

In the Matter of

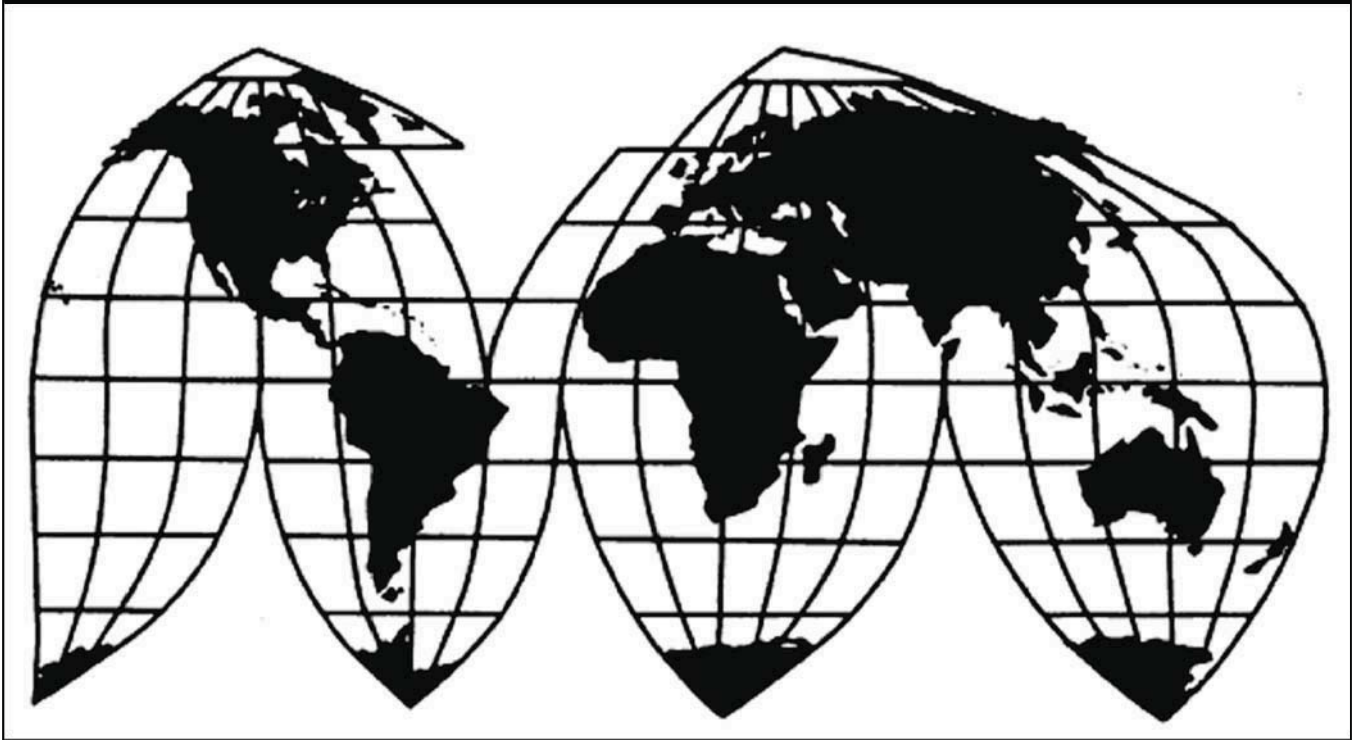
**Certain Laser Imageable
Lithographic Printing Plates**

Investigation No. 337-TA-636

Publication 4204

December 2010

U.S. International Trade Commission



Washington, DC 20436

U.S. International Trade Commission

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U.S. International Trade Commission

Washington, DC 20436
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In the Matter of

**Certain Laser Imageable
Lithographic Printing Plates**

Investigation No. 337-TA-636



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

In the Matter of

**CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Investigation No. 337-TA-636

**ISSUANCE OF A LIMITED EXCLUSION ORDER AND TERMINATION OF THE
INVESTIGATION**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has issued a limited exclusion order directed to infringing laser imageable lithographic printing plates.

FOR FURTHER INFORMATION CONTACT: Panyin A. Hughes, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 205-3042. 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 (<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: This investigation was instituted on March 13, 2008, based on a complaint filed by Presstek, Inc. of Hudson, New Hampshire ("Presstek"). The complaint alleged violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain laser imageable lithographic printing plates that infringe certain claims of United States Patent Nos. 5,339,737 ("the '737 patent") and 5,487,338 ("the '338 patent") and United States Trademark Registration No. 1,711,005 ("the '005 trademark"). All assertions relating to the '005 trademark were subsequently terminated from the investigation. Certain respondents were also terminated during the course of the investigation. The following respondents remain in the investigation: VIM Technologies, Ltd. of Kibbutz Hanita, Israel; Hanita Coatings RCA, Ltd. of Kibbutz Hanita, Israel; Guaranteed Service & Supplies, Inc. of West Bend, Wisconsin; AteCe Canada of Toronto, Ontario, Canada; Recognition Systems, Inc. of Port Washington, New York; and Spicers Paper, Inc. of Santa Fe

Springs, California (collectively, “Respondents”).

On July 24, 2009, the ALJ issued a final initial determination (“ID”) finding the domestic industry requirement satisfied, finding a violation of section 337 and containing a recommended determination on remedy and bonding. The ALJ recommended that, in the event the Commission finds a violation of section 337, the Commission should issue a limited exclusion order directed to all of Respondents’ accused products found to infringe the ’737 and ’338 patents. ID at 101-104. The ALJ further recommended that if the Commission imposes a remedy following a finding of violation, Respondents should be required to post a bond of 100 percent of the entered value of accused products imported during the Presidential review period. *Id.*

Respondents filed a combined petition for review of the ID, and Presstek and the Commission Investigative Attorney (“IA”) filed oppositions thereto. On September 24, 2009, the Commission determined to review certain aspects of the ID relating to claim construction and to modify the ID by supplementing the claim construction analysis. 74 *Fed. Reg.* 49890 (Sept. 29, 2009). The Commission also requested written submissions on the issues of remedy, the public interest and bonding, and further requested submissions of proposed remedial orders. *Id.*

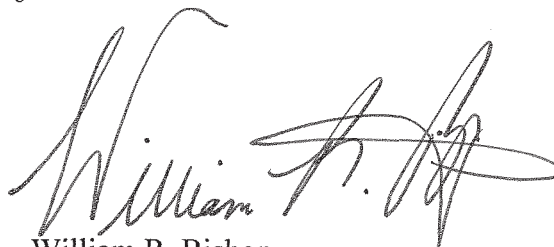
On October 5, 2009, Respondents filed a collective brief on the issues for which the Commission requested written submissions. Presstek and the IA filed their briefs on those same issues on October 6, 2009, and on October 13, 2009, Presstek filed a response to Respondents’ brief.

Having reviewed the record in this investigation, including the ID and the parties’ written submissions, the Commission has determined that the appropriate form of relief is a limited exclusion order prohibiting the unlicensed entry of laser imageable lithographic printing plates that infringe one or more of claims 1, 10 and 27 of the ’737 patent or claims 20, 21 and 23 of the ’338 patent and that are manufactured abroad by or on behalf of, or imported by or on behalf of, Respondents.

The Commission further determines that the public interest factors enumerated in section 337(d) (19 U.S.C. § 1337(d)) do not preclude issuance of the limited exclusion order. Finally, the Commission determines that no bond is required to permit temporary importation during the period of Presidential review (19 U.S.C. § 1337(j)) of the laser imageable lithographic printing plates that are subject to the order. The Commission’s order and opinion were delivered to the President and to the United States Trade Representative on the day of their issuance.

The authority for the Commission's determination is contained in section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, and in sections 210.50 of the Commission's Rules of Practice and Procedure, 19 C.F.R. § 210.50.

By order of the Commission.

A handwritten signature in black ink, appearing to read "William R. Bishop". The signature is fluid and cursive, with a large, sweeping flourish at the end.

William R. Bishop
Acting Secretary to the Commission

Issued: November 30, 2009

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

In the Matter of

**CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Investigation No. 337-TA-636

LIMITED EXCLUSION ORDER

The Commission has determined that there is a violation of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the unlawful importation, sale for importation, and sale after importation by Respondents VIM Technologies, Ltd. (“VIM”), Hanita Coatings RCA, Ltd. (“Hanita”), AteCe Canada (“AteCe”), Guaranteed Service & Supplies, Inc. (“GSS”), Recognition Systems, Inc. (“RSI”) and Spicers Paper, Inc. (“Spicers”) by reason of infringement of claims 1, 10 and 27 of United States Patent No. 5,339,737 (“the ’737 patent”) and claims 20, 21 and 23 of United States Patent No. 5,487,338 (“the ’338 patent”).

Having reviewed the record in this investigation, including the written submissions of the parties, the Commission has made its determination on the issues of remedy, the public interest, and bonding. The Commission has determined that the appropriate form of relief is a limited exclusion order prohibiting the unlicensed entry of infringing laser imageable lithographic printing plates that are manufactured abroad by or on behalf of, or imported by or on behalf of, VIM, Hanita, AteCe, GSS, RSI, and Spicers.

The Commission has further determined that the public interest factors enumerated in 19 U.S.C. § 1337(d) do not preclude issuance of the limited exclusion order. The Commission has also determined that no bond is required during the Presidential review period for imported laser

imageable lithographic printing plates that are subject to this order.

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

1. Laser imageable lithographic printing plates that infringe one or more of claims 1, 10 and 27 of the '737 patent and claims 20, 21 and 23 of the '338 patent, and that are manufactured abroad by or on behalf of, or imported by or on behalf of, VIM, Hanita, AteCe, GSS, RSI and Spicers or any of their affiliated companies, parents, subsidiaries, or other related business entities, or any of their successors or assigns, are excluded from entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, for the remaining term of the patents, except under license of the patents' owner or as provided by law.

2. Products that are excluded by paragraph 1 of this Order are entitled to entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, without bond, from the day after this Order is received by the United States Trade Representative until such time as the United States Trade Representative notifies the Commission that this action is approved or disapproved but, in any event, not later than 60 days after the date of receipt of this action.

3. At the discretion of U.S. Customs and Border Protection ("CBP") and pursuant to procedures it establishes, persons seeking to import laser imageable lithographic printing plates that are potentially subject to this Order may be required to certify that they are familiar with the terms of this Order, that they have made appropriate inquiry, and thereupon state that, to the best of their knowledge and belief, the products being imported are not excluded from entry under paragraph 1 of this Order. At its discretion, CBP may require persons who have provided the certification described in this paragraph to furnish such records or analyses as are

necessary to substantiate the certification.

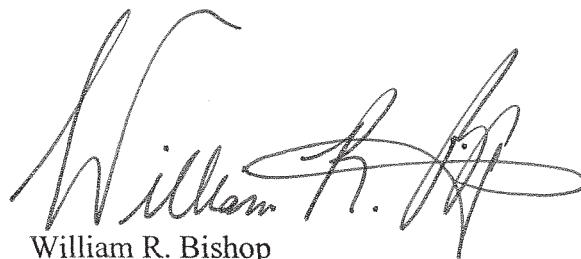
4. In accordance with 19 U.S.C. § 1337(l), the provisions of this Order shall not apply to laser imageable lithographic printing plates that are imported by and for the use of the United States, or imported for, and to be used for, the United States with the authorization or consent of the Government.

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

6. The Secretary shall serve copies of this Order upon each party of record in this investigation and upon the Department of Health and Human Services, the Department of Justice, the Federal Trade Commission and CBP.

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

By order of the Commission.

A handwritten signature in black ink, appearing to read "William R. Bishop". The signature is fluid and cursive, with a large, sweeping initial "W".

William R. Bishop
Secretary to the Commission

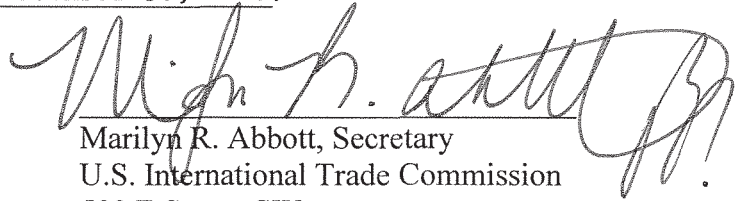
Issued: November 30, 2009

**CERTAIN LASER IMAGEABLE LITHOGRAPHIC
PRINTING PLATES**

337-TA-636

CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ISSUANCE OF A LIMITED EXCLUSION ORDER AND TERMINATION OF THE INVESTIGATION** has been served by hand upon the Commission Investigative Attorney, Aarti J. Shah, Esq., the following parties as indicated, on November 30, 2009.


Marilyn R. Abbott, Secretary
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On Behalf of Complainant Presstek Inc.:

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 Via Overnight Mail
 Via First Class Mail
 Other: _____

**On Behalf of Respondents VIM Technologies Limited;
Hanita Coatings RCA Ltd.; Guaranteed Service &
Supplies, Inc.; AteCe Canada; and, Recognition Systems
Incorporated:**

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PUBLIC VERSION

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

In the Matter of

**CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Investigation No. 337-TA-636

COMMISSION OPINION

The Commission has determined that respondents have violated section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain laser imageable lithographic printing plates that infringe one or more of claims 1, 10 and 27 of United States Patent No. 5,339,737 (“the ’737 patent”) and claims 20, 21 and 23 of United States Patent No. 5,487,338 (“the ’338 patent”). 74 *Fed. Reg.* 49890 (Sept. 24, 2009). The Commission issues herewith, a limited exclusion order prohibiting the entry of unlicensed infringing laser imageable lithographic printing plates for consumption in the United States.

BACKGROUND

The Commission instituted this investigation on March 13, 2008, based on a complaint, filed by Presstek, Inc. of Hudson, New Hampshire (“Presstek”), alleging violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain laser imageable lithographic printing plates that infringe one or more of claims 1, 10 and 27 of the ’737 patent and claims 20, 21 and 23 of the ’338 patent, and also by reason of infringing

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United States Trademark Registration No. 1,711,005 (“the ’005 Trademark”). *73 Fed. Reg.* 13567-8 (Mar. 13, 2008). The complaint also alleged the existence of a domestic industry. *Id.* The Commission’s notice of investigation named the following respondents: VIM Technologies, Ltd. of Kibbutz Hanita, Israel (“VIM”); Hanita Coatings RCA, Ltd. of Kibbutz Hanita, Israel (“Hanita”); Guaranteed Service & Supplies, Inc. of West Bend, Wisconsin (“GSS”); AteCe Canada of Toronto, Ontario, Canada (“AteCe”); Ohio Graphco, Inc. of Solon, Ohio (“Ohio Graphco”); and Recognition Systems, Inc. of Port Washington, New York (“RSI”). *Id.* at 13568. The investigation was originally assigned to Administrative Law Judge (“ALJ”) Essex. *Id.*

On May 16, 2008, the ALJ issued an Initial Determination terminating Respondent Ohio Graphco from the Investigation based on a consent order stipulation and settlement agreement. *See* Order No. 6. On June 26, 2008, the ALJ issued an Initial Determination granting Complainant’s motion to amend the Complaint and Notice of Investigation to add Spicers Paper, Inc. of Santa Fe Springs, California (“Spicers”), as a respondent to this investigation. *See* Order No. 24. The Commission determined not to review each of those orders.

On December 8, 2008, the Investigation was permanently reassigned to Judge Gildea. On December 11, 2008, the ALJ issued an Initial Determination extending the investigation target date from June 12, 2009, to November 30, 2009.

On February 5, 2009, the ALJ issued an Initial Determination granting partial termination of the investigation as to Hanita based upon partial withdrawal of the portion of the complaint alleging infringement of the ’005 Trademark. *See* Order No. 23. In that same order, the ALJ denied partial termination with respect to AteCe. *Id.* However, on March 24, 2009, the ALJ

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issued an Initial Determination granting partial termination of the investigation as to AteCe based upon partial withdrawal of the portion of the Complaint alleging infringement of the '005 Trademark. *See* Order No. 24. Also on March 24, 2009, the ALJ issued an Initial Determination granting partial termination of the investigation as to the portion of the complaint alleging infringement of the '005 Trademark against VIM, GSS, RSI and Spicers based upon a consent order stipulation. *Id.* The Initial Determination terminated all assertions of infringement of the '005 Trademark against the respondents in the investigation. *Id.* The Commission determined not to review any of those orders.

The ALJ held a *Markman* hearing on April 22, 2009, and held an evidentiary hearing from April 23, 2009, to April 28, 2009. On July 24, 2009, the ALJ issued his final initial determination (“ID”) finding a violation of section 337 by all of the respondents remaining in the investigation (collectively, “Respondents”). The ID included the ALJ’s recommendation on remedy and bond. The ALJ recommended that, in the event the Commission finds a violation of section 337, the Commission should issue a limited exclusion order directed to all of Respondents’ accused products that were found to infringe the asserted claims of the '737 and '338 patents. ID at 101-104. The ALJ further recommended that if the Commission imposes a remedy following a finding of violation, Respondents should be required to post a bond of 100 percent of the entered value of accused products imported during the Presidential review period. *Id.*

Respondents filed a combined petition for review, and Presstek and the Commission Investigative Attorney (“IA”) filed oppositions thereto. On September 24, 2009, the Commission

PUBLIC VERSION

determined to review certain aspects of the ID relating to claim construction and to modify the ID by supplementing the claim construction analysis. 74 *Fed. Reg.* 49890 (Sept. 29, 2009). The Commission also requested written submissions on the issues of remedy, the public interest and bonding, and further requested submissions of proposed remedial orders. *Id.*

On October 5, 2009, Respondents filed a collective brief on the issues for which the Commission requested written submissions. Presstek and the IA filed their briefs on those same issues on October 6, 2009, and on October 13, 2009, Presstek filed a response to Respondents' brief.

DISCUSSION

For the reasons discussed below, the Commission finds that the appropriate remedy is a limited exclusion order, prohibiting the entry of infringing laser imageable lithographic printing plates for consumption in the United States. The Commission also finds that the public interest factors set out in section 337(d) do not preclude issuance of a limited exclusion order. The Commission determines that no bond is required to permit temporary importation during the Presidential review period.

I. REVIEW OF THE ID'S CLAIM CONSTRUCTION ANALYSIS

In his ID, the ALJ concluded that Respondents waived and/or abandoned claim construction arguments with regard to three claim limitations at issue: (1) "the second layer also being partially transmissive to said radiation" and (2) "the substrate comprises a material that reflects imaging infrared radiation" from the '737 patent, and (3) "the substrate comprises means for reflecting imaging radiation" from the '338 patent. The ALJ noted that he substantively

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considered the “partially transmissive” limitation, but did not note the same with respect to the other two limitations, nor did he provide any substantive analysis of the other two limitations.

The Commission reviewed the ID to modify its claim construction analysis and affirmed the ALJ’s determination of no violation of section 337. The Commission adds that it has substantively considered Respondents’ proposed constructions and supplemented the ALJ’s claim construction analysis.

With respect to “the second layer also being partially transmissive to said radiation” limitation, the ALJ’s construction is correct because it applies the ordinary meaning of the words used in the claim, as they would be understood by a person of ordinary skill in the art. Respondents seek to read limitations from the preferred embodiment into the claim term, and argue that the purpose of the partially transmissive layer in combination with a reflective substrate is to allow “a lower power laser that is insufficiently powerful to cause ablation absent reflection” to be “reflected back into the absorptive layer to cause ablation.” Respondents’ Petition for Review at 25. Respondents, however, fail to demonstrate any reason to read limitations from the preferred embodiment into the claim, or any reason why a person of ordinary skill in the art would understand the claim to require them. “[C]ase law is clear that claims are not to be limited in light of ‘the perceived purpose served by the invention.’” *E-Pass Techs., Inc. v. 3COM Corp.*, 343 F.3d 1364, 1370 (Fed. Cir. 2003).

Regarding “the substrate comprises a material that reflects imaging infrared radiation” limitation, Respondents’ attempt to import a result of the claimed structure into the claim is improper. *See* Respondents’ Petition for Review at 25-26. While it is true that the patentees

PUBLIC VERSION

stated during prosecution, and Dr. Magee testified, that the claimed structure indeed provides the advantage the Respondents seek to require, *i.e.*, that the reflected radiation cause additional ablation of the radiation absorbing layer, that perceived advantage of the claimed structure does not limit the claim. Rather, the plain language of the claim merely requires that the substrate includes reflective material that reflects radiation back to the overlying radiation absorbing layer, as the ALJ concluded. *See* ID at 30.

Concerning “the substrate comprises means for reflecting imaging radiation” limitation, Respondents once again argue that the ALJ’s construction of the claim term ignores “the purpose of the invention.” Respondents’ Petition for Review at 31. The perceived purpose of the limitation should not be added to the construction of this claim term. *E-Pass Techs.*, 343 F.3d at 1370. Indeed, the function of the means-plus-function claim, to reflect radiation, is clearly set out in the claim itself and properly part of the ALJ’s construction. Respondents’ argument is particularly unconvincing in light of the specification’s examples of embodiments that would not meet the limitation Respondents seek to add. *See, e.g.*, ’338 patent (JX-6), col. 4, ll. 6-22.

II. REMEDY

Where a violation of section 337 has been found, the Commission must consider the issues of remedy, the public interest and bonding. The Commission has “broad discretion in selecting the form, scope, and extent of the remedy.” *Viscofan, S.A. v. U.S. Int’l Trade Comm’n*, 787 F.2d 544, 548 (Fed. Cir. 1986). ~~The Commission may issue an exclusion order excluding the goods of the person(s) found in violation (a limited exclusion order) or, if certain criteria are met, against all infringing goods regardless of the source (a general exclusion order). The~~

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Commission also has authority to issue cease and desist orders in addition to or in lieu of exclusion orders. *See* 19 U.S.C. § 1337(f). The Commission generally issues cease and desist orders to respondents who maintain commercially significant inventories of infringing products in the United States. *See, e.g., Certain Laser Bar Code Scanners and Scan Engines, Components Thereof, and Products Containing Same*, Inv. No. 337-TA-551, Commission Opinion at 22 (June 14, 2007).

The Commission finds that the appropriate remedy is a limited exclusion order directed towards Respondents' products found to infringe the asserted claims of the '737 and '338 patents, and issues, herewith, a limited exclusion order. The Commission does not issue cease and desist orders as requested by Presstek because the record evidence fails to show that Respondents keep sufficient inventories of the accused products in the United States. Thus, issuance of cease and desist orders is not warranted.¹

III. THE PUBLIC INTEREST

Section 337(d) of the Tariff Act of 1930, as amended, directs the Commission to consider certain public interest factors before issuing a remedy. These public interest factors include the effect of any remedial order on the "public health and welfare, competitive conditions

¹ We decline Presstek's invitation to take official notice of an alleged statement on VIM's website that "[o]ur dealers locally stock our products, enabling fast response times to client orders." Complainant Presstek, Inc.'s Submission on the Issues of Remedy, Public Interest, and Bonding at 4. We are unconvinced by Presstek's assertion that because Respondents maintained throughout the investigation that they do not carry such inventories [*i.e.*, inventories of infringing products in the United States], "Presstek could not have possibly presented evidence at the hearing of Respondents' U.S. inventories of infringing plates." *Id.* at 4-5. Nothing prevented Presstek from challenging Respondents' assertion or introducing evidence to disprove Respondents' assertion during the course of the investigation.

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in the United States economy, the production of like or directly competitive articles in the United States, and United States consumers.” 19 U.S.C. § 1337(d).

The facts of this investigation do not implicate the public interest factors. The record evidence establishes that demand in the United States for laser imageable lithographic printing plates can be met by Presstek and its legitimate competitors. In addition, the record does not indicate that an exclusion order on this type of product — laser imageable lithographic printing plates — raises any particular public interest concerns. Here, the public interest favors the protection of United States intellectual property rights by excluding infringing imports. *Certain Two-Handle Centerset Faucets and Escutcheons, and Components Thereof*, Inv. No. 337-TA-422, Commission Opinion at 9 (July 2000).

IV. BOND

During the 60-day period of Presidential review, imported articles otherwise subject to a remedial order are entitled to conditional entry under bond. 19 U.S.C. § 1337(j)(3). The amount of the bond is specified by the Commission and must be an amount sufficient to protect the complainant from any injury. *Id.*; 19 C.F.R. § 210.50(a)(3). The Commission frequently sets the bond by attempting to eliminate the difference in sales prices between the patented domestic product and the infringing product based upon a reasonable royalty. *Certain Microsphere Adhesives, Process For Making Same, and Products Containing Same, Including Self-Stick Repositionable Notes*, Inv. No. 337-TA-366, Commission Op. at 24, USITC Pub. No. 2949 (January 1996). In cases where the Commission does not have sufficient evidence upon which to base a determination of the appropriate amount of the bond, the Commission has set a 100

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percent bond. *See Certain Sortation Systems, Parts Thereof, and Products Containing Same*, Inv. No. 337-TA-460, Commission Opinion at 21 (March 2003). However, Complainant bears the burden of establishing the need for a bond amount in the first place. *Certain Rubber Antidegradants, Components Thereof, and Prods. Containing Same*, Inv. No. 337-TA-533, Comm'n Op. at 39,40 (July 21, 2006).

