

## NOTE

# NOT SO TECHNICAL: AN ANALYSIS OF FEDERAL CIRCUIT PATENT DECISIONS APPEALED FROM THE ITC

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## INTRODUCTION

Patents are notoriously difficult to understand.<sup>1</sup> With claims that seem like they were written using the grammar of another language, detailed specifications, and heavily-numbered drawings, deciphering patents can be intimidating for those not familiar with patent law. The United States Patent and Trademark Office (USPTO) adds to this sense of exclusivity by restricting patent prosecution to individuals with specific technical or scientific backgrounds who are able to pass the Patent Bar.<sup>2</sup>

It may then seem counterintuitive that most adjudicators of patent law disputes do not possess a technical background or have a great deal of prior patent law experience. A widespread perception among the patent law community is that the patent system would be more effective if judges with technical backgrounds and patent law experience decided patent disputes.<sup>3</sup> Proponents believe that if judges all had similar baseline knowledge of technological analysis, there would be more consistency in decision-making, leading to more predictability for parties.<sup>4</sup> Some district courts have unofficially become semi-specialized in patent law disputes,<sup>5</sup> and Congress is debating whether to institute a more formalized Patent Pilot Program in which district court judges specialize in patent law cases.<sup>6</sup>

This Note joins the debate and examines patent law cases at the Court of Appeals for the Federal Circuit (“Federal Circuit”), concentrating on appeals from the International Trade Commission (“ITC”). The ITC serves as a useful case study of patent law disputes at the Federal Circuit level, as it represents approximately seven percent of all patent law disputes that the Federal Circuit handles.<sup>7</sup> Additionally, it is becom-

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1. See, e.g., Sean B. Seymore, *Heightened Enablement in the Unpredictable Arts*, 56 UCLA L. REV. 127, 164 (2008); Matthew D. Powers & Steven C. Carlson, *The Evolution and Impact of the Doctrine of Willful Patent Infringement*, 51 SYRACUSE L. REV. 53, 102–03 (2001).

2. See U.S. PATENT & TRADEMARK ORG., GENERAL REQUIREMENTS BULLETIN FOR ADMISSION TO THE EXAMINATION FOR REGISTRATION TO PRACTICE IN PATENT CASES BEFORE THE UNITED STATES PATENT AND TRADEMARK OFFICE (2008), <http://www.uspto.gov/web/offices/dcom/olia/oed/grb.pdf>.

3. See James F. Holderman & Halley Guren, *The Patent Litigation Predicament in the United States*, 2007 U. ILL. J.L. TECH. & POL’Y 1, 6 (2007).

4. *Id.*

5. Arti K. Rai, *Specialized Trial Courts: Concentrating Expertise on Fact*, 17 BERKELEY TECH L.J. 877, 880 (2002) (finding that ten district courts handle forty percent of all patent law cases at the district court level).

6. See *infra* Part I.A.

7. This calculation was reached by looking at Federal Circuit cases between March 30, 2008, and March 30, 2010. First, I searched the total number of patent law disputes at the Federal Circuit, which included USPTO interferences. I then focused on the total number of ITC appeals from this total. While recognizing that this number is not precise, it does give an

ing an increasingly important forum for patent law disputes. The administrative law judges (“ALJs”) at the ITC are widely viewed as patent experts because of the primacy of patent cases on their docket. The great majority of the ALJs, however, do not possess a technical background.<sup>8</sup> The ITC, to an extent, can be viewed as a model for a patent-specialized trial court program due to similarities between the compositions of the ITC and the proposed specialized trial courts or judges programs.

An examination of the last twenty-five patent investigations appealed from the ITC reveals that more than seventy percent of the issues on appeal are not technical in nature, in the sense that the Federal Circuit does not analyze the issues in a way that requires knowledge of the “science” behind the patents or does not focus on technical issues. The results of this study have a variety of possible implications, some of which point in opposite directions. First, they could imply that, despite the fact that the majority of the ALJs and Commissioners at the ITC do not possess a technical background, their patent law experience allows them to effectively resolve technical issues before cases are appealed. This conclusion could support the establishment of specialized patent trial courts or designated patent judges, in order to allow the Federal Circuit to concentrate on questions of law rather than fact.<sup>9</sup> On the other hand, recent research has revealed that when compared to the generalist district courts the ITC does not perform better, at least with respect to patent claim construction issues, as measured by the reversal rates by the Federal Circuit.<sup>10</sup> If the majority of the issues on appeal, including the claim construction issues, are not technical, this suggests that the Federal Circuit does not reverse the ALJs because the ALJs misunderstand the “science” aspect of the patent but rather because of the general unpredictability of claim construction.<sup>11</sup> If all the courts, including a specialized agency such as the ITC, are reversed at the same rate, this suggests that having judges with technical backgrounds and/or technical experience may not make much difference.

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indication of the importance of ITC cases on the Federal Circuit’s docket. Overall, ITC appeals comprises approximately one percent of the Federal Circuit’s docket. Pauline Newman, *Foreword: The Federal Circuit in Perspective*, 54 AM. U.L. REV. 821, 824 (2005).

8. Of the six current ALJs, only one—Judge Luckern—has a technical background. See *Chief ALJ Paul J. Luckern*, ITC 337 L. BLOG, <http://www.itcblog.com/chief-alj-paul-j-luckern/> (last visited Oct. 12, 2010).

9. See Rai, *supra* note 5, at 879.

10. See David L. Schwartz, *Courting Specialization: An Empirical Study of Claim Construction Comparing Patent Litigation Before Federal District Courts and the International Trade Commission*, 50 WM. & MARY L. REV. 1699 (2009).

11. See Christian A. Chu, *Empirical Analysis of the Federal Circuit’s Claim Construction Trends*, 16 BERKELEY TECH. L.J. 1075, 1078–79 (2001); Kevin A. Meehan, *Shopping for Expedient, Inexpensive & Predictable Patent Litigation*, 2008 B.C. INTELL. PROP. & TECH. F. 102901, at \*5 (commenting on the unpredictability and inefficiency of claim construction at the Federal Circuit).

Finally, the results of this study suggest that patent practitioners should consider the Federal Circuit's procedure in analyzing patent issues. This study indicates that, for the most part, the Federal Circuit avoids technical claim analysis and focuses on non-technical issues. These results suggest that, as a matter of patent litigation strategy, practitioners should avoid technical arguments, at least at the appellate level.

Part I provides a background of the debate on specialized patent law trial courts and the Patent Pilot Program. It also provides a brief primer on the ITC and the procedure that brings ITC cases to the Federal Circuit, which differs in some respects from district court appeals. Part II presents the methodology of this study. Specifically, it presents the five different categories used to group issues, including the criteria by which I defined and determined whether an issue was "technical." Part III outlines the results of this study, as well as some limitations. Finally, Part IV presents the possible implications of my findings and provide some considerations regarding the adjudicators of patent law disputes.

## I. DEBATE ON SPECIALIZED PATENT COURTS AND THE ITC'S PROCEDURE

### A. *Background of the Debate on Specialized Patent Courts*

The difficulty in patent law lies not in the application of the patent legal principles but in the complicated fact-based inquiries involved in understanding the patents.<sup>12</sup> With the high reversal rate of district courts' patent claim constructions,<sup>13</sup> it seems logical that having a set of specialized patent law judges would reduce claim construction uncertainty and reduce the need for further claim construction on appeal. In 2001, Judge Kimberly Moore of the Federal Circuit (then a Professor at George Mason Law School) published an empirical study demonstrating that there was a thirty-three percent error rate in claim construction by district courts, and soon after, Christian Chu calculated that the rate of reversal was actually as high as forty-four percent.<sup>14</sup> Since then, there have been

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12. Rai, *supra* note 5, at 878.

13. See Kimberly A. Moore, *Are District Court Judges Equipped to Resolve Patent Cases?*, 15 HARV. J.L. & TECH. 1, 11 (2001); Chu, *supra* note 11, at 1092.

14. Moore, *supra* note 13, at 2; Chu, *supra* note 11, at 1104. The methodologies of these authors can be debated; however, in discussing the Patent Pilot Program, supporters in Congress adopted the thirty-three percent reversal rate based on Moore's methodology. See Nancy Olson, *Does Practice Make Perfect? An Examination of Congress's Proposed District Court Patent Pilot Program*, 55 UCLA L. REV. 745, 754 n.45 (2008) (citing 153 CONG. REC. H1430, 1431 (daily ed. Feb. 12, 2007) (statement of Rep. Berman)).

numerous proposals on how to better educate district court judges in order to produce a more predictable and efficient patent litigation process.<sup>15</sup>

Some commentators have suggested that a specialized patent law trial court could reserve fact-finding for district court judges, decrease forum-shopping, and increase predictability.<sup>16</sup> Others have proposed extending the jurisdiction of the Court of International Trade (“CIT”) and giving it exclusive jurisdiction over patent law trials.<sup>17</sup> The rationale is that the CIT provides the existing infrastructure, acts as a specialized trial court (for international trade and customs law issues), and appeals its cases to the Federal Circuit.<sup>18</sup> These two options have been criticized because of the expenditure required for a new facility and the election of new judges, as well as the expansion costs in the case of the CIT.<sup>19</sup> There is also concern that a single specialized trial court could result in excessive uniformity, losing the useful debate among the district courts that leads to the evolution of patent legal theory.<sup>20</sup>

Another proposed alternative is not to have a separate court but rather a group of judges within the existing district court system who have a special interest in hearing patent law issues. The Patent Pilot Program was first introduced by Representative Darrell Issa (R-CA) in May 2006 as a way to allow district court judges to selectively specialize in patent law disputes.<sup>21</sup> After the bill was stalled by the Senate Committee on the Judiciary, Representative Issa introduced similar bills in January 2007<sup>22</sup> and January 2009,<sup>23</sup> which both met similar fates in the Committee on the Judiciary.<sup>24</sup> Now there is a corresponding Senate bill, Senate Bill 299, introduced by Senator Arlen Specter (D-PA), which has also

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15. See, e.g., Adam Shartzter, *Patent Litigation 101: Empirical Support for the Patent Pilot Program's Solution to Increase Judicial Experience in Patent Law*, 18 FED. CIR. B.J. 191, 218 (2008).

16. E.g., Rai, *supra* note 5, at 887; Meehan, *supra* note 11, at \*6.

17. E.g., James F. Holderman, *Judicial Patent Specialization: A View from the Trial Bench*, 2002 U. ILL. J.L. TECH. & POL'Y 425, 431–33 (2002); Meehan, *supra* note 11, at \*7.

18. See, e.g., Meehan, *supra* note 11, at \*7.

19. See, e.g., *id.* at \*16–17.

20. See, e.g., *id.*

21. H.R. 5418, 109th Cong. (2006), available at <http://www.govtrack.us/congress/billtext.xpd?bill=h109-5418>.

22. H.R. 34, 110th Cong. (2007), available at <http://www.govtrack.us/congress/billtext.xpd?bill=h110-34>.

23. H.R. 628, 111th Cong. (2009), available at <http://www.govtrack.us/congress/billtext.xpd?bill=h111-628>.

24. H.R. 34 was referred to the Senate Committee on the Judiciary on February 13, 2007, and no further action has been taken. H.R. 628 was referred to the Senate Committee on the Judiciary on March 18, 2009.

been referred to the Committee on the Judiciary.<sup>25</sup> The bills propose a ten-year program to “steer patent cases to judges that have the desire and aptitude to hear patent cases, while preserving the principle of random assignment to help avoid forum shopping.”<sup>26</sup> The program has several requirements for participation: only the fifteen district courts with the highest number of patent cases would be eligible;<sup>27</sup> there would have to be at least ten judges on the bench;<sup>28</sup> and at least three judges would have to request to be in the program.<sup>29</sup> Congress would allocate at least five million dollars each fiscal year for the training of judges and hiring of law clerks with technical expertise.<sup>30</sup> The rationale is that judges with more patent experience will be reversed less frequently, leading to greater consistency and accuracy in the legal system.<sup>31</sup> Critics of the program argue that district court judges should be generalists, and this program would open the door to further judge specialization.<sup>32</sup> For better or for worse, this latest round of proposals has not gained much momentum, and no action has been taken since March 2009.<sup>33</sup>

Another proposal that would specifically address the uncertainty of claim construction is the Patent Reform Act of 2009.<sup>34</sup> As part of the Act, within ten days of a *Markman* hearing,<sup>35</sup> the district court would have the discretion to approve a claim construction interlocutory appeal to the

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25. S. 299 was referred to the Senate Committee on the Judiciary on January 22, 2009. S. 299, 111th Cong. (2009), available at <http://www.govtrack.us/congress/billtext.xpd?bill=s111-299>.

26. Press Release, Senator Arlen Specter, Specter, Issa, Schiff Introduce Legislation to Improve Patent Litigation in District Courts (Jan. 22, 2009), [http://specter.senate.gov/public/index.cfm?FuseAction=NewsRoom.NewsReleases&ContentRecord\\_id=ffe2cb49-dbd6-ae13-5759-3fb54a7fae14](http://specter.senate.gov/public/index.cfm?FuseAction=NewsRoom.NewsReleases&ContentRecord_id=ffe2cb49-dbd6-ae13-5759-3fb54a7fae14).

27. H.R. 628 § 1(b)(2)(A)(i); S. 299 § 1(b)(2)(A)(i).

28. H.R. 628 § 1(b)(2)(B)(i); S. 299 § 1(b)(2)(B)(i).

29. H.R. 628, § 1(b)(2)(B)(ii); S. 299 § 1(b)(2)(B)(ii).

30. H.R. 628 § 1(f)(1); S. 299 § 1(f)(1).

31. Shartzter, *supra* note 15, at 219. *But see* Olson, *supra* note 14, at 780 (noting that no available study found a correlation between judicial experience with patent cases and affirmation rates).

32. Shartzter, *supra* note 15, at 225; R. David Donoghue, *Northern District Judges Split on Patent Pilot Program*, CHICAGO IP LITIGATION BLOG (May 10, 2007), <http://www.chicagoplitigation.com/2007/05/articles/legal-news/northern-district-judges-split-on-patent-pilot-program/>.

33. *See* S. 299; H.R. 628.

34. Patent Reform Act of 2009, H.R. 1260, 111th Cong. (2009), available at <http://www.govtrack.us/congress/bill.xpd?bill=h111-1260>; Patent Reform Act of 2009, S. 515, 111th Cong. (2009), available at <http://www.govtrack.us/congress/bill.xpd?bill=s111-515>.

35. A *Markman* hearing is a separate claim construction hearing during which the court hears evidence and argument about how certain claims in a patent should be construed prior to the patent infringement hearing. BLACK'S LAW DICTIONARY 1058 (9th ed. 2009). The name originates from the landmark case *Markman v. Westview Instruments*, 517 U.S. 370 (1996), in which the Supreme Court held that claim construction was purely a question of law to be decided by judges and not a question of fact to be decided by juries.

Federal Circuit.<sup>36</sup> While this approach might lead to greater consistency in claim construction by allowing the Federal Circuit to perform more of these analyses, critics worry that it would create a backlog at the Federal Circuit level and impede judicial efficiency.<sup>37</sup> In addition, it might discourage parties from settling early; instead, it would incentivize them to appeal every claim construction issue. Additionally, the increased pressure on the Federal Circuit's docket may prevent it from concentrating its resources on more significant legal issues.<sup>38</sup>

### B. *The ITC and Its Procedure*

The ITC is a quasi-judicial agency with the authority to adjudicate intellectual property disputes through Section 337 of the Smoot-Hawley Tariff Act.<sup>39</sup> This statute authorizes the ITC to initiate investigations into any unlawful alleged importation, sale for importation, or importation after sale of articles that infringe upon a valid U.S. intellectual property right.<sup>40</sup> With more products manufactured outside of the United States and imported domestically, along with the increased ease of satisfying the domestic industry requirement unique to ITC proceedings, the relevance of the ITC has grown tremendously since its creation.<sup>41</sup> The ITC almost exclusively addresses patent infringement violations,<sup>42</sup> possibly because trademark and copyright holders are able to register their intellectual property with Customs and Border Protections and therefore may not have as much use for the protections of the ITC.<sup>43</sup> The ITC is quickly becoming a popular forum for patentees to air their grievances: the

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36. Compare H.R. 1260 § 10(b) with S. 515 § 8(b).

37. See, e.g., Meehan, *supra* note 11, at \*12; J. Matt Buchanan, *The Patent Reform Act of 2009—Interlocutory Claim Construction Appeals Create a Whole New Patent Backlog*, PROMOTE THE PROGRESS (Mar. 12, 2009), <http://promotetheprogress.com/the-patent-reform-act-of-2009-interlocutory-claim-construction-appeals-create-a-whole-new-patent-backlog/1121/>.

38. Edward Reines & Nathan Greenblatt, *Interlocutory Appeals of Claim Construction in the Patent Reform Act of 2009*, 2009 PATENTLY-O PATENT L.J. 1, 11 (2009), <http://www.patentlyo.com/interlocutoryappeals2009-1.pdf>.

39. The Act has since been codified in the United States Code but is still referred to as Section 337. 19 U.S.C. § 1337 (2006).

40. *Id.* §§ 1337(a)(1)(B)–(E), (b)(1).

41. See Thomas A. Broughan, III, *Modernizing § 337's Domestic Industry Requirement for the Global Economy*, 19 FED. CIR. B.J. 41, 42–43 (2009); William Dolan, *The International Trade Commission: Potential Bias, Hold-up, and the Need for Reform*, 2009 DUKE L. & TECH. REV. 11, 1 (2009).

42. Approximately eighty-five percent of Section 337 cases are patent disputes. Colleen V. Chien, *Patently Protectionist? An Empirical Analysis of Patent Cases at the International Trade Commission*, 50 WM. & MARY L. REV. 63, 70 (2008).

