

**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
(Enforcement)**

**NOTICE OF A COMMISSION DETERMINATION TO EXTEND THE DATE FOR
DETERMINING WHETHER TO REVIEW AN ENFORCEMENT INITIAL
DETERMINATION AND THE TARGET DATE FOR COMPLETION OF THIS
ENFORCEMENT PROCEEDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that in view of the shutdown of the Federal Government, the U.S. International Trade Commission (“Commission”) has determined to extend to March 15, 2019, the date for determining whether to review an enforcement initial determination (“EID”) issued by the presiding administrative law judge (“ALJ”) and the target date for completion of this enforcement investigation to May 1, 2019.

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 (<https://www.usitc.gov>). The public record for this investigation may be viewed on the Commission’s Electronic Docket Information System (“EDIS”) (<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”). 81 FR 13149 (Mar. 14, 2016). The complaint alleged that the named Respondents were violating Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. 1337, by importing, selling for importation, or selling in the United States after importation certain automated teller machines (“ATM”), ATM modules, components thereof, or products containing

same that allegedly infringe one or more claims 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 Diebold in violation of Section 337 as to the ’235 patent and issued a limited exclusion order and cease and desist orders. Diebold appealed the final determination to the U.S. Court of Appeals for the Federal Circuit (“Federal Circuit”).

On December 22, 2017, the Commission instituted the subject enforcement proceeding based on a complaint filed by Nautilus alleging that Diebold had violated the remedial orders issued in the original investigation. On August 15, 2018, during the course of this proceeding, the Federal Circuit held that the asserted claims of the ’235 patent are invalid as indefinite. *Diebold Nixdorf, Inc. v. International Trade Comm’n*, Appeal No. 2017-2553, 2018 WL 3862648 (Aug. 15, 2018).

The Commission subsequently extended the target date in this investigation, pending resolution of motions for rehearing and issuance of the Federal Circuit’s mandate. *E.g.*, Comm’n Notice (Dec. 11, 2018); Comm’n Notice (Sept. 14, 2018). On November 13, 2018, Diebold filed a petition with the Commission to rescind the remedial orders, while Hyosung filed a motion to reopen the record for the limited purpose of receiving new evidence on claim construction and indefiniteness. On the same date, Diebold moved to terminate the enforcement proceeding, which Hyosung opposed.

On December 11, 2018, the Commission issued notice of its determination to institute a rescission proceeding and rescind the remedial orders, and denied Hyosung’s motion to reopen the record as moot.

On December 21, 2018, the ALJ issued an enforcement initial determination (“EID”) denying Diebold’s motion to terminate the rescission proceeding due to its failure to comply with the agreement disclosure provisions of Commission Rule 210.21. EID at 12. The ALJ also held that in view of the Federal Circuit’s indefiniteness ruling and the Commission’s rescission of the remedial orders, no violation of any remedial order has occurred and no enforcement measures should be taken.

The parties’ petition for review and responses were due January 7 and 14, 2019, respectively. The target date for completion of this investigation is presently March 27, 2019.

Due to the recent partial shutdown of the federal government, the Commission has determined to extend from February 8, 2019, to March 15, 2019, the date for determining whether to review the EID. The Commission has further determined to extend the target date for completion of this investigation from March 27, 2019, to May 1, 2019. Under this schedule, petitions for review of the EID are due by February 11, 2019.

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 210.43 and 210.51 of the Commission's Rules of Practice and Procedure (19 CFR §§ 210.43, 210.51).

By order of the Commission.

A handwritten signature in black ink, appearing to read "Lisa R. Barton". The signature is stylized with a large initial "L" and a cursive "B".

Lisa R. Barton
Secretary to the Commission

Issued: February 6, 2019