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Strategic Considerations in Litigating Design-Arounds

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Design-arounds are a well-recognized pathway for the public to benefit from the patent system. “One of the benefits of a patent system is its so-called ‘negative incentive’ to ‘design around’ a competitor’s products, even when they are patented, thus bringing a steady flow of innovations to the marketplace.”¹ Design-arounds are therefore an example of how patents can spur innovation, and thereby promote progress in the useful arts.²

Design-arounds, also known as “redesigns,” have become an increasingly important and common element in patent litigation both in district court and before the US International Trade Commission (ITC). Potential design-arounds create strategic challenges for both plaintiffs and defendants relating to timing, discovery, claim construction, and procedures. For example, in district court litigation, plaintiffs must choose between broadly seeking discovery related to potential design-arounds and risking a finding of noninfringement by those design-arounds, or sitting back and attempting to preclude evidence regarding potential design-arounds. By contrast, defendants must choose between introducing potential design-arounds early in discovery and risking an adverse adjudication, or waiting until later on in litigation and risking preclusion or other unwanted consequences.³

Similarly, in ITC proceedings, where the relief is limited to a form of injunctive relief (*i.e.*, an exclusion order) enforced primarily by US Customs and Border Protection (CBP), parties must consider whether (1) to attempt to force the ITC to adjudicate potential design-arounds during the investigation or (2) to wait until after any exclusion order issues from the ITC, fight over the scope of any exclusion order at the CBP and/or return to the ITC to seek an advisory opinion or enforcement order.

This article explores strategic considerations in litigating potential design-arounds, such as how to meet the Federal Circuit’s “more than colorable differences” test, the benefits and risks of seeking and introducing design-around evidence during the proceedings, and the benefits and risks of waiting until after a verdict or decision issues. It discusses these considerations in the context of district court litigation and in ITC and CBP proceedings, to highlight a few differences in strategy between the different forums.

Federal Circuit Guidance on Design-Arounds

A common scenario for defendants is to attempt a design-around after a finding of infringement and the issuance of a permanent injunction by a district court. This strategy, however, carries the risk of sanctions—the plaintiff can move the district court to find the defendant in contempt of the court’s permanent injunction and award significant monetary penalties. In recent years, the Federal Circuit has reaffirmed the “no more than colorably different” standard.

Outside of the contempt proceeding context, attempted design-arounds also carry risks with respect to willful infringement. Parties should be careful and consider the impact of evidence relating to attempted design-around efforts that could be used to support willful infringement allegations.

The “More Than Colorable Differences” Test

Prior to 2011, the district court would conduct a two-step inquiry in contempt proceedings relating to possible violation of a permanent injunction by an alleged design-around. First, the court would determine whether a contempt hearing was an appropriate setting for adjudicating infringement by the alleged design-around, by considering whether there was “more than a colorable difference” between the alleged design-around and the infringing product based on the existence of “substantial open issues with respect to infringement.”⁴ Then, after determining that contempt proceedings were

appropriate, the district court would determine whether the redesigned products continued to infringe, thereby violating the injunction.⁵

In *Tivo Inc. v. Echostar Corporation*, the Federal Circuit rejected “the infringement-based understanding of the colorably different test” and held that “the contempt analysis must focus initially on the differences between the features relied upon to establish infringement and the modified features” of the alleged design-around.⁶ In particular, the analysis should focus on those elements of products that the patentee previously contended and proved satisfied specific limitations of the asserted claims.⁷ In considering the differences between the two products, courts must look to the relevant prior art, to determine if the modifications in the design-around merely employs or combines elements already known in the prior art in an obvious manner.⁸ A nonobvious modification may lead the district court to find that the design-around is more than colorably different.⁹

If the differences between the old and new elements are significant, the alleged design-around is more than colorably different from the previous infringing product, and contempt proceedings are inappropriate, regardless of whether the alleged design-around infringes.¹⁰ On the other hand, if the design-around is only colorably different, the patent owner then must prove by clear and convincing evidence that the design-around continues to infringe the asserted claims, on a limitation-by-limitation basis, using any prior claim construction performed in the case.¹¹

On appeal, the Federal Circuit reviews the district court’s findings on colorable differences and on infringement for clear error. The Federal Circuit reviews the sanctions award, if any, for abuse of discretion.¹²

Applying the “More Than Colorably Different” Test

The Federal Circuit has further clarified the “more than colorably different” test in recent cases, which provide guidance on how district courts should apply the test.