43. See *Customs and Border Protection (CBP)—Intellectual Property Rights e-Recordation (IPRR)*, U.S. CUSTOMS & BORDER PROTECTION, <https://apps.cbp.gov/e-recordations/index.asp> (last visited Oct. 14, 2010). Note, however, that this explanation does not account for trade secrets and other forms of intellectual property that are included in Section 337. § 1337(a)(1)(A), (D)–(E) (2010); see also Chien, *supra* note 42, at 83 n.123.

number of ITC investigations has tripled in the past decade.<sup>44</sup> Because the ITC is able to award injunctions but not statutory damages, about sixty-five percent of ITC cases have a district court counterpart.<sup>45</sup> In many ways, the substance of district court cases and ITC investigations appears quite similar: the parties present the same infringement and invalidity issues, use the same kind of experts and evidence, and are equally invested in the outcome.<sup>46</sup> However, there are some important procedural differences at the ITC, which I outline below.

When a patent or other intellectual property holder wishes to commence an investigation, he or she files a complaint with the Secretary of the Commission.<sup>47</sup> The detailed complaint must assert specific instances of alleged unlawful importation or sales and a description of the relevant domestic industry.<sup>48</sup> Prior to filing, potential complainants are encouraged to consult with the Office of Unfair Import Investigations (OUII) to make sure that the complaint complies with ITC rules, as well as to discuss the merits of the complaint.<sup>49</sup> This process can act as an informal “weed out” tool for improper complaints.<sup>50</sup> The OUII recommends to the ITC whether or not to initiate an investigation.<sup>51</sup>

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44. Nine investigations were instituted in 1999; thirty-one investigations were instituted in 2009. Although 1999 had fewer investigations than its neighboring years—eleven in 1998 and seventeen in 2000—the overall trend has been a significant increase in the number of investigations. *Number of Investigations by Calendar Year*, U.S. INT’L TRADE COMMISSION, [http://www.usitc.gov/intellectual\\_property/documents/cy\\_337\\_institutions.pdf](http://www.usitc.gov/intellectual_property/documents/cy_337_institutions.pdf) (last visited Oct. 14, 2010). As of May 3, 2010, twenty complaints have been filed with the ITC. *Investigations Under Section 337 of the Tariff Act of 1930*, U.S. INT’L TRADE COMMISSION, [http://www.usitc.gov/press\\_room/337\\_stats.htm](http://www.usitc.gov/press_room/337_stats.htm) (last visited Oct. 14, 2010).

45. Chien, *supra* note 42, at 70. ITC cases are almost always resolved prior to any corresponding district court decision. However, ITC decisions are only persuasive authority and not binding on the district court. See Barry Herman & Archie L. Alston II, *Did You Know . . . Determinations of Patent Issues at the ITC Are for Purposes of Section 337 Only and Do Not Have Res Judicata Effect?*, ITC 337 L. BLOG (Mar. 19, 2009, 2:03 PM), <http://www.itcblog.com/20090319/did-you-know-determinations-of-patent-issues-at-the-itc-are-for-purposes-of-section-337-only-and-do-not-have-res-judicata-effect/> (citing *Tex. Instruments Inc. v. Cypress Semiconductor Corp.*, 90 F.3d 1558, 1569 (Fed. Cir. 1996)).

46. See Schwartz, *supra* note 10, at 1710 (“On a substantive level, the underlying patent law is essentially the same before the ITC and the district courts. Importantly, there are no differences in the law of claim construction.”).

47. 19 C.F.R. § 210.8 (2010).

48. ITC complaints must contain fact pleading, 19 C.F.R. § 210.12, in contrast to the notice pleading requirement found in rule 8 of the Federal Rules of Civil Procedure. FED. R. CIV. P. 8. The domestic industry requirement is unique to the ITC. See *infra* Part IV.A.

49. See KENT R. STEVENS ET AL., DEMYSTIFYING 337 INVESTIGATION AT THE ITC: PRE-HEARING PREPARATION 6, <http://www.ipo.org/AM/Template.cfm?Section=Home&Template=/CM/ContentDisplay.cfm&ContentFileID=55206>.

50. G. Brian Busey, *An Introduction to Section 337 and the U.S. International Trade Commission*, 949 PLI/PAT 11, 15 (2008).

51. 19 C.F.R. § 207.102 (2010).



Once a complaint has been filed, the ITC will generally make a determination within thirty days as to whether or not it will commence an investigation.<sup>52</sup> If it determines that an investigation is warranted, it will issue a Notice of Investigation in the Federal Register.<sup>53</sup> The ALJ<sup>54</sup> assigned to the case will set his own ground rules and timeline for the proceeding of the investigation<sup>55</sup> and will issue any necessary protective orders.<sup>56</sup> While ALJs are not expressly bound by the Federal Rules of Civil Procedure, they will often set parallel rules for discovery, albeit on a shorter timeline.<sup>57</sup> Discovery is broader at the ITC than at the district courts due to the ability of the ITC to exercise in rem jurisdiction.<sup>58</sup>

While there is no longer a statutory timeline for the completion of ITC investigations,<sup>59</sup> Section 337 proceedings must be completed “at the earliest practicable time.”<sup>60</sup> Even with the growing number of investigations, the Code of Federal Regulations requires that the ALJ set the target date for the completion of the investigation at a maximum of sixteen months and have the initial determination completed four months prior to this target date to allow time for review by the Commission.<sup>61</sup>

There are several key differences in ITC procedure that are important to keep in mind when analyzing investigations on appeal at the Federal Circuit. First, instead of having just two parties—the complainant and the respondent—an Investigative Attorney from the OUII acts as a third party representing the public interest in the hearings.<sup>62</sup> These attorneys all have patent law experience and are not bound to any particular legal position, and thus their opinions may be given greater deference by the ALJs.<sup>63</sup> Second, ALJs rarely hold separate *Markman*

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52. 19 C.F.R. § 210.10(a) (2010).

53. *Id.* § 210.10(b).

54. There are currently six ALJs sitting at the ITC: Judges Bullock, Charneski, Essex, Gildea, Luckern, and Rogers.

55. 19 C.F.R. §§ 210.5(e), 210.51(a) (setting a preferred target date of sixteen months from the notice of the investigation).

56. *Id.* § 210.34.

57. See Schwartz, *supra* note 10, at 1724; Busey, *supra* note 50, at 25–26.

58. See Patricia Larios, *The U.S. International Trade Commission's Growing Role in the Global Economy*, 8 J. MARSHALL REV. INTELL. PROP. L. 290, 305 (2009).

59. As part of the 1974 amendments to Section 337, ITC investigations were required to be completed within twelve months, with an extension possible up to eighteen months for “more complicated” investigations. Fixed statutory time limits were eliminated as part of the 1994 amendments to Section 337, and now the statute requires completion by “the earliest practicable time.” 19 U.S.C. § 1337(b)(1) (2006).

60. *Id.*

61. 19 C.F.R. §§ 210.42, 210.51. The ALJ can extend the target date for good cause beyond the sixteen month timeframe. 19 C.F.R. §§ 210.51(a). However, the Federal Register explains that Congress did not expect these amendments to “increase the number of investigations with target dates longer than 15 months.” 73 Fed. Reg. 38, 316 (July 7, 2008).

62. Busey, *supra* note 50, at 15.

63. *Id.*

hearings, so parties often have to argue alternative claim constructions at the main hearing.<sup>64</sup> Finally, some ALJs prefer written direct testimony, with the result that some hearings are focused entirely on the cross-examination of witnesses.<sup>65</sup> As discussed in Part IV, these differences in procedure at the lower level may have an effect on the kind of issues decided on appeal.

The ITC may review the decision of the ALJ *sua sponte* or upon the petition of one of the parties.<sup>66</sup> The ITC will decide whether or not it will review all or a portion of the initial determination within sixty days.<sup>67</sup> If the ITC declines to review the initial determination, it becomes the final determination for the agency.<sup>68</sup> Even if the ITC reviews the initial determination, there are generally no additional hearings or submissions; rather, the ITC will make a determination based on the ALJ hearing and submissions.<sup>69</sup> The ITC is able to issue injunctive remedies in the form of limited exclusion orders (LEOs) directed to particular respondents<sup>70</sup> or in the form of general exclusion orders (GEOs), which exclude from importation every article that infringes the patents asserted in the suit regardless of which parties were named as respondents.<sup>71</sup> The ITC may also issue cease-and-desist orders directed towards specific respondents if there already is a “commercially significant” inventory in the United States that would render an exclusion order ineffective.<sup>72</sup>

Once the ITC decision is made, there is a sixty-day period during which the President of the United States can review the determination and choose not to adopt it.<sup>73</sup> If the President takes no action during this time period, the ITC’s decision becomes final.<sup>74</sup> Parties may appeal ITC decisions to the Federal Circuit within sixty days of the issuance of its

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64. *Id.* at 26.

65. *Id.*

66. 19 C.F.R. §§ 210.43(a), 210.46 (2010).

67. 19 C.F.R. § 210.43(d)(1).

68. U.S. INT’L TRADE COMMISSION, PUB. NO. 4105, SECTION 337 INVESTIGATIONS: ANSWERS TO FREQUENTLY ASKED QUESTIONS (2009), available at [http://www.usitc.gov/intellectual\\_property/documents/337\\_faqs.pdf](http://www.usitc.gov/intellectual_property/documents/337_faqs.pdf).

69. 19 C.F.R. § 210.43(d)(2). The ITC has the authority to ask for additional briefs from the parties, and the parties may submit a request for oral argument. 19 C.F.R. § 210.45(a) (2010).

70. 19 U.S.C. § 1337(d)(1) (2006).

71. § 1337(d)(2).

72. Carl C. Charneski, *The Role of the Office of the Administrative Law Judges Within the United States International Trade Commission*, 8 J. MARSHALL REV. INTELL. PROP. L. 216, 228 (2009).

73. 19 U.S.C. § 1337(j).

74. § 1337 (j)(4). Presidential disapproval is rare. See Bas de Blank & Bing Chen, *Where Is the ITC Going After Kyocera?*, 25 SANTA CLARA COMPUTER & HIGH TECH. L.J. 701, 719 (2009).

final determination.<sup>75</sup> Appeals to the Federal Circuit can only be entertained after the ITC has rendered a “final . . . decision on the merits, excluding or refusing to exclude articles from entry.”<sup>76</sup>

The Federal Circuit reviews ITC decisions in accordance with the APA standards.<sup>77</sup> Legal determinations are reviewed *de novo*, and issues of fact are reviewed under the “substantial evidence” standard.<sup>78</sup> The Federal Circuit has broad discretion to set aside ITC findings that are determined to be “arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.”<sup>79</sup>

## II. METHODOLOGY: DETERMINING WHAT’S TECHNICAL

### A. *The Data Collected*

The purpose of this empirical study is to analyze the character of the issues appealed from the ITC to the Federal Circuit. This study encompasses the last 101 issues on appeal, which span cases from May 2001 through April 2010, and comprises twenty-five separate investigations. There have been a total of 113 patent appeals from the ITC since the Federal Circuit was established in 1982, including multiple appeals stemming from the same investigations.<sup>80</sup> Starting in reverse chronological order, I analyzed the most recent appeals and examined the first twenty-five separate investigations. These twenty-five investigations, which have a total of 101 issues, were chosen arbitrarily as a representative sample of the recent issues that have been resolved on appeal. In counting these twenty-five investigations, cases with earlier hearings for the same investigation were counted as a single investigation.<sup>81</sup> Based on

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75. 19 U.S.C. § 1337(c).

76. Robert A. Caplen, *Recent Trends Underscoring International Trade Commission Review of Initial Determinations and Federal Circuit Appeals from Final Commission Determinations Under Section 337 of the Tariff Act of 1930*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 337, 360 (2007) (quoting *Block v. Int’l Trade Comm’n*, 777 F.2d 1568, 1571 (Fed. Cir. 1985)).

77. *See, e.g.*, *Ajinomoto Co. v. Int’l Trade Comm’n*, 597 F.3d 1267, 1272 (Fed. Cir. 2010) (providing a recent articulation of the Federal Circuit’s standards of review for ITC decisions).

78. *Id.*

79. 5 U.S.C. § 706(2)(A) (2010).

80. This number was obtained based on a LEXIS search of the category “Court of Appeals Federal Circuit—Patent Cases” with the party name “International Trade Commission.” This number is accurate as of April 1, 2010. For a discussion of the possible limitations of this methodology, see *infra* Part III.C.

81. *See, e.g.*, *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 275 F. App’x. 969 (Fed. Cir. 2008); *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366 (Fed. Cir. 2006). Not every prior proceeding for every investigation presented is included. Represented are only those conducted after September 10, 2003, the date of the Federal Circuit decision in *Alloc*

this methodology, I examined a total of thirty-three cases. Unpublished/nonprecedential opinions were included as part of the study.<sup>82</sup> The one design patent case among the last twenty-five investigations, *Crocs, Inc. v. International Trade Commission*,<sup>83</sup> was also included, as this would be within the spectrum of cases a district court or patent-specialized judge would hear. Rule 36 summary affirmances of ITC decisions were not included as part of the study, primarily because there was no way to easily locate them online.<sup>84</sup>

I collected a variety of data for each case in my analysis, including every issue decided on appeal, the identities of the ALJ at the initial hearing and members of the Federal Circuit panel, the litigation procedure, and the resolution of each issue.<sup>85</sup> I also collected the educational background of the current ALJs, Commissioners and Federal Circuit judges, as well as those who served for the analyzed cases but have since retired. In defining the “issues,” this study only counted those issues that were expressly reviewed by the Federal Circuit.<sup>86</sup>

The 101 issues on appeal were sorted into categories based on the technical complexity of the resolved issue.<sup>87</sup> This is a relevant metric, because the analysis of ITC issues at the Federal Circuit level can at least suggest what kind of issues a possible patent district court or judge would address and how these issues would be decided on appeal. In addition, examining the degree of technical complexity at the Federal Circuit level indicates what kind of issues are the most debated on ap-

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*Inc. v. Int'l Trade Comm'n*, 342 F.3d 1361 (Fed. Cir. 2003), the twenty-fifth most recent investigation on appeal.

82. See, e.g., Richard S. Arnold, *Unpublished Opinions: A Comment*, 1 J. APP. PRAC. & PROCESS 219 (1999) (discussing the importance of unpublished opinions); Tony Mauro, *Supreme Court Votes to Allow Citation to Unpublished Opinions in Federal Courts*, LAW.COM (Apr. 13, 2006), <http://www.law.com/jsp/law/LawArticleFriendly.jsp?id=1144845716431>.

83. *Crocs, Inc. v. Int'l Trade Comm'n*, 598 F.3d 1294 (Fed. Cir. 2010).

84. FED. CIR. R. PRAC. 36, available at [http://www.cafc.uscourts.gov/images/stories/rules-of-practice/rules\\_2010.pdf](http://www.cafc.uscourts.gov/images/stories/rules-of-practice/rules_2010.pdf).

85. Issues were labeled “affirmed” if the Federal Circuit came to the same ultimate resolution on the issue, even if there was a modification of the finding. Issues were marked “affirmed in part, reversed in part” when the Federal Circuit preserved some of the ITC’s analysis but not all of it. Issues that were reversed on appeal or vacated and remanded on appeal are referred to and labeled “reversed,” with a designation of these latter issues included in Appendix A.

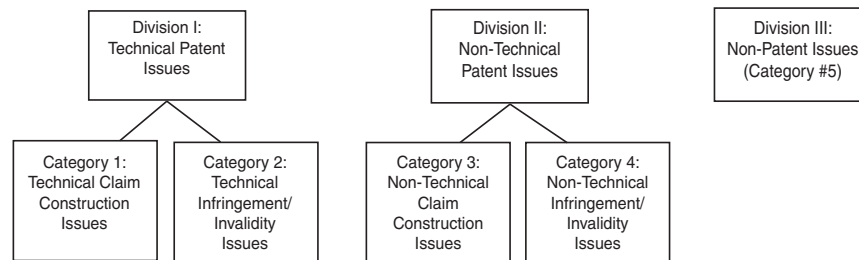
86. While this distinction is somewhat arbitrary, it follows the style of similar empirical studies. See Chu, *supra* note 11, at 1094–95. The study only counted issues where the Federal Circuit had an opportunity to render an opinion on an ITC determination, and did not count issues that the court considered on appeal *sua sponte*, such as standing.

87. See Appendix A for a comprehensive break-down of the categorization of each individual issue.

peal and may indicate what kind of background and experience is best suited to resolve these kinds of issues.<sup>88</sup>

### B. Categories

The 101 appealed issues were sorted into five separate categories based on the level of technical analysis of the patents. There are three main categories: technical patent issues, non-technical patent issues, and non-patent issues. Within the first two categories are two sub-categories: claim construction issues and infringement/invalidity issues.



Categories 1 and 3—“Technical Claim Construction Issues” and “Non-Technical Claim Construction Issues,” respectively—consist of analyses of specific claim terms in the asserted patents that are used to determine infringement or invalidity. The ITC rarely holds separate *Markman* hearings, so claim construction issues are often a major part of the Court’s opinions.<sup>89</sup> While identifying claim construction issues is relatively easy, determining a clear division between “technical” and “non-technical” claim construction issues is considerably more difficult. To provide clarity by comparison, the two categories are discussed together. Because the focus of the numbering is to differentiate on the basis of technical analysis, they are not in sequential categories.

To some extent, all claim construction analyses are arguably technical, because they involve a close reading of the patent and at least a cursory understanding of the invention. What differentiates Category 1 claim constructions from their Category 3 counterparts is the level of depth of the analysis. For Category 1 issues, the Federal Circuit analyzed technical aspects of the patent, such as details about how the device worked, or engaged in an in-depth discussion about the prior art. If it was clear that the judge would need to understand the technical aspects

88. For example, judges with a technical background or prior patent experience may be better equipped to handle certain issues than judges without such backgrounds.

89. 41.5% of the issues on appeal in this study were claim construction issues.

of the patent by way of a tutorial<sup>90</sup> or personal experience, to make a determination, the issue was placed in Category 1. *Linear Technology Corp. v. International Trade Commission* is an example of a case that has several Category 1 issues.<sup>91</sup> The patent in this case was for voltage regulators.<sup>92</sup> There were several claim constructions at issue, such as the phrase “monitoring the current to the load.”<sup>93</sup> In order to construe this claim and to assess whether this phrase was a limitation on the scope of the patent, the Federal Circuit performed a close reading of the specification as well as an analysis of how the parties’ proposed meanings comported with Ohm’s law.<sup>94</sup> To make its determination, the Federal Circuit judges needed to have some kind of understanding of the electrical engineering principles at issue and also of how the voltage regulator product worked in practice.