Presstek has failed to establish a need for a bond amount. Indeed, Presstek did not present any evidence of its price information, and made no attempt to show that it was impossible to provide price information for its products.² Accordingly, we determine that no bond is required for infringing products imported during the period of Presidential review.

CONCLUSION

For the reasons set forth above, the Commission finds that the appropriate remedy is a limited exclusion order, prohibiting the entry of infringing laser imageable lithographic printing plates for consumption in the United States. The Commission also finds that the public interest factors set out in section 337(d) do not preclude issuance of a limited exclusion order. The Commission determines that no bond is required to permit temporary importation during the Presidential review period of the infringing laser imageable lithographic printing plates.

² Presstek asserted that “[t]here are several models of Respondents’ printing plates that are packaged in different sizes, quantities, and types. These models are sold at varying prices by Respondents. Therefore, it is not possible to accurately calculate a bond on process differentials.” Complainant’s Post Hearing Brief at 120. However, Presstek did not present any evidence to substantiate its assertion.

PUBLIC VERSION

By order of the Commission.

A handwritten signature in black ink, appearing to read "Marilyn R. Abbott". The signature is written in a cursive, flowing style with a large initial "M".

Marilyn R. Abbott
Secretary to the Commission


Issued: December 23, 2009

**CERTAIN LASER IMAGEABLE LITHOGRAPHIC
PRINTING PLATES**

337-TA-636

CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **PUBLIC COMMISSION
OPINION** has been served by hand upon the Commission Investigative Attorney, Aarti
J. Shah, Esq., the following parties as indicated, on December 23, 2009.


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

On Behalf of Complainant Presstek Inc.:

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**On Behalf of Respondents VIM Technologies Limited;
Hanita Coatings RCA Ltd.; Guaranteed Service &
Supplies, Inc.; AteCe Canada; and, Recognition Systems
Incorporated:**

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GOVERNMENT AGENCIES:

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

In the Matter of

**CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Investigation No. 337-TA-636

**NOTICE OF COMMISSION DETERMINATION TO REVIEW IN PART AN INITIAL
DETERMINATION FINDING RESPONDENTS IN VIOLATION OF SECTION 337 AND
ON REVIEW TO AFFIRM THE ADMINISTRATIVE LAW JUDGE'S
DETERMINATION THAT THERE IS A VIOLATION OF SECTION 337; SCHEDULE
FOR BRIEFING ON THE ISSUES ON REVIEW AND ON REMEDY, PUBLIC
INTEREST, AND BONDING**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: The United States International Trade Commission hereby provides notice that it has determined to review in part the final initial determination ("ID") issued by the presiding administrative law judge ("ALJ") finding a violation of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) by the remaining respondents in the above-captioned investigation. Specifically, the Commission has determined to modify the ALJ's claim construction analysis, but to affirm the ALJ's determination of violation of section 337. Notice is further given that the Commission is requesting briefing on remedy, the public interest, and bonding with respect to the respondents found in violation.

FOR FURTHER INFORMATION CONTACT: Paul M. Bartkowski, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-5432. 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: This investigation was instituted on March 7, 2008, based on a complaint filed by Presstek, Inc. ("Presstek") of Hudson, New Hampshire. The complaint alleged violations of section 337 of the Tariff Act of 1930, as amended, in the importation into the United States, the sale for importation, and the sale within the United States

after importation of certain laser imageable lithographic printing plates that infringe certain claims of U.S. Patent Nos. 5,339,737 (“the ‘737 patent”) and 5,487,338 (“the ‘338 patent”) and U.S. Trademark Reg. No. 1,711,005 (“the ‘005 trademark”). All assertions relating to the ‘005 trademark were subsequently terminated from the investigation. Certain respondents have been terminated from the investigation, and the remaining respondents are VIM Technologies, Ltd., Hanita Coatings RCA, Ltd., AteCe Canada, Guaranteed Service & Supplies, Inc., Recognition Systems, Inc., and Spicers Paper, Inc. (hereinafter referred to collectively as “Respondents”).

On July 24, 2009, the ALJ issued the subject ID finding that a violation of section 337 has occurred in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain laser imageable lithographic printing plates by reason of infringement of one or more of claims 1, 10, and 27 of the ‘737 patent and by reason of infringement of one or more of claims 20, 21, and 23 of the ‘338 patent.

Respondents filed a combined petition for review of the ID, which Presstek and the Commission investigative attorney opposed. Having reviewed the record of this investigation, including Respondents’ petition for review and the responses thereto, the Commission has determined to review certain aspects of the ID relating to claim construction. On review, the Commission has determined to modify the ID by supplementing the ALJ’s claim construction analysis for reasons that will be provided in the Commission’s opinion on remedy, the public interest, and bonding, and has determined to affirm the ALJ’s determination of violation of section 337.

In connection with the final disposition of this investigation, the Commission may (1) issue an order that could result in the exclusion of the subject articles from entry into the United States, and/or (2) issue one or more cease-and-desist orders that could result in the respondent being required to cease and desist from engaging in unfair acts in the importation and sale of such articles. Accordingly, the Commission is interested in receiving written submissions that address the form of remedy, if any, that should be ordered. If a party seeks exclusion of an article from entry into the United States for purposes other than entry for consumption, the party should so indicate and provide information establishing that activities involving other types of entry either are adversely affecting it or likely to do so. For background, *see In the Matter of Certain Devices for Connecting Computers via Telephone Lines*, Inv. No. 337-TA-360, USITC Pub. No. 2843 (December 1994) (Commission Opinion).

If the Commission contemplates some form of remedy, it must consider the effects of that remedy upon the public interest. The factors the Commission will consider include the effect that an exclusion order and/or cease-and-desist orders would have on (1) the public health and welfare, (2) competitive conditions in the U.S. economy, (3) U.S. production of articles that are like or directly competitive with those that are subject to investigation, and (4) U.S. consumers. The Commission is therefore interested in receiving written submissions that address the aforementioned public interest factors in the context of this investigation.

If the Commission orders some form of remedy, the U.S. Trade Representative, as delegated by the President, has 60 days to approve or disapprove the Commission’s action. *See Presidential*

Memorandum of July 21, 2005, 70 *Fed. Reg.* 43251 (July 26, 2005). During this period, the subject articles would be entitled to enter the United States under bond, in an amount determined by the Commission and prescribed by the Secretary of the Treasury. The Commission is therefore interested in receiving submissions concerning the amount of the bond that should be imposed if a remedy is ordered.

WRITTEN SUBMISSIONS: The parties to the investigation, interested government agencies, and any other interested parties are encouraged to file written submissions on the issues of remedy, the public interest, and bonding. Complainants and the IA are also requested to submit proposed remedial orders for the Commission's consideration. Complainants are also requested to state the dates that the patents expire and the HTSUS numbers under which the accused products are imported. The written submissions and proposed remedial orders must be filed no later than close of business on October 6, 2009. Reply submissions, if any, must be filed no later than the close of business on October 13, 2009. No further submissions on these issues will be permitted unless otherwise ordered by the Commission.

Persons filing written submissions must file the original document and 12 true copies thereof on or before the deadlines stated above with the Office of the Secretary. Any person desiring to submit a document to the Commission in confidence must request confidential treatment unless the information has already been granted such treatment during the proceedings. All such requests should be directed to the Secretary of the Commission and must include a full statement of the reasons why the Commission should grant such treatment. *See* 19 C.F.R. § 201.6. Documents for which confidential treatment by the Commission is sought will be treated accordingly. All nonconfidential written submissions will be available for public inspection at the Office of the Secretary.

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.



Marilyn R. Abbott
Secretary to the Commission


Issued: September 24, 2009

**CERTAIN LASER IMAGEABLE LITHOGRAPHIC
PRINTING PLATES**

337-TA-636

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF COMMISSION DETERMINATION TO REVIEW IN PART AN INITIAL DETERMINATION FINDING RESPONDENTS IN VIOLATION OF SECTION 337 AND ON REVIEW TO AFFIRM THE ADMINISTRATIVE LAW JUDGE'S DETERMINATION THAT THERE IS A VIOLATION OF SECTION 337; SCHEDULE FOR BRIEFING ON THE ISSUES ON REVIEW AND ON REMEDY, PUBLIC INTEREST, AND BONDING** has been served by hand upon the Commission Investigative Attorney, Aarti J. Shah, Esq., the following parties as indicated, on September 25, 2009.


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

ON BEHALF OF COMPLAINANT PRESSTEK INC.:

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**ON BEHALF OF RESPONDENTS VIM
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PUBLIC VERSION (CORRECTED)*

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES

Inv. No. 337-TA-636

INITIAL DETERMINATION ON VIOLATION OF SECTION 337 AND
RECOMMENDED DETERMINATION ON REMEDY AND BOND

Administrative Law Judge E. James Gildea

(July 24, 2009)

Appearances:

For the Complainant Presstek, Inc.:

Tom M. Schaumberg, Esq.; Michael L. Doane, Esq.; and Patricia Larios, Esq. of Adduci Mastriani & Schaumberg LLP of Washington, D.C.

Kenneth P. George, Esq.; Michael V. Solomita, Esq.; Brian A. Comack, Esq.; and David A. Boag, Esq. of Amster, Rothstein & Ebenstein LLP of New York, N.Y.

For the Respondents VIM Technologies, Inc., Hanita Coatings RCA, Ltd., AteCe Canada, Guaranteed Service & Supplies, Inc., Recognition Systems, Inc. and Spicers Paper, Inc.:

Lee A. Goldberg, Esq.; Sibley P. Reppert, Esq.; Robert D. Schaffer, Esq.; Clyde A. Shuman, Esq. of Pearl Cohen Zedek Latzer of New York, N.Y.

Martin M. Zoltick, Esq. and Jenny L. Workman of Rothwell, Figg, Ernst & Manbeck of Washington, D.C.

For the Commission Investigative Staff:

Lynn I. Levine, Esq., Director; T. Spence Chubb, Supervisory Attorney; Aarti J. Shah, Esq., Investigative Attorney, of the Office of Unfair Import Investigations, U.S. International Trade Commission, of Washington, D.C.

* This public version corrects and replaces the public version of the Initial Determination that issued on August 4, 2009, which was missing the Administrative Law Judge's signature page.

PUBLIC VERSION

Pursuant to the Notice of Investigation, 73 Fed. Reg. 13567-68 (2008), this is the Initial Determination of the Investigation in the Matter of Certain Laser Imageable Lithographic Printing Plates, United States International Trade Commission Investigation No. 337-TA-636. See 19 C.F.R. § 210.42(a).

It is held that a violation of Section 337 of the Tariff Act of 1930, as amended (19 U.S.C. § 1337), has occurred in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain laser imageable lithographic printing plates by reason of infringement of one or more of claims 1, 10, and 27 of United States Patent No. 5,339,737. It is further held that a violation of Section 337 of the Tariff Act of 1930, as amended has occurred in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain laser imageable lithographic printing plates by reason of infringement of one or more of claims 20, 21, and 23 of United States Patent No. 5,487,338.

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The following abbreviations may be used in this Initial Determination:

JX	Joint Exhibit
CX	Complainant's exhibit
CDX	Complainant's demonstrative exhibit
CFF	Complainant's proposed findings of fact
CCL	Complainant's proposed conclusions of law
CBr.	Complainants' initial post-hearing brief
CORFF	Complainant's objections to Respondents' proposed findings of fact
COSFF	Complainant's objections to Staff's proposed findings of fact
CRBr.	Complainant's reply post-hearing brief
RX	Respondents' exhibit
RDX	Respondents' demonstrative exhibit
RFF	Respondents' proposed findings of fact
RCL	Respondents' proposed conclusions of law
RBr.	Respondents' initial post-hearing brief
ROCF	Respondents' objections to Complainant's proposed findings of fact
ROCCL	Respondents' objections to Complainant's proposed conclusions of law
ROSFF	Respondents' objections to Staff's proposed findings of fact
RRSCL	Respondent's objections to Staff's proposed conclusions of law
RRBr.	Respondents' reply post-hearing brief
SFF	Staff's proposed findings of fact
SCL	Staff proposed conclusions of law
SBr.	Staff's initial post-hearing brief
SOCFF	Staff's objections to Complainant's proposed findings of fact
SORFF	Staff's objections to Respondents' proposed findings of fact
SRBr.	Staff's reply post-hearing brief
Tr.	Hearing transcript

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I. BACKGROUND.

A. Institution and Procedural History of this Investigation.

By publication of a Notice of Investigation in the *Federal Register* on March 13, 2008, pursuant to subsection (b) of Section 337 of the Tariff Act of 1930, as amended, the Commission instituted Investigation No. 337-TA-636 with respect to U.S. Patent No. 5,339,737 (the “737 patent”), U.S. Patent No. 5,487,338 (the “338 patent”), and U.S. Trademark Registration No. 1,711,005 to determine the following:

[a] Whether there is a violation of subsection (a)(1)(B) of section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain laser imageable lithographic printing plates that infringe one or more of claims 1, 10, and 27 of U.S. Patent No. 5,339,737 and claims 20, 21, and 23 of U.S. Patent No. 5,487,338, and whether an industry in the United States exists as required by subsection (a)(2) of section 337;

[b] Whether there is a violation of subsection (a)(1)(C) of section 337 in the importation into the United States, the sale for importation, or the sale within the United States after importation of certain laser imageable lithographic printing plates by reason of infringement U.S. Trademark Registration No. 1,711,005, and whether an industry in the United States exists as required by subsection (a)(2) of section 337.

73 Fed. Reg. 13568 (2008).

Presstek, Inc. (“Presstek”) of Hudson, New Hampshire, is named in the Notice of Investigation as the Complainant. *Id.* at 13567. The Respondents named in the Notice of Investigation were: VIM Technologies, Ltd. of Kibbutz Hanita, Israel; Hanita Coatings RCA, Ltd. of Kibbutz Hanita, Israel; Guaranteed Service & Supplies, Inc. of West Bend, Wisconsin; AteCe Canada of Toronto, Ontario, Canada; Ohio Graphco of Solon, Ohio; and Recognition Systems, Inc. of Port Washington, New York. *Id.* at 13568. The Commission Investigative Staff

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of the Commission's Office of Unfair Import Investigations is also a party in this Investigation.

Id. The Investigation was originally assigned to Administrative Law Judge Essex. *Id.*

On May 16, 2008, Administrative Law Judge Essex issued an Initial Determination terminating Respondent Ohio Graphco, Inc. from the Investigation based on a consent order stipulation and settlement agreement. (*See* Order No. 6.) The Commission determined not to review the order. (*See* Notice of Commission Decision Not To Review an Initial Determination Granting Joint Motion to Terminate the Investigation as to Respondent Ohio Graphco, Inc. Based Upon a Settlement Agreement and Consent Order Stipulation; Issuance of Consent Order (June 6, 2008).)

On June 26, 2008, Administrative Law Judge Essex issued an Initial Determination granting Complainant's motion to amend the Complaint and Notice of Investigation to add Spicers Paper, Inc. of Santa Fe Springs, California, as a respondent to this Investigation. (*See* Order No. 7.) The Commission determined not to review the order amending the Complaint and Notice of Investigation. (*See* Notice of Commission Decision Not to Review Initial Determination Granting Complainant's Motion to Amend the Complaint and Notice of Investigation to Add a Respondent (July 21, 2008).)

On December 8, 2008, the Investigation was permanently reassigned to Administrative Law Judge Gildea. (*See* Notice to the Parties (December 8, 2008).)

On December 11, 2008, Administrative Law Judge Gildea issued an Initial Determination extending the Investigation target date from June 12, 2009, to November 30, 2009. (*See* Order No. 13.) The Commission determined not to review the order extending the Investigation target date to November 30, 2009. (*See* Notice of Commission Decision Not to Review an Initial Determination Extending the Target Date for Completion of the Investigation (January 8, 2009).)

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On February 5, 2009, Administrative Law Judge Gildea issued an Initial Determination granting partial termination of the Investigation as to Respondent Hanita Coatings RCA, Ltd. based upon partial withdrawal of that portion of the Complaint alleging infringement of U.S. Trademark Registration No. 1,711,005. (See Order No. 19.) In that same order, Administrative Law Judge Gildea denied partial termination with respect to Respondent AteCe Canada. (*Id.*) The Commission determined not to review that order. (See Notice of Commission Decision Not to Review an Initial Determination Terminating the Investigation in Part (March 11, 2009).)

On March 24, 2009, Administrative Law Judge Gildea issued an Initial Determination granting partial termination of the Investigation as to Respondent AteCe Canada based upon partial withdrawal of that portion of the Complaint alleging infringement of U.S. Trademark Registration No. 1,711,005. (See Order No. 23.) The Commission determined not to review the order granting partial termination with respect to Respondent AteCe. (See Notice of Commission Decision Not to Review an Initial Determination Terminating the Investigation in Part (April 20, 2009).)

On March 24, 2009, Administrative Law Judge Gildea issued an Initial Determination granting partial termination of the Investigation as to that portion of the Complaint alleging infringement of U.S. Trademark Registration No. 1,711,005 against Respondents VIM Technologies, Ltd., Guaranteed Service & Supplies, Inc., Recognition Systems, Inc. and Spicers Paper, Inc. based upon a consent order stipulation. (See Order No. 24.) The Initial Determination effectively terminated all assertions of infringement of U.S. Trademark Registration No. 1,711,005 against the respondents in the Investigation. (*Id.*) The Commission determined not to review the order granting partial termination with respect to Respondents VIM Technologies, Ltd., Guaranteed Service & Supplies, Inc., Recognition Systems, Inc. and Spicers

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Paper, Inc. (*See* Notice of Commission Decision Not to Review an Initial Determination Terminating the Investigation in Part as to Certain Respondents Based Upon Consent Order; Issuance of Consent Order (April 20, 2009).)

The evidentiary hearing on the question of violation of Section 337 began on April 23, 2009, and ended on April 28, 2009. Respondent VIM Technologies, Ltd. (“VIM”), Respondent Hanita Coatings RCA, Ltd. (“Hanita”), Respondent AteCe Canada (“AteCe”), Respondent Guaranteed Service & Supplies, Inc. (“GSS”), Respondent Recognition Systems, Inc. (“RSI”), and Respondent Spicers Paper, Inc. (“Spicers”) (collectively, “Respondents”); Complainant Presstek, Inc. (“Presstek”); and Commission Investigative Staff (“Staff”), were represented by counsel at the hearing. (Hearing Tr. 129:1-131:11.)

B. The Parties.

1. Complainant Presstek, Inc.

Presstek is a Delaware corporation that designs, develops, and manufactures high technology laser imaging and printing products, including laser imageable lithographic printing plates. (JX-10 at ¶¶ 3-6; CBr. at 115-116; SFF 1 (undisputed).) Presstek is a publicly traded corporation with its principal place of business in Hudson, New Hampshire. (JX-10 at ¶3; SFF 1 (undisputed).)

2. Respondent VIM Technologies, Ltd.

VIM is an Israeli corporation that is allegedly engaged in the development and manufacture, distribution, sale for importation, and sale after importation into the United States of laser imageable lithographic printing plates that infringe certain claims of the ‘737 and ‘338 patents. (JX-10 at ¶¶7, 56-66.)

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3. Respondent Hanita Coatings RCA, Ltd.

Hanita is an Israeli corporation that is allegedly engaged in the manufacture and sale for importation into the United States of laser imageable lithographic printing plates that infringe certain claims of the '737 and '338 patents. (JX-10 at ¶¶14, 56, 59, 64, 66.)

4. Respondent Guaranteed Service & Supplies, Inc.

GSS is a Wisconsin corporation having a principal place of business at 606 Schoenhaar Drive, West Bend, WI 53090. (JX-10 at ¶3.) GSS is allegedly engaged in the importation and sale after importation in the United States of laser imageable lithographic printing plates that infringe certain claims of the '737 and '338 patents. (*Id.* at ¶¶56, 58, 60, 64, 66.)

5. Respondent AteCe Canada.

AteCe is a Canadian corporation having a principal place of business at 3A Brussels St., Ste. 3A, Toronto, Ontario, Canada M8Y 1H2. (JX-10 at ¶16.) AteCe is allegedly engaged in the importation and sale after importation in the United States of laser imageable lithographic printing plates that infringe certain claims of the '737 and '338 patents. (*Id.* at ¶¶56, 58, 61, 64, 66.)

6. Respondent Recognition Systems, Inc.

RSI is a New York Corporation having a principal place of business at 30 Harbor Park Drive, Port Washington, NY 11050. (JX-10 at ¶18.) RSS is allegedly engaged in the importation and sale after importation in the United States of laser imageable lithographic printing plates that infringe certain claims of the '737 and '338 patents. (*Id.* at ¶¶56, 58, 63, 64, 66.)

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7. Respondent Spicers Paper, Inc.

Spicers is a California Corporation having a principal place of business at 12310 East Slauson Ave., Santa Fe Springs, CA 90670. (JX-10 at ¶18A.) Spicers is allegedly engaged in the importation and sale after importation in the United States of laser imageable lithographic printing plates that infringe certain claims of the '737 and '338 patents. (*Id.* at ¶¶56, 58, 63, 63A, 64-66.)

8. Respondent Ohio Graphco, Inc.

Respondent Ohio Graphco, Inc. was terminated from the Investigation based on a consent order. (*See* Section I.A. above.)

C. Overview of the Technology.

The products at issue are lithographic printing plates imageable by a laser. (JX-10 at ¶19; CFF 105 (undisputed).) These printing plates are film-like materials sold in blank rolls or sheets that can be mounted in a printing press, laser imaged, then inked and printed to make such items as magazines and catalogs. (JX-10 at ¶¶19-20; CFF 106 (undisputed); CFF 108-110 (undisputed).) The plates have a three-layer structure including a top layer transparent to laser radiation, a middle layer that absorbs laser radiation, and a bottom substrate that reflects laser radiation. (JX-10 at ¶21.)

D. The Patents at Issue.

This Investigation concerns U.S. Patent No. 5,339,737 (the "'737 patent"), entitled "Lithographic Printing Plates for Use with Laser-Discharge Imaging Apparatus," which resulted from a continuation-in-part application claiming priority to U.S. Patent Application No. 07/917,481. (*See* JX-2 at 1 ('737 patent, Reexamination Certificate).) The '737 patent was filed

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on May 13, 1993, and issued on August 23, 1994. (See JX-1 at 1.) On September 19, 1995, Presstek filed a reexamination request, based on prior art not considered during prosecution, which resulted in the '737 patent now at issue in this Investigation. (See JX-2 at 1; JX-10 at ¶29.) The Reexamination Certificate for the '737 patent issued in 1996 with amended claims 1-9, 14, 15, 17, 21, 25, 28, 29, 31, and 32. (SFF 14 (undisputed); JX-2.) The other claims of the patent were affirmed in their original forms. The '737 patent names Thomas E. Lewis, Michael T. Nowak, Kenneth T. Robichaud, and Kenneth R. Cassidy as the inventors. (JX-1 at 1.) The '737 patent was assigned to, and is now owned by, Presstek. (JX-10 at ¶28; *id.*, Ex. 5; CFF 111 (undisputed).)

The '737 patent discloses lithographic printing plates suitable for imaging with low-to-moderate power levels of near-infrared laser radiation. (JX-1 at P004801; *id.* at 3:59-62. See also Tr. at 541:15-25.) Certain areas (layers) of the plates have the ability to absorb the laser radiation and to ablate, resulting in an image spot with different affinities for ink¹ (or an adhesive fluid for ink) than the areas which do not ablate. (JX-1 at 3:59-4:22. See also Tr. at 544:16-545:6; CFF 73 (undisputed).) As a result of the opposing affinities for ink (or an adhesive fluid for ink), the imaged plate may be cleaned, inked, and printed. The '737 patent further discloses a variety of two-, three- and four-layer embodiments that have at least one layer that absorbs infrared radiation, and is therefore subject to, laser ablation. This absorptive layer may be made of any of a variety of disclosed materials "that enhance the ablative efficiency of the laser beam." (JX-1 at P004801; *id.* at 3:67-4:1, 12:45-48, Figs. 13A-13H.) In addition, the patent discloses a layer that reflects infrared radiation, which may increase the effective flux in the absorbing layer, thereby improving imaging performance. (*Id.* at 4:61-5:2. Accord Tr. at 553:25-555:12

¹ These contrasting affinities are characterized as oleophobic and oleophilic. (JX-1 at 1:31-33. Accord Tr. at 549:12-551:3 (testimony of expert witness Charles Magee "Magee"); SFF 72 (undisputed in relevant part).)

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(Magee).) For example, the '737 patent discloses several types of lithographic printing plates that have a reflective layer placed beneath a layer capable of both absorbing infrared radiation and also of transmitting some laser radiation. (JX-1 at 18:32-66; JX-2 at 1:41-57.)

