

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN LIGHT-EMITTING DIODES
AND PRODUCTS CONTAINING SAME**

Investigation No. 337-TA-512

**NOTICE OF COMMISSION FINAL DETERMINATION OF NO VIOLATION OF
SECTION 337 AS TO FIVE PATENTS AND VIOLATION OF SECTION 337 AS
TO THREE PATENTS; ISSUANCE OF LIMITED EXCLUSION ORDER;
TERMINATION OF INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined that there is no violation of 19 U.S.C. § 1337 by Dominant Semiconductors Sdn. Bhd. ("Dominant") with respect to United States Patent Nos. 6,066,861, 6,277,301, 6,613,247, 6,245,259, and 6,592,780 (collectively, the "Particle Size Patents"); that there is a violation by Dominant with respect to United States Patent Nos. 6,376,902, 6,469,321, and 6,573,580 (collectively, the "Lead Frame Patents"); and that the Commission has determined to issue a limited exclusion order.

FOR FURTHER INFORMATION CONTACT: Michelle Walters, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-5468. 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, S.W., 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: The Commission instituted this investigation based on a complaint filed by Osram GmbH and Osram Opto Semiconductors GmbH, both of Germany (collectively, "Osram"). 69 *Fed. Reg.* 32609 (June 10, 2004). In the complaint, as supplemented and amended, Osram alleged violations of section 337 of the Tariff Act of 1930 in the importation into the United States, the sale for importation, and the sale within the United States after

importation of certain light-emitting diodes and products containing the same by reason of infringement of various claims of the Particle Size Patents, United States Patent No. 6,576,930 (the “930 patent”), the Lead Frame Patents, and United States Patent No. 6,716,673 (the “673 patent”).

On May 10, 2005, the presiding administrative law judge (“ALJ”) issued his final initial determination (“ID”) finding the sole remaining respondent, Dominant, in violation of section 337, but only with respect to the ‘673 patent. The ALJ concluded that the asserted claims of the Particle Size Patents were invalid for indefiniteness, that the ‘930 patent and the Lead Frame Patents were not infringed by Dominant’s accused products, and that Osram did not meet the technical prong of the domestic industry requirement with respect to the ‘930 patent.

On June 24, 2005, the Commission determined to review the ALJ’s findings and conclusions regarding the Particle Size Patents, the ‘930 patent, and the Lead Frame Patents. *70 Fed. Reg.* 37431 (June 29, 2005). The Commission declined to review the ALJ’s determination of violation of section 337 with respect to the ‘673 patent.

On review, the Commission determined that the Particle Size Patents were not invalid for indefiniteness and construed the disputed phrase “mean grain diameter d_{50} ” to mean average diameter by volume. *Inv. No. 337-TA-512, Comm’n Op.* at 4-14 (Aug. 12, 2005). The Commission remanded the investigation to the ALJ for a determination on infringement and domestic industry with regard to the Particle Size Patents consistent with the Commission’s opinion. In addition, the Commission left open the question whether the asserted claims of the Particle Size Patents are invalid as indefinite for failing to specify the type of instrument that should be used to determine the “mean grain diameter d_{50} .” With regard to the ‘930 patent, the Commission terminated the investigation with a finding of no violation. Finally, the Commission deferred addressing the issue of violation with respect to the Lead Frame Patents, as well as issues relating to remedy, public interest, and bonding. *70 Fed. Reg.* 48194 (Aug. 16, 2005).

The ALJ issued a remand initial determination (“Remand ID”) on October 31, 2005, finding no violation of section 337 with regard to the Particle Size Patents, because Osram failed to show that there was an industry in the United States that practices those patents. The ALJ also concluded that some of Dominant’s accused products do not infringe the asserted claims of the Particle Size Patents. Finally, the ALJ declined to revisit the issue of indefiniteness, because Dominant failed to raise it on remand.

In its remand notice, the Commission had invited comments from the parties addressing the ALJ’s determination on remand, and on November 10, 2005, Osram filed comments, challenging the Remand ID. *70 Fed. Reg.* 48194 (Aug. 16, 2005). On November 18, 2005, Dominant and the Commission investigative attorney each filed responses to Osram’s comments, asserting that the ALJ’s determinations on remand are not erroneous.

