

Better Safe than Sorry

米国特許係争への備え方

008 ITCへの備え方

November 26, 2021

森下 実郎

Morgan Lewis

Overview

The U.S. International Trade Commission

“A section 337 investigation is not mere litigation between private parties.”

Administrative Law Judge Sidney Harris
Certain Gel-Filled Wrist Rests and Products Containing Same
Inv. No. 337-TA-456, Order No. 10 (Jan. 7, 2001)

The Regulatory Framework

- **Administrative Law Judges**
 - **Six sitting ALJs** (all cases are bench trials before an ALJ)
 - Issue an **Initial Determination** as to violation, subject to review by the Commission
- **Commissioners**
 - **Six Commissioners**
 - Issue the **Commission's Final Determination** as to violation and remedy
 - 30 attorneys (Office of GC) provide legal advice and support to Commission
- **Office of Unfair Import Investigations**
 - 3 supervisory and 18 full-time staff attorneys
 - Active participants in Section 337 investigations **if** assigned
 - Role is to protect public interest

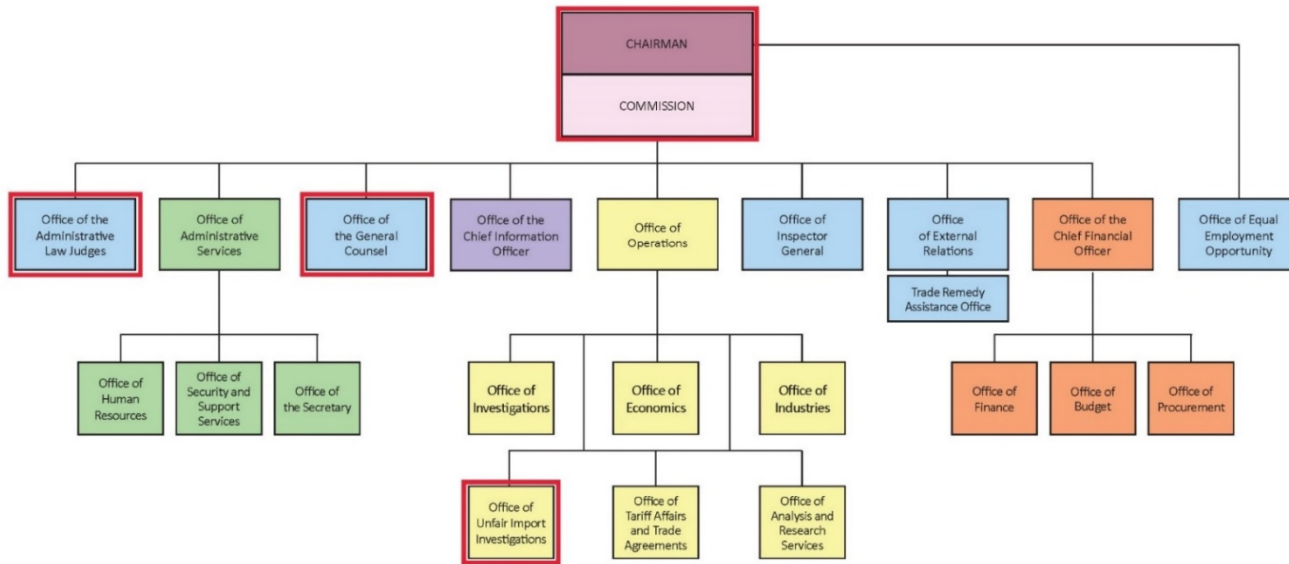
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The Regulatory Framework

UNITED STATES INTERNATIONAL TRADE COMMISSION

Office-Level Organizational Chart



Revised December 2017

ALJs



CHARLES E. BULLOCK

CHIEF

Charles E. Bullock was named Chief Administrative Law Judge at the U.S. International Trade Commission in October 2011, after serving as Acting Chief...



DAVID P. SHAW

David P. Shaw was appointed as an Administrative Law Judge at the U.S. International Trade Commission in October 2011. Prior to his USITC appointment...