Claim 1 is the sole asserted independent claim. The remaining claims at issue, claims 10 and 27, depend directly from claim 1. Claims 1, 10 and 27 read as follows:

1. A lithographic printing member directly imageable by laser discharge, the member comprising:
 - a. a topmost first layer which is polymeric; and
 - b. a second layer underlying the first layer; and
 - c. a substrate underlying the second layer;wherein
 - d. the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not[; and], *the second layer also being partially transmissive to said radiation;*
 - e. the first layer and the substrate exhibit different affinities for at least one printing liquid selected from the group consisting of ink and an adhesive² fluid for ink; *and*
 - f. *the substrate comprises a material that reflects imaging infrared radiation.*
10. The member of claim 1 wherein the substrate is at least 5 mils thick.
27. The member of claim 1 wherein the topmost layer is oleophobic and the substrate is oleophilic.

(JX-1 at 23:26-27, 24:24-25; JX-2 at 1:41-57 (emphasis in original).)

This Investigation also concerns U.S. Patent No. 4,487,338 (the "338 patent"), entitled "Lithographic Printing Plates for Use with Laser-Discharge Imaging Apparatus," which resulted from a divisional application claiming priority to U.S. Patent Application No. 08/062,431 (now the '737 patent), which is a continuation-in-part of U.S. Patent Application No. 07/917,481. (See JX-6 at 1 ('338 patent).) The '338 patent was filed on August 16, 1994, and issued on January 30, 1996. (*Id.*) The '338 patent names Thomas E. Lewis, Michael T. Nowak, Kenneth T.

² 'Adhesive' should be 'abhesive.' This error was corrected in the original patent (*see* JX-1 at P004821), although the Reexamination Certificate on its face does not appear to reflect this change. (*See* JX-2 at 1:51-54; Tr. at 374:17-375:15; JX-4 at P000309, P000378, P000411; P000521-24.) Hereinafter 'abhesive' shall be substituted for 'adhesive' where element 'e' is quoted.

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Robichaud, and Kenneth R. Cassidy as the inventors. (*Id.*) The '338 patent was assigned to, and is now owned by Presstek. (JX-10 at ¶ 33; *id.*, Ex. 5; CFF 112 (undisputed).)

The '338 patent also discloses lithographic printing plates suitable for imaging with low-to-moderate power levels of near-infrared laser radiation. (JX-1 at P004801; *id.* at 3:59-62. *See also* Tr. at 541:15-25.) The '338 patent discloses the use of materials that enhance the ablative efficiency of the laser beam, such as plate layers that facilitate efficient absorption of the laser radiation and underlying layers that reflect laser radiation back to the absorptive layers. (JX-1 at 3:65-67; 4:6-67; 12:7-10.) The '338 patent discloses several embodiments that include a reflecting layer or substrate that increases the sensitivity of a printing plate to imaging infrared radiation. (*Id.* at 4:55-67, 17:57-18:67; Tr. at 215.)

Claim 20 is the only asserted independent claim in the '338 patent. The remaining claims at issue, claims 21 and 23, depend directly from claim 20. Claims 20, 21 and 23 read as follows:

20. A lithographic printing member directly imageable by laser discharge, the member comprising:
- a. a first durable, solid organic polymer layer that is oleophobic or hydrophilic;
 - and
 - b. a solid oleophilic substrate underlying the first layer; wherein
 - c. the substrate comprises means for reflecting imaging radiation.
21. The member of claim 20 further comprising a layer of IR-absorptive metal oxide disposed above the substrate.
23. The member of claim 20 wherein the means for reflecting imaging radiation is a dispersed pigment.

(JX-6 at 22:54-23:2 (emphasis in original).)

E. The Products at Issue.

The products at issue in this Investigation are VIM waterless processless thermal plate rolls. (JX-10 at ¶11.) Presstek accuses two types of VIM's plates of infringing Presstek's patents: the VIM Di-R28, VIM Di-R36, VIM DP-R28, and VIM DP-R36 plates (the "Original

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VIM Plates”), and the VIM DP-S, VIM Di-S, and Karat 74 plates (“New VIM Plates”), (collectively, the “Accused Plates”). (CBr. at 49-50; CFF 122 (undisputed).) It is undisputed that the middle and top layers of all the Accused Plates are identical. (SFF 25 (undisputed).) It is also undisputed that the substrate of the Original VIM Plates is thicker than that of the New VIM Plates. (SFF 26 (undisputed).)

Presstek asserts that all of the Accused Plates infringe claims 1 and 27 of the ‘737 patent, and claims 20, 21 and 23 of the ‘338 patent. (JX-13C at ¶5.) In addition, Presstek accuses the Original VIM Plates of infringing claim 10 of the ‘737 patent. (*Id.*)

II. JURISDICTION AND IMPORTATION.

In order to have the power to decide a case, a court or agency must have both subject matter jurisdiction, and jurisdiction over either the parties or the property involved. *See Certain Steel Rod Treating Apparatus and Components Thereof*, Inv. No. 337-TA-97, Commission Memorandum Opinion, 215 U.S.P.Q. 229, 231 (U.S.I.T.C., 1981). For the reasons discussed below, the Administrative Law Judge finds the Commission has jurisdiction over this Investigation.

Respondents have responded to the Complaint and Notice of Investigation and fully participated in the Investigation by, among other things, participating in discovery, participating in the hearing, and filing pre-hearing and post-hearing briefs. Accordingly, the Administrative Law Judge finds that Respondents have submitted to the personal jurisdiction of the Commission and that the Commission has in rem jurisdiction over Respondents’ Accused Plates. *Certain Cloisonné Jewelry*, Inv. No. 337-TA-195, Initial Determination at 40-43 (U.S.I.T.C., March, 1985) (unreviewed).³

³ (*See also* RRSL 1-4.)

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Section 337 declares to be unlawful “[t]he importation into the United States, the sale for importation, or the sale within the United States after importation by the owner, importer, or consignee, of articles” that infringe a valid and enforceable United States patent if an industry relating to the articles protected by the patent exists or is in the process of being established in the United States. *See* 19 U.S.C. §§ 1337(a)(1)(B)(i) and (a)(2). Pursuant to Section 337, the Commission shall investigate alleged violations of the Section and hear and decide actions involving those alleged violations.

The importation or sale requirement of Section 337 establishing subject matter jurisdiction has not been challenged by Respondents VIM, GSS, RSI and Spicers. (JX-13 at ¶¶8-14 (Joint Stipulation of Material Facts); ROCCL 1.) VIM stipulates that it manufactures and sells the Original VIM Plates for importation into the United States and that it has offered for sale or offers for sale in the United States the New VIM Plates. (*Id.* at ¶¶10, 13; SFF 2 (undisputed); SFF 27 (undisputed); CFF 114 (undisputed).) GSS, AteCe, RSI and Spicers have entered into a binding stipulation that they import and sell the Original VIM Plates in the United States. (JX-13 at ¶12; SFF 29 (undisputed); SFF 31 (undisputed); SFF 32 (undisputed); CFF 114 (undisputed).)

In addition, Respondents AteCe and Hanita have stipulated to facts that establish that they also have engaged in activity that meets the importation or sale requirement of Section 337. (CFF 114 (undisputed).) Respondent AteCe has denied that it sold for importation or otherwise sold Accused Plates within the United States because it was an authorized VIM retailer for Canada. (*See* Respondents’ Pre-Hearing Statement and Brief, dated March 17, 2009, at 26.) AteCe argues that it “never admitted to importing, distributing and/or selling the accused VIM plates in the U.S.” (RRBr. at 9.) However, this argument is belied by AteCe’s express

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stipulation that it imports into and sells the Original VIM Plates in the United States. (JX-13 at ¶12; SFF 29 (undisputed); SFF 32 (undisputed).) Furthermore, AteCe admits that it supplied “a few plates to prospective dealers, for testing purposes” (see RRBBr. at 9; JX-12C at ¶16; RRCFF 36), which is sufficient to meet the importation requirement. See, e.g., *Certain Integrated Circuits, Processes for Making Same, and Products Containing Same*, Inv. No. 337-TA-450, Order No. 15, at 6-7 (U.S.I.T.C., November 2, 2001). Even a single importation of a free sample into the United States would be enough to meet the importation requirement. *Id.* Finally, Respondents, including AteCe, admit that the “evidence has shown that the importation and sale requirements have been met for all of the Respondents.” (SCL 3; RRCL 3 (emphasis added). *Accord* CFF 114 (undisputed); ROCCL 1.)

Respondent Hanita stipulates that it manufactures a portion of both the Original VIM Plates and the New VIM Plates, which as noted above are subsequently imported into and sold within the United States by Respondents VIM, GSS, AteCe, RSI or Spicers. (JX-13 at ¶¶8-9, 11, 14; SFF 3 (undisputed); SFF 28 (undisputed); SFF 30 (undisputed); CFF 117 (undisputed).) It is undisputed that Hanita’s Chief Executive Officer, Mr. Fluxman, was aware that VIM plates incorporating the portion manufactured by Hanita were sold in the United States. (SFF 35 (undisputed); SFF 82-83 (undisputed).)⁴ Sales made by a manufacturer to persons or entities outside the United States for subsequent importation into the country are subject to the jurisdiction of Section 337. *Certain High Intensity Retroreflective Sheeting*, Inv. No. 337-TA-268, Initial Determination at 119 (U.S.I.T.C., April 15, 1988) (unreviewed). *Accord Certain Welded Stainless Steel Pipe and Tube*, Inv. No. 337-TA-29, Commission Determination and Action, Opinion of Commissioners Minchew, Moore and Alberger at 10 (U.S.I.T.C., February

⁴ Staff also cites to testimony by Mr. Fluxman that he knew that VIM plates incorporating Hanita’s products were sold in the United States. (SBr. at 11-12.) However, that cited deposition excerpt, CX-632C at 293:25-294:16, is not in evidence.

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22, 1978) (determination disapproved on other grounds) (appropriate to assert jurisdiction over foreign manufacturer who sold to foreign trading companies with the knowledge of subsequent export to the United States).

Respondents further admit that the evidence has shown that the importation requirement has been met for each of the Accused Plates. (SCL 12; RRSCL 12; CFF 115-116 (undisputed).)

Thus, the Administrative Law Judge finds that Respondents VIM, GSS, RSI, Spicers, AteCe, and Hanita sell for importation, import, or sell after importation into the United States, articles that are accused in this Investigation. The Administrative Law Judge further finds that all of the Accused Plates have been imported into the United States. The importation or sale requirement of Section 337 is satisfied.

III. CLAIM CONSTRUCTION.

A. Applicable Law.

This Investigation now concerns two patents. *See* 73 Fed. Reg. 13568 (2008).⁵ All of the unfair acts alleged by Presstek are infringements of the '737 and '338 patents. Any finding of infringement requires a two-step analysis. First, the asserted patent claims must be construed as a matter of law to determine their proper scope.⁶ Second, a factual determination must be made whether the properly construed claims read on the accused devices. *See Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 976 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996).

Claim construction begins with the language of the claims themselves. Claims should be given their ordinary and customary meaning as understood by a person of ordinary skill in the art, viewing the claim terms in the context of the entire patent. *Phillips v. AWH Corp.*, 415 F.3d

⁵ Presstek's infringement allegations with respect to U.S. Trademark No. 1,711,005 have been terminated. *See* Section I.A. above.

⁶ Only claim terms in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Vanderlande Indus. Nederland BV v. Int'l Trade Comm.*, 366 F.3d 1311, 1323 (Fed. Cir. 2004); *Vivid Tech., Inc. v. American Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999).

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1303, 1312-13 (Fed. Cir. 2005). In some cases, the ordinary meaning of claim language is readily apparent and claim construction will involve little more than “the application of the widely accepted meaning of commonly understood words.” *Id.* at 1314. In other cases, claim terms have a specialized meaning and it is necessary to determine what a person of ordinary skill in the art would have understood disputed claim language to mean by analyzing “the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, as well as the meaning of technical terms, and the state of the art.” *Id.* (quoting *Innova/Pure Water, Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004)).

The claims themselves provide substantial guidance as to the meaning of disputed claim language. *Id.* at 1314. “[T]he context in which a term is used in the asserted claim can be highly instructive.” *Id.* Likewise, other claims of the patent at issue, regardless of whether they have been asserted against respondents, may show the scope and meaning of disputed claim language. *Id.*

With respect to claim preambles, a preamble may limit a claimed invention if it (i) recites essential structure or steps, or (ii) is “necessary to give life, meaning, and vitality” to the claim. *Eaton Corp. v. Rockwell Int’l Corp.*, 323 F.3d 1332, 1339 (Fed. Cir. 2003) (citations omitted). The Federal Circuit has explained that a “claim preamble has the import that the claim as a whole suggests for it. In other words, when the claim drafter chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” *Id.* (quoting *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620 (Fed. Cir. 1995)). When used in a patent preamble, the term “comprising” is well understood to mean “including but not limited to,” and

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thus, the claim is open-ended. *CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007). The patent term “comprising” permits the inclusion of other unrecited steps, elements, or materials in addition to those elements or components specified in the claims. *Id.*

In cases where the meaning of a disputed claim term in the context of the patent’s claims remains uncertain, the specification is the “single best guide to the meaning of a disputed term.” *Phillips*, 415 F.3d at 1321. Moreover, “[t]he construction that stays true to the claim language and most naturally aligns with the patent’s description of the invention will be, in the end, the correct construction.” *Id.* at 1316. As a general rule, however, the particular examples or embodiments discussed in the specification are not to be read into the claims as limitations. *Id.* at 1323.

The prosecution history may also explain the meaning of claim language, although “it often lacks the clarity of the specification and thus is less useful for claim construction purposes.” *Id.* at 1317. The prosecution history consists of the complete record of the patent examination proceedings before the U.S. Patent and Trademark Office, including cited prior art. *Id.* It may reveal “how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Id.*

If the intrinsic evidence does not establish the meaning of a claim, a court may resort to an examination of the extrinsic evidence. Extrinsic evidence may shed light on the relevant art, and consists of all evidence external to the patent and the prosecution history, “including expert and inventor testimony, dictionaries, and learned treatises.” *Id.* at 1317. In evaluating expert testimony, a court should disregard any expert testimony that is conclusory or “clearly at odds with the claim construction mandated by the claims themselves, the written description, and the

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prosecution history, in other words, with the written record of the patent.” *Id.* at 1318. Extrinsic evidence is inherently “less reliable” than intrinsic evidence, and “is unlikely to result in a reliable interpretation of patent claim scope unless considered in the context of the intrinsic evidence.” *Id.* at 1318-19.

B. Level of Skill in the Art.

Claims should be given their ordinary and customary meaning as understood by a person of ordinary skill in the art. *Phillips*, 415 F.3d at 1312-13. It is undisputed that the field of art for the ‘737 and ‘338 patents is “lithographic printing plates suitable for imaging by means of laser devices.” (SFF 119 (undisputed).) However, the private parties have not delineated the level of ordinary skill in the art that is applicable to this Investigation in their post-hearing briefing. Staff, in discussing the level of skill in the art with respect to obviousness, submits that there is no significant difference between the private parties’ definitions. (SBr. at 79.) Yet Staff does not provide the language of these definitions or any citations showing where they appear in the record. (*Id.*) The Administrative Law Judge finds that because the private parties have failed to brief the level of skill in the art, they have waived this issue. (Order No. 2, Ground Rule 11.1.)

Lacking post-hearing briefing by the parties, the Administrative Law Judge examined the parties’ pre-hearing briefs and expert reports, which are not in evidence, for guidance on the parties’ positions in determining the appropriate level of skill in the art. Presstek defined the level of ordinary skill in the art of laser imageable lithographic printing plates with respect to the ‘737 and ‘338 patents to be someone with at least a Master of Science degree in Chemical Engineering, Chemistry, or Materials Science; or a Bachelor of Science degree in Chemical Engineering, Chemistry, or Materials Science, coupled with at least three years of experience in designing laser imageable printing plates. (*See* Complainant Presstek, Inc.’s Pre-Hearing Brief

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at 21; Expert Report of Charles W. Magee, Ph.D. on Infringement, dated September 26, 2008, at ¶21; Rebuttal Expert Report of Steven A. Carlson, Ph.D. on Validity, dated October 17, 2008, at ¶19.) Respondents' expert⁷ has defined a person of ordinary skill in the relevant field to be a person with a bachelor's technical degree and at least two years of experience in lithographic printing technology; or a person with a technical associate's degree and five years of practical lithographic experience. (Expert Report of Richard M. Goodman, Ph.D., dated September 25, 2008, at ¶22.) Staff is of the opinion that there is no significant difference between the two definitions. (SBr. at 79.)

The Administrative Law Judge finds that a person of ordinary skill in the art of laser imageable lithographic printing plates with respect to the '737 and '338 patents would have at least (i) a Master of Science degree in Chemical Engineering, Chemistry or Materials Science; or (ii) a Bachelor of Science degree in Chemical Engineering, Chemistry or Materials Science coupled with at least two years of experience in laser imageable printing plate technology. The disputed terms in this Investigation will be construed in accordance with this construct of a person of ordinary skill.

C. The Disputed Claim Terms of the '737 Patent and Their Proper Construction.

1. Claim 1.

a) Preamble—"A lithographic printing member directly imageable by laser discharge, the member comprising"

Presstek argues that the preamble of claim 1 of the '737 patent is the same as the preamble of claim 20 of the '338 patent, and that the plain and ordinary meaning of the preamble should apply. (CBr. at 69.)

⁷ Respondents do not appear to define the level of a person of ordinary skill in the art in their pre-hearing brief.

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Respondents do not discuss the meaning of the preamble in their post-hearing briefing.
(See RBr. at 30-37.)

Staff agrees with Presstek that “there is no evidence in the specification or prosecution history of the ‘737 patent sufficient to demonstrate that the patentees used this language in a way at variance with the ordinary meaning of the words. (SBr. at 22.) Staff notes that Respondents stated in their pre-hearing brief that there is no dispute with respect to the preamble. (*Id.*)

The Administrative Law Judge finds that the preamble of claim 1 of the ‘737 patent is not in issue, and therefore its ordinary meaning should apply. *Phillips*, 415 F.3d at 1312-1313.

b) Element ‘a’ –“a topmost first layer which is polymeric”

Presstek argues that the claimed element “a topmost first layer which is polymeric” should be given its plain and ordinary meaning. (CBr. at 69.)

Respondents do not provide a proposed construction for this element. (RBr. at 30-37.)

Staff agrees that the ordinary meaning of the claim limitation should be used. (SBr. at 24.)

The Administrative Law Judge finds that element ‘a’ of claim 1 of the ‘737 patent is not in issue, and therefore its ordinary meaning should apply.

c) Element ‘b’ –“a second layer underlying the first layer”

Presstek argues that the claimed element “a second layer underlying the first layer” should be given its plain and ordinary meaning. (CBr. at 70-71.)

Respondents do not provide a proposed construction for this element. (RBr. at 30-37.)

Staff agrees that the ordinary meaning of the claim limitation should be used. (SBr. at 24.)

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The Administrative Law Judge finds that element 'b' of claim 1 of the '737 patent is not in issue, and therefore its ordinary meaning should apply.

d) Element 'c' –“a substrate underlying the second layer”

Presstek argues that the claimed element “a substrate underlying the second layer” should be given its plain and ordinary meaning. (CBr. at 71.)

Respondents do not provide a proposed construction for this element. (RBr. at 30-37.)

Staff agrees that the ordinary meaning of the claim limitation should be used. (SBr. at 24-25.)

The Administrative Law Judge finds that element 'c' of claim 1 of the '737 patent is not in issue, and therefore its ordinary meaning should apply.

e) Element 'd' –“the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation”

Presstek argues that the first portion of the claimed element, “the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not,” should be given its plain and ordinary meaning. (CBr. at 71.) However, Presstek does not oppose Staff's construction, disclosed below. (*Id.*) Presstek argues that the term “the second layer also being partially transmissive to said radiation” in asserted claim 1 of the '737 patent should be afforded its plain and ordinary meaning. (*Id.* at 72-73.) However, Presstek also argues that the term “partially transmissive to said radiation” should mean “for example, permitting transmission of 5-70% of the radiation for aluminum-based layers, as taught in the Presstek Patents.” (*Id.* at 73.)

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Respondents do not provide a proposed construction for the first portion of the element, “the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not.” (RBr. at 30-37.) Respondents argue that “the second layer also being partially transmissive to said radiation” should mean “[s]ince the underlying (substrate) layer is recited to be reflective, and the purpose of reflection is to supplement the insufficient absorption of the second layer (because it is transmissive), enough radiation must reach the underlying layer such that reflected incident radiation from that layer causes ablation of the absorptive layer that would not have occurred absent the reflective substrate.” (RBr. at 32.)

Staff argues that the first portion of the claimed element, “the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not,” should mean “the second layer ablatively absorbs imaging IR⁸ radiation and the first layer does not.” (SBr. at 25.) With respect to the claim term “the second layer also being partially transmissive to said radiation,” Staff argues, among other things, that the meaning of the phrase should not include a numeric range, as suggested by Presstek, because that improperly imports a limitation from the specification into the claim. (*Id.* at 29.) Staff asserts that the phrase “the second layer also being partially transmissive to said radiation” should mean “transmitting some amount of imaging infrared radiation.” (*Id.* at 30.)

Both Presstek and Staff object to Respondents’ construction, arguing that Respondents inappropriately adopted a new construction position which should be stricken or deemed waived. (CRBr. at 7-8; SRBr. at 2, 10-11.) Presstek and Staff note that Respondents argued in their Pre-Hearing Brief that “the term ‘partially transmissive’ in element ‘d’ requires that the second layer

⁸ Infrared. (*See, e.g.*, JX-6 at 4:9.)

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is 'more transmissive than the ablative layers disclosed in Nechiporenko.'"⁹ (CRBr. at 8; SRBr. at 10.) Indeed, Respondents note and reject their former construction in their post-hearing reply brief:

Presstek argues that Respondents' construction of this claim limitation is indefinite because (i) it includes the phrase "more transmissive than the ablative layers of Nechiporenko" and (ii) according to Presstek, Nechiporenko does not disclose transmissivity values but is fully absorptive. (Presstek Br. at 74) However, the clause "more transmissive than the ablative layers of Nechiporenko" is not part of Respondents' construction of this limitation as argued at the Hearing and in Respondents' initial post-Hearing brief, viz., that enough radiation must reach the underlying layer such that reflected incident radiation from that layer causes ablation of the absorptive layer that would not have occurred absent the reflective substrate. Presstek's argument is moot. (The Staff similarly argues against the construction proffered by Respondents in their pre-Hearing brief. (Staff Br. at 26-27) Again, Nechiporenko is not referenced in the construction argued by Respondents at the Hearing and in their initial post-Hearing brief.)

(RRBr. at 22 (emphasis added).) The claim construction position that Respondents disavowed in their post-hearing reply brief was included in their demonstrative exhibit and used during the hearing:

CLAIM CONSTRUCTIONS OF RESPONDENTS, COMPLAINANT AND STAFF: Claim 1, U.S. Patent No. 5,339,737 (continued)			
Claim Language	Respondents' Construction	Presstek's Construction	Staff's Construction
the second layer also being partially transmissive to said radiation	The second layer is more transmissive than the ablative layers disclosed by Nechiporenko. Since the underlying (substrate) layer is recited to be reflective, and the purpose of reflection is to supplement the insufficient ablation of the second layer (for the very reason of its being transmissive), Thus, "partially transmissive," as that term is used in the '737 Patent, means that enough radiation reaches the underlying layer such that its reflection increases the ablation a significant amount.	The element should be afforded its plain and ordinary meaning, for example, permitting transmission of 5-70% of the radiation for aluminum based layers.	This limitation should be construed according to its plain meaning, that is, transmitting some amount of imaging infrared radiation.

(RDX-42-4 through 42-6; Tr. 882:21-884:12; 1033:10-18.) Not only does Respondents' construction state that the "second layer is more transmissive than the ablative layers disclosed by Nechiporenko[,]," but Respondents also set forth the construction that "partially

⁹ Nechiporenko et al., Direct Method of Producing Waterless Offset Plates By Controlled Laser Beam ("Nechiporenko"). (RX-1.)

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transmissive[]' . . . means that enough radiation reaches the underlying layer such that its reflection increases the ablation a significant amount." (RDX-42-6.) At no point during the hearing did Respondents inform the other parties or the Administrative Law Judge that Respondents' own exhibit setting forth Respondents' claim construction was inaccurate.

Staff argues that Staff relied on Respondents' pre-hearing construction, that Staff "was never given the opportunity to obtain evidence relevant to these new positions[,] and is now in the difficult position of combing through the evidence of record that was obtained under Respondents' previous claim construction to determine if any of the evidence may be applied to rebut these new contentions." (SRBr. at 3.) Presstek says that it was sandbagged. (CRBr. at 6.)

