint alleged violations of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain probe card assemblies, components thereof, and certain tested DRAM and NAND flash memory devices and products containing same by reason of

infringement of certain claims of U.S. Patent Nos. 5,994,152; 6,509,751 (“the ‘751 patent”); 6,615,485; 6,624,648 (“the ‘648” patent); 7,168,162 (“the ‘162 patent”); and 7,225,538. The complaint named Micronics Japan Co., Ltd.; MJC Electronics Corp.; Phicom Corporation; and Phiam Corporation as respondents (collectively, “Respondents”). Subsequently, the ‘162 patent was terminated from the investigation.

On December 5, 2008, respondents Phicom Corp. and Phiam Corp., (collectively, “Phicom”) jointly filed a motion for partial summary determination that claims 20 and 34 of the ‘648 patent are invalid as indefinite under 35 U.S.C. § 112. On February 11, 2009, the ALJ issued an ID by Order No. 46. The subject ID states that “Phicom’s motion . . . for summary determination that the ‘648 patent is invalid is . . . granted.” The ID determines that claims 20 and 34, and any asserted claims depending therefrom, are invalid. Complainant FormFactor filed a petition for review of Order No. 46, which Respondents and the Commission investigative attorney oppose. On March 11, 2009, the Commission determined to review Order No.46.

The evidentiary hearing in this investigation was held from February 24, 2009 through March 6, 2009. On June 29, 2009, the ALJ issued an Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond, finding no violation of section 337. All parties to this investigation, including the Commission investigative attorney, filed timely petitions for review of various portions of the final ID, as well as timely responses to the petitions.

Having examined the record in this investigation, including the ALJ’s final ID, the petitions for review, and the responses thereto, the Commission has determined to review the ID in part. In particular, the Commission has determined to review: (1) the ID’s finding that Japanese Patent Application Publication H10-31034 to Amamiya et al. (“Amamiya” or RX-166) does not anticipate the asserted claims of the ‘751 patent under 35 U.S.C. § 102; (2) the ID’s conclusion of law regarding non-infringement of the ‘751 patent by Phicom’s accused products; (3) the ID’s conclusion that no analysis of the validity of the asserted claims that depend from claim 21 of the ‘152 patent is needed. The Commission has determined not to review the remainder of the final ID.

On review, the Commission requests the parties to brief their positions on the issues under review with reference to the applicable law and the evidentiary record. The Commission is particularly interested in responses to the following questions:

- (1) With respect to the ‘751 patent:
 - (a) What, if any, limitations are missing from the Amamiya reference such that it does not render the asserted claims of the ‘751 patent invalid as anticipated?

(b) Is there support for the Commission investigative attorney's and Phicom's argument that Amamiya anticipates the asserted claims of the '751 patent, *inter alia*, by inherency? In answering this question, address paragraphs 0012 and 0013 on p. 6/8 of Amamiya.

(c) Is the ID's conclusion that there has been no violation of section 337 with respect to the '751 patent supported by its own findings?

(2) With respect to the '152 patent:

(a) Is the ID's statement that "no analysis of the invalidity arguments related to anticipation and obviousness of the dependent claims will be made," ID at 191, consistent with the proper analysis under patent law? If not, what, if any, impact would such an error have on the ID's validity and infringement analyses as to the '152 patent?

In connection with the final disposition of this investigation, the Commission may (1) issue an order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) issue one or more cease and desist orders that could result in the respondent being required to cease and desist from engaging in unfair acts in the importation and sale of such articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry either are adversely affecting it or are likely to do so. For background, see *In the Matter of Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337-TA-360, USITC Pub. No. 2843 (Dec. 1994) (Commission Opinion).

If the Commission contemplates some form of remedy, it must consider the effects of that remedy upon the public interest. The factors the Commission will consider include the effect that an exclusion order and/or cease and desist orders would have on (1) the public health and welfare, (2) competitive conditions in the U.S. economy, (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation, and (4) U.S. consumers. The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

If the Commission orders some form of remedy, the U.S. Trade Representative, as delegated by the President, has 60 days to approve or disapprove the Commission's action. See Presidential Memorandum of July 21, 2005. 70 *Fed. Reg.* 43251 (July 26, 2005). During this period, the subject articles would be entitled to enter the United States under bond, in an amount determined by the Commission. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed.

WRITTEN SUBMISSIONS: The parties to the investigation are requested to file written submissions on the issues under review. The submissions should be concise and thoroughly referenced to the record in this investigation. Parties to the investigation, interested government

agencies, and any other interested parties are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Such submissions should address the recommended determination by the ALJ on remedy and bonding. Complainant and the Commission investigative attorney are also requested to submit proposed remedial orders for the Commission's consideration. Complainant is further requested to provide the expiration date of the '751 patent and state the HTSUS number under which the accused articles are imported. The written submissions and proposed remedial orders must be filed no later than the close of business on September 25, 2009. Reply submissions must be filed no later than the close of business on October 2, 2009. No further submissions on these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document and 12 true copies thereof on or before the deadlines stated above with the Office of the Secretary. Any person desiring to submit a document (or portion thereof) to the Commission in confidence must request confidential treatment unless the information has already been granted such treatment during the proceedings. All such requests should be directed to the Secretary of the Commission and must include a full statement of the reasons why the Commission should grant such treatment. *See* section 201.6 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 201.6. Documents for which confidential treatment by the Commission is sought will be treated accordingly. All nonconfidential written submissions will be available for public inspection at the Office of the Secretary.

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 sections 210.42-.46 of the Commission's Rules of Practice and Procedure (19 C.F.R. §§ 210.42-.46).

By order of the Commission.
Marilyn R. Abbott, Secretary to the Commission

/s/
William R. Bishop
Acting Secretary to the Commission

Issued: September 14, 2009