MARYJOAN MCNAMARA

MaryJoan McNamara was appointed as an Administrative Law Judge at the U.S. International Trade Commission in August 2015. Prior to her USITC...

ALJs



CLARK S. CHENEY

Clark S. Cheney was appointed as an Administrative Law Judge at the U.S. International Trade Commission in March 2018. Prior to his USITC...



CAMERON ELLIOT

Cameron Elliot was appointed as an Administrative Law Judge at the U.S. International Trade Commission in April 2019. Prior to joining the USITC,...



MONICA BHATTACHARYYA

Monica Bhattacharyya was appointed as an Administrative Law Judge at the U.S. International Trade Commission in September 2021. Prior to her...

The Parties to an Investigation

- **Complainant**

- Owner or exclusive licensee of U.S. IP rights; or otherwise injured by unfair act or unfair competition; and ones with **domestic industry**

- **Respondents**

- Essentially anyone along the chain of distribution:
 - ✓ **Manufacturers** of products sold for importation into U.S.
 - ✓ **Importers** of products into U.S.
 - ✓ **U.S. distributors/retailers** of imported products

- **Office of Unfair Import Investigations**

- Participates in all aspects of the investigation as a full party, **if** assigned
- Represents the **public interest**

Elements of an Investigation

- **Violation of Section 337**
 - **Importation** into U.S., sale for importation, or sale within the U.S. after importation
 - **Infringement** of IP rights or guilty of other unfair act/competition
 - **Domestic Industry** related to the articles exists or is in the process of being established
 - **Public Interest** not harmed by proposed remedies

Domestic Industry

Domestic Industry

- Domestic Industry Requirement (Statutory Cause of Action)
 - **Technical Prong:**
 - Complainant must prove it practices **one claim** of each patent
 - **Economic Prong:**
 - Investments in the U.S. related to products practicing asserted IP
 - ✓ (A) Significant investment in “**plant and equipment;**”
 - ✓ (B) Significant employment of “**labor or capital;**” or
 - ✓ (C) Substantial investment in the “**exploitation**” of the asserted IP

Domestic Industry: Economic Prong

(A) Plant and Equipment

(B) Labor and Capital

(C) Exploitation of the asserted IP

- ✓ Engineering
- ✓ Research & Development
- ✓ Testing
- ✓ Customer service and technical support
- ✓ Service and Repair
- ✓ Production-driven licensing (aka “industry-creating”, as opposed to revenue-driven licensing)

Domestic Industry: Economic Prong

- **Activities that are not generally considered as DI:**
 - Activities of a “mere importer:”
 - ✓ Sales
 - ✓ Marketing
 - ✓ Distribution and logistics
 - Revenue-driven licensing

Other Unique Aspects

Public Interest

- **ITC solicits comments on public interest issues**
 - Asks for comments after complaint is filed and at the end of an investigation
 - Seeks information on:
 - ✓ How the accused articles are used;
 - ✓ Any public health, safety, or welfare concerns;
 - ✓ The ability to replace the accused article if excluded; and
 - ✓ The impact on U.S. consumers.

Source: https://www.usitc.gov/intellectual_property/337_statistics_identification_and_number_cases.htm

Public Interest

- **ITC solicits comments on public interest issues**
 - Responses due 8 calendar days after Notice published in Federal Register.
 - Since 2010, the Commission has delegated authority to the ALJ to hear arguments on the statutory public interest factors in over 100 investigations
 - In FY 2019, approximately 16% of new investigations included public interest issues
- ***Certain Electronic Devices, Inv. No. 337-TA-794***
 - LEO issued after Apple found to infringe Samsung's SEP.
 - U.S. Trade Representative cancelled the exclusion order on policy grounds.