Respondents were required, under Ground Rules 8¹⁰ and 11,¹¹ to raise their current proposed construction of the claim language ("the second layer also being partially transmissive to said radiation") in their pre-hearing briefing or waive it. (Order No. 2, Ground Rules 8(e), 8(f), 11.1.) These rules were designed to prevent a shifting sands approach to claim construction, which, if permitted, would unfairly surprise and prejudice other parties at a late stage in an investigation. The belated shift in Respondents' position requires the parties to drastically restructure their arguments in the compressed time frame of reply briefing. The hearing is an

¹⁰ "When the alleged unfair act involves a U.S. patent, [the pre-hearing statement should contain] a statement, as to each claim in issue, indicating how a party wants the language to be interpreted and the basis in detail for that interpretation. . . . If a party in a pre-hearing statement does not raise an issue as to a word in each claim in issue, the Administrative Law Judge will take the position that the party will have no objection as to how said word is interpreted by the Administrative Law Judge." Ground Rule 8(e) (emphasis added).

The pre-hearing statement should contain a "statement of the issues to be considered at the hearing that sets forth with particularity a party's contentions on each of the proposed issues, including citations to legal authorities in support thereof. Any contentions not set forth in detail as required herein shall be deemed abandoned, or withdrawn, except for contentions of which a party is not aware and could not be aware in the exercise of reasonable diligence at the time of filing the pre-hearing statements. Pursuant to this requirement, each of the parties and the Staff shall take a position on the issues it is asserting no later than the filing of its pre-hearing statement." Ground Rule 8(f) (emphasis added).

¹¹ "The post-trial brief shall discuss the issues and evidence tried within the framework of the general issues determined by the Commission's Notice of Investigation, the general outline of the briefs as set forth in Appendix B, and those issues that are included in the pre-trial brief and any permitted amendments thereto. All other issues shall be deemed waived." Ground Rule 11.1 (emphasis added).

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indispensable, one-time opportunity for the parties to address the issues in this Investigation and enter evidence into the record. Respondents' shift in position has negatively affected both Presstek's and Staff's ability to respond. As a result, the Administrative Law Judge finds that Respondents have waived their new arguments with respect to the claim language "the second layer also being partially transmissive to said radiation." *Certain Foam Footwear*, Inv. No. 337-TA-567, Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond at 38-39 (U.S.I.T.C., April 11, 2008); *Certain Endoscopic Probes for Use in Argon Plasma Coagulation Systems*, Inv. No. 337-TA-569, Initial Determination on Violation of Section 337 and Recommended Determination on Remedy and Bond at 52-3, n.219 (U.S.I.T.C., January 16, 2008) ("*Endoscopic Probes*"). The Administrative Law Judge further finds, based, among other things, on Respondents' express disclaimer, that Respondents have abandoned their pre-hearing arguments with respect to the claim language "the second layer also being partially transmissive to said radiation."¹²

Presstek does not object to Staff's argument that "the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not" should be construed to mean "the second layer ablatively absorbs imaging IR radiation and the first layer does not." (See CBr. at 71.) Thus this portion of element 'd' of claim 1 is not in issue. However, Presstek and Staff disagree as to the meaning of "the second layer also being partially transmissive to said radiation." Therefore, claim construction is still necessary.

¹² Even if these arguments had not been abandoned, the Administrative Law Judge finds them unsupported by the evidence because, as discussed below, the Administrative Law Judge finds that the Nechiporenko reference is not enabled. A person of ordinary skill in the art would not be able to determine the transmissivity of the lacquer sublayer disclosed by Nechiporenko, thus Respondents' proposed construction that "the second layer is more transmissive than the ablative layers disclosed by Nechiporenko" is untenable. In addition, there is nothing in the intrinsic evidence to suggest that the language "partially transmissive" in claim 1 requires that enough radiation must reach the underlying layer such that its reflection increases the ablation a "significant amount." See discussion re elements 'd' and 'f' of claim 1, in this Section.

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As discussed above, the disputed language appears in asserted claim 1 in the following language:

- d. the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation

(JX-2 at 1:47-50 (formatting omitted).) A reading of the language used in the claim indicates that the second layer of the lithographic printing member is both subject to ablative absorption of imaging infrared radiation and able to transmit some of it. From the plain language of the claim, the Administrative Law Judge finds that a person of ordinary skill in the art would conclude that “the second layer also being partially transmissive to said radiation” should mean “transmitting some amount of imaging infrared radiation.”

In addition, the specification supports the conclusion that “the second layer also being partially transmissive to said radiation” means “transmitting some amount of imaging infrared radiation.” It is undisputed that in an embodiment disclosed in the specification, “some of the laser’s radiation is absorbed by the second layer 404, and some of the laser’s radiation passes through (is transmitted through) the second layer 404.” (CFF 60 (undisputed).) Without limiting the claim, the specification teaches that with respect to this embodiment transmission should be calculated to allow absorption of the imaging infrared radiation:

We have also found that a metal layer disposed as illustrated in **FIG. 13D** can, if made thin enough, support imaging by absorbing, rather than reflecting, IR radiation. This approach is valuable both where layer **416** absorbs IR radiation (as contemplated in **FIG. 13D**) or is transparent to such radiation. In the former case, the very thin metal layer provides additional absorptive capability (instead of reflecting radiation back into layer **416**); in the latter case, this layer functions as does layer **404** in **FIG. 13A**.¹³

¹³ “The plate illustrated in **FIG 13A** includes a substrate **400**, a layer **404** capable of absorbing infrared radiation, and a surface coating layer **408**.” (JX-1 at 12:18-21.)

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To perform an absorptive function, metal layer 418 should transmit as much as 70% (and at least 5%) of the IR radiation incident thereon; if transmission is insufficient, the layer will reflect radiation rather than absorbing it, while excessive transmission levels appear to be associated with insufficient absorption.

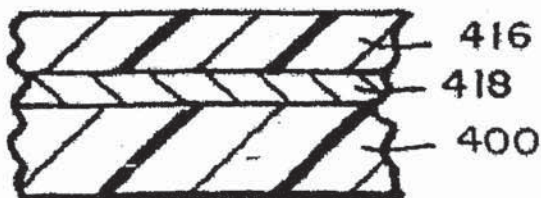


FIG. 13D

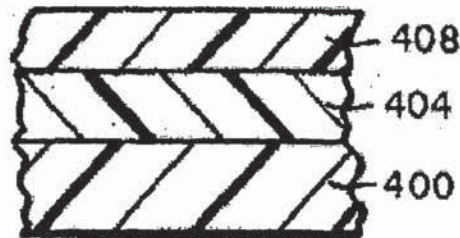


FIG. 13A

(JX-1 at 20:19-35 (emphasis added); *id.*, Figs. 13A, 13D.) Thus, the specification describes a partially transmissive middle layer that would be transmissive enough to still be “subject to ablative absorption,” yet not so transmissive that it would reflect the infrared (“IR”) radiation. Based on the foregoing, the Administrative Law Judge finds that a person of ordinary skill in the art would conclude that the term “the second layer also being partially transmissive to said radiation” is not restricted to a particular numerical value for transmissivity, as Presstek suggests, but instead means “transmitting some amount of imaging infrared radiation.”

The prosecution history created during the reexamination of the ‘737 patent also supports this finding. In summarizing the discussion during an Examiner interview, Presstek explained the rationale for “partial transmissivity” as claimed in claim 1. Presstek described its invention while distinguishing prior art reference Nechiporenko:¹⁴

The discussion then turned to claims 1, 10, 12, 13, 27 and 36, and the Nechiporenko et al. article over which these claims were rejected. The

¹⁴ Nechiporenko et al., Direct Method of Producing Waterless Offset Plates By Controlled Laser Beam. (JX-4 at P000273.)

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undersigned explained that Nechiporenko et al. contemplate full absorption of the laser beam before the radiation can even reach the substrate, and so do not contemplate reflection as claimed herein; as set forth in the specification, reflection is useful when “the absorbing layer is partially transmissive, and therefore fails to absorb a sufficient proportion of incident energy.” Col. 18, lines 36-38. Nechiporenko et al., by contrast, utilize a CO₂ laser emitting at a wavelength that is strongly absorbed by organic layers such as the lacquer they describe. Indeed, on page 142, the authors describe a series of tests in which the lacquer layer is not even fully removed, indicating that laser energy cannot possibly be reaching the substrate to be reflected.

Accordingly, we have amended claim 1 to recite a partially transmissive ablation layer, thereby clearly distinguishing the constructions of Nechiporenko et al. in terms of both structure and behavior.

(JX-4 at P000415 (emphasis added).) Presstek explained that the partially transmissive layer of claim 1 does not absorb all of the laser energy, but permits some of it to pass through the layer. This is so that some laser energy may reach the substrate to be reflected. Based on the plain language of the claim, the specification, and reexamination history, the Administrative Law Judge finds that a person of ordinary skill in the art would conclude that “the second layer also being partially transmissive to said radiation” should mean “transmitting some amount of imaging infrared radiation.”

The extrinsic evidence also supports the finding that the plain and ordinary meaning of “the second layer also being partially transmissive to said radiation” should apply. Both of Presstek’s experts, Drs. Magee and Carlson, found that the plain and ordinary meaning of the claims should apply, notably without any proviso relating to 5-70 percent transmissivity. (Tr. at 715:18-20 (testimony of expert witness Steven Carlson “Carlson”)¹⁵; *id.* at 349:15-350:11 (Magee)¹⁶.) In particular, Dr. Magee did not import the limitation of 5-70 percent transmissivity

¹⁵ “A. Right, I read the claims and I read the entire ‘737 and ‘338 patents and the prosecution history for them, including the reexam. Q. Did that include the cited prior art? A. Yes. Q. Okay. So based on those documents, did you interpret the claims? A. Yes. Q. What was their interpretation? A. My interpretation is the claims have their plain and ordinary meaning.” (Tr. at 715:9-20 (Carlson).)

¹⁶ “Q. You read these claim terms of claim 1 of the ‘737 patent, correct? A. Yes. Q. Did you have any trouble understanding terms used in this claim? A. No, I did not. Q. What is your understanding of these terms? A. I

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from the specification into the meaning of “the second layer also being partially transmissive to said radiation,” but instead cited to the specification to show an example of an aluminum layer with partial transmissivity. (CFR 347 (undisputed).) Likewise, Dr. Carlson confirmed during the hearing that he defined “partial transmissivity” as “some transmission.” (Tr. at 1152:21-25.) The testimony of Presstek’s experts supports the finding that the plain and ordinary meaning of “the second layer also being partially transmissive to said radiation” is “transmitting some amount of imaging infrared radiation.”

Based on the foregoing intrinsic and extrinsic evidence, the Administrative Law Judge finds that a person of ordinary skill in the art would define “the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation” as “the second layer ablatively absorbs imaging infrared radiation and the first layer does not, the second layer also transmitting some amount of imaging infrared radiation.”

The Administrative Law Judge rejects Presstek’s argument that “transmitting some amount of imaging infrared radiation” would be an indefinite construction of the claim language “the second layer also being partially transmissive to said radiation.” (See CBr. at 73.) According to Presstek, the claimed element “was likely not drafted to cover the situation where a second layer transmits 0.01%” of the imaging infrared radiation. (*Id.*) However, Presstek fails to read the two portions of the disputed claim element in context. As discussed above, the plain language of the claim states that the second layer of the lithographic printing member is both subject to ablative absorption of imaging infrared radiation and able to transmit some of the

understood them in plain and ordinary language, plain and ordinary meaning. Q. Did you read the specification of the '737 patent? A. Yes, I did. Q. Did that change your opinion that these claim terms should be given their plain and ordinary meaning? A. No. Q. Did you read the prosecution history for the '737 patent? A. Yes. Q. And did that change your mind? A. No.” (*Id.* at 349:15-350:11 (Magee).)

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imaging infrared radiation. The specification teaches that if there too little transmission, such as perhaps Presstek's example of 0.01 percent transmissivity, the layer would reflect radiation instead of absorbing it. Thus a person of ordinary skill in the art would likely understand that a layer having such a low transmission level would not be "subject to ablative absorption of imaging infrared radiation[,]" which is also required by the claim element. Accordingly, the Administrative Law Judge finds that "transmitting some amount of imaging infrared radiation" is not indefinite. *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) (claim is indefinite only if the claim is "insolubly ambiguous, and no narrowing construction can properly be adopted"); 35 U.S.C. § 282 (Patent claims are presumed valid.).

f) Element 'e' – "the first layer and the substrate exhibit different affinities for at least one printing liquid selected from the group consisting of ink and an adhesive fluid for ink"

Presstek argues that the language of element 'e,' "the first layer and the substrate exhibit different affinities for at least one printing liquid selected from the group consisting of ink and an adhesive fluid for ink," should be given its plain and ordinary meaning. (CBr. at 75.)

Respondents do not provide a proposed construction for this element. (RBr. at 30-37.)

Staff argues that this element is not in dispute and therefore no construction is necessary. (SBr. at 30.)

The Administrative Law Judge finds that element 'e' is not in issue, and therefore its ordinary meaning should apply.

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g) Element 'f' –“the substrate comprises a material that reflects imaging infrared radiation”

Presstek argues that the claimed element “the substrate comprises a material that reflects imaging infrared radiation” should be given its plain and ordinary meaning. (CBr. at 75.) However, Presstek does not oppose Staff’s construction, disclosed below. (*Id.*)

Respondents argue that the claimed language “the substrate comprises a material that reflects imaging infrared radiation” means “[t]he substrate includes reflective material for reflecting part of the partially transmitted radiation back into the overlying radiation absorbing layer. The reflected incident radiation causes ablation of the absorptive layer that would not have occurred absent the reflective substrate.” (RBr. at 34.)

Staff argues that “the substrate comprises a material that reflects imaging infrared radiation” should be construed to mean “the substrate includes reflective material that reflects the partially transmitted radiation back to the overlying radiation absorbing layer.”

As with Respondents’ shift in their proposed construction for the second half of element ‘d’ of the ‘737 patent, Presstek and Staff object to Respondents’ construction, arguing that Respondents improperly adopted a new construction that should be stricken or deemed waived. (CRBr. at 9; SRBr. at 10.) Presstek notes that Respondents proposed the following construction for element ‘f’ of the ‘737 patent in their Pre-Hearing Brief: “[t]he substrate includes reflective material for reflecting part of the partially transmitted radiation back into the overlying radiation absorbing layer. The fact that this layer claims reflection indicates the extent of the transmissivity of the second layer. The reflection increases the ablation of the second layer a significant amount.” (CRBr. at 9.)

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Claim 1 of the '737 Patent	Respondents' Pre-Hearing Claim Construction	Respondents' Post-Hearing Claim Construction
<p>f. the substrate comprises a material that reflects imaging infrared radiation.</p>	<p>The substrate includes reflective material for reflecting part of the partially transmitted radiation back into the overlying radiation absorbing layer. The fact that this layer claims reflection indicates the extent of the transmissivity of the second layer. <u>The reflection increases the ablation of the second layer a significant amount.</u> (Br. 48; RDX-42-6)</p>	<p>The element must be construed such that the <u>reflected incident radiation causes ablation of the absorptive layer that would not have occurred absent the reflective substrate.</u></p>

(*Id.* (providing chart comparing Respondents' proposed pre-hearing and post-hearing claim construction for element 'f').) For the same reasons discussed above with respect to element 'd', the Administrative Law Judge finds that Respondents have waived their new arguments with respect to the claim language "the substrate comprises a material that reflects imaging infrared radiation." The Administrative Law Judge further finds, based on Respondents' failure to restate their pre-hearing arguments with respect to the claim language "the substrate comprises a material that reflects imaging infrared radiation" in their post-hearing brief, that Respondents have abandoned that construction.

As Presstek does not oppose Staff's proposed construction of element 'f' ("the substrate comprises a material that reflects imaging infrared radiation"), the Administrative Law Judge finds that this element is not in issue. (CBr. at 75.) Accordingly, the Administrative Law Judge finds that a person of ordinary skill in the art would understand that the claim language "the substrate comprises a material that reflects imaging infrared radiation" means "the substrate includes reflective material that reflects the partially transmitted radiation back to the overlying radiation absorbing layer."

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2. Claim 10—“The member of claim 1 wherein the substrate is at least 5 mils thick.”

Presstek argues that the plain and ordinary meaning of claim 10 should apply. (CBr. at 76-77.)

Respondents do not provide a proposed construction for this claim. (RBr. at 30-37.)

Staff argues that there is no need to construe this claim. (SBr. at 32-33.)

The Administrative Law Judge finds that the meaning of claim 10 is not in issue, and therefore its plain and ordinary meaning should apply.

3. Claim 27 —“The member of claim 1 wherein the topmost layer is oleophobic and the substrate is oleophilic.”

Presstek argues that the plain and ordinary meaning of claim 27 should apply. (CBr. at 77.) However, Presstek notes that it does not object to the construction proposed by Staff. (*Id.*)

Respondents do not provide a proposed construction for this claim. (RBr. at 30-37.)

Staff argues that “the topmost layer is oleophobic and the substrate is oleophilic” should mean “[t]he topmost layer repels ink and the substrate accepts ink.” (SBr. at 33.)

As Presstek does not object to Staff’s proposed construction, the Administrative Law Judge finds that the language of this claim is not in issue and that a person of ordinary skill in the art would understand claim 27 to mean “the member of claim 1 wherein the topmost layer repels ink and the substrate accepts ink.”

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D. The Disputed Claim Terms of the '338 Patent and Their Proper Construction.

1. Claim 20.

a) Preamble—"A lithographic printing member directly imageable by laser discharge, the member comprising"

Presstek argues that the words in the preamble are clear and that their plain and ordinary meaning should apply. (CBr. at 40.) Presstek also argues that the preamble word "comprising" is well understood under U.S. patent law to mean that the claim is "open-ended." (*Id.*)

Respondents expressly state in their pre-hearing brief that only two claim limitations are disputed, and do not identify the preamble as one of these.¹⁷ (Respondents' Pre-Hearing Brief at 29.) However, Respondents provide a proposed construction on the next page of that brief, arguing that "[i]n light of the plain language of the claim and the disclosure in the specification, 'lithographic printing member directly imageable by laser discharge' is properly construed as follows: a printing member that is capable of being imaged by a laser." (*Id.* at 30.) In their post-hearing briefing Respondents do not reiterate this proposed construction, although they argue, based on the testimony of Presstek's expert Dr. Magee with respect to the '737 patent, that the preamble means that the laser can actually produce an image on the plate. (RBr. at 20.) Respondents do not dispute Presstek's construction of the word "comprising" but instead argue that "the claimed printing member must include, at a minimum, the two recited layers, and that those layers must function as a lithographic printing member directly imageable by laser discharge, as claimed." (RRBr. at 4.)

¹⁷ According to Respondents in their pre-hearing brief: "[t]he construction of the following claim limitations is disputed: In claim 20: 'a first durable, solid organic polymer layer that is oleophobic or hydrophilic' and 'the substrate comprises means for reflecting imaging radiation.' There are no disputes concerning the construction of the other words in claim 20." (See Respondents' Pre-Hearing Brief at 29 (internal formatting omitted).)

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Staff argues that the plain and ordinary meaning of the preamble applies, and also notes that the “term ‘comprising’ is an open one, meaning structures additional to those listed in the claim may be added without avoiding infringement. (SBr. at 16-17.)

The preamble of claim 20 of the ‘338 patent, “[a] lithographic printing member directly imageable by laser discharge, the member comprising[.]” is identical to the preamble of the ‘737 patent. The language of the preamble when considered in the context of the entire claim indicates that the claimed invention is a lithographic printing member which is suitable for imaging directly by laser discharge. As a matter of law, the patent term “comprising” means “including but not limited to,” and therefore the claimed invention may include other unnamed layers or elements. *CLAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007). Under the plain meaning of the claim language, this means that the claimed printing member includes, but is not limited to, the organic polymer layer and substrate disclosed in elements ‘a’, ‘b’, and ‘c’ of the claim. Even Respondents agree that “claim 20 only recites 2 layers; therefore, at a minimum, it must contain a first, durable, solid organic polymer layer and a substrate with a means for reflecting.” (RRBr. at 14 (emphasis in original).) Thus, the Administrative Law Judge finds that a person of ordinary skill in the art would understand the preamble, “[a] lithographic printing member directly imageable by laser discharge, the member comprising[.]” to have its plain and ordinary meaning, namely “a lithographic printing member that may be imaged directly by laser discharge, the member including but not limited to [elements ‘a’, ‘b’, and ‘c’].”

The Administrative Law Judge finds that this understanding is confirmed by the specification, which explains that the patent is for —

[l]ithographic printing plates suitable for imaging by means of laser devices that emit in the near-infrared region. Laser output either ablates one or more plate

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layers or physically transforms a surface layer, in either case resulting in an imagewise pattern of features on the plate. The image features exhibit an affinity for ink or an ink-abhesive fluid that differs from that of unexposed areas.

(JX-6 at P004825 (emphasis added).) The specification further explains that “[l]aser output can be provided directly to the plate surface via lenses or other beam-guiding components, or transmitted to the surface of a blank printing plate from a remotely sited laser using a fiber-optic cable.” (*Id.* at 5:14-17.) The specification also discloses a variety of two-, three-, and four-layer embodiments of lithographic printing plates that are suitable for imaging directly by laser discharge. (*Id.* at 4:6-67, 11:46-21:55, Figs. 13A-H.) Based on the foregoing, the Administrative Law Judge finds that a person of ordinary skill in the art would understand that the preamble means “a lithographic printing member that may be imaged directly by laser discharge, the member including but not limited to [elements ‘a’, ‘b’, and ‘c’].”

The extrinsic evidence further supports this finding. Presstek’s expert, Dr. Magee, a person of ordinary skill in the art, testified that the plain and ordinary meaning of the preamble should apply. (Tr. at 243:3-245:2.) He further testified that the preamble language makes clear that claim 20 is not limited to the two layers recited in elements (a)-(c):

Q. And the invention disclosed there was a two-layer photographic printing member, lithographic printing member, correct?

A. Excuse me. The preamble uses the word “comprising,” so I think it can contain two, but it doesn’t limit it to two.

(Tr. at 592:8-13 (Magee).) The Administrative Law Judge finds, based on the intrinsic and extrinsic evidence, that the preamble of claim 20 means “a lithographic printing member that may be imaged directly by laser discharge, the member including but not limited to [elements ‘a’, ‘b’, and ‘c’].”

The Administrative Law Judge rejects Respondents’ argument that even if claim 20 of the ‘338 patent is open-ended, it must recite all of the elements necessary to be a fully operable

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printing plate. Respondents essentially argue that the lithographic printing plate disclosed in claim 20 would have to include something to absorb the laser energy in order to function. (RBr. at 20.) However, claim 20 need not disclose every component necessary to enable operation of a working printing plate.¹⁸ *Rambus Inc. v. Infineon Technologies AG*, 318 F.3d 1081, 1093 (Fed. Cir. 2003). See also *Smith & Nephew, Inc. v. Ethicon, Inc.*, 276 F.3d 1304, 1308-10 (Fed. Cir. 2001) (finding that even though the parties agreed that “any prudent surgeon would assure that an anchor is seated within the bone structure” by performing a “pulling step,” a patent claim having the word “comprising” in the preamble was correctly construed to “neither exclude nor require” such a tug); *Ventana Medical Systems, Inc. v. BioGenex Laboratories, Inc.*, 473 F.3d 1173, 1181 (Fed. Cir. 2006) (when a patent claim includes only some features from the specification, it is improper to limit the claim to other, unclaimed features).¹⁹ The Administrative Law Judge finds that a person of ordinary skill in the art would understand upon reading the entire claim that something in addition to the recited two layers is needed to image the printing member, and would thereby be disposed to look to the patent’s other claims, the specification, or even the prior art described in the file wrapper to add any unrecited elements (such as the addition of ablatively absorptive material to the first layer or in a middle layer) to make the printing member operable. See *Deering v. Winona Harvester Works*, 155 U.S. 286, 302 (1894) (Even if additional elements are necessary to render a device operative, it does not follow that those elements be read into a patent claim for it to be valid because the appropriate

¹⁸ Indeed, Respondents’ argument leads to a specious result, because, by the same token, it would also require that claim 20 include a laser for imaging and a printing device in order for the claimed lithographic printing plate to be ‘fully operable.’

¹⁹ See also *Asyst Technologies, Inc. v. Empak, Inc.*, 268 F.3d 1364, 1371 (Fed. Cir. 2001) (“The fact that a means of transferring data between the second microcomputer means and the second two-way communication means enables the claimed device to work does not mean that the communication line 51 is necessarily part of the claimed structure corresponding to one or the other of those functional limitations. It is well established that ‘it is not necessary to claim in a patent every device required to enable the invention to be used.’”) (quoting *Hughes Aircraft Co. v. United States*, 640 F.2d 1193, 1197 (Ct. Cl. 1980) “*Hughes Aircraft*”) (emphasis added).

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means for making it operative will be understood.); *Hughes Aircraft*, 640 F.2d at 1197-98 (It is not necessary to claim the device required to make a claimed invention operable; instead, the patent specification should provide sufficient information to enable one skilled in the art to practice the invention.). This finding is confirmed by the prosecution history of the '338 patent, as the patent examiner noted that it was already known in the art to use, for example, a dispersion of particles to enhance the ablative characteristics of a silicone coating (top layer). (JX-7 at P000711.)

b) Element 'a' --"a first durable, solid organic polymer layer that is oleophobic or hydrophilic; and"

Presstek argues that the claimed element "a first durable, solid organic polymer layer that is oleophobic or hydrophilic" should be given its plain and ordinary meaning. (CBr. at 42.)

