

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN TWO-WAY GLOBAL
SATELLITE COMMUNICATION
DEVICES, SYSTEM AND
COMPONENTS THEREOF**

**Investigation No. 337-TA-854
(Modification) (Remand)**

**NOTICE OF REQUEST FOR WRITTEN SUBMISSIONS FOLLOWING REMAND
FROM THE U.S. COURT OF APPEALS FOR THE FEDERAL CIRCUIT**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission is requesting written submissions from the parties following remand in *DBN Holding, Inc. v. ITC*, -- Fed.Appx. --, 2018 WL 6181653 (Fed. Cir. Nov. 27, 2018) (“*DBN Holding*”).

FOR FURTHER INFORMATION CONTACT: Clint Gerdine, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, SW., Washington, D.C. 20436, telephone (202) 708-2310. 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 <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 Inv. No. 337-TA-854 (Enforcement Proceeding) on May 24, 2013, based on an enforcement complaint filed on behalf of BriarTek IP, Inc. of Alexandria, Virginia. 78 Fed. Reg. 31576-77 (May 24, 2013). The complaint alleged violations of the April 5, 2013, consent order (“the Consent Order”) issued in the underlying investigation by the continued practice of prohibited activities such as selling or offering for sale within the United States after importation any two-way global satellite communication devices, system, or components thereof that infringe one or more claims of U.S. Patent No. 7,991,380 (“the ’380 patent”). The Commission’s notice of institution of enforcement proceeding named DeLorme Publishing Company, Inc. and DeLorme InReach LLC (collectively, “DeLorme”), but now known as DBN Holding, Inc. and BDN LLC, all of

Yarmouth, Maine, as respondents. The Office of Unfair Import Investigations was also a party to the enforcement proceeding. *Id.*

On June 10, 2014, following review of the presiding administrative law judge's enforcement initial determination in the enforcement proceeding, the Commission issued a civil penalty order in the amount of \$6,242,500 for DeLorme's violation of the Consent Order on 227 separate days. DeLorme appealed the Commission's final determination to the U.S. Court of Appeals for the Federal Circuit. During the pendency of the appeal, the U.S. District Court for the Eastern District of Virginia ("EDVA") granted summary judgment in a declaratory judgment action filed by DeLorme against the patentee, finding the relevant claims of the '380 patent to be invalid. After requesting and receiving supplemental briefing on the issue of the effect, if any, of affirming the EDVA summary judgment on the Commission's final determination, the Federal Circuit, on the same date, affirmed both the \$6,242,500 in civil penalties and the EDVA summary judgment of invalidity. *See DeLorme v. ITC*, 805 F.3d 1328 (Fed. Cir. 2015) ("*DeLorme I*"); *DeLorme Publishing Co. v. BriarTek IP, Inc.*, 622 Fed.Appx. 912 (Fed. Cir. 2015).

On December 22, 2015, following issuance of the Federal Circuit's decision in *DeLorme I*, DeLorme filed a petition to rescind, or in the alternative, to modify the civil penalty order under Commission Rule 210.76(a)(1) because of "changed conditions," *i.e.*, the EDVA invalidity judgment and the affirmance of that judgment. Stating that the arguments raised by DeLorme involved issues that could have been raised in *DeLorme I* or were raised and rejected by the Federal Circuit in *DeLorme I*, the Commission denied DeLorme's petition based on res judicata. DeLorme appealed the Commission's final determination denying its petition to the Federal Circuit. The Court reversed the Commission's final determination and remanded the case for further proceedings consistent with its opinion. *See DBN Holding*.

As set forth in the Commission's Order, issued contemporaneously with this notice, the Commission is requesting written submissions from the parties regarding whether the Commission should rescind or modify the civil penalty in light of the final judgment of invalidity of the relevant claims of the '380 patent in accordance with *DBN Holding*.

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: March 26, 2019