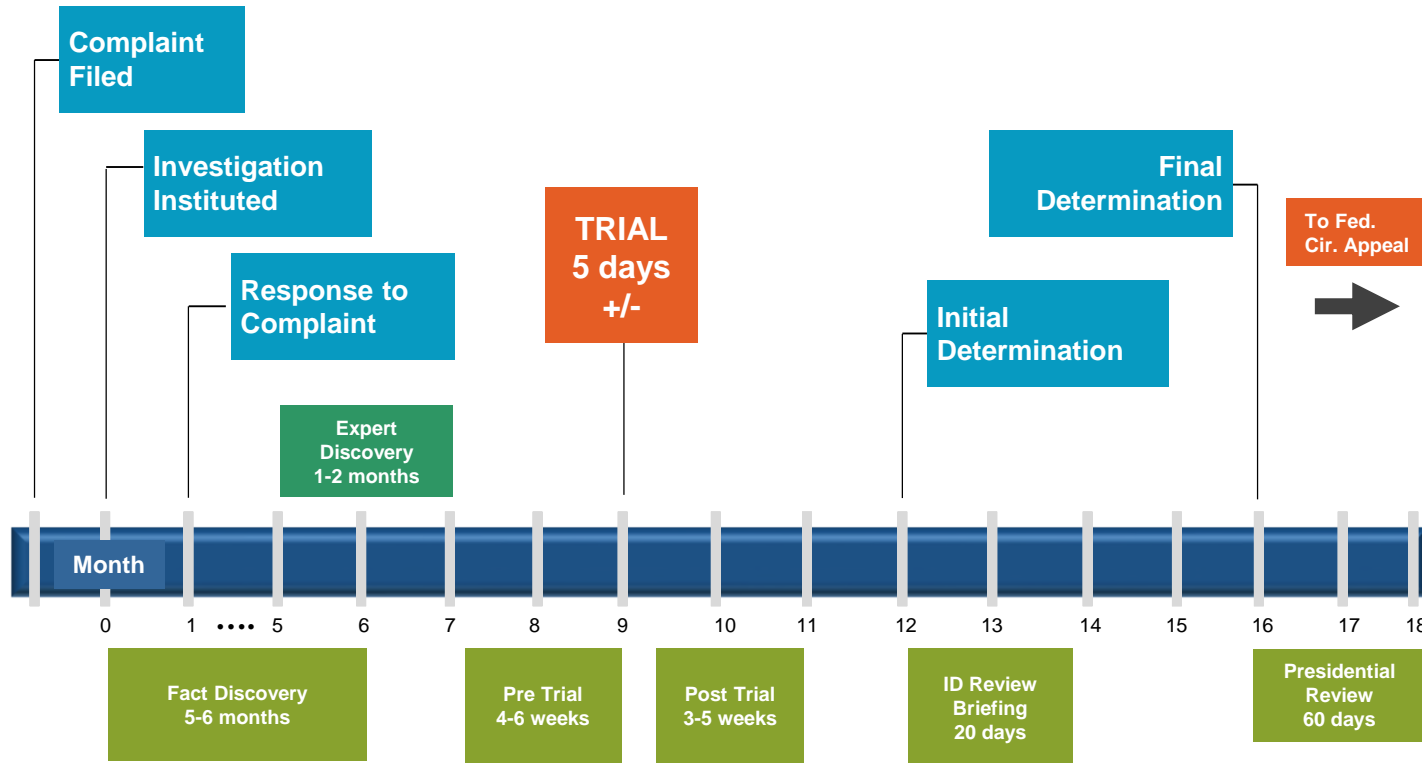


Speed

- U.S. District Court: over 2 years to trial
- ITC: 8-9 months to trial (average case completed in 17.7 months)

Fiscal Year	Investigations Completed on Merits ^a	Shortest ^a	Longest ^a	Average ^a	Average for all Investigations ^c
2006	12	3.5	19.0	12.0	11.2
2007	12	8.0	23.5	16.6	12.0
2008	15	6.0	28.0	16.7	13.2
2009	16	3.5	28.5	17.9	10.4
2010	22 ^b	6.4	25.4	18.4	12.5
2011	17	5.2	24.2	13.7	9.9
2012	22	2.6	28.9	16.7	12.6
2013	21	4.3	30.1	19.7	13.3
2014	18	7.4	23.9	17.1	13.9
2015	11	5.6	21.9	15.6	11.4
2016	16	4.4	21	15.8	10.8
2017	16	3.7	27.2	15.1	10.3
2018	21	5.3	21.4	15.85	11.2
2019	22	9.4	29.3	17.7	14.1
2020 Q3	29	8.22	28.1	19.2	15.8

