

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN AUTOMATED TELLER
MACHINES, ATM MODULES,
COMPONENTS THEREOF, AND
PRODUCTS CONTAINING THE SAME**

**Investigation No. 337-TA-989
(Violation)**

**NOTICE OF COMMISSION DETERMINATION TO DENY RESPONDENTS'
PETITION TO TEMPORARILY RESCIND REMEDIAL ORDERS
PENDING ISSUANCE OF THE FEDERAL CIRCUIT'S MANDATE**

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 deny Respondents’ petition to temporarily rescind the remedial orders issued in the above-captioned investigation pending issuance of the mandate by the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”) in the related appeal.

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 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, telephone 202-205-1810.

SUPPLEMENTARY INFORMATION: On March 14, 2016, the Commission instituted the original investigation based on a Complaint filed by Nautilus Hyosung Inc. (now Hyosung TNS Inc.) of Seoul, Republic of Korea, and Nautilus Hyosung America Inc. of Irving, Texas (collectively, “Nautilus”). The Complaint alleged Respondents were violating Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, by importing into the United States, selling for importation, or selling within the United States after importation certain automated teller machines, ATM modules, components thereof, and products containing the same by reason of infringement of any of claims 1-3, 6, 8, and 9 of U.S. Patent No. 8,523,235 (“the ’235 patent”). The Notice of Investigation named Diebold Nixdorf, Incorporated, and Diebold Self-Service

Systems, both of North Canton, Ohio (collectively, “Diebold”) as Respondents. The Office of Unfair Import Investigations (“OUII”) was not named as a party.

On July 14, 2017, the Commission found the ’235 patent valid and infringed by Diebold, and issued a limited exclusion order and cease and desist orders accordingly. Diebold appealed the Commission’s determination to the U.S. Court of Appeals for the Federal Circuit.

On August 15, 2018, the Federal Circuit issued its opinion on appeal, in which it found the ’235 patent invalid as indefinite under Section 112(6), 35 U.S.C. § 112(6), and reversed the Commission’s determination that Diebold was violating Section 337. *Diebold Nixdorf, Inc. v. Internat’l Trade Comm’n*, Appeal No. 2017-2553, 2018 WL 3862648 (Fed. Cir. Aug. 15, 2018).

On August 29, 2018, Diebold filed a petition requesting the Commission to temporarily rescind the remedial orders issued in the underlying investigation pending issuance of the Federal Circuit’s mandate in the above-referenced appeal. Nautilus filed its opposition to Diebold’s petition on September 10, 2018.

The Commission has determined to deny Diebold’s petition at this time. Diebold may renew its motion after the Federal Circuit issues its mandate in the related appeal.

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: September 26, 2018