In *Ncube Corp. v. SeaChange International Inc.*, the Federal Circuit explained that “the colorable-differences standard focuses on how the patentee in fact proved infringement, not what the claims require.”¹³ The defendant had modified its system so that an infringing feature was now performed elsewhere in the redesigned system.¹⁴ The district court found that modification was significant and that the patent owner failed to prove that there were only colorable differences.¹⁵ On appeal, the Federal Circuit affirmed the district court, rejecting the patent owner’s argument that any difference was insignificant because both the design-around and the previous infringing product were updated with the same 6-byte MAC

address information.¹⁶ The Federal Circuit found that the patent owner never relied on the MAC address at trial to prove infringement and therefore could not rely on that feature in contempt proceedings.¹⁷

More recently, in *Proveris Scientific Corporation v. Innovasystems, Inc.*,¹⁸ the Federal Circuit explained that removing an infringing feature is not sufficient to show that a design-around is more than colorably different from the previous infringing product. The defendant’s design-around removed a software feature that allowed users to identify what range of images they wanted to analyze. In the previous product, that feature met the “at a predetermined instant in time” element in the preamble of an asserted claim, and defendant argued that removal of this feature meant that the two products were more than colorably different.¹⁹

The Federal Circuit rejected defendant’s argument. Even if the removed features were a basis for the prior finding of infringement, the district court was still required to determine whether the modification was significant.²⁰ The Federal Circuit compared the redesigned product’s user manual to the previous infringing product’s manual and found that the two products were functionally identical, thus agreeing with the district court that the two products were not more than colorably different.²¹

By applying the “more than colorably different test” in these recent cases, the Federal Circuit has highlighted several considerations for defendants considering a potential design-around. As the “more than colorably different” test focuses on infringing features that the patent owner relied on at trial, the design-around should be directed to modifying those features. It may not be enough, however, to remove an infringing feature, if the product manuals or other evidence show that the modifications left the products “functionally identical.”

Risks to Design-Arounds

Design-arounds carry the risk of a finding of contempt and award of sanctions by the district court, even in the absence of intent to violate the injunction. In *Tivo*, for example, the Federal Circuit again made clear that “lack of intent to violate an injunction alone cannot save an infringer from a finding of contempt.”²²

Another risk to design-arounds relates to willful infringement, which the patent owner may allege if it decides to litigate the design-around in a new action. The patent owner may more easily obtain a judgment of willful infringement and enhanced damages based on evidence about defendant’s need for a design-around.

In *Applied Medical Resources Corporation v. U.S. Surgical Corporation*, for example, the Federal Circuit affirmed a judgment of willful infringement and an

award of enhanced damages.²³ In the first litigation between the parties, the jury found that the defendant willfully infringed the asserted patent with its Versaport I product.²⁴ The defendant redesigned its product to create the Versaport II, and, when the patent owner sued a second time on the same patent, the district court granted summary judgment of infringement, and the Federal Circuit affirmed.²⁵

The district court held a jury trial on damages, and the defendant moved to exclude all evidence relating to the prior litigation, including the finding of willful infringement. The Federal Circuit agreed with the district court on the admissibility of evidence from the first litigation. The prior litigation was relevant to the defendant's state of mind, particularly an in-house patent lawyer's admission that defendant initiated and redoubled its design around efforts as a result of the first lawsuit.²⁶

Likewise, the Federal Circuit affirmed the judgment of willful infringement because plaintiff provided evidence that the defendant desperately needed the redesigned product to remain competitive in the market, that defendant's management did not properly oversee or adequately participate in the development of the potential design-around, and that defendant placed intense time pressure on its engineers to create the potential design-around.²⁷ In particular, the Federal Circuit noted that defendant's former general counsel testified that defendant wanted "no gap" in the supply of its products, from which the jury could infer that defendant was not concerned about infringement and would have proceeded with the design-around despite receiving outside legal opinions.²⁸

Design-Around Considerations in Original Actions in District Court

Design-arounds often are litigated in new litigation between the parties. In some cases, however, defendants seek to introduce the design-around in the pending district court litigation. Plaintiffs, on the other hand, may have an interest in obtaining discovery or excluding late-produced evidence relating to design-arounds.