Timeline of the Investigation (16 months)



Elements of an Investigation

- **Remedies Available (Prospective only; no money damages)**
 - **General Exclusion Order:** excludes all infringing products regardless of source
 - **Limited Exclusion Order:** excludes infringing products of named respondents
 - **Cease and Desist Order:** prevents sale, repair, service of imported product
- **Commission and Executive Branch Review**
 - Commission may adopt or review, in whole or in part, the Judge's Initial Determination
 - 60-day period where USTR (**President**) may disapprove the remedy on policy grounds
- **Appeal to CAFC**

Enforcement

4. ENFORCEMENT. In general, Exclusion Orders issued by the ITC are administered by the Office of Regulations & Rulings, IPR Branch, but are processed by the Office of Field Operations. Upon receipt of orders from the ITC, an “Exclusion Order Notice” is released to the field through the Office of Field Operations. Notices regarding the enforcement of exclusion orders are to be transmitted to the field via the U.S. Customs Bulletin Board (Trade Enforcement, OTO1). Exclusion Order Notices will provide details relative to the enforcement of a particular order. Exclusion Orders are catalogued within the ACS/IPR module in the same manner as trademarks and copyrights.

4.1 Procedures. The strategic operational analysis staff (SOAS) will update cargo and/or summary selectivity criteria to include exclusion order information.

4.1.1 Given the highly technical nature of articles which are the subject of most Exclusion Orders, Customs officers should seek the advice of Customs laboratories, which provide technical assistance in determining whether goods meet the parameters of the subject patent. Field officers may contact the designated field laboratory servicing their geographic area or the Laboratories and Scientific Services at Customs Headquarters for advice.

§ 315(b) [Patent Owner's Action]

an inter partes review may not be instituted if the petition requesting the proceeding is filed more than 1 year after the date on which the petitioner... is served with a complaint alleging infringement of the patent.

The PTAB decline[d] to interpret § 315(b) as including ITC complaints. *See Robert Bosch Tool Corp. v SD3, LLC*, IPR2016-01753 (PTAB March 22, 2017)

IPR and ITC

Certain Integrated Circuits with Voltage Regulators and Products Containing Same (337-TA-1024)

The PTAB's Final Written Decision issued after institution of the investigation, but before an initial determination on the merits. While acknowledging that stays of ITC investigations are generally disfavored, Judge Bullock found for ordering a stay.

Certain Hybrid Electric Vehicles and Components Thereof (337-TA-1042)

ITC was instituted based on claims that had mostly been found unpatentable by the PTAB and were on appeal at the Federal Circuit. Over the objection of the proposed respondent, the Commission apparently determined that PTAB final written decisions regarding patent invalidity are not entitled to deference absent affirmance on appeal by the Federal Circuit.

IPR and ITC

Certain Three-Dimensional Cinema Systems & Components Thereof (337-TA-939)

The PTAB's final written decision was released after the ALJ's Initial Determination, but before the Commission's Final Determination. The Commission exercised its discretion to suspend enforcement of its exclusion and cease and desist orders as to the patent at issue.

Certain Network Devices, Related Software and Components Thereof (337- TA-945)

The ITC refused to suspend or rescind its limited exclusion orders and cease and desist orders when, during the 60- day Presidential Review period following the Commission's Final Determination, the PTAB issued two final written decisions finding all claims on which the orders were based to be unpatentable. Commission held that "the law is clear that patent claims are valid until the PTO issues certificates cancelling for [sic] those claims, which it cannot do until the exhaustion of any appeals".