Having examined the record of this investigation, including the ALJ’s final ID and Remand ID and the submissions of the parties, the Commission has determined (1) that there is no violation of section 337 by Dominant with regard to the Particle Size Patents; (2) that there is a violation of

section 337 by Dominant with regard to the Lead Frame Patents; and (3) to issue a limited exclusion order with respect to the Lead Frame Patents and the '673 patent. The Commission's order was delivered to the President on the day of its issuance.

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 section 210.45 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.45).

By order of the Commission.

A handwritten signature in black ink, appearing to read "Marilyn R. Abbott", written in a cursive style.

Marilyn R. Abbott
Secretary to the Commission

Issued: January 11, 2006

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

In the Matter of

**CERTAIN LIGHT-EMITTING
DIODES AND PRODUCTS
CONTAINING SAME**

Inv. No. 337-TA-512

LIMITED EXCLUSION ORDER

The Commission has determined that there is a violation of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337), as amended, in the unlawful importation and sale by respondent Dominant Semiconductors Sdn. Bhd. ("Dominant") of certain light-emitting diodes by reason of infringement of one or more of claims 1 and 5-8 of United States Patent No. 6,376,902, claims 1 and 5-8 of United States Patent No. 6,469,321, claims 1, 5-8, and 10-11 of United States Patent No. 6,573,580, and claims 1-3 and 5 of United States Patent No. 6,716,673.

The Commission has also made its determination on the issues of remedy, the public interest, and bonding. The Commission has determined that the appropriate form of relief is a limited exclusion order prohibiting the unlicensed entry of infringing light-emitting diodes that are manufactured abroad by or on behalf of, or imported by or on behalf of, Dominant. The Commission has further determined that the public interest factors enumerated in 19 U.S.C. § 1337(d) do not preclude issuance of the limited exclusion order, and that the bond during the Presidential review period shall be in the amount of 100 percent of the entered value of the light-emitting diodes that are subject to this Order.

Accordingly, the Commission hereby **ORDERS** that:

1. Light-emitting diodes that infringe one or more of claims 1 and 5-8 of United States Patent No. 6,376,902, claims 1 and 5-8 of United States Patent No. 6,469,321, and claims 1, 5-8, and 10-11 of United States Patent No. 6,573,580, and light-emitting diodes that are made by methods that infringe one or more of claims 1-3 and 5 of United States Patent No. 6,716,673, and are manufactured abroad by or on behalf of, or imported by or on behalf of, Dominant Semiconductors Sdn. Bhd., or any of its affiliated companies, parents, subsidiaries, or other related business entities, or any of its successors or assigns, shall be excluded from entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, for the remaining term of the patents, except under license of the patent owner or as provided by law.

2. Light-emitting diodes that are excluded by paragraph 1 of this Order are entitled to entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, under bond in the amount of 100 percent of the entered value pursuant to subsection (j) of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337(j), from the day after this Order is received by the President until such time as the President notifies the Commission that he approves or disapproves this

action but, in any event, not later than 60 days after the date of receipt of this action.

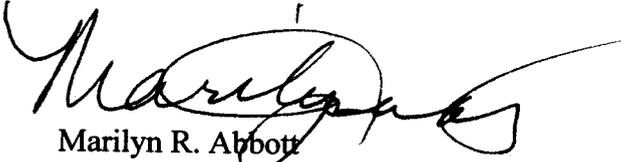
3. In accordance with 19 U.S.C. § 1337(l), the provisions of this Order shall not apply to light-emitting diodes that are imported by and for the use of the United States, or imported for, and to be used for, the United States with the authorization or consent of the Government.

4. The Commission may modify this Order in accordance with the procedures described in section 210.76 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.76.

5. The Secretary shall serve copies of this Order upon each party of record in this investigation and upon the Department of Health and Human Services, the Department of Justice, the Federal Trade Commission, and the U.S. Bureau of Customs and Border Protection.

6. Notice of this Order shall be published in the *Federal Register*.

By Order of the Commission.