Admissibility or Preclusion of Design-Around Evidence

The timing and admissibility of design-arounds can play critical roles in patent litigation. The admissibility of evidence regarding design-arounds may influence the scope of liability for infringement, as well as damages.

Plaintiffs frequently seek and obtain evidence of the defendant's design-around activities.²⁹ Such activities

are relevant not only to liability but also to the amount of damages. For instance, courts have concluded that evidence that a defendant failed to pursue design-arounds or pursue any other remedial actions with respect to patents that were found infringed by a jury was a factor supporting enhanced damages.³⁰ Other courts have held that a defendant's failure to take any remedial action in the form of modifying an infringing product until after a patent infringement case was filed weighs somewhat in favor of an award of enhanced damages.³¹

Defendants sometimes seem to have more leeway with introducing evidence of design-arounds that did not exist during discovery itself. In *Airborne Athletics, Inc. v. Shoot-A-Way, Inc.*, the district court granted a four-month period of additional discovery, for a design-around product developed after the close of discovery.³² Plaintiff's technical expert had opined in deposition that two design changes would lead to a noninfringing product, and defendant immediately redesigned its accused product and put the new product on the market.³³ Though plaintiff sought to exclude evidence of the potential redesign from trial, the district court found that the redesign was relevant to the lost profits analysis and that defendant disclosed the redesign within days of its development and release.³⁴ Defendants can look to *Airborne Athletics* as a success case for introducing a new design-around after the close of discovery.

However, defendants cannot count on the admissibility of a late-produced, potential design-around. For example, in *Hypertherm v. American Torch Tip*, the court excluded evidence of defendant's design-around when it was produced near the deadline for final pretrial filings and when new expert testimony would have been required.³⁵

Markman Implications

Both plaintiffs and defendants may have to consider potential design-arounds, and how to accuse them, while being uncertain about the claim construction that would apply to the products. In particular, jurisdictions without local patent rules may create more uncertainty, because they do not always hold early *Markman* hearings. Uncertainty regarding claim construction obviously increases the risks of being wrong about the merits of an attempted design-around.

At the same time, the introduction of a design-around can affect the district court's claim construction. In *K-TEC, Inc. v. Vita-Mix Corporation*, the defendant introduced a redesign in which the accused "fifth wall" of a blending jar was no longer flat, but curved.³⁶ The district court was not persuaded by this design-around

and granted summary judgment of infringement by the redesigned product.³⁷ Before trial, the district court also construed the recited “fifth truncated wall” to cover curved walls.³⁸ The Federal Circuit affirmed the district court’s grant of summary judgment and claim construction, finding that the district court properly clarified its claim construction after rejecting defendant’s claim construction arguments.³⁹ Accordingly, the introduction of an unsuccessful design-around can lock in a bad claim construction for the rest of the case.

Design-Around Considerations in the ITC and before the CBP

The ITC enforces Section 337 of the Tariff Act of 1930, which prohibits the importation, sale for importation, or sale within the United States after importation of products that infringe intellectual property rights such as patents. Unlike district courts, which must consider the four-factor *eBay* test to issue a permanent injunction, remedies for violation of Section 337 include a general or limited exclusion order, excluding defendant’s infringing products from entry into the United States, and cease and desist orders enforced within the domestic United States to bar the sale of previously imported, infringing products.⁴⁰

Furthermore, the ITC operates under a statutory mandate directing speedy resolution of Section 337 investigations.⁴¹ Once an investigation is instituted by the CBP, the assigned Administrative Law Judge (ALJ) typically sets a target date of 15-16 months for the completion of the investigation. This schedule usually requires a hearing before the ALJ within seven to nine months of the institution of an investigation and an Initial Determination on the merits of the case around 12 months after the institution.