Better Safe Than Sorry 2022

Better Safe Than Sorry 2022 (仮)

2022年開催日	テーマ	スピーカー/ゲストスピーカー
01月 28日(金)	2021年重要知財判例トップ10	森下実郎
02月 25日(金)	弁護士秘匿特権	森下実郎
04月 22日(金)	国際消尽（日米比較）	森下実郎/志賀国際特許事務所
05月 27日(金)	国際仲裁	森下実郎/Sabine Konrad (MLB Frankfurt)
07月 29日(金)	ディスクバリーを意識した文書管理	森下実郎/FTI Consulting
08月 26日(金)	テキサス/デラウェア裁判最前線	森下実郎/Amy Dudash (MLB DE) /Elizabeth Chiavello (MLB Dallas)
10月 28日(金)	間接侵害（日米比較）	森下実郎/TMI総合法律事務所
11月 25日(金)	裁判記録の調べ方	森下実郎

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IP TRAINING IN THE US

実践型研修プログラム(目的)

- 米国特許法関連の企業実務力の底上げ
 - ✓ Dual力の強化
 - ✓ 実務ノウハウの共有
 - ✓ 日本の技術を尊重させたい
- ALL Japanチームの結集
 - ✓ チームメンバーによる切磋琢磨
 - ✓ 一生続く関係を構築
- アメリカという国をもっと知って貰いたい
 - ✓ 百聞は一見に如かず
 - ✓ アメリカの空気を吸って貰いたい

実践型研修プログラム(目的)

判例分析研修

- 判例を読み込んで要点を理解する
- 理解した判例要点をまとめて他人に説明する
- 関連判例を自分で探す

技術論争研修

- 特許と製品の対応クレームチャートを作成する
- 作成したクレームチャートをDefendする
- 攻められやすいポイントを理解する事で強いクレームについて理解を深める

実践型研修プログラム(目的)

現地実習

- ▶ アメリカの知財関係の要所を実地見学して特許のライフサイクルについて具体的なイメージをつける

特許ライフサイクル :

米国議会⇒企業⇒法律事務所⇒特許庁⇒連邦地方裁判所⇒巡回控訴裁判所⇒最高裁判所

- ▶ 米国の国としての成り立ち、文化的背景を理解する
- ▶ 知財業界における人的ネットワークを構築する

実践型研修プログラム（実施イメージ（仮））

1. 事前研修

- 米国特許制度について座学（東京：2022年4月18日）
- 判例調査、判例分析、判例発表、作成したクレームチャートの発表（東京：2022年5月23日）

2. 米国実地研修（集合：ワシントンDC、解散：シリコンバレー）

- 6月13日（月）

午前	米国控訴裁判所、米国特許庁見学
午後	判例発表、技術論争、セミナー「ITC特有の裁判手続き」
夜	Welcome Dinner (モルガンルイスワシントンDCオフィス)
- 6月14日（火）

午前	最高裁判所、米国議会、国立公文書館見学
午後	判例発表、技術論争 (夜:ダラスに移動)
- 6月15日（水）

午前	米国テキサス州北部連邦裁判所見学、セミナー「テキサス特有の裁判手続き」
午後	判例発表、技術論争 (夜:野球観戦)
- 6月16日（木）

午前	サンフランシスコに移動
午後	判例発表、技術論争 (夜:サンフランシスコ観光)
- 6月17日（金）

午前	Google、Facebook訪問
午後	判例発表、技術論争、セミナー「IPR特有の裁判手続き」
夜	Farewell Dinner (モルガンルイスシリコンバレーオフィス)、落語一席

3. 事後研修

- 研修まとめ、判例発表（東京：2022年7月4日）

Jitsuro Morishita



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Jitsuro Morishita devotes his practice to resolving complex global disputes in the areas of intellectual property, antitrust, and governmental investigations.

Early in his career, he worked in-house for two global technology companies, Pioneer Corporation and Fujifilm Corporation, bringing unique expertise to advocate using profound understanding of Japanese company cultures.

Jitsuro is devoted to bringing his clients (i) easy communication using excellent communication skills, (ii) pleasant surprises from creative and out-of-the-box ways of thinking, and (iii) deep satisfaction through great results and client-friendly experiences.



31 OFFICES
ACROSS 17
TIME ZONES

700+
PARTNERS

180+
SENIOR
LAWYERS

1100+
ASSOCIATES

450+
LEGAL
PROFESSIONALS