Marilyn R. Abbott
Secretary to the Commission

Issued: January 11, 2006

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

In the Matter of

CERTAIN LIGHT-EMITTING DIODES
AND PRODUCTS CONTAINING SAME

Investigation No. 337-TA-512

RECEIVED
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U.S. INTERNATIONAL TRADE COMMISSION
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**NOTICE OF ISSUANCE ON REMAND OF A LIMITED EXCLUSION ORDER WITH
RESPECT TO CERTAIN PATENTS**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has, on remand from the United States Court of Appeals for the Federal Circuit, determined to issue a limited exclusion order with respect to five patents in the above-referenced investigation.

FOR FURTHER INFORMATION CONTACT: Michelle Walters, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-5468. 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, S.W., 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: The Commission instituted this investigation on June 10, 2004, based on a complaint filed by Osram GmbH and Osram Opto Semiconductors GmbH of Germany (collectively, "Osram"). 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 light-emitting diodes and products containing the same due to infringement of various claims of United States Patent Nos. 6,066,861, 6,277,301, 6,613,247, 6,245,259, 6,592,780 ("the Particle Size Patents"), 6,576,930 ("the '930 patent"), 6,376,902, 6,469,321, 6,573,580 ("the Lead Frame Patents"), and 6,716,673 ("the '673 patent").

The Commission found that respondent Dominant Semiconductors Sdn. Bhd. violated section 337 with respect to the Lead Frame Patents and the '673 patent, but not with regard to the Particle Size Patents and the '930 patent. The Commission issued a limited exclusion order

directed to light emitting diodes that infringe the Lead Frame Patents and the '673 patent. On appeal by Osram, the Federal Circuit reversed the Commission's determination of no violation with regard to the Particle Size Patents and remanded the investigation to the Commission for further proceedings, *i.e.*, remedy, the public interest, and bonding. Prior to the remand, the parties had briefed the issues of remedy, the public interest, and bonding.

Having examined the record of this investigation, including the submissions of the parties, the Commission has determined on remand (1) to issue a limited exclusion order with respect to the Particle Size Patents; (2) that the public interest factors set out in 19 U.S.C. § 1337(d) do not preclude issuance of such an order; and (3) that the amount of the bond to be posted pursuant to 19 U.S.C. § 1337(j) during the Presidential review period be set at 100 percent of the entered value of the subject articles. The Commission's order was delivered to the President on the day of its issuance. The Commission's prior remedial order issued in this investigation remains in effect.

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).

By order of the Commission.

A handwritten signature in black ink, appearing to read "Marilyn R. Abbott", with a large, stylized flourish at the end.

Marilyn R. Abbott
Secretary to the Commission

Issued: March 28, 2008

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

In the Matter of

**CERTAIN LIGHT-EMITTING DIODES
AND PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-512

ORDER

On October 31, 2007, the United States Court of Appeals for the Federal Circuit reversed the Commission's determination of no violation of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337), as amended, in the unlawful importation and sale by respondent Dominant Semiconductors Sdn. Bhd. ("Dominant") of certain light-emitting diodes by reason of infringement of one or more of claims 1, 3, 6-7, and 10-13 of United States Patent No. 6,066,861; claims 1-2, 6-7, 11-12, and 14-15 of United States Patent No. 6,277,301; claims 1, 3, 6-7, 10-15, 17, and 20-21 of United States Patent No. 6,613,247; claims 1, 3, 6-7, 10-13, and 15 of United States Patent No. 6,245,259; and claims 2-5, 7, and 10 of United States Patent No. 6,592,780. *Osram GmbH v. Int'l Trade Comm'n*, 505 F.3d 1351 (Fed. Cir. 2007). The Federal Circuit remanded the investigation to the International Trade Commission for further proceedings consistent with its opinion.

The Commission has made a determination on the issues of remedy, the public interest, and bonding. The Commission has determined that the appropriate form of relief is a limited exclusion order prohibiting the unlicensed entry of infringing light-emitting diodes that are manufactured abroad by or on behalf of, or imported by or on behalf of, Dominant. The Commission has further determined that the public interest factors enumerated in 19 U.S.C.

§ 1337(d) do not preclude issuance of the limited exclusion order, and that the bond during the Presidential review period shall be in the amount of 100 percent of the entered value of the light-emitting diodes that are subject to this Order.