In light of the nature of the injunctive-like-remedy and the accelerated schedule in ITC Section 337 cases, potential design-arounds can become an important consideration early in the case. The respondent must decide whether to begin to design around the asserted patents earlier in the process, to import the redesign, and/or to subject the design-around to the ITC’s broad discovery and to adjudication before the ALJ. Alternatively, the respondent can wait for a possible infringement determination by the ITC and introduce the design-around in proceedings before the CBP or, alternatively, return to the ITC after an exclusion order issues for an advisory opinion. The strategy of delaying adjudication of an attempted design-around, however, risks enforcement of the ITC’s exclusion orders through separate enforcement proceedings before the ITC initiated by the patent holder.

Introduction to a Pending Investigation

Respondents may seek to introduce design-arounds in a pending ITC investigation, to obtain adjudication by the ALJ and the ITC. A threshold question will be whether the ITC has jurisdiction over the redesigned product, based on either an actual importation or an imminent importation into the United States during the discovery period.

In *Certain Probe Card Assemblies*, for example, respondent Phicom wanted its new design to receive a ruling as to infringement, but complainant argued that the ITC did not have jurisdiction over the new design, because there was no imminent importation.⁴² The Office of Unfair Import Investigations (OUII) agreed with respondent and argued that the ITC had jurisdiction despite an absence of evidence of actual importation, “because Phicom stands **ready and willing to sell** its new probe cards to customers in the United States upon receipt of an order.”⁴³ The ALJ and the ITC agreed that the ITC possessed jurisdiction over the new design and determined that the new design did not infringe.⁴⁴

Even if a respondent were not willing or ready to introduce a design-around into the investigation, a complainant often seeks discovery of design-around efforts in Section 337 investigations. Section 337 investigations allow a broad scope of discovery, “generally somewhat broader than the scope of the investigation itself.”⁴⁵ The burden is on the party resisting discovery to prove that the requested information is clearly irrelevant. Unlike district courts, the ALJ also may order broader discovery with respect to parties in foreign jurisdictions. Moreover, discovery is not limited to specific products identified in the complaint, but instead is governed by the broad terms of the ITC’s Notice of Investigation.

Informal Approval from Customs

Another option for a respondent is to wait for a finding of infringement and issuance of a general or limited exclusion order by the ITC, and then seek informal approval from the CBP for its redesigned products. The CBP enforces and oversees the administration of the exclusion order. Although a respondent can continue to import infringing products under bond during the 60-day Presidential review period, the CBP normally begins to enforce an exclusion order against respondents’ products shortly following issuance of an exclusion order.

In the past several years, the CBP has established a number of Centers for Excellence and Expertise (CEEs)

that focus on CBP enforcement with respect to specific industries. These CEEs are part of CBP's mechanism for enforcing the ITC's exclusion orders such as by performing inspection and testing of potentially infringing products and reviewing disclosures by importers. For example, enforcement of exclusion orders relating to consumer electronics such as smartphones and televisions is assigned to the CEE located at the port of Long Beach, CA.

One goal for the CEEs is to offer centralized processing and advisory services for importers and to improve uniformity of enforcement across the over 300 US ports of entry. The CEEs offer a potential opportunity for respondents to approach them and seek informal guidance regarding whether their products are covered by an ITC exclusion order. Respondents may be able to demonstrate to the CEEs that their design-arounds do not fall within the scope of an exclusion order. This process is *ex parte*, informal and typically faster and cheaper than a formal ruling approach. However, depending on the complexity of the design-around, the patents involved, and the CBP's administration, a respondent may be required to seek a formal ruling request from the CBP's Intellectual Property Branch (IPR) within the Office of Rulings and Regulations at Customs headquarters in Washington, DC.

Formal Ruling from Customs

A respondent may seek a formal ruling that its design-around products are outside the scope of a limited or general exclusion order by filing a ruling request under 19 C.F.R. § 177. Pursuant to Customs' current regulations, the ruling request involves an *ex parte* process in which the patent holder is not notified of the respondent's or importer's ruling request or the substances of the redesign. The patent holder normally only will become aware of the potential redesign after Customs publishes its final ruling as to whether the redesign is infringing or noninfringing, and thus subject to the exclusion order or beyond its reach.

Recently, there have been efforts within the Executive Branch to improve the enforcement of ITC exclusion orders. In June 2013, the Intellectual Property Enforcement Coordinator (IPEC) within the White House identified improving CBP enforcement of ITC exclusion orders as part of IPEC's overall strategic plan.⁴⁶ The CBP also has been internally developing potential new regulations for handling ruling requests involving attempted redesigns. According to Customs sources, these new potential rules would involve an *inter partes* procedure involving submissions by both the respondent and the patent holder, followed by a

potential oral hearing of some type, before a decision is issued.