Conversely, the claim constructions in Category 3 did not involve a technical analysis of the patent.<sup>95</sup> Claim construction issues fit into Category 3 when the Federal Circuit used non-technical techniques to make determinations, such as when it focused on grammatical issues, turned to dictionaries or specifications for definitions, or performed superficial comparisons of the prior art or drawings. For example, the claim construction at issue in *Energizer Holdings, Inc. v. International Trade Commission*,<sup>96</sup> involved the term “said zinc anode.” The patent was for a (substantially) mercury-free electrolytic alkaline battery cell, and claim 1 had been held invalid by the ITC for indefiniteness based on this phrase.<sup>97</sup> The ITC’s invalidation of the claim was based on matching the word “said” to the appropriate antecedent.<sup>98</sup> The Federal Circuit discussed the requirement of an antecedent basis. It ultimately concluded

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90. See Jeffrey L. Snow & Andrea B. Reed, *Tutorials in Patent Litigation: Educating District Court Judges*, ABA LITIGATION NEWS (2009), [http://www.abanet.org/litigation/litigationnews/practice\\_areas/intellectual-patent-district-court.html](http://www.abanet.org/litigation/litigationnews/practice_areas/intellectual-patent-district-court.html) (providing an overview of the tutorial process).

91. *Linear Tech. Corp. v. Int’l Trade Comm’n*, 566 F.3d 1049 (Fed. Cir. 2009). This case should not be confused with its companion case *Linear Tech. Corp. v. International Trade Commission*, 292 F. App’x 52 (Fed. Cir. 2008) (reviewing a different patent stemming from the same original ITC investigation).

92. U.S. Patent No. 6,580,258 (filed Oct. 15, 2001).

93. See *Linear Tech.*, 566 F.3d at 1053.

94. *Id.* at 1059–60.

95. This is not to say that the Federal Circuit did not understand the technical aspects of the patent but rather that such analysis was not a critical part of the Federal Circuit’s opinion.

96. *Energizer Holdings, Inc. v. Int’l Trade Comm’n*, 435 F.3d 1366 (Fed. Cir. 2006). Again, this is not to be confused with the more recently appealed case from the same investigation, *Energizer Holdings, Inc. v. International Trade Commission*, 275 F. App’x 969 (Fed. Cir. 2008).

97. *Energizer Holdings*, 435 F.3d at 1367–68; U.S. Patent No. 5,464,709 (filed Dec. 2, 1994).

98. *Energizer Holdings*, 435 F.3d at 1369–70.

that the claim was not invalid, because neither the Commission nor the intervenors argued on appeal that the lack of an antecedent caused them to misunderstand the intended scope of the claim.<sup>99</sup> The Federal Circuit did not provide a detailed explanation of how the battery worked, nor was it necessary to know the technical details of the patent in order to perform this analysis.

The crucial difference between Categories 1 and 3 is the focus of the analysis and not necessarily the claim terms themselves. For example, the disputed phrase “transparent window layer” in *Epistar Corp. v. International Trade Commission* did not seem on its face to merit a technical claim construction analysis, but the Federal Circuit analyzed the issue in a technical manner that required a scientific understanding of how LED lights function, placing it in Category 1.<sup>100</sup>

Certainly, some issues could conceivably fit into either Categories 1 or 3, or both. In making claim construction determinations, the Federal Circuit rarely consults just one source. In these borderline cases, I erred towards categorizing the issue in the “Technical Claim Construction” category. Because I use my findings to infer the kind of background judges making patent dispute determinations should have, it makes sense to overestimate, rather than underestimate, the number of technical issues. Presumably the adjudicators with technical backgrounds would be equipped to deal with both technical and non-technical issues, whereas adjudicators without a technical background and/or without experience might struggle with the technical issues.

Issues in these two claim construction categories include both the actual construction of disputed claim terms, as well as related infringement and invalidity analyses exclusively based on the properly construed term. Sometimes, the claim construction issue was analyzed separately from the infringement or invalidity analysis, and in these cases, the issues were evaluated separately. When the claim construction analysis was inextricably bound with the infringement or invalidity analysis, it was counted as a single issue.

Categories 2 and 4—“Technical Infringement/Invalidity Issues” and “Non-Technical Infringement/Invalidity Issues,” respectively—comprise a wide range of patent issues. Any issue that involved the asserted patent(s) but did not consist of claim construction fit into one of these categories. Claim construction issues were placed in a separate category because of their prominence in patent cases at the Federal Circuit level and because many prior studies analyzing issues on appeal have focused exclusively on

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99. *Id.* at 1370–71.

100. *Epistar v. Int’l Trade Comm’n*, 566 F.3d 1321, 1330–31 (Fed. Cir. 2009).

claim construction.<sup>101</sup> The Category 2 issues have a similar depth of analysis as the “Technical Claim Construction” issues of Category 1 but are not centered on the analysis of a particular phrase or claim. For example, in *Broadcom Corp. v. International Trade Commission*, Broadcom argued that the ALJ’s finding of non-infringement for one of the accused products was based on a misunderstanding of an expert witness’s testimony.<sup>102</sup> In analyzing the issue, the Federal Circuit needed to have an understanding of the claim terms as interpreted by the ITC, as well as the expert testimony.<sup>103</sup> In *Solomon Technologies, Inc. v. International Trade Commission*, the Federal Circuit compared the accused devices and the devices described in the specification of the patent.<sup>104</sup> The Federal Circuit needed to have a familiarity with the terminology of the patent and needed to interpret what was being described in the preferred embodiments.<sup>105</sup>

Issues in Category 4 are related to the asserted patent but do not involve any in-depth analysis. Examples of patent-related issues in Category 4 include filing date disputes,<sup>106</sup> patent misuse issues,<sup>107</sup> and the application of the Safe Harbor Clause.<sup>108</sup> The asserted patents were often discussed in broad terms, and the Federal Circuit typically did not go into detail about the individual patents. The basic criterion for this category is that the issues are connected to the asserted patents but do not require any technical understanding of the patent claims or how the invention works.

Issues that are completely independent of the patents at issue are placed in Category 5, entitled “Non-Patent Issues.” What differentiates these issues from those in Categories 2 and 4 is that the analysis the Federal Circuit performed was not necessarily related to issues unique to patent law. Generally, the issues in this category are related to civil procedure, including standing,<sup>109</sup> the timing of the petition for review,<sup>110</sup> identifying the statutory basis for initiating enforcement proceedings,<sup>111</sup> and asserting a specific defense.<sup>112</sup>

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101. See, e.g., Chu, *supra* note 11; Moore, *supra* note 13; Schwartz, *supra* note 10.

102. *Broadcom Corp. v. Int’l Trade Comm’n*, 542 F.3d 894, 905–07 (Fed. Cir. 2008).

103. *Id.*

104. *Solomon Techs., Inc. v. Int’l Trade Comm’n*, 524 F.3d 1310, 1317–18 (Fed. Cir. 2008).

105. *Id.*

106. See, e.g., *Ajinomoto Co. v. Int’l Trade Comm’n*, 597 F.3d 1267, 1276–78 (Fed. Cir. 2010).

107. *Princo Corp. v. Int’l Trade Comm’n*, 563 F.3d 1301 (Fed. Cir.), *vacated*, 583 F.3d 1380 (Fed. Cir. 2009), *rev’d en banc*, 616 F.3d 1318 (Fed. Cir. 2010).

108. See, e.g., *Amgen Inc. v. Int’l Trade Comm’n*, 565 F.3d 846 (Fed. Cir. 2009).

109. See, e.g., *SiRF Tech., Inc. v. Int’l Trade Comm’n*, 601 F.3d 1319, 1325–29 (Fed. Cir. 2010).

110. See, e.g., *Broadcom Corp. v. Int’l Trade Comm’n*, 542 F.3d 894, 896–97 (Fed. Cir. 2008).

111. See, e.g., *VastFame Camera, Ltd. v. Int’l Trade Comm’n*, 386 F.3d 1108, 1112–13 (Fed. Cir. 2004).

112. *Id.* at 1114–15.



Issues related to remedies were also included in this category.<sup>113</sup> Overall, this category consists of the “et cetera” issues in the study and captured those matters that were only tangentially related to the asserted patents.

### III. FINDINGS AND LIMITATIONS

The results of this study indicate that the majority of the issues on appeal at the Federal Circuit are not technical in nature (or are not analyzed in a technical manner), and that most of the time the determinations of the ITC are affirmed. Perhaps the most surprising finding is that a comparison of the affirmance rates for technical and non-technical issues demonstrates that the ITC was affirmed at a higher rate for the technical issues than for the non-technical issues, even though most of the ALJs and members of the ITC do not have a technical background.

#### A. Findings—Generally

Of the 101 issues on appeal, the Federal Circuit affirmed the ITC’s findings for 63.3% of the issues and for 70.3% of the issues including decisions affirmed in part. The following chart summarizes the findings of the study.<sup>114</sup>

	<b>Category 1</b>	<b>Category 2</b>	<b>Category 3</b>	<b>Category 4</b>	<b>Category 5</b>
	<i>Technical Claim Construction Issues</i>	<i>Technical Infringement/Invalidity Issues</i>	<i>Non-Technical Claim Construction Issues</i>	<i>Non-Technical Infringement/Invalidity Issues</i>	<i>Non-Patent Issues</i>
Total Number of Issues (and Percentage)	19 (18.8%)	7 (6.9%)	23 (22.7%)	33 (32.7%)	19 (18.8%)
Determination	17 (89.5%) AFFIRMED	4 (57.1%) AFFIRMED	11 (47.8%) AFFIRMED	19 (57.6%) AFFIRMED	13 (68.4%) AFFIRMED
	2 (10.5%) REVERSED	2 (28.6%) REVERSED	9 (39.1%) REVERSED	12 (36.3%) REVERSED	5 (26.3%) REVERSED
		1 (14.3%) AFFIRMED IN PART/ REVERSED IN PART	3 (13.0%) AFFIRMED IN PART/ REVERSED IN PART	2 (6.1%) AFFIRMED IN PART/ REVERSED IN PART	1 (5.3%) AFFIRMED IN PART/ REVERSED IN PART

113. See, e.g., *Fuji Photo Film Inc. v. Int’l Trade Comm’n*, 474 F.3d 1281 (Fed. Cir. 2007).

114. See Appendix A for a detailed analysis of all the issues on appeal.

**Claim Construction Issues:** There were forty-two claim construction issues on appeal, slightly under half of all the issues reviewed by the Federal Circuit. The ITC's determination was affirmed on twenty-eight (66.7%) of the issues and on thirty-one issues (73.9%) including affirmances in part. Curiously enough, the rate of affirmance was higher for technical claim construction issues (89.5%) than for non-technical claim construction issues (47.8%, or 60.9% including affirmances in part).

**Infringement/Invalidity Issues:** There were a total of forty infringement/invalidity issues, the vast majority falling into Category 4 ("Non-Technical Infringement/Invalidity Issues"). With both Categories 2 and 4 combined, the ITC was affirmed on twenty-three (57.5%) of the issues (65.0% including affirmances in part). Breaking down the findings by category, the Federal Circuit affirmed the issues in Category 2 ("Technical Infringement/Invalidity Issues") on four (57.1%) occasions (71.4% including an affirmance in part) and the Category 4 issues on nineteen (57.6%) occasions (63.6% including affirmances in part).

**Non-Patent Issues:** There were a total of nineteen non-patent issues, and the Federal Circuit affirmed the opinion of the ITC for thirteen (68.4%) of these issues (73.7% including affirmances in part).

**Technical vs. Non-Technical Issue Comparison:** There were a total of twenty-six technical issues (comprising those issues in Categories 1 and 2) on appeal, and the ITC's determinations were affirmed for twenty-one (80.8%) of these issues (84.6% including an affirmance in part). There were seventy-five non-technical issues (from Categories 3, 4, and 5) on appeal, with a 57.3% affirmance rate (65.3% including affirmances in part).

### B. Findings—Technical Background

After categorizing the 101 issues on appeal based on the degree of technical analysis, I used educational background as a variable to reveal any correlation between an ALJ's educational background and the rate at which their decisions were reversed on appeal. This analysis was performed by examining the procedural history of the issues reviewed by the Federal Circuit. For simplicity, this study did not take into account those issues that were not expressly reviewed by the Federal Circuit, although it is entirely possible that if the ITC modified (or determined not to review) certain issues, the Federal Circuit would have resolved those issues. In cases where the ITC may have modified the ALJ's finding but reached the same ultimate conclusion, I counted this as an affirmance by

the ITC.<sup>115</sup> I did not take into account the type of technical background the ALJ had in order to determine their area of expertise. Having experience in one field does not mean expertise in all fields, although an argument could be made that having technical training and experience could be useful for multiple fields, just as having training in one area of law could be helpful for practicing in different legal areas. For this portion of the study, affirmances in part were counted as part of the affirmance rate.

The following table presents a summary of the findings.

<b>Background</b>	<b>Judge</b>	<b>Affirmance Rate —Overall</b>	<b>Affirmance Rate —Technical Issues (Categories 1 and 2)</b>	<b>Affirmance Rate —Non-Technical Issues (Categories 3–5)</b>
Technical	Luckern	63.2% (24 of 38 issues)	80.0% (4 of 5 issues)	60.6% (20 of 33 issues)
Technical	Terrill	66.7% (4 of 6 issues )	100% (1 of 1 issue)	60.0% (3 of 5 issues)
	<i>Totals</i>	<i>63.6%</i> <i>(28 of 44 issues)</i>	<i>83.3%</i> <i>(5 of 6 issues)</i>	<i>60.5%</i> <i>(23 of 38 issues)</i>
Non-Technical	Bullock	63.0% (17 of 27 issues)	80.0% (4 of 5 issues)	59.1% (13 of 22 issues)
Non-Technical	Charneski	80.0% (4 of 5 issues)	0% (0 of 1 issue)	100% (4 of 4 issues)
Non-Technical	Harris	44.0% (11 of 25 issues)	64.3% (9 of 14 issues)	18.2% (2 of 11 issues)
	<i>Totals</i>	<i>56.1%</i> <i>(32 of 57 issues)</i>	<i>65.0%</i> <i>(13 of 20 issues)</i>	<i>51.4%</i> <i>(19 of 37 issues)</i>

I hypothesized that the judges with a technical background would be affirmed at a higher rate than their peers without a technical background for the “technical” issues resolved by the Federal Circuit. These results suggest that that this hypothesis is correct and further suggest that the judges with a technical background perform better at the Federal Circuit overall. A closer look at the results, particularly among the judges without a technical background, demonstrates the wide variance in affirmance rates. It is worth noting that Judges Terrill and Charneski had each only ruled on one technical issue each, and this may have skewed the results.<sup>116</sup> In addition, there are only five judges analyzed; all had

115. See, e.g., *Vanderlande Indus. Nederland BV v. Int’l Trade Comm’n*, 366 F.3d 1311, 1313 (Fed. Cir. 2004) (modifying the ALJ’s analysis but reaching the same ultimate conclusion on the equitable estoppel issue).

116. That said, even by removing these two judges from the analysis, the overall conclusions would not vary. Judge Luckern, who is now the only judge with a technical background

served as ALJs for different lengths of time. For example, Judge Luckern has been serving for the ITC since 1984, whereas Judge Charneski joined the bench in 2007.<sup>117</sup>

### C. Limitations

There are several shortcomings to the study's methodology that must be acknowledged. First, all of the identified cases were selected through LexisNexis,<sup>118</sup> and not all court dispositions necessarily have an electronically available option.<sup>119</sup>

Determining how to "count" issues was not intuitive in all cases. Generally, I based the number of issues on the Federal Circuit's formatting of its opinions (i.e. headings and numbers) as well as on available appellate briefs. An example of a particularly difficult case in which to define issues was *Linear Technology Corp. v. International Trade Commission*.<sup>120</sup> I found eleven separate issues on appeal.<sup>121</sup> The Federal Circuit performed several claim constructions,<sup>122</sup> made infringement determinations about the accused product for two different sets of claims (three claims in the first group, one in the second),<sup>123</sup> and finally made validity determinations for each set of claims.<sup>124</sup> In analyzing the second set of claims (the set comprising one claim), the infringement and invalidity analyses were entirely based on a claim construction determination made by the Federal Circuit in an earlier part of the opinion.<sup>125</sup> In other words, the three issues were inextricably intertwined. For the sake of uniformity, however, I analyzed them as three separate issues since the Federal Circuit placed them under distinct headings.

Establishing which issues were "expressly reviewed" was also not an exact science. I tended to err on the side of inclusiveness and included a wide range of analyses. When the Federal Circuit performed a de mini-

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in the assessment, has a higher affirmance rate than the present two judges with non-technical backgrounds.

117. Chief ALJ Paul J. Luckern, ITC 337 L. BLOG, <http://www.itcblog.com/chief-alj-paul-j-luckern/> (last visited Oct. 14, 2010); ALJ Carl C. Charneski, ITC 337 L. BLOG, <http://www.itcblog.com/alj-carl-c-charneski/> (last visited Oct. 14, 2010).

118. The search performed was through the LEXIS database "Court of Appeals Federal Circuit—Patent Cases" with the limitation "NAME ('International Trade Commission')." Each case was individually reviewed, and cases not involving Section 337 issues were ignored.

119. For example, Federal Rule of Civil Procedure 36 summary affirmances did not come up based on the search input. See Olson, *supra* note 14, at 772–73.

120. *Linear Tech. Corp. v. Int'l Trade Comm'n*, 566 F.3d 1049 (Fed. Cir. 2009).

121. See Appendix A.

122. *Linear Tech.*, 566 F.3d at 1054–61.

123. *Id.* at 1061–65, 1067.

124. *Id.* at 1066–68.