Respondents argue that the "'first durable, solid organic polymer layer that is oleophobic or hydrophilic' must be construed to include IR-absorptive material, so that the top layer may ablatively absorb imaging infrared radiation and the claimed printing member having at least two layers may be directly imageable by laser discharge." (RBr. at 22.)

Staff argues "that Respondents' proposed claim construction is erroneous and the ordinary meaning of the element should be used." (SBr. at 17-18.)

At issue is whether element 'a' should be construed to include infrared-absorptive material. The Administrative Law Judge found, as discussed in Section III.D.1.a) above, that claim 20 is open-ended and may include elements other than those recited in the claim. The Administrative Law Judge further found that it is not necessary for claim 20 to disclose every component, such as infrared-absorptive material, to be operable. A reading of the term within the entire claim reveals that the lithographic printing member has a first layer that is durable, repels oil, and is solid organic polymer. From the plain language of the claim, the

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Administrative Law Judge finds that a person of ordinary skill in the art would understand element 'a' of claim 20 to have the plain and ordinary meaning denoted.

In addition to the plain language of the claim, the specification supports a finding that the plain and ordinary meaning of claim 20 applies. The specification discloses several embodiments that have a first, or topmost, layer "chosen for its affinity for (or repulsion of) ink or an ink adhesive fluid." (JX-6 at 4:27-28, 11:49-12:13, 12:53-17:35; Fig. 13A.) This layer may contain infrared-absorptive material, but is not required to by the specification. (*Id.*) For example, one embodiment discloses a first layer that either attracts or repels ink, a second layer that absorbs infrared radiation, and a substrate under the second layer that has a different affinity for ink than the top layer:

Exposure of the plate to a laser pulse ablates the absorbing second layer, weakening the topmost layer as well. As a result of ablation of the second layer, the weakened surface layer is no longer anchored to an underlying layer, and is easily removed. The disrupted topmost layer (and any debris remaining from destruction of the absorptive second layer) is removed in a post-imaging cleaning step. This, once again, creates an image spot having a different affinity for the ink or ink-adhesive fluid than the unexposed first layer.

Post-imaging cleaning can be accomplished using a contact cleaning device such as a rotating brush (or other suitable means as described in U.S. Pat. No. 5,148,746, commonly owned with the present application and hereby incorporated by reference). Although post-imaging cleaning represents an additional processing step, the persistence of the topmost layer during imaging can actually prove beneficial. Ablation of the absorbing layer creates debris that can interfere with transmission of the laser beam (e.g., by depositing on a focusing lens or as an aerosol (or mist) of fine particles that partially blocks transmission). The disrupted but unremoved topmost layer prevents escape of this debris.

(*Id.* at 4:27-54 (emphasis added).) As the specification explains, a printing plate may benefit from having a top layer that does not contain infrared-absorptive material because a non-absorptive top layer can block debris that might otherwise interfere with operation of the laser. The extrinsic evidence further supports this finding. Presstek's expert, Dr. Magee, a person of

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ordinary skill in the art, testified that the plain and ordinary meaning of element 'a' should apply. (Tr. at 243:3-245:2.) Based on the foregoing, the Administrative Law Judge finds that a person of ordinary skill in the art would understand element 'a' of claim 20 to have its plain and ordinary meaning and would conclude that this element may contain, but does not require, infrared-absorptive material.

The Administrative Law Judge rejects Respondents' argument that the doctrine of claim differentiation requires a finding that the layer disclosed in element 'a' must include infrared-absorptive material. Respondents argue that if the claim were not so defined, the use of a third (unrecited) infrared absorptive layer to make the invention claimed in claim 20 would run afoul of dependent claim 21. (RBr. at 23-24.) According to Respondents, there is only one option for persons of ordinary skill in the art to use the claimed invention if the solid organic polymer layer disclosed in element 'a' is not construed to require infrared-absorptive material: the use of a middle layer containing infrared-absorptive metal oxide. This argument is speculative and not supported by law.

First, for the reasons discussed above, the Administrative Law Judge finds that a person of ordinary skill in the art would conclude that element 'a' of claim 20 may contain, but does not require, infrared-absorptive material. Second, even if a person of ordinary skill in the art were to add an unrecited middle layer with infrared-absorptive material in order to practice the claimed invention, that person would not be limited to using a metal oxide (as claimed in claim 21). For example, the specification discloses that metal borides, carbides, nitrides, and carbonitrides are also suitable infrared-absorbers. (JX-6 at 17:36-56.) Finally, Respondents' reliance on claim differentiation law is misplaced. No party has argued that a person of ordinary skill in the art would understand the language of claim 20 to require a layer of infrared-absorptive metal oxide

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disposed above the substrate; thus the doctrine of claim differentiation is not in issue. *Karlin Technology, Inc. v. Surgical Dynamics, Inc.*, 177 F.3d 968, 971-72 (Fed. Cir. 1999) (“This [claim differentiation] doctrine, which is ultimately based on the common sense notion that different words or phrases used in separate claims are presumed to indicate that the claims have different meanings and scope, normally means that limitations stated in dependent claims are not to be read into the independent claim from which they depend.”) (internal citations omitted).

Also, the Administrative Law Judge finds that Respondents’ argument that an absorbing layer requirement is “essential” to element ‘a’, is not supported by the law. Respondents cite to a Ninth Circuit opinion, one that has never been endorsed by the Federal Circuit, for the proposition that an absorptive layer is essential to the definition of the particular invention that claim is drawn to cover. (RBr. at 26-27 (citing *Pursche v. Atlas Scraper and Engineering Co.*, 300 F.2d 267 (9th Cir. 1961) (“*Pursche*”).) Even assuming that this case were binding authority, Respondents’ arguments are misplaced. The *Pursche* court distinguished between a claim that was incomplete and therefore lacking an “essential” element, such as a claim for a device which omitted one of two rings serving to press a tire against a mold, and claims that need not include all the elements necessary to make up a complete and operative device. *Pursche*, 300 F.2d at 476. While the specification of the ‘338 patent makes clear that “[l]aser output either ablates one or more plate layers or physically transforms a surface layer,” ablative material is not “essential” to the invention as claimed in claim 20. (JX-6 at P004825.) On the contrary, the specification notes that a “key aspect of the present invention lies in use of materials that enhance the ablative efficiency of the laser beam.” (*Id.* at 3:65-67.) The specification further teaches that “IR absorption can be further improved by adding an IR-reflective surface” Thus, the novel aspect of the invention as claimed in claim 20 relates to the material that enhances the ablative

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efficiency of the laser: the infrared reflective surface disclosed in element 'c'. Therefore the Administrative Law Judge finds that the claim is not "incomplete" or lacking an aspect essential to the definition of the particular invention.²⁰ As discussed above with respect to the preamble of claim 20, the Administrative Law Judge finds that a person of ordinary skill in the art would understand that ablative (or other transformative) material, not to mention a laser and a printing press, would be needed to make the lithographic printing member operative, and that such adjuncts are not required in the claim language as a matter of law.

c) Element 'b' – "a solid oleophilic substrate underlying the first layer; wherein"

Presstek argues that the claimed element "a solid oleophilic substrate underlying the first layer" should be given its plain and ordinary meaning. (CBr. at 46.)

Respondents do not provide a proposed construction for this element in their post-hearing brief. (RBr. at 20-30.)

Staff agrees that the ordinary meaning of this element should be used. (SBr. at 18.)

The Administrative Law Judge finds that element 'b' of claim 20 of the '338 patent is not in issue, and therefore its plain and ordinary meaning should apply.

d) Element 'c' – "the substrate comprises means for reflecting imaging radiation."

Presstek argues that the claimed element "the substrate comprises means for reflecting imaging radiation" should be given its plain and ordinary meaning. However, Presstek also notes that it has no objection to Staff's proposed construction, disclosed below. (CBr. at 47, 55.)

²⁰ In contrast, had the claim disclosed an oleophobic layer and omitted an oleophilic layer in a closed claim requiring opposing affinities for ink, perhaps it would lack an "essential" aspect in line with *Pursche*.

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Respondents argue that the claim language *the substrate comprises means for reflecting imaging radiation* “covers materials such as aluminum, aluminum alloy, other metals and dispersed pigments that cause the reflected incident radiation to cause ablation of the absorptive layer that would not have occurred absent the reflective substrate.” (RBr. at 27.)

Staff argues that this claim limitation is written in means-plus-function format, “with the means being the substrate and the function being reflecting imaging IR radiation.” (SBr. at 19.) As a result, the Staff submits that the proper construction for element ‘c’ is “the substrate includes materials, such as aluminum, aluminum alloy, other metals, or dispersed pigments that cause the substrate to reflect imaging IR radiation.” (*Id.* at 20.)

Both Presstek and Staff object to Respondents’ construction, arguing that Respondents have belatedly and improperly adopted a new construction that should be stricken or waived. (CRBr. at 11-12; SRBr. at 2-3, 9-10.) Presstek provides a chart with a side by side comparison of Respondent’s shift in position with respect to element ‘c’:

Claim 20 of the '338 Patent	Respondents' Pre-Hearing Claim Construction	Respondents' Post-Hearing Claim Construction
c. the substrate comprises means for reflecting imaging radiation.	The substrate includes materials, such as aluminum, aluminum alloy, other metals, or dispersed pigments that cause the substrate to <u>reflect imaging IR radiation sufficient to enhance the ablation of the second layer by a significant amount.</u> (BR. 34; RDX-42-1)	This element must cover materials such as aluminum, aluminum alloy, other metals and dispersed pigments that cause the reflected incident radiation to <u>cause ablation of the absorptive layer that would not have occurred absent the reflective substrate.</u> (Br. 4)

(CBr. at 11. *See also* Respondents’ Pre-Hearing Brief at 33-34.) For the reasons discussed in Section III.C.1.e) above, the Administrative Law Judge finds that Respondents have waived their new arguments with respect to the claim language “the substrate comprises means for reflecting

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imaging radiation.” The Administrative Law Judge further finds that Respondents have abandoned their pre-hearing arguments with respect to the claim language “the substrate comprises means for reflecting imaging radiation.”

As Presstek does not object to Staff’s construction, the Administrative Law Judge finds that element ‘c’ is not in issue and that a person of ordinary skill in the art would understand “the substrate comprises means for reflecting imaging radiation” to mean “the substrate includes materials, such as aluminum, aluminum alloy, other metals, or dispersed pigments that cause the substrate to reflect imaging IR radiation.”

2. Claim 21—“The member of claim 20 further comprising a layer of IR-absorptive metal oxide disposed above the substrate.”

Presstek argues that the plain and ordinary meaning should apply for claim 21 of the ‘338 patent. (CBr. at 48.) Presstek is not opposed to the pre-hearing construction set forth by Respondents and Staff. (*Id.*)

Respondents do not provide a proposed construction for claim 21 in their post-hearing brief. (RBr. at 20-30.)

Staff argues that “the proper construction of claim 21 is ‘[a] layer of IR-absorbing metal oxide is interposed between the first layer and the substrate.’” (SBr. at 21.)

As Presstek does not oppose Staff’s proposed construction, the Administrative Law Judge finds that the language of this claim is not in issue and that a person of ordinary skill in the art would understand claim 21 to mean “the member of claim 20 further comprising a layer of IR-absorptive metal oxide interposed between the first layer and the substrate.”

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3. Claim 23—“The member of claim 20 wherein the means for reflecting imaging radiation is a dispersed pigment.”

Presstek argues that the plain and ordinary meaning should apply for claim 23 of the '338 patent. (CBr. at 48.) Presstek is not opposed to the pre-hearing construction set forth by Respondents and Staff. (*Id.*)

Respondents do not provide a proposed construction for claim 23 in their post-hearing brief. (RBr. at 20-30.)

Staff argues that “the proper construction for this limitation is “(t)he IR reflecting material in the substrate is a pigment that is dispersed therein, such as barium sulfate.”” (SBr. at 21-22.)

As Presstek does not oppose Staff’s proposed construction, the Administrative Law Judge finds that the language of this claim is not in issue and that a person of ordinary skill in the art would understand claim 23 to mean “the member of claim 20 wherein the IR reflecting material in the substrate is a pigment that is dispersed therein, such as barium sulfate.”

IV. INFRINGEMENT DETERMINATION

A. Applicable Law

“Determination of infringement is a two-step process which consists of determining the scope of the asserted claim (claim construction) and then comparing the accused product . . . to the claim as construed.” *Certain Sucralose, Sweeteners Containing Sucralose, and Related Intermediate Compounds Thereof*, Inv. No. 337-TA-604, Comm’n Op. at 36 (U.S.I.T.C., April 28, 2009) (citing *Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1454 (Fed. Cir. 1998) “*Litton*”). An accused device literally infringes a patent claim if it contains each limitation recited in the claim exactly. *Litton*, 140 F.3d at 1454. Each patent claim element or limitation is considered material and essential. *London v. Carson Pirie Scott & Co.*, 946 F.2d 1534, 1538

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(Fed. Cir. 1991). In a Section 337 investigation, the complainant bears the burden of proving infringement of the asserted patent claims by a preponderance of the evidence. *Enercon GmbH v. Int'l Trade Comm'n*, 151 F.3d 1376, 1384 (Fed. Cir. 1998).

If the accused product does not literally infringe the patent claim, infringement might be found under the doctrine of equivalents. The Supreme Court has described the essential inquiry of the doctrine of equivalents analysis in terms of whether the accused product or process contains elements identical or equivalent to each claimed element of the patented invention. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 40 (1997). Under the doctrine of equivalents, infringement may be found if the accused product or process performs substantially the same function in substantially the same way to obtain substantially the same result. *Valmont Indus., Inc. v. Reinke Mfg. Co.*, 983 F.2d 1039, 1043 (Fed. Cir. 1993).

B. Analysis of the Accused Plates with Respect to the '737 Patent.

1. Claim 1.

Presstek has accused Respondents of infringement of independent claim 1 and dependent claims 10 and 27 of the '737 patent by the importation, the sale for importation or the sale after importation of the Accused Plates in the United States.

a) Literal Infringement.

Presstek argues that all of the Accused Plates identified in Section I.E. above meet all of the limitations of claim 1 of the '737 patent. The Original VIM Plates and the New VIM Plates were evaluated to determine whether they met the limitations of the asserted claims of the '737 patent. Specifically, the Accused Plates were tested to determine their make-up and the level of transmissivity of the middle, or MMO, layer. (CX-239-40; CX-256-67; CX-346C; CX-351C-354C; CX-496C; CX-556C; CX-582C; CX-587C; CFF 409 (undisputed); CFF 411-62

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(undisputed); CFF 465-469 (undisputed); RX-19C.) In addition, the Accused Plates were evaluated to determine whether their substrates reflect imaging infrared radiation. (CX-238; CX-240-42; CX-244-54; CX-297C-300C; CX-637C; RX-11C at VIM0006698; RX-19C at VIM00016385.) Furthermore, Respondents conceded at the hearing or through admissions that the Accused Plates meet several limitations of the '737 patent. (CFF 190 (undisputed); CFF 192 (undisputed); CFF 194-95 (undisputed); CFF 224 (undisputed); CFF 226 (undisputed); CFF 228 (undisputed); CFF 355 (undisputed); CFF 359 (undisputed); CFF 361 (undisputed); CFF 364 (undisputed); CFF 366 (undisputed); CFF 376 (undisputed); CFF 378 (undisputed); CFF 380 (undisputed); CFF 382-83 (undisputed); CFF 385 (undisputed); CFF 393 (undisputed); CFF 395-96 (undisputed); CFF 398 (undisputed); CFF 407 (undisputed); CFF 495-96 (undisputed); JX-12C, Ex. 6 at 1-2, 6, 8.)

(1) Preamble—*“A lithographic printing member directly imageable by laser discharge, the member comprising”*

The parties do not dispute that all of the Accused Plates meet the preamble of claim 1 of the '737 patent. (CBr. at 80; RBr. at 12, 42-51; SBr. at 45; CFF 105 (undisputed); CFF 148 (undisputed); CFF 151 (undisputed); CFF 357 (undisputed); SFF 58 (undisputed).) Respondents admit that the Accused Plates are lithographic printing plates directly imageable by laser discharge. (CFF 141 (undisputed); CFF 143 (undisputed); CFF 145 (undisputed); CFF 355 (undisputed); CFF 359 (undisputed); RBr. at 12; JX-12C, Ex. 6 at 1; CX 635C at 132:5-16.)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates are lithographic printing plates directly imageable by laser discharge. Therefore, the Administrative Law Judge finds that all of Respondents' Accused

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Plates listed in Section I.E. above meet the preamble of claim 1 of the '737 patent that requires "[a] lithographic printing member directly imageable by laser discharge."

(2) Element 'a' – *"a topmost first layer which is polymeric"*; **Element 'b'** – *"a second layer underlying the first layer"*; **Element 'c'** – *"a substrate underlying the second layer"*

The parties do not dispute that all of the Accused Plates meet elements 'a', 'b', and 'c' of claim 1 of the '737 patent. (CBr. at 80-82; RBr. at 12, 42-51; SBr. at 45-46; CFF 361 (undisputed); CFF 366 (undisputed); CFF 369 (undisputed); CFF 372 (undisputed); SFF 59-64 (undisputed); JX-12C at 26.) Respondents admit that the Accused Plates have a topmost polymeric first layer that is composed of silicone, a second layer underlying the first layer, and a substrate underlying the second layer. (CFF 123 (undisputed); CFF 125 (undisputed); CFF 127 (undisputed); CFF 361 (undisputed); CFF 363-63 (undisputed); RBr. at 12; JX-12C at 26, Ex. 6 at 1-2; CX 635C at 133:6-134:25.)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a topmost first layer which is polymeric, a second layer underlying the first layer, and a substrate underlying the second layer. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates listed in Section I.E. above meet elements 'a', 'b', and 'c' of claim 1 of the '737 patent that require "a topmost first layer which is polymeric," "a second layer underlying the first layer," and "a substrate underlying the second layer."

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(3) Element 'd' – *“the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation”*

The Administrative Law Judge has already found that a person of ordinary skill in the art would conclude that the words “the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation” with respect to this portion of claim 1 mean “the second layer ablatively absorbs imaging infrared radiation and the first layer does not, the second layer also transmitting some amount of imaging infrared radiation.” Essentially, element ‘d’ requires that the second plate layer be subject to ablative absorption of imaging infrared radiation and be partially transmissive to some amount of said radiation. Element ‘d’ also requires that the first layer of the lithographic printing member be formed of a material that is not subject to ablative absorption of imaging infrared radiation.

Presstek argues that the Accused Plates meet all the requirements of element ‘d’ of claim 1. (CBr. at 82-90.)

Respondents make no argument with respect to whether the Accused Plates meet element ‘d’ of claim 1 in their initial post-hearing brief. (RBr. at 42-51.) In their reply brief, Respondents argue that Presstek’s assertion that there is no dispute as to whether the Accused Plates meet the “partially transmissive” limitation is wrong because it is based on Presstek’s claim construction. (RRBr. at 29.)

Staff argues that the evidence shows that the Accused Plates meet all the requirements of element ‘d’ of claim 1. (SBr. at 46-49.)

As Respondents’ arguments are based upon a claim construction position that was waived, as previously discussed, there is little residual dispute that all of the Accused Plates meet element

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'd' of claim 1 of the '737 patent. (CFF 375-376 (undisputed); CFF 386 (undisputed); CFF 388 (undisputed); CFF 505-507 (undisputed in relevant part); CFF 508-511 (undisputed).)

Respondents admit that the Accused Plates have a topmost first layer formed of a material that is not subject to ablative absorption of imaging infrared radiation and a second layer that is subject to ablative absorption of imaging infrared radiation and is also partially transmissive to some of that radiation. (CFF 376 (undisputed); CFF 378 (undisputed); CFF 380 (undisputed); CFF 382-83 (undisputed); CFF 385 (undisputed); CFF 407 (undisputed); CFF 411 (undisputed); SFF 53 (undisputed); SFF 65-69 (undisputed); JX-12C, Ex. 6 at 2; CX 635C at 135:23-137:5.) In particular, it is undisputed that testing on the Accused Plates showed that the middle, or MMO, layer of the Accused Plates is "more than 10% (10-14%) transmissive to infrared radiation." (CFF 411 (undisputed); *see also* CFF 412-471 (undisputed); SFF 68-69 (undisputed in relevant part).)

The '737 patent specification teaches, without limiting claim 1, that for one embodiment a middle layer made of metal transmitting 5-70 percent of infrared radiation is adequately transmissive. (JX-1 at 20:29-39.) Suitable partially transmissive aluminum middle layers for this embodiment are "appreciably thinner than the 200-700 Å thickness useful in a fully reflective layer." (*Id.*; CFF 505-506 (undisputed).) It is undisputed that the middle layer of the Accused Plates is at least 10 percent transmissive, which is well within the range taught in the '737 specification. Furthermore, Respondents admit that the middle layer of the Accused Plates contains a mixture of aluminum metal and aluminum oxide. (CFF 495-96 (undisputed); CFF 509 (undisputed).) Presstek's expert Dr. Magee established through his tests of the Accused Plates and the data in Dr. Brenner's report²¹ that the thickness of 66-84 Å of aluminum in the

²¹ VIM commissioned Dr. Brenner of Technion to perform testing on the Accused Plates. (CFF 508 (undisputed).)

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middle layer of the Accused Plates means that the middle layer is partially transmissive. (CFF 507 (undisputed in relevant part); CFF 510-11 (undisputed).)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a topmost first layer formed of a material that is not subject to ablative absorption of imaging infrared radiation and a second layer both subject to ablative absorption of imaging infrared radiation and partially transmissive to some amount of that radiation. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates listed in Section I.E. above meet element 'd' of claim 1 of the '737 patent that requires "the second layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation."

(4) Element 'e' – *"the first layer and the substrate exhibit different affinities for at least one printing liquid selected from the group consisting of ink and an adhesive fluid for ink"*

The parties do not dispute that all of the Accused Plates meet element 'e' of claim 1 of the '737 patent. (CBr. at 82-83; RBr. at 12, 42-51; SBr. at 50; CFF 392 (undisputed).) Respondents admit that the Accused Plates have a first layer and substrate with different affinities for ink. (CFF 393 (undisputed); CFF 395-96 (undisputed); CFF 398 (undisputed); CFF 400 (undisputed); CFF 402 (undisputed); CFF 404 (undisputed in relevant part); RFF 18 (undisputed in relevant part); RBr. at 12; JX-12C, Ex. 6 at 6; CX 635C at 137:15-25.)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a first layer and substrate with different affinities for ink. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates listed in Section I.E. above meet element 'e' of claim 1 of the '737 patent that requires "the first layer and

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the substrate exhibit different affinities for at least one printing liquid selected from the group consisting of ink and an adhesive fluid for ink.”

(5) Element ‘f’ – *“the substrate comprises a material that reflects imaging infrared radiation”*

The Administrative Law Judge found above that a person of ordinary skill in the art would understand that the claim language “the substrate comprises a material that reflects imaging infrared radiation” with respect to this portion of claim 1 means “the substrate includes reflective material that reflects the partially transmitted radiation back to the overlying radiation absorbing layer.” Essentially, element ‘f’ requires a reflective substrate that reflects imaging infrared radiation back to the middle layer. The ‘737 patent specification discloses, without limiting claim 1, a suitable reflective substrate:

One can also employ, as an alternative to a metal reflecting layer, a layer containing a pigment that reflects IR radiation. Once again, such a layer can underlie layer **408** or **416**, or may serve as substrate **400**. A material suitable for use as an IR-reflective substrate is the white **329** film supplied by ICI Films, Wilmington, DE, which utilizes IR-reflective barium sulfate as the white pigment.

(JX-1 at 19:38:45.)

Presstek argues that the substrate of the Accused Plates is polyethylene terephthalate (“PET”) with barium sulfate that reflects at least 90 percent of incident infrared radiation. (CBr. at 90-92.)

Respondents argue that there is no proof that the substrate of the Accused Plates reflects imaging infrared radiation to “cause ablation of the [middle] absorbing layer that would not otherwise have occurred.” (RBr. at 42-51.)

Staff argues that the substrate of the Accused Plates “comprises PET with barium sulfate particles dispersed therein” and that it reflects incident imaging infrared radiation. (SBr. at 51-52.)