In the current Part 177 ruling process the CBP generally attempts to complete its rulings within 90-120 days after requests are filed; however, sometimes depending on the complexity of the patents and products it may take six months or longer. Thus, respondents that wish to continue importing and selling redesign products despite an ITC exclusion order are incentivized to file a ruling request (when necessary) as soon as possible after the ITC issues its remedy orders.

A potential downside of the formal ruling approach is that CBP rulings are not binding on the ITC, and the complainant patent holder may request that the ITC institute enforcement proceedings for violation of the exclusion order. In *Certain Lens-Fitted Cameras*, for example, the CBP interpreted the exclusion order to allow entry of certain camera products.⁴⁷ The complainant, however, successfully sought the imposition of monetary penalties for violation of the exclusion order from the ITC, notwithstanding CBP's interpretation.⁴⁸

Though CBP rulings on redesigns are not binding on the ITC, they may still be an attractive alternative because they typically are less expensive and faster than the ITC advisory opinion process.

ITC Advisory Opinions

Under 19 C.F.R. § 210.79, a respondent may file a request with the ITC for an advisory opinion proceeding. To determine whether to issue an advisory opinion, the ITC considers whether the issuance of such an advisory opinion would facilitate the enforcement of Section 337, would be in the public interest, would benefit consumers and competitive conditions in the United States, and whether the requester has a compelling business need for the advice and has framed its request as fully and accurately as possible.⁴⁹

The typical schedule for an ITC advisory opinion process often is lengthier than the Customs process. In Investigation No. 337-TA-650, for example, a non-respondent filed a request on September 12, 2011. The ITC directed the complainant and the OUII or the Staff to submit their respective views on whether the request should be granted and whether the matter should be referred to an ALJ. Both the complainant and the Staff filed a response stating that referral to an ALJ was not necessary. On February 9, 2012, around five months after the original request, the ITC issued an advisory opinion.

Alternatively, the ITC may delegate a request for advisory opinion to an ALJ, who can then conduct any proceedings deemed necessary. Thus, the advisory opinion proceeding may expand to include the ALJ issuing

a protective order, ordering discovery, holding hearings and taking evidence. The ALJ can set a procedural schedule that closely resembles the procedural schedule in an original Section 337 investigation. In Investigation No. 337-TA-565, for example, two respondents jointly requested an advisory opinion on December 13, 2010, and the complainants filed a petition to modify the general exclusion order and the cease and desist order on February 3, 2011. The ITC instituted consolidated proceedings on March 18, 2011 and directed the designation of an ALJ to issue an initial advisory opinion 11 months after institution. The ALJ's initial advisory opinion becomes the ITC's final determination 60 days after its issuance, unless the ITC determines to review it.

Recently, the ITC assigned certain advisory opinion proceedings to the OUII, in a process that required briefing but not a hearing.⁵⁰ In *Certain Kinesiotherapy Devices*, the OUII investigated the design-around devices and prepared a report, finding that the new devices were not covered by the general exclusion order and cease and desist order against the petitioning respondent. Upon the issuance of the OUII's report, the complainant and respondent filed comments and replies to comments. After reviewing the OUII's report and the parties' submissions, the ITC decided to adopt the report of the OUII as its advisory opinion.⁵¹

A major disadvantage of the ITC's advisory opinion process is that such opinions are not appealable to the Federal Circuit, as they are not considered as final determinations of the ITC.⁵² At the same time, the advisory opinions cannot be reviewed by any other federal court under the Administrative Procedure Act.⁵³

Advisory opinions have the benefit of being the ITC's official interpretation of its exclusion orders. The respondent or nonparty seeking the advisory opinion, however, bears the burden of proving noninfringement in an advisory opinion proceeding.⁵⁴ Moreover, if the ITC finds that the proposed design-around violates an existing exclusion order, the ITC may modify the existing order to reflect its advisory opinion.⁵⁵

The modified exclusion order could potentially remove any ambiguity about the attempted design-around product, and a complainant can request an enforcement proceeding if the respondent attempts to import the redesigned product. By statute, the enforcement proceeding can impose civil penalties of up to the greater of twice the entered value of the products imported or sold in violation of the consent order, or \$100,000 per violation each day an import occurs.⁵⁶ Civil penalties are reviewed for abuse of discretion.⁵⁷ The Federal Circuit, however, has affirmed civil penalties as high as \$11.11 million, rejecting arguments that such an amount was a punitive penalty.⁵⁸

Key Considerations in Introducing Potential Design-Arounds

Design-arounds present important strategic choices for both plaintiffs and defendants in patent litigation in district court and the ITC.

