

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN NON-VOLATILE MEMORY
DEVICES AND PRODUCTS CONTAINING
SAME**

Investigation No. 337-TA-1046

**NOTICE OF COMMISSION DETERMINATION TO RESCIND REMEDIAL ORDERS
ISSUED IN THIS INVESTIGATION BASED UPON LICENSE AND SETTLEMENT**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to rescind the limited exclusion order and cease and desist orders issued in this investigation based upon settlement.

FOR FURTHER INFORMATION CONTACT: Panyin Hughes, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW., Washington, DC 20436, telephone (202) 708-4716. 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-1046 on April 12, 2017, based on a complaint filed by Macronix International Co., Ltd. of Hsin-chu, Taiwan and Macronix America, Inc. of Milpitas, California (collectively, "Macronix"). 82 FR 17687-88 (Apr. 12, 2017). The complaint alleged violations of section 337 of the Tariff Act of 1930, as amended (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 non-volatile memory devices and products containing the same that infringe certain claims of U.S. Patent No. 6,552,360; U.S. Patent No. 6,788,602 ("the '602 patent"); and U.S. Patent No. 8,035,417. The Notice of Investigation named the following respondents: Toshiba Corporation of Tokyo, Japan; Toshiba America, Inc. of New York, New York; Toshiba America Electronic Components, Inc. of Irvine, California; Toshiba America Information Systems, Inc. of Irvine, California; and Toshiba Information Equipment (Philippines), Inc. of Binan, Philippines (collectively, "Toshiba"). The Office of Unfair Import Investigations was also named as a party to the investigation.

On June 16, 2017, the Commission determined not to review the ALJ's order (Order No. 11) granting an unopposed motion to amend the Notice of Investigation to add Toshiba Memory Corporation of Tokyo, Japan as a respondent. *See* Order 11, Comm'n Notice of Non-Review (June 16, 2017).

On April 13, 2018, the ALJ issued her final initial determination finding no violation of section 337 violation with respect to the asserted patents. On June 28, 2018, the Commission determined to review the final ID in part. *See* 83 FR 31416-18 (July 5, 2018). On review, the Commission found a violation of section 337 in connection with asserted claim 6 of the '602 patent. *See* 83 FR 51980-82 (Oct. 15, 2018). Having found a violation, the Commission determined that the appropriate remedy is a limited exclusion order ("LEO") against Toshiba's infringing products and cease and desist orders ("CDOs") against the domestic Toshiba respondents. *See id.*

On October 15, 2018, Macronix and Toshiba filed a joint petition to rescind the LEO and CDOs based upon a license and settlement agreement. The petition states that rescission is warranted because "the specific conduct covered by the Remedial Orders has become authorized or licensed by way of settlement and license." Petition at 2. On October 25, 2018, the Commission investigative attorney filed a response in support of the petition. No other party filed response or opposition to the petition.

In view of the settlement agreement between Macronix and Toshiba, the Commission finds that the conditions justifying the remedial orders no longer exist, and therefore, granting the petition is warranted under 19 U.S.C. 1337(k) and 19 CFR 210.76(a). Accordingly, the Commission has determined to rescind the remedial orders.

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: November 13, 2018