125. *Id.*

mis analysis of an issue in just a few sentences,<sup>126</sup> or explicitly stated that an issue had been resolved or that it was not going to reach a certain issue, that issue was not included as part of the study.

Several variables that potentially affect the findings were not factored into the study. First, the influence of subsequent decisions that changed the law gave the false impression that the ITC got the law “wrong.” For example, in *Kyocera Wireless Corp. v. International Trade Commission*<sup>127</sup> the Federal Circuit vacated and remanded the ITC’s decision based on an intervening Federal Circuit case that changed the analysis. Despite the effect on the assessment, I left this issue in the analysis so that the results would model as closely as possible what a patent-experienced district court or judge’s results could look like. The influence of the technically-trained law clerks to the ALJs and Federal Circuit judges on the opinions was not accounted for, as this was impossible to quantify.

Finally, the character of the issues appealed from the ITC may not be comparable to the issues appealed from the district courts.<sup>128</sup> Moreover, most cases are not appealed up to the Federal Circuit. This may be due to the merits of the cases, the ability of the lawyers, the preference for settling, or the resources of the parties.<sup>129</sup> This makes it difficult to accurately assess the ability of the ITC, as the issues that are on appeal are likely to be more complicated.<sup>130</sup> While the Federal Circuit can choose which issues it wishes to resolve, it has no direct influence on which issues are appealed.

#### IV. IMPLICATIONS OF THE RESULTS

The results of this study do not necessarily point to one conclusion. At least for ITC cases on appeal, the Federal Circuit tends to concentrate on non-technical forms of analysis. Compared to similar studies reporting on claim construction reversal rates by the Federal Circuit, these results provide a more optimistic view of the ITC’s abilities. The findings show that the ITC is reversed at a slightly lower rate than another

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126. This often occurred when one issue was dependent on the finding of another. For example, in *Kyocera Wireless Corp. v. International Trade Commission*, 545 F.3d 1340, 1349 (Fed. Cir. 2008), the issue of anticipation of the asserted patent depended entirely on the Federal Circuit’s claim construction. Once the claim construction was performed, there was no longer any need to reexamine the issue on appeal. *Id.*

127. *Id.*

128. See Chien, *supra* note 42, at 78–81 (comparing ITC and district court patent cases).

129. See Chu, *supra* note 11, at 1096.

130. See Shartzer, *supra* note 15, at 230–31. *But see* Moore, *supra* note 13, at 10 (suggesting that the unappealed claim construction decisions may not substantially affect a study on affirmance rates).

recent study on ITC appeals reports<sup>131</sup> and also performs better at the Federal Circuit than district courts.<sup>132</sup>

Although these results provide some indication that a patent-experienced court would be effective, at least as measured by Federal Circuit affirmance rates, they do not provide any clear direction as to the effectiveness of the proposed Patent Pilot Program or a similar patent district court program. These results may not be an adequate predictor of how such a program would perform because they may be explained by factors that would not be a part of a specialized program, such as the different character of the issues appealed from the ITC.

*A. Majority of Issues Appealed Are Non-Technical—  
Possible Reasons*

The results of this study show that the majority of the issues on appeal from the ITC are not technical in nature, or at least are not analyzed in a technical manner. This may be because the technical issues are effectively resolved by the ALJ or ITC, and so non-technical issues are the ones typically appealed to the Federal Circuit. The ALJs deal almost exclusively with patent law cases, and perhaps because parties know the rate of affirmance is so high for the “technical” issues (80.8% and 84.6% including affirmances in part), these issues are not often raised on appeal.<sup>133</sup> If the ITC’s unique expertise or position discourages parties from appealing “technical” issues, this study’s focus on Federal Circuit analysis makes it difficult to predict how the judges in the proposed Patent Pilot program or a special patent trial-level court would fare in making initial decisions on technical issues. On the other hand, most of the issues can be analyzed in a technical or non-technical manner, and it is unlikely that parties can predict in advance how the Federal Circuit will analyze an issue.<sup>134</sup> If the Patent Pilot program or another similar program had a makeup similar to the ITC in which patent-experienced judges hear almost exclusively patent cases and in which judges are able

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131. See Schwartz, *supra* note 10, at 1716 (reporting a 31.0% rate of claim construction reversal by the Federal Circuit). This study shows a claim construction reversal rate of 26.2% (eleven of forty-two issues).

132. See Chu, *supra* note 11, at 1112 (finding a reversal rate of 45.2% of claim construction issues in summary judgment, jury or JMOL rulings, and bench trial decisions); Moore, *supra* note 13, at 3 (finding a reversal rate of 33.0% percent). The discrepancy between these findings is due to Chu’s exclusion of Rule 36 cases (summary affirmances), thus resulting in a higher claim construction reversal rate. See David L. Schwartz, *Practice Makes Perfect? An Empirical Study of Claim Construction Reversal Rates in Patent Cases*, 107 MICH. L. REV. 223, 234–35 (2008).

133. Further research on the issues that are not included in appeals to the Federal Circuit may be worthwhile to evaluate the ITC’s efficacy in resolving “technical” issues.

134. Of course, the way in which a party briefs an issue could influence how the Federal Circuit interprets that issue.

to perform just as well on technical issues, perhaps the Federal Circuit would continue to hear less of these technical issues on appeal.

This result may also have something to do with the character of the issues brought to the ITC as compared to those brought to district courts and also with the standards of review on appeal. Findings of fact for Section 337 cases are reviewed under the “substantial evidence” standard, while district court findings of fact are based on more deferential “clearly erroneous” standard.<sup>135</sup> Legal determinations from the ITC are generally reviewed de novo, while Section 337-specific determinations, such as satisfaction of the domestic industry requirement, are reviewed with a greater level of deference.<sup>136</sup> This could certainly affect which issues the parties choose to raise on appeal and may result in a different variety of issues.<sup>137</sup> ITC cases also proceed at an expedited pace, and are more likely to reach a decision on the merits rather than settling,<sup>138</sup> which may also affect which issues are appealed. Moreover, the ITC has different standing requirements, rules and procedures, and available remedies. All of these factors make it difficult to predict whether appeals from a Patent Pilot judge or a patent district court would look the same.

Finally, this result may have nothing to do with the ITC at all, because the Federal Circuit may have a preference for analyzing issues in a non-technical manner. The ALJs are closest to the fact-based inquiries,<sup>139</sup> and the Federal Circuit may prefer to concentrate on those issues that do not require analyses of the details of the patents. The Federal Circuit does not get its own tutorial and is unlikely to have any independent understanding of the subject matter, unless someone on the panel has a background in the area. It seems logical that most of the time the Federal Circuit would prefer to analyze the issues on a more superficial level, unless it deemed it absolutely necessary to examine the details of the patents and accused products.

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135. *Panel Discussion on Review in Trade Cases Compared to Patent Cases*, 11 FED. CIR. B.J. 565, 575 (2001) [hereinafter *Panel Discussion*].

136. *Id.* Legal determinations by district courts are always given de novo review by the Federal Circuit. *See Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454–56 (Fed. Cir. 1998) (reaffirming this standard for legal determinations, including claim construction).

137. *See Panel Discussion, supra* note 135, at 570 (documenting Judge Gajarsa’s assertion that tailoring a brief based on the standard of review is important). *But see id.* at 577–78 (relating Larry Schatzer’s suggestion that standards of review, at least for findings of fact, are in practice not all that different).

138. *See Schwartz, supra* note 10, at 1715.

139. *Panel Discussion, supra* note 135, at 595 (documenting former ITC Chairman Koplan’s explanation that the ITC’s high degree of deference for factual findings by the ALJs relates to the ALJs’ closeness to the facts).

### B. *The ITC's Success at Claim Construction*

Professor Schwartz's recent study presents the troubling conclusion that the rate of reversal for the patent-experienced ITC and the generalist district courts are similar, at least for claim construction issues.<sup>140</sup> While his study finds the ITC reversal rate to be 31.0%, the present study finds a somewhat lower reversal rate of 26.2%, based on individual issues.<sup>141</sup> The results of this study present the possibility that the patent-experienced ITC has a lower reversal rate on claim construction issues, at least when looking at each claim construction individually.<sup>142</sup> It is apparent that the ITC is more likely than the district courts to have its "technical" claim constructions affirmed compared to the "non-technical" claim construction issues (89.5% compared to 47.8%, or 60.9% including affirmances in part). This implies that the ITC generally does not err in its technical and/or scientific analyses but rather in its general claim constructions. When the Federal Circuit reverses the ITC's claim constructions, it tends to do so because it chooses a different grammatical claim construction or focuses on a different dictionary definition, rather than because there was a fundamental flaw in the ITC's scientific findings.

Claim construction issues in this study comprise only slightly more than twenty-five percent of all issues on appeal and, when used to predict the success of a patent-specialized program, should be looked at in context of all issues appealed to the Federal Circuit. Because of the small sample of claim construction issues, the results should be viewed cautiously. Assuming that the results are accurate, it seems counterintuitive that the ITC would perform better on the technical issues compared to the non-technical ones. I hypothesized that because the ITC is primarily made of judges without a technical background, it would generally do

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140. See Schwartz, *supra* note 10, at 1709, 1715 (finding that the ITC's overall rate of reversal is 31.0%, compared to the district court's 29.7% reversal rate).

141. This 4.8% difference is likely due to the difference in the study parameters. The main difference between our methodologies is that Schwartz focused on the Federal Circuit's ultimate ruling, while this study broke down the findings by each claim construction issue. *Id.* at 1736. In many instances, the Federal Circuit reviewed multiple claim construction issues, and any one error could result in the decision being reversed, even if the ITC was affirmed on all other claim constructions. The opposite was also true in some cases: the Federal Circuit reversed the ITC's claim construction but affirmed the case overall. In addition, Schwartz included Rule 36 summary affirmances, which, interestingly enough, would have the effect of decreasing the reversal rate on appeal. *Id.* It should also be noted that Schwartz's study comprises ITC investigations from 1996 to 2008, while this analysis encompasses investigations from 2001 through 2010. *Id.*

142. Further research on the reversal rate for district court decisions based on the individual issues would provide a fuller picture in comparing how courts fare at the Federal Circuit. While the overall result is certainly important, analyzing the types of issues on appeal from district courts and the reversal rate for each would aid in comparing the courts' success.



better on the issues that did not require a technical understanding of the patents. In addition, the study reveals that the ITC has had the opportunity to decide more non-technical claim construction issues than technical claim constructions.<sup>143</sup> Given the findings, claim construction may just be generally unpredictable.<sup>144</sup> Numerous other studies and articles have detailed the indeterminacy of Federal Circuit decisions for claim construction,<sup>145</sup> and there is no reason to think that the ITC's decisions would be immune. Perhaps the claim construction analysis for technical issues is more consistent, whereas there is more variation in analyzing non-technical claims. Granted, most issues do not clearly belong in one category, and the Federal Circuit has a choice in how it analyzes the issues.

Another possibility is that the procedure of the ITC, namely the inclusion of the Office of Unfair Import Investigations in the litigation process, gives ALJs an advantage in determining the technical claim construction issues. The investigative staff attorneys often have considerable experience with the technologies at issue, so they may provide the judge with unique insights that allow him to make superior technical claim construction determinations. While it is not entirely clear why this same logic would not apply to non-technical claim constructions, I suggest that there is more flexibility in construing non-technical claim construction issues.

The results for claim construction issues cut both ways in terms of the possible success of the Patent Pilot Program or a patent-specialized district court. The ITC does an excellent job construing claims analyzed in a technical manner, and it performs better than generalist district courts at this. However, the claim construction issues are a minority of the issues on appeal and perhaps should be viewed in context of overall affirmance rates.<sup>146</sup>

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143. See *supra* Part III.A.

144. See Meehan, *supra* note 11; Chu, *supra* note 11.

145. See, e.g., Jeffrey A. Lefstin, *The Measure of the Doubt: Dissent, Indeterminacy, and Interpretation at the Federal Circuit*, 58 HASTINGS L.J. 1025 (2007); Joseph Scott Miller, *Enhancing Patent Disclosure for Faithful Claim Construction*, 9 LEWIS & CLARK L. REV. 177 (2005); Judge S. Jay Plager, *Intellectual Property Challenges in the Next Century: Article Challenges for Intellectual Property Law in the Twenty-First Century: Indeterminacy and Other Problems*, 2001 U. ILL. L. REV. 69, 71–72 (2001).

146. See Shartzer, *supra* note 15, at 231–35 (finding a positive correlation between the experience of top fifteen patent districts with overall affirmances by the Federal Circuit). A comparison of my results to this study indicates a much lower rate of affirmance (63.3% compared to 88.5%), but Shartzer's study included Federal Rule of Procedure 36 affirmances and did not analyze cases at the level of individual issues.

### C. The Federal Circuit's Evaluation

The results of this study may support the conclusion that the relatively low affirmance rate is related not to how the ITC evaluates cases, but rather to how the Federal Circuit decides issues which lead to inconsistencies. The Federal Circuit has exclusive jurisdiction to hear patent law appeals, and it is often viewed by the patent community as the “ultimate” arbiter of patent law issues, especially for ITC decisions.<sup>147</sup> Nonetheless, it is arguable that the judges of the Federal Circuit are misinterpreting issues and not providing proper guidance to the ITC (or to federal district courts). This may be because the judges of the Federal Circuit are not any more technically qualified than the judges at the district courts and the ITC, and technical qualifications are necessary to accurately resolve patent issues. Almost two thirds of the current Federal Circuit judges do not possess a technical background.<sup>148</sup>

However, the lack of a technical background may not be a determinative factor in the quality of the Federal Circuit's decisions. Even if a judge has a technical background in one subject area, it does not follow that he or she will then be knowledgeable about the variety of scientific and technical matters that arise on appeal.<sup>149</sup> In addition, there is no evidence that Federal Circuit judges with a technical background affirm claim constructions at a different rate from Federal Circuit judges with a non-technical background when it comes to district court issues on appeal.<sup>150</sup> Furthermore, at least between April 1996 and 2000, the Federal Circuit only disagreed internally about the proper claim construction of a term three percent of the time.<sup>151</sup> This suggests that the Federal Circuit is consistent in its patent claim construction, at least internally.

Despite this internal agreement, commentators suggest that the uniformity the Federal Circuit had hoped to achieve through precedential guidance post-*Markman* has not been successful.<sup>152</sup> Instead of providing clear canons of claim construction, the Federal Circuit has taken varying

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147. To date, the Supreme Court has not yet decided a patent law case originating at the ITC.

148. Of the sixteen current judges sitting on the bench, including senior judges, only six hold technical degrees: Gajarsa, Linn, Lourie, Mayer, Moore, and Newman. *See Judges*, U.S. CT. APPEALS FED. CIR., [http://www.cafc.uscourts.gov/index.php?option=com\\_content&view=category&layout=blog&id=1&Itemid=4](http://www.cafc.uscourts.gov/index.php?option=com_content&view=category&layout=blog&id=1&Itemid=4) (last visited Oct. 14, 2010). However, Federal Circuit judges generally hire law clerks from a variety of technical backgrounds to assist them in deciding cases. *See Moore, supra* note 13, at 18.

149. *See, e.g., Rai, supra* note 5, at 879.

150. *See Moore, supra* note 13, at 26–27. There is also no significant difference in percentages when comparing Federal Circuit judges with and without previous patent experience. *Id.*

151. *Id.* at 23.

152. Meehan, *supra* note 11, at \*13 (citing Holderman & Guren, *supra* note 3, at 7).

approaches regarding the manner in which it values different forms of patent evidence, including specifications, drawings, and dictionary definitions.<sup>153</sup> Granted, there can be no exact formula to follow due to the factual differences in the cases, but it would be helpful if the Federal Circuit were able to provide a uniform approach to claim construction.<sup>154</sup>

According to this view, because the current system does not encourage consistency, the overall reversal rate may not accurately measure effectiveness. This study breaks down reversal rate by issue, but one could instead analyze issues by technology type. Perhaps reversal rate should not be used at all; some other determinant, such as the frequency of contradiction, might be a better evaluation tool.

Additionally, unless the Federal Circuit were to become more consistent and thus provide proper guidance to the ITC or district courts, establishing a Patent Pilot Program or a patent district court would not necessarily increase uniformity in patent law decision-making. Perhaps the new court or judges in the Patent Pilot Program would do better at analyzing certain kinds of issues, but they would not necessarily be reversed at a lower rate overall. Of course, only a small percentage of cases are appealed to the Federal Circuit, and this study does not make any comment on the level of consistency in determinations by the ITC or district courts.

#### *D. Does Having a Technical Background Matter?*

The results of this study suggest that ALJs with a technical background perform better overall (63.6% compared to 56.1%) on issues that are appealed to the Federal Circuit. This finding should be viewed with caution given the small sample size. While not a significant difference, it does lend support to the idea that educational background should be a factor in evaluating ALJs at the ITC and judges for the Patent Pilot Program or another patent-specific court.<sup>155</sup>

First, it is worth noting that having a technical background is distinct from having patent law experience. The fact that almost three-quarters of the issues on appeal at the ITC are “non-technical” at least suggests that having a technical background is not a necessary prerequisite to determining patent law issues.<sup>156</sup> Logically, it does not seem like a technical

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153. Holderman & Guren, *supra* note 3, at 7–9.

154. *Id.* at 13, 16.

155. I am not aware of any study that specifically compares the educational background of federal district court judges and their effectiveness in dealing with patent law issues. Such research would have access to a larger population of judges from which to draw samples and might provide a clearer indication of the importance of a judge’s technical background in resolving patent issues.

156. The results of this study suggest that the ALJs with a technical background performed better on the non-technical claim construction issues (60.5% compared to 51.4%). However, this particular result may be due to other factors.

background would be highly beneficial in dealing with non-technical issues, and factors like patent experience would be a more meaningful requirement. As long as the judges have an understanding of the patent law concepts, which would likely be gained through experience, they could rely on the parties and law clerks to educate them about any substantive issues on appeal. Thus, while having a technical background may be beneficial in some instances, arguably it should not be the ultimate criterion: judges are intelligent people, and what is most important is their capacity and desire to learn about the technologies at issue.<sup>157</sup>

On the other hand, the background of the judges should serve as a consideration in the hiring of ALJs or district court judges in the Patent Pilot program based on the idea, albeit imperfect, that a judge with a technical background is more adept at evaluating outside experts.<sup>158</sup> Even without training in a substantive area of law, judges with a technical background would have a better understanding of the scientific method generally and would be better suited to evaluating the credibility of the experts, even without being able to evaluate the substance of their work.<sup>159</sup> Again, the results did show that the judges with a technical background performed better at the Federal Circuit overall, particularly on the technical issues on appeal.