For plaintiffs, there can be benefits in seeking early discovery regarding potential design-arounds and accusing those products of infringement. In this scenario, it is important that the plaintiff obtain a claim construction that is broad enough to cover the attempted design-around and yet not weaken its validity position. If the plaintiff can obtain coverage of the attempted design-around, it could increase potential damages and strengthen its settlement leverage.

However, plaintiffs also face significant risks when accusing design-arounds in an existing case. If the plaintiff has to argue for an excessively broad claim construction to cover the potential design-around, it could provide an opportunity for a defendant to mount a stronger invalidity challenge. Also, if the district court reaches an adverse decision on the attempted design-around's infringement, then it likely will result in lesser damages and lower settlement value. Further, if there is a no infringement determination on the design-around, it could result in a toothless injunction or ITC exclusion order that leaves the design-around in the market.

For defendants, there also can be benefits in the right circumstances from disclosing its potential design-around during discovery and obtaining a favorable adjudication. If a defendant is able to obtain a judgment of noninfringement with respect to an attempted design-around, it may be able to limit the risk of a market foreclosure through a district court injunction or ITC exclusion order. Also, if a defendant can demonstrate that a potential design-around was relatively quick and easy to design and implement, it may limit damages for infringement that it may owe on older products that are found to infringe.

But there are numerous risks for defendants considering potential design-arounds related to ongoing litigation. Often, clients are highly sensitive to discovery of products still under development, even when protective orders are in place. Also, there is the danger that the inclusion of potential design-arounds in a pending case might be premature if claim construction has not yet issued, making it difficult to analyze whether an attempted design-around might continue to infringe. By contrast, waiting to introduce potential design-arounds carries risks that the new products may not be found "colorably different" from products found to infringe, and thus subject

to contempt proceedings in district court with potential monetary sanctions. In the ITC, there also is the risk that potential design-around products may be found to be

within the scope of an exclusion order and thus subject to an enforcement action and potential substantial monetary penalties.