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As Respondents' arguments are based upon a previously undisclosed claim construction that has been waived, as discussed above, there is little dispute that all of the Accused Plates meet element 'f' of claim 1 of the '737 patent. Respondents admit that the substrate of the Accused Plates is made of Melinex 329, which is a PET with barium sulfate. (CFF 189-190 (undisputed); CFF 192 (undisputed); CFF 194-97 (undisputed); CFF 209 (undisputed).) Respondents further admit that barium sulfate is a material that reflects imaging infrared radiation. (CFF 226 (undisputed); CX-633C at 80:8-14, 112:3-12, 219:7-13, 270:22-271:10 (Deposition of Avigdor Bieber ("Bieber")).) Indeed, Respondents' own testing of the substrate of the Accused Plates shows 82 percent reflectance of the imaging infrared radiation at a wavelength of 830 nanometers. (CFF 221-24 (undisputed); RX-11C at VIM0006730; Tr. at 309:6-310:1 (Magee).) The CEO of Hanita confirmed that Hanita tested the substrate of the Accused Plates and found that it is reflective:

Q. Did Dr. Carmi test for the reflectivity of the substrate in the Hanita product?

A. Yes.

Q. Is it reflective?

A. Yes.

Q. What makes it reflective?

A. I believe . . . the components this film is made from,

(CX-631C at 167:13-21 (Deposition of Sason Fluxman ("Fluxman")); CFF 228 (undisputed).)

As further support, Presstek's own testing by its expert Dr. Magee shows that the substrate of the Accused Plates is reflective and reflects imaging infrared radiation back to the middle layer. (CFF 196-97 (undisputed); CX-238; CX-240-42; CX-244-54; CX-297C-300C; CX-637C; Tr. at 291:2-307:21, 462:16-25, 641:12-642:14 (Magee); Tr. at 878:14-879:2 (Carlson).)

The Administrative Law Judge finds that the undisputed evidence shows that each of Respondents' Accused Plates has a reflective substrate that reflects imaging infrared radiation back to the middle layer. Therefore, the Administrative Law Judge finds that all of Respondents'

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Accused Plates listed in Section I.E. above meet element 'f' of claim 1 of the '737 patent that requires "the substrate comprises a material that reflects imaging infrared radiation."

The Administrative Law Judge rejects Respondents' argument that there is no evidence to show that the substrate of the Accused Plates reflects sufficient radiation to cause ablation of the middle layer that, absent substrate reflection, would not have occurred. Claim 1 of the '737 patent does not require that the substrate reflect a particular level of imaging infrared radiation, only that it reflect imaging infrared radiation. (See Section III.C.1.g), above.)

b) The Doctrine of Equivalents

Presstek did not offer any evidence that Respondents' Accused Plates infringe claim 1 of the '737 patent under the doctrine of equivalents. Pursuant to Ground Rules 8(f) and 11.1, Presstek has waived the opportunity to raise this issue. *Endoscopic Probes*, 52-3, n.219.

c) Conclusion

As set forth above, the evidence shows that all of Respondents' Accused Plates meet all of the claim limitations of claim 1 of the '737 patent. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates literally infringe claim 1 of the '737 patent.

2. Claims 10 and 27.

Claims 10 and 27 depend on independent claim 1 of the '737 patent. Inasmuch as each claim limitation must be present in an accused device in order for infringement to be found (either literally or under the doctrine of equivalents), an accused product cannot infringe a dependent claim if it does not practice every limitation of the independent claim from which it depends. See *Monsanto Co. v. Syngenta Seeds, Inc.*, 503 F.3d 1352, 1359 (Fed. Cir. 2007);

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Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 40 (1997). Furthermore, the Federal Circuit has explained:

One may infringe an independent claim and not infringe a claim dependent on that claim. The reverse is not true. One who does not infringe an independent claim cannot infringe a claim dependent on (and thus containing all the limitations of) that claim.

Wahpeton Canvas Co., Inc. v. Frontier, Inc., 870 F.2d 1546, 1552 n.9 (Fed.Cir.1989) (citing *Teledyne McCormick Selph v. United States*, 558 F.2d 1000, 1004 (Ct .Cl. 1977)).

As noted above, all of the Accused Plates have been found to literally infringe independent claim 1 of the '737 patent. (See Section IV.B.1. above.) Therefore, the Administrative Law Judge must now determine whether those Accused Plates that infringe independent claim 1 infringe dependent claims 10 and 27 as well. Presstek does not accuse the New VIM Plates of infringing claim 10, only the Original VIM Plates. (JX-13C at ¶5.) Presstek asserts that all of the Accused Plates infringe claim 27 of the '737 patent. (*Id.*)

a) Literal Infringement

(1) Claim 10: *"The member of claim 1 wherein the substrate is at least 5 mils thick."*

As set forth in Section IV.B.1. above, the Administrative Law Judge found that all of the Accused Plates, including the Original VIM Plates, meet the limitations of claim 1 of the '737 patent.

The parties do not dispute that to the extent Respondents' Original VIM Plates meet claim 1 of the '737 patent they meet the limitations of claim 10 of the '737 patent. (CBr. at 92-93; RBr. at 42-51; SBr. at 53; CFF 517 (undisputed); JX-12C, Ex. 6 at 8.) Respondents VIM and Hanita admit that the substrate of the Original VIM Plates is at least 5 mils thick. (CFF 519-20 (undisputed in relevant part); CFF 522 (undisputed); CFF 524 (undisputed).)

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The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Original VIM Plates are more than 5 mils thick and therefore meet the limitation of claim 10 that requires "[t]he member of claim 1 wherein the substrate is at least 5 mils thick." Accordingly the Administrative Law Judge finds that the Original VIM Plates identified in Section I.E. above infringe claim 10.

(2) Claim 27: *"The member of claim 1 wherein the topmost layer is oleophobic and the substrate is oleophilic."*

As set forth in Section IV.B.1. above, the Administrative Law Judge found that all of the Accused Plates meet the limitations of claim 1 of the '737 patent. In addition, the Administrative Law Judge found that a person of ordinary skill in the art would understand claim 27 to mean "the member of claim 1 wherein the topmost layer repels ink and the substrate accepts ink."

The parties do not dispute that to the extent Respondents' Accused Plates meet claim 1 of the '737 patent they meet the limitations of claim 27 of the '737 patent. (CBr. at 93; RBr. at 12, 42-51; SBr. at 53-54; CFF 528 (undisputed); JX-12C, Ex. 6 at 8.) Respondents admit that the Accused Plates have a topmost layer that repels ink and a substrate that accepts ink. (CFF 155 (undisputed); CFF 157 (undisputed); CFF 163-65 (undisputed); CFF 171 (undisputed); CFF 173-4 (undisputed); CFF 176 (undisputed); CFF 178 (undisputed); CFF 531 (undisputed); RBr. at 12; CX 635C at 141:16-142:20.)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a topmost layer that repels ink and a substrate that accepts ink, and therefore meet the limitation of claim 27 that requires "[t]he member of claim 1 wherein the topmost layer is oleophobic and the substrate is oleophilic." Accordingly the Administrative Law Judge finds that all of the Accused Plates identified in Section I.E. above infringe claim 27.

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b) The Doctrine of Equivalents

Presstek did not offer any evidence that Respondents' Accused Plates infringe claims 10 or 27 of the '737 patent under the doctrine of equivalents. Pursuant to Ground Rules 8(f) and 11.1, Presstek has waived the opportunity to raise this issue.

c) Conclusion.

The evidence shows that all of Respondent's Original VIM Plates meet all of the limitations of claim 10 of the '737 patent and therefore the Administrative Law Judge finds that the Original VIM Plates literally infringe claim 10 of the '737 patent. The evidence further shows that all of Respondents' Accused Plates meet all of the claim limitations of claim 27 of the '737 patent and therefore the Administrative Law Judge finds that the Accused Plates literally infringe claim 27 of the '737 patent.

C. Analysis of the Accused Plates with Respect to the '338 Patent.

1. Claim 20.

Presstek has accused Respondents of infringing independent claim 20 and dependent claims 21 and 23 of the '338 patent by the importation, the sale for importation, or the sale after importation of Accused Plates in the United States.

a) Literal Infringement.

Presstek argues that all of the Accused Plates identified in Section I.E. above meet all of the limitations of claim 20 of the '338 patent. The Original VIM Plates and the New VIM Plates were evaluated to determine whether they met the limitations of the asserted claims of the '338 patent. Specifically, the Accused Plates were tested to determine their makeup and whether imaging infrared radiation is reflected by the substrate of the Accused Plates. (CX-238-42; CX-244-54; CX-256-67; CX-297C-300C; CX-346C; CX-351C-354C; CX-496C; CX-556C; CX-

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582C; CX-587C; CX-637C; CFF 409 (undisputed); CFF 411-62 (undisputed); CFF 465-469 (undisputed); RX-11C at VIM0006698; RX-19C at VIM00016385.) Furthermore, Respondents conceded at the hearing and through admissions that the Accused Plates meet several limitations of the asserted claims of the '338 patent. (CFF 141 (undisputed); CFF 143 (undisputed); CFF 145 (undisputed); CFF 155 (undisputed); CFF 157 (undisputed); CFF-159-165 (undisputed); CFF 169-184 (undisputed); SFF 36-37 (undisputed); SFF 42 (undisputed); RBr. at 12; CX-107; CX-109; JX-12C, Ex. 7 at 1.)

(1) Preamble—*“A lithographic printing member directly imageable by laser discharge, the member comprising”*

The parties do not dispute that all of the Accused Plates meet the preamble of claim 20 of the '338 patent. (CBr. at 54; RBr. at 12, 51-52; SBr. at 38; CFF 105 (undisputed); CFF 148 (undisputed); CFF 151 (undisputed); CFF 357 (undisputed); SFF 36 (undisputed); SFF 58 (undisputed).) Respondents admit that the Accused Plates are lithographic printing plates directly imageable by laser discharge. (CFF 141 (undisputed); CFF 143 (undisputed); CFF 145 (undisputed); CFF 355 (undisputed); CFF 359 (undisputed); RBr. at 12; CX-107 at 3; CX 635C at 145:24-146:11; JX-12C, Ex.7 at 1.)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates are lithographic printing plates directly imageable by laser discharge. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates meet the preamble of claim 20 of the '338 patent that requires “[a] lithographic printing member directly imageable by laser discharge.”

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(2) **Element 'a'** – *“a first durable, solid organic polymer layer that is oleophobic or hydrophilic; and”*

As set forth in Section III.D.1.b) above, the Administrative Law Judge found that a person of ordinary skill in the art would understand element 'a' of claim 20 to have its plain and ordinary meaning and would conclude that this element may contain, but does not require, infrared-absorptive material.

Presstek argues that the Accused Plates meet all of the requirements of element 'a' of claim 20. (CBr. at 54-55.)

Respondents do not discuss specific claim elements in their initial post-hearing brief but generally argue that the Accused Plates do not infringe claim 20 because the “top layer of the [Accused] Plates does not include infrared-absorptive material” (RBr. at 51-52.)

Respondents rely on their claim construction of element 'a' with respect to infringement. (RRBr. at 35-36.)

Staff argues that the evidence shows that the Accused Plates meet all of the requirements of element 'a' of claim 20. (SBr. at 38-39.)

As Respondents' arguments are based upon a claim construction that the Administrative Law Judge has rejected, as discussed above, there is little residual dispute that all of the Accused Plates meet element 'a' of Claim 20 of the '338 patent. (CFF 155 (undisputed); CFF 157 (undisputed); CFF-159-165 (undisputed); SFF 37 (undisputed).) Respondents admit that the silicone top layer of the Accused Plates is durable, solid, and oleophobic:

Q. [The] [s]ilicone layer in the VIM plates, is that oleophobic?

A. It's oleophobic.

Q. It's the top layer in the VIM plate, correct?

A. Correct.

Q. Silicone is an organic polymer, correct?

A. Correct.

Q. Is it solid?

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A. Correct.

Q. Is it durable?

A. Yes.

(CX-633C at 111:9-21 (Bieber Depo.). *See also* CFF 155 (undisputed); CFF 157 (undisputed); CFF-159-165 (undisputed); CX-107 at 3-7.) Accordingly, the Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a first durable, solid organic polymer layer that is oleophobic. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates listed in Section I.E. above meet element 'a' of claim 20 of the '338 patent that requires "a first durable, solid organic polymer layer that is oleophobic or hydrophilic."

(3) Element 'b' – *"a solid oleophilic substrate underlying the first layer; wherein"*

Presstek argues that Respondents admit the Accused Plates meet all of the requirements of element 'b' of claim 20. (CBr. at 55.)

Respondents do not discuss element 'b' in their initial or reply briefing. (RBr. at 51-52; RRBr. at 35-37.)

Staff argues that the evidence shows that the Accused Plates meet all of the requirements of element 'b' of claim 20. (SBr. at 39-40.)

There is little dispute that all of the Accused Plates meet element 'b' of claim 20 of the '338 patent. (CFF 169-184 (undisputed); SFF 42 (undisputed).) Respondents admit that the Accused Plates have a solid oleophilic substrate underlying the first layer:

Q. Okay. Is there an oleophilic substrate in the VIM plates?

A. Oleophilic substrate? Yes.

Q. Is it solid?

A. Yes.

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(CX-633C at 111:22-112:2 (Bieber Depo). *See also* CFF 171 (undisputed); CFF 173-74 (undisputed); CFF 176 (undisputed); CFF 178 (undisputed); CFF 180 (undisputed); CFF 182 (undisputed); SFF 42 (undisputed); CX-107 at 3, 24; CX-109 at 6-7; CX 635C at 154:18-155:11; JX-12C, Ex. 7 at 1.) Accordingly, the Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a solid oleophilic substrate underlying the first layer. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates listed in Section I.E. above meet element 'b' of claim 20 of the '338 patent that requires "a solid oleophilic substrate underlying the first layer."

(4) Element 'c' – *"the substrate comprises means for reflecting imaging radiation."*

The Administrative Law Judge found above that a person of ordinary skill in the art would understand element 'c' to mean "the substrate includes materials, such as aluminum, aluminum alloy, other metals, or dispersed pigments that cause the substrate to reflect imaging IR radiation." The Administrative Law Judge further found that Respondents had waived their new arguments and abandoned their pre-hearing arguments with respect to the claim language "the substrate comprises means for reflecting imaging radiation." *See* Section III.D.1.d) above.

Presstek argues that the Accused Plates have a polyethylene terephthalate ("PET") substrate with barium sulfate dispersed pigments that cause the substrate to reflect imaging IR radiation in accordance with element 'c' of claim 20. (CBr. at 56.)

Relying on their claim construction, Respondents argue that the substrate of the Accused Plates does not reflect sufficient radiation to increase the ablation of the absorptive layer that would not otherwise have occurred. (RBr. at 51-52.)

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Staff argues that the evidence shows that element 'c' is met because the substrate of the Accused Plates contains reflective barium sulfate particles and the parties' tests show that the substrate reflects incident infrared radiation. (SBr. at 41-42.)

As Respondents' arguments are based upon a claim construction that was waived, as noted above, there is little residual dispute that all of the Accused Plates meet element 'c' of claim 20 of the '338 patent. (CFF 189-190 (undisputed); CFF 192 (undisputed); CFF 194-97 (undisputed); CFF 209 (undisputed); SFF 43-44 (undisputed); SFF 45 (undisputed in relevant part); SFF 57 (undisputed).) Respondents admit that the substrate of the Accused Plates is made of Melinex 329, which is a PET with barium sulfate. (CFF 189-190 (undisputed); CFF 192 (undisputed); CFF 194-97 (undisputed); CFF 209 (undisputed).) Respondents further admit that barium sulfate is a pigment that reflects imaging infrared radiation. (CFF 226 (undisputed); SFF 57 (undisputed); CX-633C at 80:8-14, 112:3-12, 219:7-13, 270:22-271:10 (Bieber).) Indeed, Respondents' own testing of the substrate of the Accused Plates shows 82 percent reflectance of the imaging infrared radiation at a wavelength of 830 nanometers. (CFF 221-24 (undisputed); RX-11C at VIM0006730; Tr. at 309:6-310:1 (Magee).) The CEO of Hanita confirmed that Hanita tested the substrate of the Accused Plates and found that it is reflective. (CFF 228 (undisputed); CX-631C at 167:13-21 (Fluxman).) As further support, Presstek's own testing by its expert Dr. Magee shows that the substrate of the Accused Plates is reflective and reflects imaging infrared radiation back to the middle layer. (CFF 196-97 (undisputed); CX-238; CX-240-42; CX-244-54; CX-297C-300C; CX-637C; Tr. at 291:2-310:9, 320:14-321:14; 462:16-25, 641:12-642:14 (Magee); Tr. at 878:14-879:2 (Carlson).)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a substrate with dispersed pigments (barium sulfate) that

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cause the substrate to reflect imaging IR radiation. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates listed in Section I.E. above meet element 'c' of claim 20 of the '338 patent that requires that "the substrate comprises means for reflecting imaging radiation."

The Administrative Law Judge rejects Respondents' argument that there is no evidence to show that the substrate of the Accused Plates does not reflect sufficient radiation to increase the ablation of the absorptive layer that would not otherwise have occurred. Claim 20 of the '338 patent does not require that the substrate reflect a particular amount of imaging IR radiation, only that it reflect such radiation.

b) The Doctrine of Equivalents

Presstek did not offer any evidence that Respondents' Accused Plates infringe claim 20 of the '338 patent under the doctrine of equivalents. Pursuant to Ground Rules 8(f) and 11.1, Presstek has waived any opportunity to raise this issue. *Endoscopic Probes*, at 52-3, n.219.

c) Conclusion

As set forth above, the evidence shows that all of Respondents' Accused Plates meet all of the claim limitations of claim 20 of the '338 patent. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates literally infringe claim 20 of the '338 patent.

2. Claims 21 and 23.

Claims 21 and 23 depend on independent claim 20 of the '338 patent, and therefore must practice all of its limitations. *Monsanto*, 503 F.3d at 1359. As noted above, all of the Accused Plates have been found to literally infringe claim 20 of the '338 patent. (See Section IV.C.1. above.) Therefore, the Administrative Law Judge must now determine whether those Accused

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Plates that infringe independent claim 1 also infringe dependent claims 21 and 23. Presstek asserts that all the Accused Plates infringe these claims.

a) Literal Infringement.

(1) **Claim 21:** *"The member of claim 20 further comprising a layer of IR-absorptive metal oxide disposed above the substrate."*

As set forth in Section IV.C.1. above, the Administrative Law Judge found that all of the Accused Plates meet the limitations of claim 20 of the '338 patent. The Administrative Law Judge further found that a person of ordinary skill in the art would understand claim 21 to mean "the member of claim 20 further comprising a layer of IR-absorptive metal oxide interposed between the first layer and the substrate." See Section III.D.2. above.

The parties do not dispute that to the extent Respondents' Accused Plates meet claim 20 of the '338 patent they meet the limitations of claim 21 of the '338 patent. (CBr. at 58; RBr. at 51-52; SBr. at 43-44.) Respondents, particularly VIM and Hanita, admit that the Accused Plates "have a layer containing a metal and a metal oxide underlying a silicone layer and overlying a substrate." (CFF 247-48 (undisputed); SFF 22 (undisputed); SFF 54 (undisputed); CX-107 at 4, 8; CX-109 at 3-5.) Furthermore, it is undisputed that this metal-metal oxide layer absorbs infrared radiation. (CFF 249 (undisputed); CFF 251-55 (undisputed); CFF 257 (undisputed); SFF 55 (undisputed); CX-107 at 8-9, 14-15; CX-109 at 5-6, 10-11.)

The Administrative Law Judge finds that the undisputed evidence shows that Respondents' Accused Plates have a layer of IR-absorptive metal oxide interposed between the first layer and the substrate. Therefore the Administrative Law Judge finds that all of Respondents' Accused Plates listed in Section I.E. above meet claim 21 of the '338 patent that requires the "member of claim 20 further comprising a layer of IR-absorptive metal oxide disposed above the substrate."

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(2) **Claim 23:** *“The member of claim 20 wherein the means for reflecting imaging radiation is a dispersed pigment.”*

As set forth in Section IV.C.1. above, the Administrative Law Judge found that all of the Accused Plates meet the limitations of claim 20 of the ‘338 patent. The Administrative Law Judge further found that a person of ordinary skill in the art would understand claim 23 to mean “the member of claim 20 wherein the IR reflecting material in the substrate is a pigment that is dispersed therein, such as barium sulfate.” See Section III.D.3. above.

The parties do not dispute that to the extent Respondents’ Accused Plates meet claim 20 of the ‘338 patent they meet the limitations of claim 23 of the ‘338 patent. (CBr. at 59-60; RBr. at 51-52; SBr. at 44-45.) As discussed above with respect to element ‘c’ of claim 20 of the ‘338 patent, Respondents admit that the substrate of the Accused Plates is made of Melinex 329, which is a PET with barium sulfate. (CFF 189-190 (undisputed); CFF 192 (undisputed); CFF 194-97 (undisputed); CFF 209 (undisputed).) Respondents further admit that barium sulfate is a pigment that reflects imaging infrared radiation:

Q. At 830 nanometers are barium sulfate particles reflected – do they reflect part of that energy?

A. If you – if you light them, heat them, light them – light them with 830 nanometer laser, they will reflect.

(CX-633C at 80:8-14 (Bieber). See also *id.* at 112:3-12, 219:7-13, 270:22-271:10 (Bieber); CFF 226 (undisputed); SFF 57 (undisputed).)

The Administrative Law Judge finds that the undisputed evidence shows that each substrate in Respondents’ Accused Plates includes a dispersed pigment, barium sulfate, to reflect IR radiation. Therefore the Administrative Law Judge finds that all of Respondents’ Accused Plates listed in Section I.E. above meet claim 23 of the ‘338 patent that requires the “member of claim 20 wherein the means for reflecting imaging radiation is a dispersed pigment.”

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b) The Doctrine of Equivalents.

Presstek did not offer any evidence that Respondents' Accused Plates infringe claims 21 and 23 of the '338 patent under the doctrine of equivalents. Pursuant to Ground Rules 8(f) and 11.1, Presstek has waived any opportunity to raise this issue. *Endoscopic Probes*, at 52-3, n.219.

c) Conclusion.

The evidence shows that all of Respondents' Accused Plates meet all of the claim limitations of claims 21 and 23 of the '338 patent. Therefore, the Administrative Law Judge finds that all of Respondents' Accused Plates literally infringe claims 21 and 23 of the '338 patent.

D. Indirect & Contributory Infringement

1. Applicable Law

"Whoever actively induces infringement of a patent shall be liable as an infringer." 35 U.S.C. § 271(b). A patentee asserting a claim of inducement must show (i) that there has been direct infringement and (ii) that the alleged infringer "knowingly induced infringement and possessed specific intent to encourage another's infringement." *Minnesota Mining & Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1304-05 (Fed. Cir. 2002). The specific intent requirement for inducement necessitates a showing that the alleged infringer was aware of the patent, induced direct infringement, and that he knew or should have known that his actions would induce actual direct infringement. *DSU Medical Corp. v. JMS Co., Ltd.*, 471 F.3d 1293, 1305 (Fed. Cir. 2006) (en banc in relevant part). The intent to induce infringement may be proven with circumstantial or direct evidence and may be inferred from all the circumstances. *Id.* at 1306; *Broadcom Corp. v. Qualcomm Inc.*, 543 F.3d 683, 699 (Fed. Cir. 2008).

35 U.S.C. § 271(c) sets forth the rules for contributory infringement:

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Whoever offers to sell or sells within the United States or imports into the United States a component of a patented machine, manufacture, combination, or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

35 U.S.C. § 271(c). As explained by the Federal Circuit, in order to succeed on a claim of contributory infringement, complainant must show that respondent “knew that the combination for which its components were especially made was both patented and infringing” and that respondent’s components have “no substantial noninfringing uses.” *Cross Med. Prods., Inv. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1312 (Fed. Cir. 2005) (citations omitted).

2. Indirect Infringement

Presstek argues that Respondent Hanita induced infringement of the asserted claims of the ‘737 and ‘338 patents because Hanita manufactured the middle metal-metal oxide layer of the Accused Plates, which Hanita coated on a white substrate and then provided to Respondent VIM for completion. (CBr. at 111-113.) Presstek further argues that by 2004 Hanita was aware of the asserted patents, that Hanita was aware that third parties had warned VIM in 2004 that the Accused Plates might infringe the asserted patents, and that the Accused Plates were being sold in the United States. (*Id.* at 111-113.)

Respondents do not address induced infringement in their initial post-hearing brief. In their post-hearing reply brief Respondents note that Hanita purchases a commercially available substrate from DuPont Teijin Films but do not directly dispute Presstek’s other allegations relating to induced infringement. (RRBr. at 9.)

Staff argues that the evidence shows that Respondent Hanita “induces or contributes to the infringement” of the ‘737 and ‘338 patents, because the asserted patents have been directly

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infringed, Hanita had knowledge in 2004 that the Accused Plates were covered by the asserted patents, the process used to manufacture the middle metal-metal oxide layer of the Accused Plates is unique and not used for any other products, and Hanita was aware the Accused Plates were sold in the United States. (SBr. at 54-56.)

The undisputed evidence shows that—

- Hanita manufactures and provides VIM with a portion of the Accused Plates for importation and/or sale after importation in the United States (CFF 117 (undisputed); CFF 672 (undisputed in relevant part); CFF 676 (undisputed); JX-13C at ¶¶8-9, 11, 14);
- In 2004 AGFA and Kodak advised VIM that VIM's plates might infringe the '737 and '338 patents (CFF 673-75 (undisputed); CX-54C at 7, 9);
- VIM advised Hanita that VIM's plates might infringe the '737 and '338 patents (CFF 673-75 (undisputed); CX-54C at 7, 9); and
- The process Hanita uses to manufacture the middle metal-metal oxide layer of the Accused Plates is unique and not used as a component for any other product (CFF 677-82 (undisputed); CX-632C at 291:12-293:4, 409:17-410:5 (Fluxman Depo)).