Accordingly, the Commission hereby **ORDERS** that:

1. Light-emitting diodes that infringe one or more of claims 1, 3, 6-7, and 10-13 of United States Patent No. 6,066,861; claims 1-2, 6-7, 11-12, and 14-15 of United States Patent No. 6,277,301; claims 1, 3, 6-7, 10-15, 17, and 20-21 of United States Patent No. 6,613,247; claims 1, 3, 6-7, 10-13, and 15 of United States Patent No. 6,245,259; and claims 2-5, 7, and 10 of United States Patent No. 6,592,780, and are manufactured abroad by or on behalf of, or imported by or on behalf of, Dominant Semiconductors Sdn. Bhd., or any of its affiliated companies, parents, subsidiaries, or other related business entities, or any of its successors or assigns, shall be excluded from entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, for the remaining term of the patents, except under license of the patent owner or as provided by law.

2. Light-emitting diodes that are excluded by paragraph 1 of this Order are entitled to entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, under bond in the amount of 100 percent of the entered value pursuant to subsection (j) of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337(j), from the day after this Order is received by the United States Trade Representative as delegated by the President, 70 *Fed. Reg.* 43251, until such time as the United States Trade Representative notifies the Commission that this action is approved or disapproved, but, in any event, not later than 60 days after the date of receipt of this action.

3. In accordance with 19 U.S.C. § 1337(l), the provisions of this Order shall not apply to light-emitting diodes that are imported by and for the use of the United States, or imported for, and to be used for, the United States with the authorization or consent of the Government.

4. The Commission may modify this Order in accordance with the procedures described in section 210.76 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.76.

5. The Secretary shall serve copies of this Order upon each party of record in this investigation and upon the Department of Health and Human Services, the Department of Justice, the Federal Trade Commission, and the U.S. Bureau of Customs and Border Protection.

6. Notice of this Order shall be published in the *Federal Register*.

By Order of the Commission.

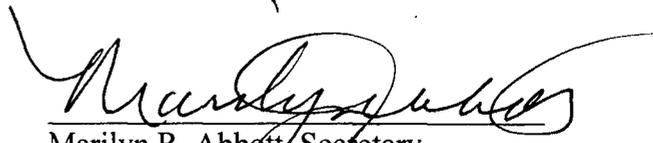
A handwritten signature in black ink, appearing to read 'Marilyn R. Abbott', with a large, stylized flourish at the end.

Marilyn R. Abbott
Secretary to the Commission

Issued: March 28, 2008

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF ISSUANCE ON REMAND OF A LIMITED EXCLUSION ORDER WITH RESPECT TO CERTAIN PATENTS** has been served by hand upon the Commission Investigative Attorney Spence T. Chubb, Esq., on the following parties as indicated, on March 28, 2008.



Marilyn R. Abbott, Secretary
U.S. International Trade Commission
500 E Street, SW
Washington, DC 20436

**ON BEHALF OF COMPLAINANTS OSRAM GmbH
AND OSRAM OPTO SEMICONDUCTORS GmbH:**

Evelyn G. Heilbrunn, Esq.
FISH & RICHARDSON P.C.
1425 K Street, NW
Suite 1100
Washington, DC 20005

Via Hand Delivery
 Via Overnight Mail
 Via First Class Mail
 Other: _____

Alan D. Smith, Esq.
Charles H. Sanders, Esq.
FISH & RICHARDSON, P.C.
225 Franklin Street
Boston, MA 02110

Via Hand Delivery
 Via Overnight Mail
 Via First Class Mail
 Other: _____

**ON BEHALF OF RESPONDENT DOMINANT
SEMICONDUCTORS SDN BHD:**

Anna, Kurian, Esq.
Celine Jimenez Crowson, Esq.
Raymond A. Kurz, Esq.
HOGAN & HARTSON, LLP
Columbia Square
555 Thirteenth Street, NW
Washington, DC 20004

Via Hand Delivery
 Via Overnight Mail
 Via First Class Mail
 Other: _____

Robert L. Wrights, Esq.
WRIGHT & BERRY LLP
612 Eighth Avenue
Fort Worth, TX 76104

- Via Hand Delivery
- Via Overnight Mail
- Via First Class Mail
- Other: _____