#### E. *Litigation Strategy Considerations*

An appellant has a mere fifteen minutes and 14,000 words to make its million-or-billion-dollar argument to the Federal Circuit.<sup>160</sup> Inevitably, parties have to make difficult choices about which issues to preserve on appeal.<sup>161</sup> The results of this study show that the Federal Circuit uses non-technical analysis for the majority of issues on appeal, and so a Section 337 practitioner may want to structure his or her brief accordingly. Instead of focusing on the technical issues, which may have more importance at the lower levels, the appellate briefs may be better designed by focusing on the non-technical issues. These results suggest that it is not necessary to tailor briefs to the panel, as the type of analysis does not change considerably based on which judge is writing the opinion.

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157. Meehan, *supra* note 11, at \*15.

158. Rai, *supra* note 5, at 894 (discussing backgrounds of adjudicators in the context of court-appointed experts).

159. *Id.*

160. FED. CIR. R. PRAC. 28.1(e)(2), available at [http://www.cafc.uscourts.gov/images/stories/rules-of-practice/rules\\_2010.pdf](http://www.cafc.uscourts.gov/images/stories/rules-of-practice/rules_2010.pdf).

161. *Panel Discussion*, *supra* note 135, at 576–77 (emphasizing the importance of choosing only those issues with the best chance of success on appeal).

## CONCLUSION

Ideally, the establishment of the Patent Pilot Program or a specialized district court would increase the uniformity of patent law, create greater certainty for litigants, and minimize the negative effects of forum shopping. The ITC is an imperfect model for how such a program would function, although the results of this study indicate that a patent-experienced court may provide consistency in certain kinds of issues, particularly those that are technical in nature. Further, the high percentage of non-technical issues on appeal suggests that some characteristic(s) of the ITC, whether it is the patent-experienced judges, procedure, the litigants, or some combination thereof, allows the Federal Circuit to focus on issues that do not require an in-depth understanding of the patents on appeal.

## APPENDIX A

<i>SiRF Tech., Inc. v. Int'l Trade Comm'n</i> , 601 F.3d 1319 (Fed. Cir. 2010)—Judge Dyk (with Michel and Cleverger)			
<i>ITC:</i>	Certain GPS Devices and Products Containing Same, Inv. No. 337-TA-602, 2009 ITC LEXIS 173 (Jan. 15, 2009).		
<i>ALJ:</i>	Certain GPS Devices and Products Containing Same, Inv. No. 337-TA-602, 2008 ITC LEXIS 1970 (Aug. 8, 2008).— Charneski		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Global Locate filed a complaint against SiRF, E-TEN, Pharos, MITAC, and Mio for violating six of its patents ('801, '346, '000, '651, '187, and '080)</li> <li>• ALJ found violations by each of the respondents with respect to each of the six patents; concluded that all six patents were not invalid or unenforceable</li> <li>• ITC reviewed issue of standing for '346 patent, and violation of patents '651 and '000 by SiRF; arrived at same ultimate conclusions; issued a LEO against all respondents and C&amp;D orders against three respondents</li> <li>• Federal Circuit affirmed for all issues</li> </ul>		
<i>Product:</i>	GPS devices and products containing these devices		
<i>Issues; Categories; and Determinations:</i>	Standing to assert '346 patent	5) Civil procedure and contract issues based on whether a corporation is a co-owner of the patent; agreed with ITC that appellants had presented substantial evidence of a lack of standing	AFFIRMED
	Construction of "communication" and "transmission" steps (whether or not they must be performed by end consumers)	3) Federal Circuit did not provide a lot of analysis but found that neither the claim language nor the specifications required that these steps be direct; looked to marketing material to show that SiRF performed the entire process and thus there was direct infringement	AFFIRMED
	Construction of "processing" and "representing" steps (whether or not they must be performed by end consumers)	3) Determined that the claims did not require the end users to perform these steps and that SiRF is the only entity involved, thus there was direct infringement	AFFIRMED
	Claims of the '801 and '187 patents as patentable subject matter	4) Federal Circuit examined issue in light of <i>In re Bilski</i> <sup>162</sup> case; determined that met test because a GPS receiver is a "machine" and so was patentable subject matter	AFFIRMED

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162. *In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008).

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<i>Ajinomoto Co. v. Int'l Trade Comm'n</i> , 597 F.3d 1267 (Fed. Cir. 2010)—Judge Lourie (with Newman and Linn)			
<i>ITC:</i>	Certain L-Lysine Feed Products, Their Methods of Production and Genetic Constructs For Production, Inv. No. 337-TA-571, 2009 ITC LEXIS 2081 (Sept. 29, 2008).		
<i>ALJ:</i>	Certain L-Lysine Feed Products, Their Methods of Production and Genetic Constructs For Production, Inv. No. 337-TA-571, 2008 ITC LEXIS 1343 (July 31, 2008).—Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Ajinomoto filed a complaint against GBT;</li> <li>• GBT claimed Ajinomoto's patents were invalid;</li> <li>• ALJ found no violation of Section 337 and found both patents invalid based on best mode requirement and unenforceable based on inequitable conduct;</li> <li>• ITC took no position on invalidity/unenforceability of '160 and did not review the remainder of the finding;</li> <li>• Federal Circuit affirmed and found that '698 and '160 did not meet best mode requirement (does not reach unenforceability issue) and that Ajinomoto's priority date argument was properly rejected by the ITC as a bait-and-switch tactic</li> </ul>		
<i>Product:</i>	Methods of producing lysine (amino acid)		
<i>Issues; Categories; and Determinations:</i>	Scope of best mode requirement as it related to the patents	2) Federal Circuit needed an understanding of the patent to determine what had to be included	AFFIRMED
	Satisfaction of the best mode requirement	2) Borderline—Federal Circuit again needed an understanding of the preferred mode	AFFIRMED
	Violation of '160 based on filing date	4) Filing date discussion was patent-related but not technical	AFFIRMED

<i>Crocs, Inc. v. Int'l Trade Comm'n</i> , 598 F.3d 1294 (Fed. Cir. 2010)—Judge Rader (with Lourie and Prost)			
<i>ITC:</i>	Certain Foam Footwear, Inv. No. 337-TA-567, 2008 ITC LEXIS 1239 (July 25, 2008).		
<i>ALJ:</i>	Certain Foam Footwear, Inv. No. 337-TA-567, 2008 ITC LEXIS 590 (April 11, 2008).—Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Crocs filed a complaint against eleven knock-off manufacturers, six settled so five left in the investigation;</li> <li>• ALJ determined that '789 was not infringed because technical prong of the domestic industry requirement was not satisfied and '858 was obvious under two pieces of prior art;</li> <li>• ITC affirmed on everything and elaborated about non-infringement and lack of satisfaction of the technical prong;</li> <li>• Federal Circuit reversed on all issues—found infringement of '789 and satisfaction of the technical prong of the domestic industry and found '858 not obvious based on the prior art and secondary considerations</li> </ul>		
<i>Product:</i>	Crocs foam shoes		
<i>Issues; Categories; and Determinations:</i>	Infringement of '789	4) Examined drawings of Crocs and infringing products side by side (design patent, so analysis based on "ordinary observer" and not technical at all)	REVERSED
	Satisfaction of technical prong ('789)	4) Performed identical analysis for technical prong of the domestic industry	REVERSED
	Obviousness of '858	4) Determined that the prior art taught away from the use of foam straps—no technical background necessary to understand; secondary considerations not technical	REVERSED

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<i>Norgren Inc. v. Int'l Trade Comm'n</i> , 336 F. App'x 991, slip op. (Fed. Cir. May 26, 2009)—Judge Moore (with Schall and Gajarsa) (Unpublished/Nonprecedential)			
<i>ITC:</i>	Certain Connecting Devices ("Quick Clamps") for Use With Modular Compressed Air Conditioning Units, Including Filters, Regulators, and Lubricators ("FRLs") That Are Part of Larger Pneumatic Systems and the FRL Units They Connect; Notice of Commission Decision Not To Review an Initial Determination of the Administrative Law Judge Finding No Violation of Section 337; Termination of the Investigation, Inv. No. 337-TA-587, 73 FR 21157 (April 18, 2008).		
<i>ALJ:</i>	Certain Connecting Devices ("Quick Clamps") for Use With Modular Compressed Air Conditioning Units, Including Filters, Regulators, and Lubricators ("FRLs") That Are Part of Larger Pneumatic Systems and the FRL Units They Connect, Inv. No. 337-TA-587, 2008 ITC LEXIS 285 (Feb. 13, 2008).—Charneski		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Norgen filed a complaint against SMC alleging that its connecting structures infringed the '392 patent;</li> <li>• ALJ held that no infringement of the patent and that the patent claims were nonobvious;</li> <li>• ITC affirmed without review;</li> <li>• Federal Circuit reversed and found infringement, and remanded for obviousness based on new definition</li> </ul>		
<i>Product:</i>	Structures that connect filters, regulators, or lubricators (FRLs) installed in compressed air systems		
<i>Issue; Category; and Determination:</i>	Construction of "generally rectangular ported flange"	1) Borderline case, Federal Circuit found that the ITC read limitations into the claim that were only in the preferred embodiments, went through the specification, needed to know a bit about how the device works	REVERSED



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<i>Epistar Corp. v. Int'l Trade Comm'n</i> , 566 F.3d 1321 (Fed. Cir. 2009)—Judge Rader (with Archer and Dyk)			
<i>ITC:</i>	Certain High-Brightness Light Emitting Diodes, and Products Containing Same, Inv. No. 337-TA-556, 2008 ITC LEXIS 1062 (May 9, 2007).		
<i>ALJ:</i>	Certain High-Brightness Light Emitting Diodes, and Products Containing Same, Inv. No. 337-TA-556, 2008 ITC LEXIS 1068 (Jan. 8, 2007).—Harris		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Lumileds had filed separate suits against Epistar and UEC in district court (the companies later merged);</li> <li>• Lumileds settled with UEC, as part of the agreement UEC covenanted not to challenge validity of Lumileds' '718 patent;</li> <li>• Lumileds filed a complaint against both at the ITC for infringing the '718;</li> <li>• Soon after UEC and Epistar merged, and Epistar assumed all of UEC's assets, liabilities, and contracts as part of merger agreement;</li> <li>• Lumileds asserted that Epistar could not assert the invalidity of Lumiled's patents based on the settlement agreement;</li> <li>• Epistar countered that the agreement did not cover the products at issue and still could assert invalidity;</li> <li>• ALJ found UEC-Lumileds agreement precluded Epistar from contesting the validity of the '718 patent; found infringement based on claim construction (later reviewed and discovered that under the distinct Lumileds-Epistar settlement agreement an invalidity claim was permissible, but it was too late because ITC determined not to review)</li> <li>• ITC declined to review the settlement agreement issues, affirmed on infringement performed different claim constructions</li> <li>• Federal Circuit affirmed for claim construction but found that the agreement permitted Epistar to claim invalidity, also rules on the scope of the ITC's LEO post-Kyocera Wireless</li> </ul>		
<i>Product:</i>	LED light with special transparent window layer		
<i>Issues; Categories; and Determinations:</i>	Validity estoppel order (settlement agreement)	5) Federal Circuit analyzed the separate Lumileds-Epistar agreement, focused on claim preclusion and contract interpretation and not patent law	REVERSED
	Construction of "transparent window layer"	1) Performed close reading of the specification to see if the patent disclaimed the use of ITO as a window layer, need an understanding of what is technically possible, and concepts like "ITO" and "current crowding" problems	AFFIRMED
	Construction of "substrate"	1) Affirmed ITC's interpretation that declined to limit term to the preferred embodiments in the specification	AFFIRMED
	Scope of the LEO	5) Kyocera Wireless case prohibited LEOs that extended to entities not named as respondents, the ITC's LEO did not have this limitation	REVERSED (vacated and remanded)

<i>Linear Tech. Corp. v. Int'l Trade Comm'n</i> , 566 F.3d 1049 (Fed. Cir. 2009)—Judge Schall (with Mayer and Lourie)			
<i>ITC:</i>	Certain Voltage Regulators, Components Thereof and Products Containing Same, Inv. No. 337-TA-564, 2007 ITC LEXIS 1108 (Oct. 19, 2007).		
<i>ALJ:</i>	Certain Voltage Regulators, Components Thereof and Products Containing Same, Inv. No. 337-TA-564, 2007 ITC LEXIS 536 (May 22, 2007).—Harris		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Linear filed a complaint against AATI for violating its '258 patent;</li> <li>• ALJ found no Section 337 violation by AATI, either because no infringement or because claim 35 was invalid (other 3 claims at issue were valid);</li> <li>• ITC modified claim constructions, determined that one product (AAT1143) infringed and affirmed invalidity findings;</li> <li>• Federal Circuit affirmed on infringement of AAT1143, but also found additional infringement by one other product (AAT1146), affirmed validity of 3 claims and vacated invalidity finding for claim 35</li> </ul>		
<i>Product:</i>	Electronic voltage regulators		
<i>Issues; Categories; and Determinations:</i>	Construction of "switch . . . including a pair of synchronously switched switching transistors"	3) ITC used the explicit definition from the specification and Federal Circuit affirmed—not very technical	AFFIRMED
	Construction of "second circuit" and "third circuit" limitations	1) Federal Circuit needed an understanding of the circuits to know how broadly they could be construed	AFFIRMED
	Construction of "a second control signal . . . to cause both transistors to be OFF" limitation	1) Performed close reading of the specification; seems necessary to have an understanding of how the regulator works in practice	AFFIRMED
	Construction of "first state of circuit operation" and "second state of circuit operation" limitations	1) Federal Circuit needed to know the basics about high load and low load currents to interpret	AFFIRMED
	Construction of "monitoring the current to the load"	1) Federal Circuit needed to understand how the voltage regulator works (whether a monitoring current can function both directly and indirectly, and Ohm's law) to make a determination	REVERSED
	Infringement of "sleep mode" claims—AAT1143 device	2) Examined substantial evidence from the ITC composed of circuit schematics, graphs, and expert testimony (need a technical understanding)	AFFIRMED
	Infringement of "sleep mode" claims—AAT1146 device	2) Found that this device is nearly identical to AAT1143—need to understand how the products work to make this determination	REVERSED
	Infringement of "sleep mode" claims—AAT1151 and AAT1265	2) Federal Circuit needed to have an understanding of how products works to make determination (ZC comparator circuitry, second part is not as technical and references ITC's internal inconsistencies)	AFFIRMED IN PART; REVERSED IN PART (vacated and remanded)
	Validity of asserted patent claims 2, 3, and 34	4) Federal Circuit reviewed ITC's substantial evidence lack of anticipation, as well as expert testimony admitting the limited scope of the prior art	AFFIRMED

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	Infringement of claim 35 by AAT1143 and AAT1146	4) Federal Circuit examined evidence from ITC, but finds that in light of new claim construction finding is not supported by substantial evidence (not a technical analysis)	REVERSED (vacated and remanded)
	Validity of asserted patent claim 35	4) identical analysis to infringement of claim 35	REVERSED (vacated and remanded)

<i>Linear Tech. Corp. v. Int'l Trade Comm'n, (companion case)</i> 292 F. App'x 52, slip op. (Fed. Cir. Aug. 28, 2008)—Schall (with Mayer and Lourie) (Unpublished/Nonprecedential)			
<i>ITC:</i>	Certain Voltage Regulators, Components Thereof and Products Containing Same, Inv. No. 337-TA-564, 2007 ITC LEXIS 1108 (Oct. 19, 2007).		
<i>ALJ:</i>	Certain Voltage Regulators, Components Thereof and Products Containing Same, Inv. No. 337-TA-564, 2007 ITC LEXIS 536 (May 22, 2007).—Harris		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>Linear Tech filed a complaint against AATI for violating its '531 patent;</li> <li>ALJ found no infringement, claims of '531 patent were invalid, and Linear did not satisfy the domestic industry requirement;</li> <li>ITC affirmed except about one claim being anticipated by a particular prior art patent (but still found that anticipated by another prior art patent);</li> <li>Federal Circuit reviewed invalidity and affirmed anticipation by '300 patent</li> </ul>		
<i>Product:</i>	Charge pump DC/DC converter		
<i>Issue; Category; and Determination:</i>	Anticipation/Claim construction "voltage regulator" for '300 patent	1) Extensive analysis involved technical details about the specifications and the drawings	AFFIRMED

<i>ERBE Elektromedizin GmbH v. Int'l Trade Comm'n,</i> 566 F.3d 1028 (Fed. Cir. 2009)—Judge Dyk (with Michel and Rader)			
<i>ITC:</i>	Available on EDIS, Notice of Commission Decision to Review in Part an Initial Determination and on Review to Affirm the Administrative Law Judge's Determination that there is No Violation of Section 337, Inv. No. 337-TA-569 (Mar. 17, 2008).		
<i>ALJ:</i>	Certain Endoscopic Probes For Use in Argon Plasma Coagulation Systems, Inv. No. 337-TA-569, 2008 ITC LEXIS 111 (Jan. 16, 2008).—Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>ERBE filed a complaint against Canady for contributory and induced infringement of '745 patent;</li> <li>ALJ found no direct infringement and that ERBE had not satisfied domestic industry requirement;</li> <li>ITC affirmed all ALJ findings except construction of "predetermined minimum safety distance" but same conclusion of no direct infringement (and so no possibility of contributory/induced infringement);</li> <li>Federal Circuit affirmed</li> </ul>		
<i>Product:</i>	APC probes (for surgery)		
<i>Issue, Category, and Determination:</i>	Claim construction "working channel"	3) Looks at labels in drawings to see that optics is marked separately from working channel, and consults dictionary, not very technical analysis	AFFIRMED