Based on the undisputed evidence, Hanita induced direct infringement by manufacturing and providing VIM with a portion of the Accused Plates, which, in their finished form, have been found to infringe certain claims of the '737 and '338 patents, as discussed above. The Administrative Law Judge finds that Hanita was aware of the '737 and '338 patents and was aware that the Accused Plates might directly infringe these two patents. Hanita knew or should have known that its actions in manufacturing a portion of the Accused Plates and supplying them to VIM for completion would induce actual direct infringement by VIM. Hanita's failure to investigate after learning of possible patent infringement is sufficient circumstantial evidence of Hanita's intent to induce infringement. *Broadcom*, 543 F. 3d at 699-700; *Certain Digital Televisions and Certain Products Containing Same and Methods of Using Same*, Inv. No. 337-TA-617, Comm'n Op. at 7 (U.S.I.T.C., April 23, 2009). Accordingly, the Administrative Law Judge finds that Hanita has induced infringement of the '737 and '338 patents.

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3. Contributory Infringement

Presstek asserts that Hanita is a contributory infringer of the asserted patents under 35 U.S.C. 271(c) because Hanita makes and sells a unique component of the Accused Plates that is not used as a component for any other product. (CBr. at 113-114.)

Respondents do not address contributory infringement in their initial post-hearing brief. In their post-hearing reply brief, Respondents note that Hanita purchases a commercially available substrate from DuPont Teijin Films, but Respondents do not directly dispute Presstek's other allegations relating to contributory infringement. (RRBr. at 9.)

As discussed above with respect to induced infringement, Staff argues that the evidence shows that Respondent Hanita "induces or contributes to the infringement" of the '737 and '338 patents, because the asserted patents have been directly infringed, Hanita had knowledge in 2004 that the Accused Plates were alleged to be covered by the asserted patents, the process used to manufacture the middle metal-metal oxide layer of the Accused Plates is unique and not used for other products, and Hanita was aware the Accused Plates were being sold in the United States.. (SBr. at 54-56.)

None of the parties discusses the most fundamental issue set forth in 35 U.S.C. § 271(c), which is whether Hanita "offers to sell or sells within the United States or imports into the United States" any portion of the Accused Plates. Here, the facts establish that Hanita, outside of the United States, manufactures and applies a metal-metal oxide layer onto a pre-made substrate, then provides this two layer plate to VIM. (JX-13C at ¶¶8, 9, 11.) VIM, still outside the United States, then finishes manufacture of the Accused Plates. (*Id.*) Then VIM sells the completed Accused Plates for importation into the United States. (*Id.* at ¶¶10, 13.) While this activity by Hanita is sufficient to meet Section 337 jurisdictional requirements, as discussed in Section II

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above, the Administrative Law Judge questions whether Hanita meets the strict territorial requirements of 35 U.S.C. § 271(c). The plain language of the statute, which does not include “sale for importation,” indicates that direct interaction with the United States is required. *See e.g. DSU*, 471 F.3d at 1303-04 (finding that “to prevail on contributory infringement, DSU must have shown that ITL made and sold the Platypus, that the Platypus has no substantial non-infringing uses in its closed-shell configuration, that ITL engaged in conduct (made sales) within the United States that contributed to another’s direct infringement, and that JMS engaged in an act of direct infringement on those sales that ITL made in the United States.”) (emphasis added). Accordingly, the Administrative Law Judge finds that Hanita does not contributorily infringe the ‘737 and ‘338 patents.

V. VALIDITY

A. Background

One cannot be held liable for practicing an invalid patent claim. *See Pandrol USA, LP v. AirBoss Railway Prods., Inc.*, 320 F.3d 1354, 1365 (Fed. Cir. 2003). However, patent claims are presumed valid. 35 U.S.C. § 282. A respondent that has raised patent invalidity as an affirmative defense must overcome the presumption by “clear and convincing” evidence of invalidity. *Checkpoint Systems, Inc. v. United States Int’l Trade Comm’n*, 54 F.3d 756, 761 (Fed. Cir. 1995). Further, as stated by the Federal Circuit in *Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co.*:

when a party alleges that a claim is invalid based on *the very same references* that were before the examiner when the claim was allowed, that party assumes the following additional burden:

When no prior art other than that which was considered by the PTO examiner is relied on by the attacker, he has the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more

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examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.

Ultra-Tex Surfaces, Inc. v. Hill Bros. Chem. Co., 204 F.3d 1360, 1367 (Fed. Cir. 2000)

(emphasis added) (quoting *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984) “*American Hoist*”). This “especially difficult” burden is no different when, as is the present case, Respondents attempt to rely on prior art that was before the patent examiner during reexamination. *Glaxo Group Ltd. v. Apotex, Inc.*, 376 F.3d 1339, 1348 (Fed. Cir. 2004) (citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 1323 (Fed. Cir. 1999)).²²

B. Anticipation

A determination that a patent is invalid as being anticipated under 35 U.S.C. § 102 requires a finding, based upon clear and convincing evidence, that each and every limitation is found either expressly or inherently in a single prior art reference. See *Celeritas Techs. Inc. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). Anticipation is a question of fact, including whether a limitation, or element, is inherent in the prior art. *In re Gleave*, 560 F.3d 1331, 1334-35 (Fed. Cir. 2009). The limitations must be arranged or combined the same way as in the claimed invention, although an identity of terminology is not required. *Id.* at 1334 (“the reference need not satisfy an *ipsisimilis verbis* test”); MPEP § 2131.

In addition, the prior art reference’s disclosure must enable one of ordinary skill in the art to practice the claimed invention “without undue experimentation.”²³ *Gleave*, 560 F.3d at 1334-35. A prior art reference that allegedly anticipates the claims of a patent is presumed enabled;

²² See also *Custom Accessories, Inc. v. Jeffrey-Allan Industries, Inc.*, 807 F.2d 955, 961 (Fed. Cir. 1986); *Fromson v. Advance Offset Plate, Inc.*, 755 F.2d 1549, 1555 (Fed. Cir. 1985); *American Hoist*, 725 F.2d at 1364.

²³ This is not to be confused with the standards for enablement to support issuance of a patent claim under 35 U.S.C. § 112. *Gleave*, 560 F.3d at 1334. Respondents erroneously cite to *In re Wands* (see RBr. at 53), which provides guidance on the enablement requirement for issuance of a patent, but not for an anticipatory prior art reference.

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however, a patentee may present evidence of nonenablement to overcome this presumption.

Impax Labs., Inc. v. Aventis Pharmaceuticals Inc., 468 F.3d 1366, 1382 (Fed. Cir. 2006).

“[W]hether a prior art reference is enabling is a question of law based upon underlying factual findings.” *Gleave*, 560 F.3d at 1335.

The Nechiporenko Reference.

Respondents argue that claims 1 and 27 of the '737 patent are invalid as anticipated by the Nechiporenko²⁴ prior art reference. That this reference is prior art under at least 35 U.S.C. § 102(b) is not in dispute. (SFF 104 (undisputed).) At issue is whether Nechiporenko discloses a portion of element 'd' and elements 'e' and 'f' of claim 1, and claim 27. (CBr. at 99.)

Nechiporenko discusses, in a general overview, the investigation of two types of waterless offset plates, including one with a “polymer adhesive (in respect to printing ink) top layer”; a lacquer sublayer; and a metal substrate made, for example, of smooth aluminum foil. (RX-1 at P000360.) Without specifying the essential composition of the materials discussed, the article discloses that the lacquer sublayer may be opaque or semi-opaque. (*Id.* at P000360.) Later in the article, with respect to an opaque lacquer sublayer, Nechiporenko discloses the mechanism for absorption of a laser beam. (*Id.* at P000361.) Immediately following this paragraph, Nechiporenko discusses the results from a “silicone lacquer with heat resistance of the same order of magnitude as that of a polysiloxane but with a higher absorption factor in the wavelength range of laser emission,” equating them with “lacquer coatings with a lower heat resistance, e.g. formulated from bakelite or nitrocellulose lacquers.” (*Id.* at P00361.) In greater detail, the article discloses test results, particularly in Table 1, for “waterless offset printing plates consisting of a metal substrate, bakelite lacquer sublayer and polysiloxane coating”

²⁴ Nechiporenko et al., Direct Method of Producing Waterless Offset Plates By Controlled Laser Beam.

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wherein "the lacquer sublayer is not removed entirely down to the substrate." (*Id.* at P00362.)

Nechiporenko's concern was with the depth and characteristics of depressions created by the CO₂ laser beam (which affected print quality), and thus Nechiporenko focused on the thicknesses and heat resistance of the lacquer sublayer used in the tests:

In offset, printing ink transfer from printing areas over 5 µm deep onto the offset blanket and paper presents difficulties.

* * *

To study quality and rate characteristics of the recording process, the effect of the nature and thickness of the lacquer sublayer . . . [was] investigated. It was established that on waterless offset plates consisting of a metal substrate, bakelite lacquer sublayer and polysiloxane coating, the depth of the depressions in the lacquer sublayer whose thickness ranged from 0 to 7.5 µm does not depend on recording rate, i.e. on the duration of laser beam exposure (see Table 1) and the lacquer sublayer is not removed entirely down to the substrate.

* * *

A similar dependence of the depression depth and width on the sublayer thickness for various durations of laser beam exposure has been obtained for two other lacquer coatings (silicone and nitrocellulose), of a different nature and distinct from bakelite lacquer in heat resistance.

(*Id.* at P000361-62, P000364.) Nechiporenko does not expressly disclose a partially transmissive second layer, or a reflective substrate.

Analysis of Nechiporenko with Respect to the '737 Patent.

1. **Claim 1, Portion of Element 'd':** "*the second layer also being partially transmissive to said radiation*"; and
Element 'f': "*the substrate comprises a material that reflects imaging infrared radiation*"

Respondents argue that Nechiporenko contains all the information one of ordinary skill in the art would need to expressly or inherently understand what was claimed in claims 1 and 27.

(RBr. at 54.) Respondents further argue that Presstek failed to apprise the Examiner of what Nechiporenko discloses, and thus a heightened burden of proof should not apply.²⁵ (*Id.* at 55.)

Respondents further argue that the test data, shown primarily in Nechiporenko Table 1,

²⁵ Respondents do not go so far as to suggest that the clear and convincing evidentiary standard does not apply to them.

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inherently disclose transmission of imaging IR radiation through the lacquer sublayer and reflection of imaging IR radiation by the substrate. (*Id.* at 58-70.) Respondents do not contend that there is any express disclosure in Nechiporenko of elements 'd' and 'f' of claim 1 of the '737 patent.

Presstek argues that Respondents have failed to prove anticipation. Presstek argues that Respondents' arguments ignore the fact that Examiner Funk of the USPTO had thoroughly considered Nechiporenko during reexamination and had found that it did not anticipate the '737 patent. (CBr. at 99.) Presstek further argues that Nechiporenko does not anticipate claim 1 of the '737 patent because Nechiporenko does not disclose elements 'd', 'e', and 'f'. (*Id.*) According to Presstek, Nechiporenko fails to expressly disclose whether any of its plate layers is partially transmissive to infrared radiation because it does not provide sufficient information regarding the specific type of bakelite used in its sublayers for a person of ordinary skill in the art to make them. (*Id.* at 101-02.) As a result, Presstek argues, no imaging IR radiation reaches the substrate to be reflected back, as required by element 'f'.

Staff argues that Respondents by no means show by clear and convincing evidence that Nechiporenko anticipates the '737 patent. Staff argues that the evidence does not demonstrate that Nechiporenko is enabled because it fails to disclose sufficient information about the composition of the bakelite sublayer. (SBr. at 71-72.) According to Staff—

Bakelite is a trademark used to describe "polyethylene, polypropylene, epoxy, phenolic, polystyrene, phenoxy, perylene, polysulfone, ethylene copolymers, ABS, acrylics, vinyl resins and compounds." N. Irving Sax and Richard J. Lewis, Sr., Hawley's Condensed Chemical Dictionary 114 (Eleventh ed. 1987). It is a term that clearly encompasses a broad range of substances and compositions, which presumably have varying degrees of transmissivity. Even Respondents' original expert Dr. Goodman testified that there are many different types of Bakelite, with varying ratios of key components. CX-635C at 131. As Dr. Goodman admitted, the term Bakelite is used generically for an entire family of phenol-based polymer materials. *Id.* Dr. Carmi admitted that he did not know which member of the

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Bakelite family Nechiporenko discussed. Carmi, Tr. at 1041. He further admitted that he was not sure if all Bakelites have the same transmissivity to infrared radiation and that they would not all function identically in a printing plate. Carmi, Tr. at 1065.

(*Id.* at 72-73.) As a result, Staff argues, without knowing what type of bakelite Nechiporenko used, it is impossible to tell whether the lacquer sublayer transmits any radiation at all. (*Id.* at 73-74.) With respect to element 'f' of claim 1, Staff argues that Nechiporenko discussed heating of the substrate in relation to the data in Table 1, but did not discuss reflection of imaging IR radiation. (*Id.* at 75-78.) Staff notes that the testing results reported in Table 1 of Nechiporenko involved an opaque lacquer sublayer, and thus it would not have been transmissive enough for actual reflection to occur. (*Id.*)

The Administrative Law Judge finds that Respondents have failed to show by clear and convincing evidence that Nechiporenko discloses each claim limitation of claims 1 and 27 of the '737 patent. As an initial matter, Nechiporenko was considered during reexamination of the '737 patent (SFF 105 (undisputed)), but Examiner Funk still found the '737 patent to be patentable over the prior art (CFF 90 (undisputed)). Respondents' arguments that they do not have the "especially difficult" burden of invalidating a patent using prior art that was in front of the patent examiner, *see, e.g., Glaxo*, 376 F.3d at 1348, are unavailing in light of the amount of consideration given the reference by Examiner Funk and the following communications in the reexamination file history:

- In its Request for Re-Examination, Presstek stated that reexamination was requested in view of three references, one of them Nechiporenko (JX-4 at P000273);
- Presstek stated that Nechiporenko discloses a "semi-opaque" lacquer sublayer (JX-4 at P000274; SFF 124 (undisputed));
- Examiner Funk considered the reflective nature of the smooth aluminum substrate in Nechiporenko (JX-4 at P000403);
- Presstek and Examiner Funk had a telephonic interview, during which Presstek explained that Nechiporenko contemplates "full absorption of the laser beam before the radiation

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can reach the substrate” because the Nechiporenko tests used a CO₂ laser “emitting at a wavelength that is strongly absorbed by organic layers” such as the lacquer sublayer disclosed. Specifically, Presstek referred to the testing on page 142 of Nechiporenko because the lacquer layer was not fully removed, preventing any laser energy from reaching the substrate to be reflected. Presstek explained that claim 1 was amended to add a partially transmissive middle layer to distinguish Nechiporenko “in terms of both structure and behavior” (JX-4 at P000415); and

- In allowing amended claim 1, Examiner Funk noted that “the limitations that the second layer is partially transmissive to the radiation and that the substrate reflects the radiation, are not taught or suggested by Nechiporenko et al.” (JX-4 at P00422).

Contrary to Respondents’ assertions (RBr. at 55), Presstek advised Examiner Funk that Nechiporenko expressly discloses a semi-opaque lacquer sublayer and pointed out the precise page of Nechiporenko that (i) discusses the test data in Table 1, (ii) contains Table 1, (iii) discusses the “rectangular profile of the printing elements of small thicknesses of the lacquer sublayer,” and (iv) discusses the theory that “a thin sublayer is ‘heated up’ better on both sides.” Examiner Funk is accorded the legal presumption that he possesses expertise in interpreting Nechiporenko, not to mention familiarity with the level of ordinary skill in the art. *American Hoist*, 725 F.2d at 1359. Therefore, the Administrative Law Judge rejects Respondents’ argument that deference should not be given to Examiner Funk’s decision to issue amended claim 1 over Nechiporenko. *Id.* at 1360.

The evidence shows that Nechiporenko does not inherently disclose a second layer transmitting some amount of imaging infrared radiation, and thus the reference does not inherently disclose a substrate with reflective material that reflects the partially transmitted radiation back to the overlying radiation absorbing layer. Nechiporenko does not provide an adequate description to enable one of ordinary skill in the art to create a second layer transmitting some amount of imaging infrared radiation without undue experimentation.

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First, while Nechiporenko discusses the use of an opaque or semi-opaque²⁶ lacquer sublayer, the reference does not make clear whether it refers to any (or all) of the silicone, bakelite, or nitrocellulose lacquer sublayer examples discussed, or even some other lacquer material. (RX-1 at P000360.) On the contrary, the opaque lacquer reference “the output energy of the laser beam is at first absorbed on the surface of the opaque lacquer sublayer” found in the paragraph immediately prior to Nechiporenko’s discussion of silicone, bakelite, and nitrocellulose lacquer sublayers, suggests, at least to Presstek and Staff, that these examples were opaque. (*Id.* at P000361; CBr. at 99 (“Nechiporenko further indicates that the opaque lacquer sublayer may be ‘bakelite lacquer...’”) (emphasis added); SBr. at 75 (“[t]he data in Table 1 of Nechiporenko was derived from tests using the opaque lacquer sublayer. . .”) (emphasis added).) Nechiporenko’s failure to specify the opacity of the lacquer sublayers that were actually used in the testing leaves the article too ambiguous to interpret with certainty.

Second, the more detailed test data on p. 142 of Nechiporenko relates to a plate with a bakelite lacquer sublayer of unknown composition and opacity.²⁷ (*Id.* at P000362.) Bakelite, by all accounts, may refer to many different families of polymers, and thus a person of ordinary skill in the art would be unable to recreate the bakelite sublayer of Nechiporenko.

This finding is confirmed by the testimony of Dr. Carlson:

Q. Dr. Carlson, let's take a look at table 1 of Nechiporenko again.

A. Yes.

²⁶ Opacity should not be confused with transmissivity. “Opacity is generally used with reference to visible light; opacity generally refers to the degree to which visible light passes through a material, rather than the degree to which other sorts of radiation, such as heat or x-rays, pass through it.” (SBr. at 73.) Staff points out that the language in Nechiporenko does not suggest that Nechiporenko used transmissivity and opacity synonymously: “the Staff does not believe that is clear that Nechiporenko used ‘opaque’ to mean ‘non-transmissive to imaging radiation,’ particularly given that when discussing the absorption of energy from a CO2 laser beam, Nechiporenko used the term ‘absorptivity.’” (*Id.* at 73-74.) Presstek argues that Nechiporenko did not provide enough information to determine what it meant by ‘semi-opaque’ and thus opacity should not be used synonymously with transmissivity. (CBr. at 103.) Dr. Carmi argues that the two terms are synonymous, although he warns “that English is not my first language.” (Tr. at 947 (Carmi).)

²⁷ As discussed immediately above, Staff and Presstek believe this bakelite sublayer is opaque. However, the passage in Nechiporenko is silent as to opacity.

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Q. And this table refers to bakelite lacquer sublayer.

A. That's correct.

Q. Okay. What is bakelite?

A. Well, bakelite is a generic name that's come over the years, since it was first discovered slightly after 1900, to not only mean the original polymer that the chemists discovered as the first polymer but to also indicate generically other types of polymers, including polymers where people put fillers or pigments into. So it has come to be, from being a first plastic, to a very broad generic name for polymers and fill polymers.

Q. Do all bakelite materials have the same properties and formulations?

A. No. Just because of the broad association of the word bakelite, it covers many different families of polymers. And even the original polymer that was discovered that you might call the original bakelite before the name broadened in its usage, the formaldehyde-type polymer has many, many different variations, many, many ratios of the product and many different applications where they tailor-make even that type of polymer for it. So it is -- there is many, many variations of the material.

Q. Okay. And what type of bakelite was used in the plates of table 1 of Nechiporenko?

A. There is no information as to which of these thousands of bakelites might have been used in this particular publication.

Q. Okay. Does Nechiporenko provide any information as to the composition, formulation, or materials in the bakelite layers in table 1?

A. No.

Q. Without this information, could you recreate the bakelite layer of Nechiporenko?

A. No.

(Tr. at 1103:11-1105:5 (Carlson) (emphasis added).) This finding is also confirmed by Hawley's Condensed Chemical Dictionary, cited by Staff (SBr. at 72-73); by the testimony of Avigdor Bieber, VIM's CEO (CX-634C at 549:2-7, 550:15-20, 551:5-10, 553:12-16); and by Presstek's expert, Dr. Carmi (Tr. at 1040:2-1041:11 (Carmi)). More particularly, Dr. Carmi could not identify which of the myriad types of bakelite was used for the testing in Nechiporenko:

Q. Do you know which member of this [bakelite] family Nechiporenko is talking about?

A. No.

(Tr. at 1031:16-18 (Carmi).) Likewise, Dr. Carmi could not identify the transmissivity of the various bakelites:

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Q. Dr. Carmi, earlier today you said that bakelite was a series of materials with similar chemical properties, correct?

A. Correct.

Q. Do all of these bakelites have the same transmissivity to infrared radiation?

A. I can't tell.

Q. Sorry, could you please say again?

A. I cannot tell.

Q. Okay. Would they you will have the same transmissivity to light?

A. I cannot tell you that.

(Tr. at 1065:2-13 (Carmi).) Furthermore, Dr. Carmi admitted that bakelite materials do not produce the same results if used in a printing plate:

Q. Would every single bakelite material provide similar results if used in a printing plate?

A. If they are different, probably not. I mean, they are different from each other. The results cannot be identical.

Q. So you are saying that not all bakelites would give you identical results, correct?

A. Yes.

(Tr. at 1065:19-1066:3 (Carmi).) Taking into account the above evidence, as well as Dr. Carmi's admission that he has never worked with bakelite, the Administrative Law Judge cannot credit Dr. Carmi's statement that "it is pretty simple" to recreate bakelite to obtain the same results Nechiporenko obtained. (Tr. at 1067:14-1068:7.)

The Administrative Law Judge finds that a person of ordinary skill would be unable to identify the type or properties of Nechiporenko's bakelite sublayer, and thus would be unable to determine or infer its transmissivity. Therefore, the Administrative Law Judge finds that the Nechiporenko reference does not inherently disclose the portion of element 'd' in independent claim 1 of the '737 patent that requires "the second layer also being partially transmissive to said radiation." Because Nechiporenko does not disclose a transmissive bakelite sublayer, the Administrative Law Judge finds that Nechiporenko does not inherently disclose a substrate with reflective material that reflects the partially transmitted radiation back to the overlying radiation.

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absorbing layer. Accordingly, the Administrative Law Judge finds claim 1 of the '737 patent to be valid.

The Administrative Law Judge rejects Respondents' argument that the test data in Nechiporenko Table 1²⁸ is clear and convincing evidence that a person of ordinary skill in the art would inherently understand that the bakelite sublayer is partially transmissive or that the substrate reflects the partially transmitted radiation back to the bakelite sublayer. First, Examiner Funk had the data in Table 1 in front of him and did not reach the same conclusion as Respondents espouse here. See reexamination history discussion above. Second, Dr. Carlson testified that Table 1 only shows that the metal substrate acted as a heat sink, and that the carbon dioxide ("CO₂") laser radiation did not reach the substrate:

Q. What type of laser is used to image these Nechiporenko plates?

A. It uses a carbon dioxide laser.

Q. Okay. So based on your knowledge of bakelite in general, as well as the teachings of '737 -- I'm sorry, the teachings of Nechiporenko, do you have an opinion as to whether or not the carbon dioxide laser radiation would be partially transmitted through the bakelite layer?

A. No, it is my opinion that, once again, not knowing which of many different types of bakelite there are, but it is my opinion that the carbon dioxide laser radiation would be fully absorbed by the bakelite lacquer layer in the Nechiporenko plates.

²⁸ Nechiporenko notes that the depth of depressions created as the lacquer sublayer was ablated were not dependent upon the duration of CO₂ laser beam exposure. (RX-1 at P000362.) Table 1, reproduced below with a line added by Respondents, shows the depth of depressions in the bakelite sublayer at various recording rates. (*Id.*)

TABLE 1. Effect of Bakelite Lacquer Sublayer Thickness on Depth of Depressions

Thickness of Bakelite Lacquer sublayer (μm)	Depth of depressions (μm) at recording rates (n/min)					
	50	100	150	200	250	300
0	0	0	0	0	0	0
1.7	0.8	0.8	0.8	0.8	0.8	0.8
3.5	2.5	2.5	2.5	2.5	2.5	2.5
4.4	3.5	3.5	3.5	3.5	3.5	3.5
4.5	3.0	5.0	5.0	5.0	5.0	5.0
7.5	6.5	6.5	6.5	6.5	6.5	6.5
8.7	8.0	8.0	7.3	2.6	0.8	0.5
10.0	9.0	9.0	7.0	3.2	1.5	0.8
13.0	12.0	8.0	4.0	3.5	2.4	1.5

Note: the thickness of the polysiloxane layer is 2 μm.

