

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, DC 20436

In the Matter of

**CERTAIN ELECTRONIC DEVICES WITH
COMMUNICATION CAPABILITIES,
COMPONENTS THEREOF, AND RELATED
SOFTWARE**

Investigation No. 337-TA-808

**NOTICE OF COMMISSION DECISION NOT TO REVIEW THE
ADMINISTRATIVE LAW JUDGE'S INITIAL DETERMINATION
PARTIALLY TERMINATING THE INVESTIGATION
WITH RESPECT TO FIVE ASSERTED PATENTS**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined not to review the presiding administrative law judge's ("ALJ") initial determination ("ID") (Order No. 15) partially terminating the investigation with respect to five asserted patents.

FOR FURTHER INFORMATION CONTACT: Sidney A. Rosenzweig, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-2532. Copies of non-confidential documents filed in connection with this investigation are or will be available for inspection during official business hours (8:45 a.m. to 5:15 p.m.) in the Office of the Secretary, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <http://www.usitc.gov>. The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <http://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on September 30, 2011, based on a complaint filed by HTC Corp. ("HTC") on August 16, 2011, alleging violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337 ("Section 337"), in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain electronic devices with communication

capabilities, components thereof, and related software by reason of infringement of three patents. The Notice of Investigation named Apple Inc. (“Apple”) as the respondent.

On August 29, 2011, HTC and third-party Google, Inc. (“Google”) entered into an Assignment of Patent Rights (“Assignment”) and a Patent Purchase Agreement (“Purchase Agreement”) whereby HTC acquired certain rights related to nine U.S. patents. On September 7, 2011, HTC filed an Amended Complaint adding further allegations of infringement based on its newly acquired rights in five of the nine U.S. patents, specifically U.S. Patent Nos. 6,473,006, 6,708,214, 6,868,283, 7,020,849 and 7,289,772 (collectively, “the Google Patents”). The Amended Complaint alleged that HTC “owns by assignment the entire right, title, and interest in and to” each of the Google Patents. HTC included a copy of the Assignment with the Amended Complaint, but did not include the Purchase Agreement, even though the Assignment expressly stated that it was subject to the Purchase Agreement, and that in the event of any conflict between the two documents, the terms of the Purchase Agreement trump the Assignment. Consequently, HTC’s ownership was always limited by the Purchase Agreement. On October 3, 2011, Apple served its first set of requests for production to HTC, which specifically requested documents related to HTC’s purchase and ownership of the patents-in-suit, including the Google Patents. Nonetheless, HTC withheld the Purchase Agreement until March 19, 2012, five months after Apple’s discovery request, and seven months after the amended complaint. HTC continues to withhold, on the basis of privilege and work product protection, most of the documents and correspondence surrounding the Purchase Agreement.

On May 15, 2012, Apple filed a motion for partial termination of this investigation with respect to the Google Patents on the basis that HTC lacks standing to maintain an action for infringement of the Google Patents, in view of the Assignment and the Purchase Agreement together. On May 25, 2012, HTC filed an opposition to Apple’s motion and the Commission investigative attorney (“IA”) filed a response in support of Apple. On May 31, 2012, Apple moved for leave to file a reply that accompanied its motion. On June 8, 2012, the presiding ALJ issued the subject ID (Order No. 15) granting Apple’s motion for leave to file a reply and Apple’s motion for partial termination of this Investigation with respect to the Google Patents due to lack of standing. On June 15, 2012, HTC petitioned for review of Order No. 15. Apple and the IA filed responses in opposition.

Having reviewed the record of this investigation, including the ALJ’s ID, the Assignment and the Purchase Agreement, the motions, petitions, and responses thereto, the Commission has determined not to review the ID. The Commission notes that HTC’s petition requests permission “to join on [*sic*] or more additional” and unspecified parties, HTC Pet. 29, despite the fact that there are no pending motions for joinder of these unidentified persons or for amendment of the Notice of Investigation. The Commission agrees with the ALJ that the issue is not yet ripe. Order No. 15 at 13. Accordingly, the Commission has not taken a position whether such other persons would have standing, *see* Apple Pet. Resp. 18, and, if they do, whether it would be appropriate to join them at this stage of the investigation in view of, *inter alia*, HTC’s delay in producing the Purchase Agreement.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), and in section 210.42 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.42).

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', with a large, sweeping flourish at the end.

Lisa R. Barton
Acting Secretary to the Commission

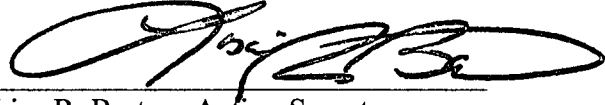
Issued: July 10, 2012

**CERTAIN ELECTRONIC DEVICE WITH
COMMUNICATION CAPABILITIES COMPONENTS
THEREOF, AND RELATED SOFTWARE**

337-TA-808

CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **NOTICE** has been served by hand upon the Commission Investigative Attorney, R. Whitney Winston, Esq., and the following parties as indicated, on **July 10, 2012**



Lisa R. Barton, Acting Secretary
U.S. International Trade Commission
500 E Street, SW
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On Behalf of Complainant HTC Corp.:

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On Behalf of Respondent Apple Inc.:

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