<i>Amgen, Inc. v. Int'l Trade Comm'n</i> , 565 F.3d 846 (Fed. Cir. 2009)—Judges Newman, Lourie, and Linn (per curiam)			
<i>ITC:</i>	Certain Products and Pharmaceutical Compositions Containing Recombinant Human Erythropoietin, Inv. No. 337-TA-568, 2006 ITC LEXIS 578 (Aug. 31, 2006).		
<i>ALJ:</i>	Certain Products and Pharmaceutical Compositions Containing Recombinant Human Erythropoietin, Inv. No. 337-TA-568, 2006 ITC LEXIS 443 (July 7, 2006).—Luckern		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Amgen filed a complaint against Roche for importing certain EPO products which violated 6 of its patents;</li> <li>• ALJ held that the products fell under the Safe Harbor exemption in § 271(e)(1) and were not in violation of Section 337;</li> <li>• ITC did not review;</li> <li>• Amgen appealed and argued that exemption applied to product patents only (oppose to process patents) and not all imports fit under the exemption;</li> <li>• Federal Circuit affirmed and held that exemption applies for process or product patents related to obtaining FDA approval, reversed ruling for Roche's entitlement to summary judgment, and remanded dispute of fact about if all of the imports fit under the exemption</li> </ul>		
<i>Product:</i>	Human EPO		
<i>Issues, Categories, and Determinations:</i>	Scope of the safe harbor clause	4) Safe Harbor clause is patent-related but not technical, analyzed legislative history (through other cases) and intent, found the legal analysis of the clause correct but not its factual application (too far-sweeping)	AFFIRMED IN PART, REVERSED IN PART
	Jurisdiction	5) Analysis is not related to the asserted patents—Federal Circuit discussed why jurisdiction is not really relevant to the dispute but explains how it has jurisdiction based on Amgen's allegations	REVERSED

<i>Princo Corp. v. Int'l Trade Comm'n</i> , 563 F.3d. 1301 (Fed. Cir. 2009)—Judge Dyk (with Bryson and Gajarsa)			
<i>ITC:</i>	Certain Recordable Compact Discs and Rewritable Compact Discs, Inv. No. 337-TA-474, 2007 ITC LEXIS 185 (Feb. 5, 2007).		
<i>ALJ:</i>	Certain Recordable Compact Discs and Rewritable Compact Discs, Inv. No. 337-TA-474, 2003 ITC LEXIS 723 (Oct. 24, 2003).—Harris		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Philips arranged a licensing arrangement for its CD-Rs and CD-RWs with Princo, as part of the agreement had to pay for all of the patents even if not using all of them;</li> <li>• Princo stopped paying fees, Philips filed a complaint for infringement;</li> <li>• ALJ found patent misuse per se and under the rule of reason (but claims were valid and infringed and domestic industry requirement had been satisfied, so would have been a Section 337 violation otherwise);</li> <li>• ITC adopted all the findings of fact and conclusions of law concerning patent misuse, but on narrower grounds;</li> <li>• Federal Circuit reversed and remanded and said no patent misuse (see U.S. Philips Corp. v. ITC, 424 F.3d 1179 (Sept. 21, 2005) <i>infra</i>);</li> <li>• The second time ITC again said no patent misuse, reversed ALJ's findings and found there was a violation of Section 337, and issued a GEO;</li> <li>• On appeal Federal Circuit affirmed ITC's finding of no patent misuse due to tying, vacated and remanded for anticompetitive agreement</li> </ul>		
<i>Product:</i>	Various features for the manufacture of CD-Rs and CD-RWs		

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<i>Issues, Categories, and Determinations</i>	Patent misuse by tying Lagadec patent to the essential Orange Book patents	4) Generally related to the asserted patents, but more like an antitrust issue	AFFIRMED
	Patent misuse based on agreement to prevent competing technologies	4) Generally related to the asserted patents, but more like an antitrust issue, found that ITC's analysis of the agreement was flawed	REVERSED (vacated and remanded)

<i>U.S. Philips Corp. v. Int'l Trade Comm'n, (companion case)</i> 424 F.3d 1179 ( Fed. Cir. 2005)—Judge Bryson (with Gajarsa and Linn)			
<i>ITC:</i>	Certain Recordable Compact Discs and Rewritable Compact Discs, Inv. No. 337-TA-474, 2004 ITC LEXIS 990 (April 8, 2004).		
<i>ALJ:</i>	Certain Recordable Compact Discs and Rewritable Compact Discs, Inv. No. 337-TA-474, 2003 ITC LEXIS 723 (Oct. 24, 2003).—Harris		
<i>Procedure:</i>	See <i>Princo Corp. v. ITC</i> , 563 F.3d. 1301 (Fed. Cir. 2009), <i>supra</i> .		
<i>Product:</i>	Various features for the manufacture of CD-Rs and CD-RWs		
<i>Issues, Categories, and Determinations:</i>	Patent misuse—package licensing arrangements are <i>per se</i> illegal	4) Generally related to the asserted patents, but more like an antitrust issue	REVERSED
	Patent misuse based on the rule of reason	4) Generally related to the asserted patents, but more like an antitrust issue	REVERSED

<i>Kyocera Wireless Corp. v. Int'l Trade Comm'n,</i> 545 F.3d 1340 (Fed. Cir. 2008)—Judge Rader (with Bryson and Linn)			
<i>ITC:</i>	Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, Inv. No. 337-TA-543, 2007 ITC LEXIS 621 (June 19, 2007).		
<i>ALJ:</i>	Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, Inv. No. 337-TA-543, 2006 ITC LEXIS 803 (Oct. 10, 2006).—Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Broadcom filed a complaint against Qualcomm for violating five patents because of the EV-DO standard which it created and promoted (which induced others to infringe the patents)</li> <li>• This Federal Circuit appeal focuses on '983 (see related case, <i>Broadcom v. ITC</i>, 542 F.3d 894 (Fed. Cir. 2008), <i>infra</i>).</li> <li>• ALJ found that Qualcomm was violating the patent through inducement and the patent was not invalid,</li> <li>• ITC affirmed and issued an extended LEO order to include downstream products;</li> <li>• Federal Circuit affirmed and said patent was not invalid and no direct infringement, but says ITC misapplied induced infringement standard so remanded issue of induced infringement and the LEO</li> </ul>		
<i>Product:</i>	Mobile computing device (specifically Qualcomm's chips and chipsets)		

<i>Issues, Categories, and Determinations:</i>	Claim construction "different"	1) Close reading of the specification to determine what "different" referred to in context, needed to understand the drawings and details of the description	AFFIRMED
	Anticipation by GSM standard based on "printed publication" requirement	4) Analysis of whether the prior art was publicly available was related to the asserted patent; Federal Circuit affirmed on different grounds	AFFIRMED
	Timing of obviousness defense	5) Not related to the asserted patent, a civil procedure issue	AFFIRMED
	Direct infringement	4) Affirmed ITC's finding of infringement based on witness testimony	AFFIRMED
	Induced Infringement	4) Found that ITC's analysis was outdated in light of DSU decision, <sup>163</sup> not a technical analysis	REVERSED (vacated and remanded)

<i>LG Elecs. Mobilecomm U.S.A., Inc. v. Int'l Trade Comm'n, (companion case)</i> 243 F. App'x 598, slip op. (Fed. Cir. July 20, 2007)—Judge Prost (with Mayer and Michel) (Unpublished/Nonprecedential)			
<i>ITC:</i>	Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, Inv. No. 337-TA-543, 2007 ITC LEXIS 621 (June 19, 2007).		
<i>ALJ:</i>	Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, Inv. No. 337-TA-543, 2006 ITC LEXIS 803 (Oct. 10, 2006).—Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Broadcom filed a complaint against Qualcomm for violating its '983 patent;</li> <li>• ALJ found Qualcomm was infringing and recommended that the ITC issue a LEO for Qualcomm's chips but not the downstream products containing them;</li> <li>• ITC affirmed finding of a violation, extended the LEO proposed by the ALJ to include downstream products as well;</li> <li>• Federal Circuit found the appeal premature</li> </ul>		
<i>Product:</i>	Power-saving technique for wireless devices		
<i>Issue, Category, and Determination:</i>	Jurisdiction to review ITC order denying a stay of the LEO	5) Entirely statutory analysis	AFFIRMED
	Jurisdiction to review LEO and C&D order during Presidential review period	5) Entirely statutory analysis	AFFIRMED

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163. DSU Med. Corp. v. JMS Co., 471 F.3d 1293 (Fed. Cir. 2006).

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<i>Broadcom Corp. v. Int'l Trade Comm'n, (companion case)</i> 542 F.3d 894 (Fed. Cir. 2008)—Judge Bryson (with Rader and Linn)			
<i>ITC:</i>	Available on EDIS, Commission Decision to Review and Modify in Part a Final Initial Determination Finding a Violation of Section 337, Inv. No. 337-TA-543 (Dec. 8, 2006)		
<i>ALJ:</i>	Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, Inv. No. 337-TA-543, 2006 ITC LEXIS 803 (Oct. 10, 2006).—Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Broadcom filed a complaint against Qualcomm for violating 5 patents because of the EV-DO standard which it created and promoted (which induced others to infringe the patents)</li> <li>• This Federal Circuit appeal focuses on patents '311 and '675 (see related case, Kyocera Wireless Corp. v. ITC, 545 F.3d 1340 (Fed. Cir. 2008), <i>supra</i>).</li> <li>• ALJ found no indirect infringement (found direct infringement by unrelated third parties, but no inducement);</li> <li>• ITC determined not to review infringement for these patents;</li> <li>• Federal Circuit affirmed for non-infringement of '311, but vacated and remanded the non-infringement determination for '675</li> </ul>		
<i>Product:</i>	Mobile computing device (specifically Qualcomm's chips and chipsets)		
<i>Issues, Categories, and Determinations:</i>	Claim construction of EV-DO standard "may"	4) Federal Circuit looked to the specification, which makes clear that "may" meant that a certain feature is optional	AFFIRMED
	Waiver of argument about infringement of claim 16	4) Federal Circuit found that Broadcom had not raised this argument before the ITC and had waived the issue	AFFIRMED
	Waiver of argument about actual use of handset in a power-saving state	4) Found that Broadcom waived argument by not raising it before the ITC in its petition for review	AFFIRMED
	Noninfringement of RFT6150 chip based on expert testimony	2) Analyzed expert testimony and written description in a way that required an understanding of the terminology and how the chips work	REVERSED (vacated and remanded)
	Noninfringement of other 7 chips	2) Analyzed expert testimony in a way that required an understanding of the terminology and how the chips work	AFFIRMED

<i>Yingbin-Nature Wood Indus. Co. v. Int'l Trade Comm'n,</i> 535 F.3d 1322 (Fed. Cir. 2008)—Judge Schall (with Michel and Dyk)	
<i>ITC:</i>	Certain Laminated Floor Panels, Inv. No. 337-TA-545, 2007 ITC LEXIS 175 (Jan. 24, 2007).
<i>ALJ:</i>	Certain Laminated Floor Panels, Inv. No. 337-TA-545, 2006 ITC LEXIS 507 (July 3, 2006).—Luckern

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<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Unilin filed a complaint against Power Dekor for infringing its '779, '836, and '292 patents;</li> <li>• ALJ found that Power Dekor did not infringe claims 1 and 2 of the '836 patent and claims 3 and 4 of the '292 patent, claims 5 and 17 of the '779 patent were invalid, and that the Power Dekor products infringed claims 10, 18, and 23 of '836 ("snap action claims");</li> <li>• ITC reversed on first two issues and held that Power Dekor products infringed claims 1 and 2 of the '836 patent and 3 and 4 of the '292 patent, and that claims 5 and 17 of the '779 patent were not invalid; did not review "snap action claims" of '836;</li> <li>• Federal Circuit affirmed on all of ITC's findings</li> </ul>		
<i>Product:</i>	Mechanism to attach laminate floor boards temporarily without adhesive		
<i>Issues, Categories, and Determinations:</i>	Whether case is moot based on ITC's GEO	5) Federal Circuit performed an analysis of the scope of the ITC's GEO and its potential collateral estoppel effects	AFFIRMED IN PART, REVERSED IN PART
	Invalidity of "clearance" claims (5 and 17 of the '779 patent)	1) Performed a close readings of the claims, specifications, and drawings to determined term "clearance" was defined adequately and used consistently; needed a basic understanding of the product to make the determination	AFFIRMED

<i>Solomon Techs., Inc. v. Int'l Trade Comm'n</i> , 524 F.3d 1310 (Fed. Cir. 2008)—Judge Bryson (with Lourie and Rader)			
<i>ITC:</i>	Certain Combination Motor and Transmission Systems and Devices Used Therein, and Products Containing the Same, Inv. No. 337-TA-561, 2007 ITC LEXIS 422 (April 30, 2007).		
<i>ALJ:</i>	Certain Combination Motor and Transmission Systems and Devices Used Therein, and Products Containing the Same, Inv. No. 337-TA-561, 2007 ITC LEXIS 377 (Feb. 13, 2007).—Luckern		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Solomon filed a complaint against Toyota for infringing its '932 patent;</li> <li>• ALJ found no infringement of '932, but that '932 was invalid for lack of enablement and domestic industry requirement was not satisfied;</li> <li>• ITC did not review aspects relevant to the appeal (and took no position on domestic industry);</li> <li>• Federal Circuit affirmed on basis of non-infringement and did not reach issue of invalidity</li> </ul>		
<i>Product:</i>	Combination motor and transmission devices (Toyota transaxles allegedly infringe)		
<i>Issues, Categories, and Determinations:</i>	Claim construction "integral combination"	3) Federal Circuit looked to prosecution history and description, discussion is more grammatical than technical in nature	AFFIRMED
	Claim construction "within an envelope"	1) Technical analysis based on the drawings; required an understanding of the terminology and functions of the patent	AFFIRMED
	Structural equivalence of the products' power means based on specification	1) Construed the specification of the patent to determine whether there was a substantial difference between the Toyota devices and the specifications described in the '932 patent; required an understanding of the products	AFFIRMED



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<i>Energizer Holdings, Inc. v. Int'l Trade Comm'n</i> , 275 F. App'x 969 (Fed. Cir. 2008)—Judge Schall (with Newman and Linn) (Unpublished/Nonprecedential)			
<i>ITC:</i>	<i>Certain Zero-Mercury-Added Alkaline Batteries</i> , Inv. No. 337-TA-493, 2007 ITC LEXIS 214 (Feb. 23, 2007).		
<i>ALJ:</i>	<i>Certain Zero-Mercury-Added Alkaline Batteries</i> , Inv. No. 337-TA-493, 2004 ITC LEXIS 673 (June 2, 2004). – Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Energizer filed a complaint against 14 Chinese battery manufactures for infringing its '709 patent;</li> <li>• ALJ held that the patent was infringed and the claims were not invalid;</li> <li>• ITC reversed and found the claims invalid for indefiniteness (2004 ITC LEXIS 789 (Oct. 1, 2004));</li> <li>• Federal Circuit found that the claims were not indefinite and remanded to the ITC (see 435 F.3d 1366 (Jan. 25, 2006) <i>infra</i>);</li> <li>• On remand ITC found claims were invalid for failing to meet the written description requirement;</li> <li>• Federal Circuit affirmed</li> </ul>		
<i>Product:</i>	Zero-mercury-added alkaline batteries		
<i>Issue, Category, and Determination:</i>	Satisfaction of the written description requirement	4) Federal Circuit analyzed disconnect between the claims and the specifications, more of a grammatical analysis even though many of the terms are technical	AFFIRMED

<i>Energizer Holdings, Inc. v. Int'l Trade Comm'n</i> , (prior case) 435 F.3d 1366 (Fed. Cir. 2006)—Judge Newman (with Archer and Schall)			
<i>ITC:</i>	<i>Certain Zero-Mercury-Added Alkaline Batteries</i> , Inv. No. 337-TA-493, 2004 ITC LEXIS 789 (Oct. 1, 2004).		
<i>ALJ:</i>	<i>Certain Zero-Mercury-Added Alkaline Batteries</i> , Inv. No. 337-TA-493, 2004 ITC LEXIS 673 (June 2, 2004). – Bullock		
<i>Procedure:</i>	See 275 F. App'x. 969 Fed. Cir. 2008) <i>supra</i>		
<i>Product:</i>	Zero-mercury-added alkaline batteries		
<i>Issue, Category, and Determination:</i>	Invalidity of claims for indefiniteness ("said zinc anode")	3) Analysis is primarily grammatical; Federal Circuit reversed because neither ITC nor interveners claimed they did not understand the term because of the absence of an antecedent	REVERSED

<i>Sinorgchem Co. v. Int'l Trade Comm'n</i> , 511 F.3d 1132 (Fed. Cir. 2007)—Judge Dyk (with Newman and Yeakel, U.S. District Court for the Western District of Texas)			
<i>ITC:</i>	<i>Certain Rubber Antidegradants</i> , Inv. No. 337-TA-533, 2006 ITC LEXIS 591 (July 21, 2006).		
<i>ALJ:</i>	<i>Certain Rubber Antidegradants</i> , Inv. No. 337-TA-533, 2006 ITC LEXIS 212 (Feb. 17, 2006). – Luckern		

<i>Procedure:</i>	<ul style="list-style-type: none"> <li>Flexsys filed a complaint against Sinorgchem alleging that it infringed its two method patents;</li> <li>ALJ found that Sinorgchem had infringed the patents;</li> <li>ITC construed claims differently based on Flexsys's specification and still found infringement;</li> <li>Federal Circuit performed a different claim construction based on definition in the specifications, reversed and found there no infringement</li> </ul>		
<i>Product:</i>	Method for producing compounds 6PPD and 4-ADPA		
<i>Issue, Category, and Determination:</i>	Claim construction "controlled amount"	3) Federal Circuit looked to the definition in specification, and idea of drafters as their own "lexicographers;" grammatical reasoning	REVERSED (vacated and remanded)