1. *State Indus. Inc. v. A.O. Smith Corp.*, 751 F.2d 1226, 1236 (Fed.Cir.1985).
2. *See Slimfold Mfg. Co., Inc. v. Kinkead Industries, Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991) (“Intentional ‘designing around’ the claims of a patent is not by itself a wrong that must be compensated by invocation of the doctrine of equivalents. Designing around patents is, in fact, one of the ways in which the patent system works to the advantage of the public in promoting progress in the useful arts, its constitutional purpose.”)
3. *See, e.g., TiVo Inc. v. EchoStar Corp.*, 646 F.3d 869 (Fed. Cir. 2011) (*en banc*) (affirming finding of contempt and civil penalties).
4. *Id.* at 880-881.
5. *Id.* at 882.
6. *Id.*
7. *Id.*
8. *Id.* at 882.
9. *Id.* at 882-883.
10. *Id.*
11. *Id.* at 883.
12. *Id.*
13. *Neube Corp. v. SeaChange Int’l Inc.*, 732 F.3d 1346, 1351 (Fed. Cir. 2013).
14. *Id.* at 1349.
15. *Id.* at 1350.
16. *Id.* at 1351.
17. *Id.*
18. *Proveris Scientific Corp. v. Innovasystems, Inc.*, 739 F.3d 1367, 1371 (Fed. Cir. 2014).
19. *Id.* at 1370-1371.
20. *Id.* at 1371.
21. *Id.* at 1371.
22. *Tivo*, 646 F.3d at 880.
23. *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 435 F.3d 1356, 1364-1365 (Fed. Cir. 2006).
24. *Id.* at 1358.
25. *Id.* at 1359.
26. *Id.* at 1366.
27. *Id.* at 1365.
28. *Id.*
29. *See Hypertherm, Inc. v. American Torch Tip Co.*, 2009 WL 703271 (D. N.H. March 16, 2009); *Visteon Global Technologies Inc. v. Garmin Int’l Inc.*, 903 F. Supp. 2d 521 (E.D. MI 2012) (compelling deposition of defendant’s in-house regarding design-around).
30. *Funai Elec. Co. v. Daewoo Electronics Corp.*, 593 F. Supp. 2d 1088, 1116 (N.D. Cal. 2009).
31. *I-Flow Corp. v. Apex Med Techs, Inc.*, 2010 US DIST LEXIS 1021 at *9 (S.D. Cal. Jan. 6, 2010).
32. *Airborne Athletics, Inc. v. Shoot-A-Way, Inc.*, No. 10-3785, 2012 WL 3612035, *1-2, 6 (D. Minn. Aug. 21, 2012).
33. *Id.* at *1-2.
34. *Id.* at *6.
35. *Hypertherm Inc.*, 2009 WL 703271 at 1-2.
36. *K-TEC, Inc. v. Vita-Mix Corp.*, 696 F.3d 1364, 1370 (Fed. Cir. 2012).
37. *Id.* at 1371.
38. *Id.*
39. *Id.* at 1376.
40. *Spansion v. USITC*, 401 F.3d 1323, 1339 (Fed. Cir. 2010).
41. Pursuant to 19 U.S.C. § 1337(b)(1), the ITC is directed to complete Section 337 investigations “at the earliest practicable time...”
42. *Certain Probe Card Assemblies, Components Thereof, and Certain Tested DRAM and NAND Flash Memory Devices, and Products Containing Same*, Inv. No. 337-TA-621, 2009 WL 2196921, Initial Determination, at *52 (2009).
43. *Id.* at *9 (emphasis added).
44. *Id.* at *9, *52-54; *Comm’n Op.*, 2009 WL 4757332, at *6.
45. *Certain Electronic Digital Media Devices and Components Thereof*, Inv. No. 337-TA-796, Order No. 14, at 5 (Feb. 14, 2012).
46. Office of the U.S. Intellectual Property Enforcement Coordinator, “2013 Joint Strategic Plan on Intellectual Property Enforcement,” at 17 (June 2013).
47. *See Lens-Fitted Film Packages*, HQ 471165 (CBP May 15, 2002).
48. *See Lens-Fitted Film Packages*, Inv. No. 337-TA-406, *Comm’n Op. (Enforcement)*, at 19-21 (June 24, 2003).
49. 19 C.F.R. § 210.79.
50. *See Certain Kinesiotherapy Devices and Components Thereof*, Inv. No. 337-TA-823, *Comm’n Decision To Adopt A Report Issued By The Office of Unfair Import Investigations as An Advisory Op.*, 79 Fed. Reg. 38330 (July 7, 2014); *Certain Cases for Portable Electronic Devices*, 79 Fed. Reg. 64214-15 (Oct. 28, 2014) (instituting advisory opinion proceeding and referring to OUII for investigation and issuance of report within 90 days).
51. *Id.*
52. *Certain Hardware Logic Emulation Systems and Components*, Inv. No. 337-TA-383, *Initial Adv. Op.* at 11-24 (Aug. 7, 2000), *Not. Of Comm’n Non-Review* (Sept. 22, 2000).
53. *Id.*
54. *Certain Sleep-Disordered Breathing Treatment Systems and Components Thereof*, Inv. No. 337-TA-879, *Advisory Op.*, at 11 (Aug. 11, 2014).
55. *See Certain Ink Cartridges and Components*, Inv. No. 337-TA-565, *Comm’n Order* at 2 (Mar. 18, 2011) (consolidating an advisory opinion proceeding and a modification proceeding).
56. *See* 19 U.S.C. §1337(f)(2).
57. *See Genentech, Inc. v. U.S. Int’l Trade Comm’n*, 122 F.3d 1409, 1414 (Fed. Cir. 1997).
58. *See Ninestar Tech. Co. v. Int’l Trade Comm’n*, No. 09-1549, *Slip. Op.* at 15 (Fed. Cir. 2012).

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