<i>OSRAM GmbH v. Int'l Trade Comm'n</i> , 505 F.3d 1351 (Fed. Cir. 2007)—Judge Newman (with Rader and Dyk)			
<i>ITC:</i>	2007 ITC LEXIS 1454 (Jan. 26, 2006); 70 FR 37431 (June 29, 2005)		
<i>ALJ:</i>	2005 ITC LEXIS 781 (Oct. 31, 2005); 2005 ITC LEXIS 631 (May 10, 2005)—Bullock Inv. No. 337-TA-512		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>OSRAM filed a complaint against Dominant for infringing its LED patents ('861, '301, '247, '259, and '780),</li> <li>ALJ found symbol in claim to confusing as to whether it meant "median" or "mean" and held the claim invalid for indefiniteness (and found infringement of one of the patents);</li> <li>ITC reversed and said it was clear from the rest of the patent that it was meant to be "mean" but it noted that it was unclear whether mean grain diameter is measured by the number of grains or overall volume, so remanded;</li> <li>ALJ went with volume method and found one series of Dominant's products infringed and the other did not;</li> <li>ITC affirmed;</li> <li>Federal Circuit held that the number-based method was correct and found infringement</li> </ul>		
<i>Product:</i>	Wave-length converting compositions for LEDs		
<i>Issue, Category, and Determination:</i>	Claim Construction—number-based on volume-based determination of mean grain diameter	3) Federal Circuit reviewed ITC's determination based on treatises and expert witness; experts on both sides agreed and Federal Circuit took this view	REVERSED
	Infringement based on claim construction	4) Short analysis based on claim construction; determined that the ITC did not respond to the record evidence	REVERSED
	Technical Prong of the Domestic Industry	4) Short analysis based on claim construction; OSRAM had met its burden based on the correct number-based method	REVERSED

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<i>Fuji Photo Film Co. v. Int'l Trade Comm'n</i> , 474 F.3d 1281 (Fed. Cir. 2007)—Judge Dyk (with Lourie and Schall)			
<i>ITC:</i>	<i>Certain Lens-Fitted Film Packages</i> , Inv. No. 337-TA-406, 2004 ITC LEXIS 545 (July 27, 2004).		
<i>ALJ:</i>	Enforcement Initial Determination (April 6, 2004)—Luckern (confidential) Inv. No. 337-TA-406		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Case had been appealed to the Federal Circuit four times prior to this case;</li> <li>• Fuji originally brought a complaint against Jazz for infringing its patents for disposable cameras by taking the cameras after they were used, refurbishing them, and then importing/selling them back into the US</li> <li>• During first investigation, ITC found repairing the cameras first sold in the US was permissible and reconstructing them was not;</li> <li>• Determined that Jazz's actions were in the impermissible category, and so ITC issued a GEO and also specific C&amp;Ds against Jazz;</li> <li>• Federal Circuit reversed and said permissible repair;</li> <li>• On remand ITC did not modify or clarify its orders orders;</li> <li>• Litigation for this case is centered on an alleged violation of a C&amp;D order by 2 Jazz executives (by continuing to import/sell cameras after the Federal Circuit decision);</li> <li>• ALJ found that the vast majority (approximately ninety-four percent) of the cameras imported/sold did not constitute permissible repair and issued a penalty</li> <li>• ITC did not review violation findings but reduced the penalty for one of the execs;</li> <li>• Federal Circuit affirmed on most counts, reversed on issue of one repair technique which it found was permissible</li> </ul>		
<i>Product:</i>	Disposable cameras		
<i>Issues, Categories, and Determinations:</i>	Applicability of civil penalties to appellant Benun	5) Federal Circuit performed analysis completely unrelated to the patents at issue to determine that ITC had authority to issue the order, the C&D order covered him as an individual, and he had been given sufficient notice of potential liability	AFFIRMED
	Applicability of affirmative defense of repair	5) Non-technical analysis based on evidence from prior case, more about trade law	AFFIRMED
	Evidence about the process of refurbishing	5) Federal Circuit held that the burden was on Benun to provide evidence, and the ITC correctly found it insufficient; not related to the patents at all	AFFIRMED
	Replacement of full backs as reconstruction	5) Reviewed relevant caselaw to determine that this particular activity constituted permissible repair	REVERSED

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<i>Fuji Photo Film Co. v. Int'l Trade Comm'n, (prior case)</i> 386 F.3d 1095 (Fed. Cir. 2004)—Judge Bryson (with Cleverger and Linn)			
<i>ITC:</i>	<i>Certain Lens-Fitted Film Packages</i> , Inv. No. 337-TA-406, 2003 ITC LEXIS 807 (June 23, 2003).		
<i>ALJ:</i>	<i>Certain Lens-Fitted Film Packages</i> , Inv. No. 337-TA-406, 2002 ITC LEXIS 473 (May 2, 2002). – Luckern		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• In 2001 Fuji filed a complaint with the ITC to enforce its GEO;</li> <li>• ALJ found infringement violations for all 7 patents but did not issue a C&amp;D order</li> <li>• ITC determined not to review relevant aspects on appeal (3 patents)</li> <li>• Federal Circuit affirmed infringement of two patents and reversed for one based on modified claim construction, affirmed refusal to issue C&amp;D order</li> </ul>		
<i>Product:</i>	Disposable cameras		
<i>Issues, Categories, and Determinations:</i>	Construction of “opening”	3) Analyzed specification to see how “opening” was used, no real technical analysis	AFFIRMED
	Construction of “said means”	3) Federal Circuit performed a grammatical analysis to determine what the phrase included based on the claims, specification, and prosecution history	AFFIRMED
	Applicability of claim “must be destroyed to open the same” (Achiever Cameras)	4) Examined the ALJ’s determination and the prosecution history to determine its meaning; not technical in nature	AFFIRMED
	Applicability of claim “must be destroyed to open the same” (Highway Holdings cameras)	4) Looked to expert witness testimony to determine its inapplicability	AFFIRMED
	Construction of “in a darkroom”	3) Federal Circuit noted “in a darkroom” was included in only in one of the three limitations, more of a grammatical analysis about what was included in the specification and what was merely included as a preferred embodiment	REVERSED (vacated and remanded)
	ITC’s refusal to issue C&D orders	4) Entirely unrelated to the patents; a trade issue rather than a patent law issue	AFFIRMED

<i>Jazz Photo Corp. v. Int'l Trade Comm'n,</i> 264 F.3d 1094 (Fed. Cir. 2001)—Judge Newman (with Michel and Gajarsa)	
<i>ITC:</i>	<i>Certain Lens-Fitted Film Packages</i> , Inv. No. 337-TA-406, 1999 ITC LEXIS 502 (June 2, 1999).
<i>ALJ:</i>	<i>Certain Lens-Fitted Film Packages</i> , Inv. No. 337-TA-406, 1999 ITC LEXIS 116 (Feb. 24, 1999). – Luckern
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Jazz was one of the respondents found to be infringing Fuji’s patents, import used disposable cameras that have been refurbished</li> <li>• ITC modified the ALJ’s repair/reconstruction standard of proof, but affirmed conclusions on definition of repair/reconstruction and validity/enforcement of ‘649</li> <li>• This appeal centered on whether the refurbishing done abroad was permissible repair or prohibited reconstruction</li> </ul>
<i>Product:</i>	Disposable cameras

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<i>Issues, Categories, and Determinations:</i>	Burden and standard of proof	5) Civil procedure analysis that is not related to the patents at issue	AFFIRMED
	Definitions of "repair" and "reconstruction"	4) Analyzed caselaw to determine the standards, then applied test from precedential cases to the "remanufacturers" to find that their actions were sometimes impermissible reconstruction	AFFIRMED IN PART; REVERSED IN PART
	Validity/Enforceability of the '649 patent	4) Adopted evidentiary findings from the ALJ without much analysis	AFFIRMED

<i>VastFame Camera, Ltd. v. Int'l Trade Comm'n, (related case)</i> 386 F.3d 1108 (Fed. Cir. 2004)—Judge Linn (with Clevenger and Bryson)			
<i>ITC:</i>	Available on EDIS, Notice of Commission Decision not to Review the Administrative Law Judge's Supplemental Initial Determination, Inv. No. 337-TA-406 (May 15, 2003)		
<i>ALJ:</i>	<i>Certain Lens-Fitted Film Packages</i> , Inv. No. 337-TA-406, 2002 ITC LEXIS 473 (May 2, 2002). – Luckern		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• VastFame was not a party to the Initial Investigation, but it was named as a respondent in enforcement hearing</li> <li>• ALJ held that VastFame's cameras were in violation of one claim of the '087 patent, and refused to hear VastFame's invalidity defense;</li> <li>• ITC did not review this issue;</li> <li>• Federal Circuit vacated non-infringement determination and remanded because ALJ erred in not allowing VastFame to present invalidity defense</li> </ul>		
<i>Product:</i>	Disposable cameras		
<i>Issues, Categories, and Determinations:</i>	Statutory basis of enforcement proceeding	5) Analysis involved statutory interpretation of § 1337; not related to the asserted patent	AFFIRMED
	Permissibility of in the invalidity defense	5) Analysis not related to the asserted patents	REVERSED (vacated and remanded)

<i>MStar Semiconductor Inc. v. Int'l Trade Comm'n,</i> 183 F. App'x 957 (Fed. Cir. May 25, 2006)—Judge Clevenger (with Lourie and Bryson) (Unpublished/Nonprecedential)			
<i>ITC:</i>	Confidential, Commission Opinion (August 27, 2004)		
<i>ALJ:</i>	<i>Certain Display Controllers</i> , Inv. No. 337-TA-491, 2004 ITC LEXIS 331 (Apr. 14, 2004). – Terrill		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Genesis filed a complaint with the ITC for infringement of its '867 patent (MStar was not an initial respondent, and was added through an amended complaint); Based on a prior investigation, ALJ found infringement of claims 1, 2, 9, and 33-36 of '867 patent and that Genesis's claims were not invalid;</li> <li>• ITC consolidated the investigation with another, reversed and said claims 1 and 9 of '867 were invalid but upheld infringement of 2 and 33-36;</li> <li>• Federal Circuit affirmed the ITC's claim constructions and infringement</li> </ul>		
<i>Product:</i>	Method and device for "upscaling" (increasing resolution of video image on a computer monitor)		

<i>Issues, Categories, and Determinations:</i>	Construction of "generated . . . such that"	3) Analysis is based on grammar—determined that MStar's proposed claim construction did not differ in any meaningful way from the ITC's construction	AFFIRMED
	Construction of "equality" limitation	1) Analysis is technical because needed to know terminology about pixel data and an understanding of how the process works	AFFIRMED

<i>Sorensen v. Int'l Trade Comm'n</i> , 427 F.3d 1375 (Fed. Cir. 2005)—Judge Rader (with Michel and Linn)			
<i>ITC:</i>	<i>Certain Auto. Tail Light Lenses</i> , Inv. No. 337-TA-502, 2004 ITC LEXIS 654 (Aug. 20, 2004).		
<i>ALJ:</i>	<i>Certain Auto. Tail Light Lenses</i> , Inv. No. 337-TA-502, 2004 ITC LEXIS 555 (July 9, 2004).—Harris		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Sorensen filed a complaint Mercedes-Benz infringing its '184 patent;</li> <li>• ALJ granted summary determination for non-infringement;</li> <li>• ITC did not review;</li> <li>• Federal Circuit reversed and remanded</li> </ul>		
<i>Product:</i>	Injection molded laminated tail lights		
<i>Issue, Category, and Determination:</i>	Construction of "different characteristics"	3) Federal Circuit examined the specification and prosecution history to find the limitation was not limited to a difference in molecular properties; not a technical analysis	REVERSED (vacated and remanded)

<i>Gemstar-TV Guide Int'l, Inc. v. Int'l Trade Comm'n</i> , 383 F.3d 1352 (Fed. Cir. 2004)—Judge Linn (with Michel and Cleverger)			
<i>ITC:</i>	<i>Certain Set Top Boxes</i> , Inv. No. 337-TA-454, 2002 ITC LEXIS 812 (Aug. 30, 2002).		
<i>ALJ:</i>	<i>Certain Set-Top Boxes</i> , Inv. No. 337-TA-454, 2002 ITC LEXIS 759 (June 21, 2002).—Luckern		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Gemstar filed a complaint with the ITC claiming that several companies were infringing three of its patents ('268, '204, and '121);</li> <li>• ALJ found that patents were not being infringed, '121 was "unenforceable", Gemstar failed to meet the technical prong of the domestic industry requirement, and Gemstar misused the '121 patent;</li> <li>• ITC affirmed on everything relevant to this litigation;</li> <li>• Federal Circuit affirmed finding of the non-infringement of the '268 patent, vacated and remanded non-infringement finding of patents '204 and '121 based on errors in claim constructions</li> </ul>		
<i>Product:</i>	Interactive program guides for digital cable boxes		
<i>Issues, Categories, and Determinations:</i>	Construction of "means . . . for displaying the television schedule" ('268 patent)	1) Borderline issue—the dispute concerned the structure corresponding to the means-plus-function limitation; consulted written description; needed an understanding of how the system works	AFFIRMED
	Construction of "visual identification" ('204 patent)	3) Federal Circuit examined the ordinary meaning of the phrase, rather than solely the written description; analysis was not technical	REVERSED (vacated and remanded)

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	Construction of "moving . . . between . . . cells" ('204 patent)	3) Federal Circuit performed a nearly identical analysis and held that the ITC did not look to the ordinary meaning of the phrase	REVERSED (vacated and remanded)
	Construction of "storage means in a data processor" ('121 patent)	3) Used a technical dictionary; disagreed with ITC's assertion that there is no ordinary skill in the art definition	REVERSED
	Construction of "information identifying" ('121 patent)	3) Looked to the dictionary as well as the written description and prosecution history; not a technical analysis (two-part analysis for scope of identifying information, as well as what the information references)	AFFIRMED IN PART, REVERSED IN PART
	Construction of "combining" ('121 patent)	3) Similar analysis—Federal Circuit looked to dictionary definition and prosecution history (two-part analysis for types of combinations and order)	AFFIRMED IN PART, REVERSED IN PART
	Construction of "said user selection criteria" ('121 patent)	3) Federal Circuit found that ITC construed "criteria" part of the claim too narrowly based on written description and prosecution history; grammatical issue about the antecedent of "said" based on the Federal Circuit's construction of "combining"	AFFIRMED IN PART, REVERSED IN PART
	Co-inventorship	4) Federal Circuit found that the ITC erred finding Neil to be an unnamed co-inventor (and thus holding the '121 patent "unenforceable") based on the evidence presented; not a technical analysis	REVERSED

<i>Vanderlande Indus. Nederland BV v. Int'l Trade Comm'n</i> , 366 F.3d 1311 (Fed. Cir. 2004)—Judge Michel (with Gajarsa and Linn)			
<i>ITC:</i>	<i>Certain Sortation Sys.</i> , Inv. No. 337-TA-460, 2003 ITC LEXIS 176 (Jan. 27, 2003).		
<i>ALJ:</i>	<i>Certain Sortation Sys.</i> , Inv. No. 337-TA-460, 2002 ITC LEXIS 767 (Oct. 22, 2002). – Bullock		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Siemens and Rapistan filed a complaint against Vanderlande for infringing its '510 patent;</li> <li>• ALJ found that Vanderlande had infringed claims 1 and 4 but not any of the thirteen other claims in dispute, and that Siemens/Rapistan was not equitably estopped from asserting their patent against Vanderlande;</li> <li>• ITC modified claim construction for claims 30, 33, and 35; reached same ultimate conclusions as ALJ;</li> <li>• Federal Circuit affirmed on all findings, but modified one claim construction</li> </ul>		
<i>Product:</i>	Shoe-sorter systems		
<i>Issues; Categories; and Determinations:</i>	Construction of "glide surface surrounding said [slat] wall"	3) Federal Circuit looked to the preferred embodiment and summary of the invention, as well as guidance from the experts to find that the ITC definition was overly broad (still found infringement)	AFFIRMED

	Construction of "glide surface having substantially the same configuration as said outer surface of said slat"	3) Federal Circuit noted that this limitation was not in dispute when the ALJ construed the claims and so does not construe it now, and enough evidence to show that substantially similar design	AFFIRMED
	Equitable estoppel defense	5) Reviewed evidence of actual notice received by Vanderlande of infringement to find that elements of the defense cannot be met	AFFIRMED

<i>Kinik Co. v. Int'l Trade Comm'n</i> , 362 F.3d 1359 (Fed. Cir. 2004)—Judge Newman (with Bryson and Linn)			
<i>ITC:</i>	<i>Certain Abrasive Prod. Made Using a Process for Powder Preforms</i> , Inv. No. 337-TA-449, 2002 ITC LEXIS 236 (May 9, 2002).		
<i>ALJ:</i>	<i>Certain Abrasive Prod. Made Using a Process for Powder Preforms</i> , Inv. No. 337-TA-449, 2002 ITC LEXIS 167 (Feb. 8, 2002). – Terrill		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• 3M filed a complaint against Kinik alleging that was infringing its '489 patent;</li> <li>• ALJ found Kinik was infringing by using the '489 patent in Taiwan to produce products that were imported into the US; also held that the § 271(g) defenses were not available;</li> <li>• ITC effectively vacated one invalidity claim but for the most part did not review;</li> <li>• Federal Circuit affirmed on unavailability of the § 271(g) defenses, but reversed on infringement</li> </ul>		
<i>Product:</i>	Method for making Post-It Notes glue		
<i>Issues; Categories; and Determinations:</i>	§ 271(g) defenses	5) Not related to the asserted patent; more about statutory interpretation	AFFIRMED
	Construction of claim involving "liquid binder composition" and "powdered matrix material"	3) Federal Circuit determined that the claim did not specify any particular ratio between the materials, but the specification clearly explained that the volume of "liquid binder" "substantially exceeds" the volume of "matrix powder"; more of a grammatical analysis	REVERSED
	Invalidity	4) Issue was not raised in a timely fashion and so was waived	AFFIRMED

<i>Alloc, Inc. v. Int'l Trade Comm'n</i> , 342 F.3d 1361 (Fed. Cir. 2003)—Judge Rader (with Michel and Schall)			
<i>ITC:</i>	<i>Certain Flooring Prod.</i> , Inv. No. 337-TA-443, 2002 ITC LEXIS 241 (May 1, 2002).		
<i>ALJ:</i>	<i>Certain Flooring Products</i> , Inv. No. 337-TA-443, 2001 ITC LEXIS 742 (Nov. 2, 2001). – Luckern		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Alloc filed a complaint generally against importers of flooring materials for violating its patents '267, '907, and '410;</li> <li>• Intervenors (with exception of one) admitted importation of the products but denied infringement of the patents;</li> <li>• ALJ found Alloc had not satisfied the technical prong of domestic industry requirement, and no infringement (based on "play" requirement);</li> <li>• ITC affirmed on all findings (but found different functions for some of the claims), Federal Circuit affirmed on non-infringement and lack of satisfaction of domestic industry requirement</li> </ul>		



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<i>Product:</i>	Flooring products		
<i>Issues; Categories; and Determinations:</i>	Construction of "play" limitation	1) Borderline case—need to have some understanding of the terminology; Federal Circuit noted that none of the claims used the term "play" but specification did; specification criticized prior art that did not have "play", and the prosecution history shows that it disavowed systems without play; so determined that must be a part of the claim	AFFIRMED
	Infringement of imported floor systems	4) Deferred to the experts and evidence presented by the parties to uphold ALJ's finding of non-infringement	AFFIRMED
	Domestic Industry	4) Found that Alloc essentially conceded that it did not meet the technical prong of the domestic industry requirement	AFFIRMED

<i>Honeywell Int'l, Inc. v. Int'l Trade Comm'n,</i> 341 F.3d 1332 (Fed. Cir. 2003)—Judge Linn (with Lourie and Gajarsa)			
<i>ITC:</i>	<i>Certain Polyethylene Terephthalate Yarn</i> , Inv. No. 337-TA-457, 2002 ITC LEXIS 665 (May 17, 2002).		
<i>ALJ:</i>	<i>Certain Polyethylene Terephthalate Yarn</i> , Inv. No. 337-TA-457, 2002 ITC LEXIS 99 (Feb. 4, 2002). – Terrill		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Honeywell filed a complaint against Hyosung alleging that it was infringing its '976 patent;</li> <li>• Hyosung moved for summary judgment of non-infringement and invalidity of the '976 patent;</li> <li>• ALJ found no infringement, and that claims were not invalid due to indefiniteness, lack of enablement, or failure to provide an adequate written description;</li> <li>• ITC did not review non-infringement issue; reversed ALJ's determination and found that the claims were indefinite;</li> <li>• Federal Circuit opinion reviewed invalidity issue and affirmed ITC; because indefinite claim no need to resolve infringement issue (moot)</li> </ul>		
<i>Product:</i>	PET yarn		
<i>Issue; Category; and Determination:</i>	Construction of "melting point elevation"	3) Federal Circuit noted that there were at least two possible constructions for the term and that the intrinsic record does not point to one in particular, and no sufficient extrinsic evidence that explains which one applies; not a technical analysis	AFFIRMED

<i>Windbond Elecs. Corp. v. Int'l Trade Comm'n</i> , 2001 U.S. App. LEXIS 25113 (Fed. Cir. 2001)—Judge Rader (with Clevenger and Dyk)			
<i>ITC:</i>	<i>Certain EPROM, EEPROM, Flash Memory, and Flash Microcontroller Semiconductor Devices</i> , Inv. No. 337-TA-395, 1998 ITC LEXIS 371 (July 9, 1998).		
<i>ALJ:</i>	<i>Certain EPROM, EEPROM, Flash Memory, and Flash Microcontroller Semiconductor Devices</i> , Inv. No. 337-TA-395, 1998 ITC LEXIS 85 (Mar. 19, 1008). – Luckern		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Atmel filed a complaint against Macronix, Windbond, and Sanyo for infringing its '903 patent;</li> <li>• ALJ concluded in first ID that an incorrect listing of inventors prevented enforcement of the '903 patent; and also unenforceable because of original assignee's discussions with Joint Electronics Device Council (JEDEC);</li> <li>• ITC found the patent unenforceable for failure to name an inventor;</li> <li>• ALJ came to same conclusion in second ID because the Certificate of Correction named incorrect inventors and Atmel committed inequitable conduct in obtaining it from the PTO;</li> <li>• For second hearing, the ITC found that issues about the proper inventors of the '903 patent was not relevant for enforcement issues, and that Atmel had not committed inequitable conduct before the PTO; also held that neither wavier nor implied license doctrines precluded enforcement of the patent;</li> <li>• Federal Circuit affirmed all issues</li> </ul>		
<i>Product:</i>	Erasable programmable read only memory (EPROM)		
<i>Issues; Categories; and Determinations:</i>	Inventorship	4) Federal Circuit noted that the burden was on the respondents to show that the inventorship was incorrect; determined that there was insufficient evidence based on asserted testimony	AFFIRMED
	Inequitable Conduct	4) Examined the testimony from earlier hearing and found that substantial evidence that Atmel did not exclude the testimony from the PTO with intent to deceive; the patent itself was not analyzed	AFFIRMED
	Implied License/Waiver	5) Reviewed timeline and communications between original assignee and JEDEC to find that no implied license or waiver; more of a contract law issue	AFFIRMED
	Scope of attorney-client privilege and work product protection waiver	5) Short analysis—Federal Circuit noted that the precedent was that an inadvertent waiver of attorney-client privileges constituted a general waiver	AFFIRMED

<i>Oak Tech., Inc. v. Int'l Trade Comm'n</i> , 248 F.3d 1316 (Fed. Cir. 2001)—Judge Clevenger (with Newman and Bryson)			
<i>ITC:</i>	<i>Certain CD-ROM Controllers</i> , Inv. No. 337-TA-409, 1999 ITC LEXIS 314 (Oct. 18, 1999).		
<i>ALJ:</i>	<i>Certain CD-ROM Controllers</i> , Inv. No. 337-TA-191, 1999 ITC LEXIS 191 (May 12, 1999). – Harris		
<i>Procedure:</i>	<ul style="list-style-type: none"> <li>• Oak filed a complaint against MediaTek for violating its '715 patent;</li> <li>• ALJ found no infringement; that the claims were invalid on several grounds; and the patent was unenforceable due to inequitable conduct before the USPTO;</li> <li>• ITC reversed on invalidity and unenforceability findings; affirmed on finding of non-infringement;</li> <li>• Federal Circuit affirmed</li> </ul>		
<i>Product:</i>	CD-ROM drive controller		

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<i>Issues, Categories, and Determinations:</i>	Construction of "said assembled data"	1) Federal Circuit actually presented a lengthy technical description prior to claim construction; needed to understand terminology to analyze the claims and specification	AFFIRMED
	Construction of "after"	1) Analyzed written description in a way that required an understanding of how the product worked in practice	AFFIRMED
	Construction of "cyclic redundancy checker"	1) Borderline—Used constructions of other terms to determine the meaning of this phrase; noted that the definition was actually undisputed	AFFIRMED
	Infringement	1) Analysis required an understanding of the process of the products to recognize the differences between them	AFFIRMED

## APPENDIX B

Notes:

This chart should be used in conjunction with Appendix A, which gives details about the numbered issues in the "Determinations" column.

The educational background of the Commissioners is not included in this Appendix because each case is reviewed by all ITC members, none of whom hold a technical background.

The abbreviation "NT" stands for "non-technical background," while the abbreviation "T" implies that the judge has an educational background in science/engineering.

Case	Date of Federal Circuit Decision	ITC Determination	Federal Circuit Determination	ALJ	Federal Circuit Panel
<i>SIRF Tech., Inc. v. Int'l Trade Comm'n</i>	4/12/2010	ITC reviewed some issues from ALJ decision and arrived at same ultimate conclusions	Category 3: 2 AFFIRMED Category 4: 1 AFFIRMED Category 5: 1 AFFIRMED	Charneski (NT)	Dyk (NT) (Michel and Clevenger)
<i>Ajinomoto Co. v. Int'l Trade Comm'n</i>	3/8/2010	ITC reviewed some aspects of ALJ decision and affirmed, but did not review other parts	Category 2: 2 AFFIRMED Category 4: 1 AFFIRMED	Bullock (NT)	Lourie (T) (Newman and Linn)
<i>Crocs, Inc. v. Int'l Trade Comm'n</i>	2/24/2010	ITC upheld ALJ determination	Category 4: 3 REVERSED	Bullock (NT)	Rader (NT) (Lourie and Prost)
<i>Norgren Inc. v. Int'l Trade Comm'n</i>	5/26/2009	ITC upheld ALJ determination	Category 1: 1 REVERSED	Charneski (NT)	Moore (T) (Schall and Gajarsa)
<i>Epistar Corp. v. Int'l Trade Comm'n</i>	5/22/2009	ITC did not review ALJ's error in considering the two settlement agreements as one entity; accepted part of ALJ's claim construction and modified another part	Category 1: 2 AFFIRMED Category 5: 2 REVERSED	Harris (NT)	Rader (NT) (Archer and Dyk)
<i>Linear Tech. Corp. v. Int'l Trade Comm'n</i>	5/21/2009	ITC reversed ALJ's finding of non-infringement for some of the products and remanded invalidity for one claim	Category 1: 3 AFFIRMED; 1 REVERSED Category 2: 1 AFFIRMED; 1 REVERSED; 1 AFFIRMED IN PART Category 3: 1 AFFIRMED Category 4: 1 AFFIRMED; 2 REVERSED	Harris (NT)	Schall (NT) (Mayer and Lourie)
<i>Linear Tech. Corp. v. Int'l Trade Comm'n</i>	8/28/2008	ITC did not review most findings; effectively vacated finding of one claim for invalidity	Category 1: 1 AFFIRMED	Harris (NT)	Schall (NT) (Mayer and Lourie)
<i>ERBE Elektromedizin GmbH v. Int'l Trade Comm'n</i>	5/19/2009	ITC affirmed on all issues except construction of one term that did not affect the outcome of the decision	Category 3: 1 AFFIRMED	Bullock (NT)	Dyk (NT) (Michel and Rader)

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<b>Case</b>	<b>Date of Federal Circuit Decision</b>	<b>ITC Determination</b>	<b>Federal Circuit Determination</b>	<b>ALJ</b>	<b>Federal Circuit Panel</b>
<i>Amgen, Inc. v. Int'l Trade Comm'n</i>	4/30/2009	ITC did not review ALJ's findings	Category 4: 1 AFFIRMED IN PART Category 5: 1 REVERSED	Luckern (T)	Newman (T), Lourie (T), and Linn (T) (per curiam)
<i>Princo Corp. v. Int'l Trade Comm'n</i>	4/20/2009	ITC reversed ALJ and found no patent misuse violation	Category 4: 1 AFFIRMED; 1 REVERSED	Harris (NT)	Dyk (NT) (Bryson and Gajarsa)
<i>U.S. Philips Corp. v. Int'l Trade Comm'n</i>	9/21/2005	ITC adopted all the findings concerning patent misuse, but on narrower grounds	Category 4: 2 REVERSED	Harris (NT)	Bryson (NT) (Gajarsa and Linn)
<i>Kyocera Wireless Corp. v. Int'l Trade Comm'n</i>	10/14/2008	ALJ developed a broad definition for the disputed term "different" and ITC narrowed it, FEDERAL CIRCUIT affirmed	Category 1: 1 AFFIRMED Category 4: 2 AFFIRMED; 1 REVERSED Category 5: 1 AFFIRMED	Bullock (NT)	Rader (NT) (Bryson and Linn)
<i>LG Elecs. Mobilecomm U.S.A., Inc. v. Int'l Trade Comm'n</i>	7/20/2007	ITC affirmed infringement but excluded downstream products from exclusion order	Category 5: 2 AFFIRMED	Bullock (NT)	Prost (NT) (Mayer and Michel)
<i>Broadcom Corp. v. Int'l Trade Comm'n</i>	9/19/2008	ITC determined not to review	Category 2: 1 AFFIRMED; 1 REVERSED Category 4: 3 AFFIRMED	Bullock (NT)	Bryson (NT) (Rader and Linn)
<i>Yingbin-Nature Wood Indus. Co. v. Int'l Trade Comm'n</i>	7/31/2008	ITC reversed 2 of the 3 ALJ findings	Category 1: 1 AFFIRMED Category 5: 1 AFFIRMED IN PART	Luckern (T)	Schall (NT) (Michel and Dyk)
<i>Solomon Techs., Inc. v. Int'l Trade Comm'n</i>	5/7/2008	ITC did not review ALJ	Category 1: 2 AFFIRMED Category 3: 1 AFFIRMED	Luckern (T)	Bryson (NT) (Lourie and Rader)
<i>Energizer Holdings, Inc. v. Int'l Trade Comm'n</i>	4/21/2008	ITC reversed and found patents invalid for failure to meet description requirement	Category 4: 1 AFFIRMED	Bullock (NT)	Schall (NT) (Newman and Linn)
<i>Energizer Holdings, Inc. v. Int'l Trade Comm'n</i>	1/25/2006	ITC reversed and found patents invalid on indefiniteness	Category 3: 1 REVERSED	Bullock (NT)	Newman (T) (Archer and Schall)
<i>Sinorgchem Co. v. Int'l Trade Comm'n</i>	12/21/2007	ITC affirmed infringement with different claim construction	Category 3: 1 REVERSED	Luckern (T)	Dyk (NT) (Newman and Yeakel)

Case	Date of Federal Circuit Decision	ITC Determination	Federal Circuit Determination	ALJ	Federal Circuit Panel
<i>Osram GmbH v. Int'l Trade Comm'n</i>	10/31/2007	ITC reversed ALJ first time and said claim was not indefinite; affirmed second time	Category 3: 1 REVERSED Category 4: 2 REVERSED	Bullock (NT)	Newman (T) (Rader and Dyk)
<i>Fuji Photo Film Co. v. Int'l Trade Comm'n</i>	7/11/2007	ITC affirmed and slightly lowered penalty amount for individual	Category 5: 3 AFFIRMED; 1 REVERSED	Luckern (T)	Dyk (NT) (Lourie and Schall)
<i>Fuji Photo Film Co. v. Int'l Trade Comm'n</i>	10/7/2004	ITC did not review issues on appeal	Category 3: 2 AFFIRMED; 1 REVERSED Category 4: 3 AFFIRMED	Luckern (T)	Bryson (NT) (Clevenger and Linn)
<i>Jazz Photo Corp. v. Int'l Trade Comm'n</i>	8/21/2001	ITC reversed issue of standard of proof; affirmed definitions and enforceability of patent	Category 4: 1 AFFIRMED; 1 AFFIRMED IN PART Category 5: 1 AFFIRMED	Luckern (T)	Newman (T) (Michel and Gajarsa)
<i>VastFame Camera, Ltd. v. Int'l Trade Comm'n</i>	10/7/2004	ITC determined not to review	Category 5: 1 AFFIRMED; 1 REVERSED	Luckern (T)	Linn (T) (Clevenger and Bryson)
<i>MStar Semiconductor Inc. v. Int'l Trade Comm'n</i>	5/25/2006	ITC reversed some rulings of the ALJ and found certain claims to be invalid (but still found infringement of certain claims)	Category 1: 1 AFFIRMED Category 3: 1 AFFIRMED	Terrill (T)	Clevenger (NT) (Lourie and Bryson)
<i>Sorensen v. Int'l Trade Comm'n</i>	10/31/2005	ITC determined not to review	Category 3: 1 REVERSED	Harris (NT)	Rader (NT) (Michel and Linn)
<i>Gemstar-TV Guide Int'l, Inc. v. Int'l Trade Comm'n</i>	9/16/2004	ITC affirmed on everything relevant to the Federal Circuit litigation	Category 1: 1 AFFIRMED Category 3: 3 AFFIRMED IN PART; 3 REVERSED Category 4: 1 REVERSED	Luckern (T)	Linn (T) (Clevenger and Michel)
<i>Vanderlande Indus. Nederland BV v. Int'l Trade Comm'n</i>	5/3/2004	ITC affirmed all of the ALJ conclusions and most of the findings (none issues on appeal)	Category 3: 2 AFFIRMED Category 5: 1 AFFIRMED	Bullock (NT)	Michel (NT) (Gajarsa and Linn)
<i>Kinik Co. v. Int'l Trade Comm'n</i>	3/25/2004	ITC did not review most findings, effectively vacated finding of one claim for invalidity	Category 3: 1 REVERSED Category 4: 1 AFFIRMED Category 5: 1 AFFIRMED	Terrill (T)	Newman (T) (Bryson and Linn)
<i>Alloc Inc. v. Int'l Trade Comm'n</i>	9/10/2003	ITC upheld the ALJ determination	Category 1: 1 AFFIRMED Category 4: 2 AFFIRMED	Luckern (T)	Rader (NT) (Michel and Schall)

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<b>Case</b>	<b>Date of Federal Circuit Decision</b>	<b>ITC Determination</b>	<b>Federal Circuit Determination</b>	<b>ALJ</b>	<b>Federal Circuit Panel</b>
<i>Honeywell Int'l, Inc. v. Int'l Trade Comm'n</i>	8/26/2003	ITC did not review infringement issue; reversed invalidity determination	Category 3: 1 AFFIRMED	Terrill (T)	Linn (T) (Lourie and Gajarsa)
<i>Windbond Elecs. Corp. v. Int'l Trade Comm'n</i>	8/22/2001	ITC first found the patent unenforceable for failure to name an inventor; second time ITC found inventor issue irrelevant; reversed inequitable conduct finding; and no waiver or implied license	Category 4: 2 AFFIRMED Category 5: 2 AFFIRMED	Luckern (T)	Rader (NT) (Clevenger and Dyk)
<i>Oak Tech., Inc. v. Int'l Trade Comm'n</i>	5/2/2001	ITC reversed on invalidity and unenforceability findings; affirmed on finding of non-infringement	Category 1: 4 AFFIRMED	Harris (NT)	Clevenger (NT) (Newman and Bryson)