(RBr. at 57.) Nechiporenko found for sublayers thicker than 7.5 μm, that as the CO₂ laser recording rate increased, the depth of depressions decreased. (RX-1 at P000362.)

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Q. And is that based on your general understanding of the properties of bakelite?

A. Well, what I am saying is that organic polymers absorb carbon dioxide laser radiation strongly. There is so many different types of bakelite, you have no idea how strongly the bakelite might be, but it is -- so it is impossible to be specific because of the vagueness and indefiniteness of the word bakelite, as stated in the Nechiporenko.

Q. Does table 1 of Nechiporenko relate to your opinion that Nechiporenko does not disclose a partially transmissive layer?

A. Yes. Well, the bakelite sublayer is never removed fully down to the substrate. And that's further evidence that the laser radiation is being absorbed before it reaches the substrate and it is not getting beyond the fairly thick 3 micron or even at the final results here, the 3 micron or so bakelite sublayer.

Q. Okay. So looking at the information in table 1 of Nechiporenko, is there anything -- is there any information in table 1 that indicates to you whether or not the laser's radiation is partially transmitted?

A. No.

Q. Do you have an opinion whether or not the laser's radiation is partially transmitted through the bakelite layer in table 1?

A. Well, as I just stated, I think the carbon dioxide laser radiation at 10.6 microns is absorbed in this layer and is not partially transmitted through this bakelite sublayer.

Q. Okay. So let's talk about that opinion. Earlier you explained that table 1 shows that the bakelite layer is not entirely removed down to the substrate; is that correct?

A. That's correct.

Q. Okay. And does this have any relation to your opinion on partial transmissivity?

A. Yes, you know, in addition to the strongly absorbing properties of organic polymers, bakelite is certainly in that family. And then the fact that it is not removed down to the aluminum shows that there is a significant thickness of bakelite lacquer that is available throughout all these examples in table 1 to be absorbed, to absorb the carbon dioxide laser radiation.

Q. Why are there no depressions formed in the bottom of the bakelite layers?

A. This is because of the heat-loss effect from heat buildup in that layer. The aluminum, being a very strong conductor of heat, draws the heat away from the entire Nechiporenko construction, the first and the second layer, but, you know, it is particularly strongest in those areas most adjacent to the aluminum plate. So the aluminum plate is basically cooling down, this 3 micron or so bakelite sublayer, while the laser is trying to heat it up. And as we discussed on ablation before, it is a threshold event, and if you don't get the heat up enough to a high enough level, no ablation occurs. And then when the heat is enough and it reaches threshold, then ablation occurs.

Q. Do you have a name for the unablated region in the bakelite layer adjacent to the substrate?

A. Yes, I refer to that as the heat sink zone.

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(Tr. at 1105:6-1108:20 (Carlson) (emphasis added).)

This testimony by Dr. Carlson is consistent with Nechiporenko's focus on the heat resistant qualities of the lacquer sublayers tested, and with Nechiporenko's theory that a thin sublayer is heated up better than a thick sublayer because of the "higher thermal conductivity" of the metal substrate. (RX-1 at P000364.) At the hearing, Dr. Carmi confirmed that Nechiporenko's reference to heating means "increasing the temperature," and that Nechiporenko's reference to thermal conductivity refers to the heat sink, not to any reflectivity. (Tr. at 1072:6-7, 1072:12-21.) Dr. Carmi also admitted that a possible "mechanism" for explaining the data in Table 1 is that as the bakelite layer was heated by the CO₂ laser, the heat was propagated by conductance to the bottom of the depression, causing ablation there. (Tr. at 972.) According to Dr. Carmi, "[t]he energy of the laser was absorbed by the bakelite layer underneath, and the heat was propagating up or propagating all directions, but also up, and caused the evaporation [of the non-absorptive polysiloxane top layer.]" (*Id.* at 982:23-983:3 (emphasis added).) Thus a person of ordinary skill in the art would have understood that heat alone (as opposed to laser radiation) was not only traveling up to the polysiloxane top layer, but also down to the metal substrate. The Administrative Law Judge finds that a person of ordinary skill in the art would likely understand Table 1 to show the effects of a heat sink, and thus Respondents do not demonstrate by clear and convincing evidence that a person of ordinary skill in the art would understand Table 1 to inherently disclose partial transmissivity of the lacquer sublayer or any reflectance of the imaging CO₂ laser beam.

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2. Claim 1, Element 'e': *"the first layer and the substrate exhibit different affinities for at least one printing liquid selected from the group consisting of ink and an adhesive fluid for ink"*

With respect to element 'e' of claim 1, Respondents argue that the polysiloxane top layer repels ink and the aluminum metal substrate attracts ink. (RBr. at 72.) Thus, Respondents argue that the plates disclosed by Nechiporenko exhibit different affinities for ink. (*Id.*)

Presstek argues that the polysiloxane layer and metal substrate of Nechiporenko do not exhibit different affinities for ink, as required by element 'e' of claim 1, because the "lacquer sublayer is not removed entirely down to the substrate." (CBr. at 104.) Thus, ink never touches the substrate, and the substrate's affinity for ink is never exhibited. (*Id.*)

Staff disagrees with Presstek that Nechiporenko does not disclose element 'e' of claim 1. On the contrary, Staff argues that aluminum and polysiloxane are known to have opposing affinities for ink, and thus it is irrelevant whether ink actually reaches the substrate. (SBr. at 76-77.)

The Administrative Law Judge rejects Presstek's arguments that Nechiporenko fails to disclose a first layer and a substrate exhibiting different affinities for ink, as required by element 'e' of claim 1 of the '737 patent. Both Respondents and Staff argue, and Presstek's expert, Dr. Carlson admits (Tr. at 1100:23), that polysiloxane is oleophobic. (*See also* CRRFF 142 ("Presstek does not dispute that polysiloxane, by itself, repels ink. . .").) While Nechiporenko expressly discloses a "polymer adhesive (in respect to printing ink) top layer," the reference also indicates that this is the coating for the "non-image areas on a waterless offset plate." (RX-1 at P000360.) Respondents' expert, Dr. Carmi, explains that while this language discloses a layer accepting ink, it appears to be an error:

Q. You have earlier testified that the top layer, the polysiloxane coating in Nechiporenko, is oleophobic; is that correct?

A. Yes.

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Q. Do you see where it says, “the polymer adhesive in respect to the printing ink top layer”?

A. Yes.

Q. What does “polymer adhesive in respect to printing ink” mean?

A. Yeah, as I say, that's a mistake. It should be adhesive,²⁹ which is repelling ink.

Q. Okay. But as it reads right now, does it mean accepting ink?

A. The way it is written right now, it won't work as a printing plate because both the image and the nonimage part would be the same affinity. So you won't get an image on the paper.

Tr. at 1077:21-1078:14 (Carmi) (emphasis added). Nechiporenko appears to teach away from a plate with a top layer and substrate with differing affinities for ink, as the Nechiporenko testing data shows that the ablation of the lacquer sublayer never reached the level of the aluminum foil substrate. (RX-1 at P000362; Tr. at 1095:2-4 (Carlson)). However, this is not determinative, as aluminum foil is inherently oleophilic. (Tr. at 1011:8-12, 1080:4-10 (Carmi); CRRFF 142 (“Presstek does not dispute that . . . aluminum, by itself, attracts ink.”).) *Accord Smithkline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1345 (Fed. Cir. 2005). As a result, the Administrative Law Judge finds that the evidence clearly and convincingly shows that a person of ordinary skill in the art would understand that the language “polymer adhesive (in respect to printing ink) top layer” is erroneous, and that the top layer and substrate of the plates disclosed in Nechiporenko inherently have different affinities for ink.

3. Claim 27: “The member of claim 1 wherein the topmost layer is oleophobic and the substrate is oleophilic”

Respondents argue that Nechiporenko inherently discloses an oleophobic polysiloxane top layer and an oleophilic substrate. (RBr. at 72.)

Presstek argues, as with element ‘e’, Nechiporenko cannot invalidate claim 27 of the ‘737 patent because the substrate never “accepts ink.” (CBr. at 106.) According to Presstek, because

²⁹ Dr. Carmi appears to state that ‘adhesive’ is a mistake and should instead be ‘adhesive.’ It is unlikely that Dr. Carmi meant to say the same word. This may be an error in the transcript: more likely Dr. Carmi said that ‘adhesive’ should be ‘abhesive.’ An abhesive surface tends to be repellent or slippery.

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the lacquer sublayer is not removed entirely down to the substrate, ink never touches the substrate; thus, the substrate's oleophilic nature is never exhibited. (*Id.* at 104.)

Staff argues that while Respondents have shown that the top layer disclosed in Nechiporenko is oleophobic and the substrate is oleophilic, they have not demonstrated that Nechiporenko discloses all of the elements of claim 1 of the '737 patent. (SBr. at 78.) As a result, Staff concludes that Nechiporenko does not anticipate claim 27. (*Id.*)

The Administrative Law Judge finds, for the same reasons as with element 'e' of claim 1, discussed immediately above, that Nechiporenko inherently discloses a polysiloxane top layer that is oleophobic and an oleophilic aluminum substrate. However, the Administrative Law Judge also found above that Nechiporenko does not disclose elements 'd' and 'f' of claim 1, and therefore Nechiporenko cannot anticipate claim 27. Accordingly, the Administrative Law Judge finds claim 27 of the '737 patent to be valid.

C. Obviousness

Under 35 U.S.C. § 103(a), a patent is valid unless "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made" to a person having ordinary skill in the art. 35 U.S.C. § 103(a). The ultimate question of obviousness is a question of law, but "it is well understood that there are factual issues underlying the ultimate obviousness decision."

Richardson-Vicks Inc. v. Upjohn Co., 122 F.3d 1476, 1479 (Fed. Cir. 1997) (citing *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966) ("*Graham*")).

After claim construction, "[t]he second step in an obviousness inquiry is to determine whether the claimed invention would have been obvious as a legal matter, based on underlying factual inquiries including: (1) the scope and content of the prior art, (2) the level of ordinary

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skill in the art, (3) the differences between the claimed invention and the prior art; and (4) secondary considerations of non-obviousness.” *Smiths Indus. Med. Sys., Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1354 (Fed. Cir. 1999) (citing *Graham*, 383 U.S. at 17). The existence of secondary considerations of non-obviousness does not control the obviousness determination: a court must consider “the totality of the evidence” before reaching a decision on obviousness. *Richardson-Vicks*, 122 F.3d at 1483.

The Supreme Court recently clarified the obviousness inquiry in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 389 (2007) (“*KSR*”). The Supreme Court said:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill. *Sakraida* and *Anderson’s-Black Rock* are illustrative—a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions.

Following these principles may be more difficult in other cases than it is here because the claimed subject matter may involve more than the simple substitution of one known element for another or the mere application of a known technique to a piece of prior art ready for the improvement. Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit.

* * *

The obviousness analysis cannot be confined by a formalistic conception of the words teaching, suggestion, and motivation, or by overemphasis on the importance of published articles and the explicit content of issued patents. The diversity of inventive pursuits and of modern technology counsels against limiting the analysis in this way. In many fields it may be that there is little discussion of obvious techniques or combinations, and it often may be the case that market demand, rather than scientific literature, will drive design trends. Granting patent protection to advances that would occur in the ordinary course without real

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innovation retards progress and may, in the case of patents combining previously known elements, deprive prior inventions of their value or utility.

KSR, 550 U.S. at 417-19.

The Federal Circuit has since held that when a patent challenger contends that a patent is invalid for obviousness based on a combination of several prior art references, “the burden falls on the patent challenger to show by clear and convincing evidence that a person of ordinary skill in the art would have had reason to attempt to make the composition or device, or carry out the claimed process, and would have had a reasonable expectation of success in doing so.”

PharmaStem Therapeutics, Inc. v. ViaCell, Inc., 491 F.3d 1342, 1360 (Fed. Cir. 2007) (citations omitted).

The TSM³⁰ test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence--teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)--that arise before the time of invention as the statute requires. As *KSR* requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans.

Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc., 520 F.3d 1358, 1365 (Fed. Cir. 2008).

Claim 10: “The member of claim 1 wherein the substrate is at least 5 mils thick.”

Respondents argue that claim 10 of the ‘737 patent is obvious in light of the prior art, namely Nechiporenko and U.S. Patent No. 4,132,168 (the “168 patent”).

As an initial matter, the private parties submitted scanty briefing (one page each) on the issue of obviousness. Neither they, nor Staff, discussed or presented any facts relating to secondary considerations of non-obviousness. As a result, the Administrative Law Judge will respond to those issues raised by the parties and will consider all other considerations with respect to obviousness waived. The scope and content of Nechiporenko was evaluated in detail

³⁰ TSM means teaching, suggestion, motivation.

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in Section V.B. above. The '168 patent discloses pre-sensitized planographic printing plates, including one with "[a]n anodized and silicated 8 mil aluminum base." (RX-4 at 1:58-59, 2:56-58.) The level of ordinary skill in the art, which was also given no shrift by the private parties in their post-hearing briefing, was determined in Section III.B. above. The differences between the claimed invention and the prior art are discussed below.

Respondents argue that Nechiporenko discloses all of the limitations of claim 1 (*see* Section V.B. above), and that the '168 patent discloses a laser-imageable printing plate having a substrate that is at least 5 mils thick. (RBr. at 75.) Specifically, Respondents argue that use of substrate at least 7 mils thick was well known to one of ordinary skill in the art, and that "Dr. Carmi concluded that it would have been obvious to one of ordinary skill in the art to use a substrate of 5 mil or more, in light of Nechiporenko and the '168 patent." (*Id.*)

Presstek argues that Nechiporenko and the '168 patent fail to render claim 10 of the '737 patent obvious. (CBr. at 105.) Presstek argues that both Nechiporenko and the '168 patent were before the examiner during prosecution of the '737 patent, so there is a strong presumption that claim 10 is valid. (*Id.*) Presstek further argues that because Nechiporenko does not disclose all the elements of claim 1, the combination of Nechiporenko and the '168 patent cannot invalidate claim 10. (*Id.*) Presstek does not discuss whether it would have been obvious to one of ordinary skill in the art to use a substrate of 5 mils or more at the time the invention was made.

Staff argues that Nechiporenko does not disclose several limitations in claim 1, which are also not found in the '168 patent. (SBr. at 79-80.) Thus Staff concludes that the two references cannot render claim 10 of the '737 patent obvious. (*Id.*) Staff notes, however, that the '168 patent appears to discuss a lithographic printing plate with a substrate thicker than 5 mils. (*Id.* at 80.)

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The Administrative Law Judge finds that Respondents have failed to show by clear and convincing evidence that claim 10 of the '737 patent is obvious in light of Nechiporenko and the '168 patent. The two references were considered by the patent examiner during the prosecution of the '737 patent, but the examiner still found claim 10 to be patentable. (CFF 661 (undisputed).) *See also Ultra-Tex*, 204 F.3d at 1367. As discussed above in Section V.B., the evidence also shows that Nechiporenko fails to disclose elements 'd' and 'f' of claim 1 of the '737 patent and therefore this reference cannot render claim 10 obvious. Therefore, the Administrative Law Judge finds that Respondents have failed to meet their burden of showing by clear and convincing evidence that claim 10 of the '737 patent is invalid for obviousness. Accordingly, the Administrative Law Judge finds that claim 10 of the '737 patent is valid.

VI. WAIVER OR WITHDRAWAL OF RESPONDENTS' OTHER DEFENSES.

1. Enforceability, '338 Patent.

At the hearing, Respondents withdrew their defense that the '338 patent is unenforceable due to inequitable conduct. (CFF 337-339 (undisputed); CBr. at 66; SBr. at 82; Tr. at 1081-82.)

2. Enforceability, '737 Patent.

In the post-hearing briefing, Respondents did not re-assert their defense that the '737 patent is unenforceable due to inequitable conduct. (CRBr. at 30. *See also* ROCCL 8.) Under Ground Rule 11.1, this defense is deemed abandoned or withdrawn.

3. Validity, '338 Patent.

At the hearing, Respondents withdrew all of their defenses that claim 20 of the '338 patent is invalid. (CFF 335-337 (undisputed); CBr at 66; Tr. at 1082-83.)

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4. Validity, '737 Patent.

At the hearing, Respondents withdrew their defense that the '737 patent is invalid based upon reference USSR Patent No. 962,000. (Tr. at 1083.)

5. Respondents' Remaining Defenses.

Respondents' Answer to the Amended Complaint contains a number of defenses and arguments that were not raised in their Pre-Hearing Statement, discussed at the hearing, or raised in post-hearing briefing. (SBr. at 86.) These defenses include failure to state a claim, lack of an unfair act, patent misuse, and the defense that the relief requested by Presstek is not in the public interest. (JX-12C at 43-44.) Under Ground Rules 8(f) and 11.1, these defenses and arguments are deemed abandoned or withdrawn.

VII. DOMESTIC INDUSTRY

As stated in the Notice of Investigation, a determination must be made as to whether an industry in the United States exists as required by subsection (a)(2) of Section 337. Section 337 declares unlawful the importation, the sale for importation or the sale in the United States after importation of articles that infringe a valid and enforceable U.S. patent "only if an industry in the United States, relating to articles protected by the patent . . . concerned, exists or is in the process of being established." 19 U.S.C. § 1337(a)(2); *Certain Ammonium Octamolybdate Isomers*, Inv. No. 337-TA-477, Comm'n Op. at 55 (U.S.I.T.C., Jan. 2004) ("*Certain Isomers*"). The domestic industry requirement consists of both an economic prong (*i.e.*, the activities of, or investment in, a domestic industry) and a technical prong (*i.e.*, whether complainant practices its own patents). *Certain Isomers*, at 55. The complainant bears the burden of proving the existence of a domestic

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industry. *Certain Methods of Making Carbonated Candy Products*, Inv. No. 337-TA-292, Comm'n Op. at 34-35, Pub. No. 2390 (U.S.I.T.C., June 1991).

Thus, in this Investigation Presstek must show that it satisfies both the technical and economic prongs of the domestic industry requirement with respect to the '737 and '338 patents. As noted, and as explained below, it is found that these domestic industry requirements have been satisfied.

A. Technical Analysis

A complainant in a patent-based Section 337 investigation must demonstrate that it is practicing or exploiting the patents at issue. See 19 U.S.C. § 1337(a)(2) and (3); *Certain Microsphere Adhesives, Process for Making Same, and Products Containing Same, Including Self-Stick Repositionable Notes*, Inv. No. 337-TA-366, Comm'n Op. at 8, Pub. No. 2949 (U.S.I.T.C., January 16, 1996). "In order to satisfy the technical prong of the domestic industry requirement, it is sufficient to show that the domestic industry practices any claim of that patent, not necessarily an asserted claim of that patent." *Certain Isomers, supra*, at 55. Fulfillment of the "technical prong" of the domestic industry requirement is not determined by a rigid formula but rather by the articles of commerce and the realities of the marketplace. *Certain Diltiazem Hydrochloride and Diltiazem Preparations*, Inv. No. 337-TA-349, Initial Determination at 139; Pub. No. 2902 (U.S.I.T.C., June 1995) (unreviewed in relevant part); *Certain Double-Sided Floppy Disk Drives and Components Thereof*, Inv. No. 337-TA-215, Views of the Comm'n, Additional Views of Chairwoman Stern on Domestic Industry and Injury at 22, 25, Pub. No. 1860 (U.S.I.T.C., May 1986).

The test for claim coverage for the purposes of the technical prong of the domestic industry requirement is the same as that for infringement. *Certain Doxorubicin and*

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Preparations Containing Same, Inv. No. 337-TA-300, Initial Determination at 109, 1990 WL 710463 (U.S.I.T.C., May 21, 1990), *aff'd*, Views of the Commission at 22 (October 31, 1990).

“First, the claims of the patent are construed. Second, the complainant’s article or process is examined to determine whether it falls within the scope of the claims.” *Id.* The technical prong of the domestic industry can be satisfied either literally or under the doctrine of equivalents.

Certain Dynamic Sequential Gradient Compression Devices and Component Parts Thereof, Inv. No. 337-TA-335, Initial Determination at 44, Pub. No. 2575 (U.S.I.T.C., November 1992).

1. ‘737 Patent.

Presstek argues that its PearlDry, PearlDry Plus, and ProFire Digital Media Printing Plates (the “Presstek Plates”) practice all of the elements of claims 1, 10 and 27 of the ‘737 patent. (CBr. at 93.) It is undisputed that the Presstek Plates have the same construction of a top silicone layer, “MMO” layer made of titanium and titanium oxide, and white substrate made of PET containing barium sulfate. (CFF 263-65 (undisputed).)

Respondents argue, however, that “the Presstek Plates do not practice either the ‘partially transmissive’ or ‘reflects imaging infrared radiation’ limitations of claim 1 of the ‘737 patent, as those terms are properly construed.” (RBr. at 38-41.)

Staff argues that the Presstek Plates practice claim 1 of the ‘737 patent, satisfying the technical prong of the domestic industry requirement. (SBr. at 59-62.)

Whether the Presstek Plates meet the preamble and elements ‘a’, ‘b’, ‘c’, and ‘e’ of claim 1 of the ‘737 patent is not in issue. (CFF 105 (undisputed); CFF 535-37 (undisputed).) At issue is whether the Presstek Plates meet elements ‘d’ and ‘f’ of claim 1, claim 10 and claim 27.

As set forth above in Section III.C.1., the Administrative Law Judge found with respect to claim 1 that a person of ordinary skill in the art would understand element ‘d’, “the second

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layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation,” to mean “the second layer ablatively absorbs imaging infrared radiation and the first layer does not, the second layer also transmitting some amount of imaging infrared radiation.” The Administrative Law Judge further found that a person of ordinary skill in the art would understand that the claim language of element ‘f’, “the substrate comprises a material that reflects imaging infrared radiation,” means “the substrate includes reflective material that reflects the partially transmitted radiation back to the overlying radiation absorbing layer.” With respect to claim 10, the Administrative Law Judge found that the plain and ordinary meaning of “[t]he member of claim 1 wherein the substrate is at least 5 mils thick” should apply. The Administrative Law Judge also found that a person of ordinary skill in the art would understand claim 27 to mean “the member of claim 1 wherein the topmost layer repels ink and the substrate accepts ink.”

The Administrative Law Judge finds that Presstek has established, by a preponderance of the evidence, that the titanium-titanium oxide second layer of the Presstek Plates ablatively absorbs imaging infrared radiation and the silicone top layer does not. (CFF 543-550 (undisputed); CFF 554 (undisputed); CX-281; Tr. at 477:18-481:17 (Magee).) The Administrative Law Judge further finds that the titanium-titanium oxide second layer also transmits approximately 20 percent of imaging infrared radiation at a wavelength of 830 nanometers. (CFF 556 (undisputed); CFF 563 (undisputed in relevant part); CFF 571-72 (undisputed in relevant part); Tr. at 483:10-492:23 (Magee); CX-306C-CX-313C.) Thus, the Presstek Plates meet the limitation of element ‘d’ of claim 1 which requires that “the second

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layer is formed of a material being subject to ablative absorption of imaging infrared radiation and the first layer is not, the second layer also being partially transmissive to said radiation.”

The Administrative Law Judge also finds that the substrate of the Presstek Plates is made of PET and contains reflective barium sulfate that reflects approximately 90 percent of the partially transmitted radiation back to the second layer. (SFF 84 (undisputed); Tr. at 232:1-235:7, 494:14-496:18 (Magee); CX-291C; CX-289C at P018650; CX-290C. *See also* RBr. at 39 (conceding that Dr. Magee established on direct examination “that the Presstek plates are composed of a material (PET with barium sulfate) that possesses a reflectivity of ‘90 percent or over’ at 830nm”).) As a result, the Presstek Plates meet the limitation of element ‘f’ of claim 1 which requires that “the substrate comprises a material that reflects imaging infrared radiation.” Therefore, the Administrative Law Judge finds that the evidence shows that the Presstek Plates meet all of the limitations of claim 1 of the ‘737 patent.

The Administrative Law Judge further finds that the Presstek Plates meet the claim limitations of claims 10 and 27 of the ‘737 patent. Specifically, the Administrative Law Judge finds that the Presstek Plates have an oleophilic substrate that is 7 mils thick, and an oleophobic silicone polymer top layer. (SFF 85 (undisputed); SFF 87-89 (undisputed); CFF 547-48 (undisputed); Tr. at 493:17-494:8, 497:1-499:4 (Magee); CX-289C at P018650.) Therefore, the Administrative Law Judge finds that the Presstek Plates meet the limitations of claim 10, which requires “[t]he member of claim 1 wherein the substrate is at least 5 mils thick,” and claim 27, which requires “[t]he member of claim 1 wherein the topmost layer is oleophobic and the substrate is oleophilic.”

Accordingly, the Administrative Law Judge finds that the Presstek Plates satisfy the technical prong of the domestic industry requirement with respect to the ‘737 patent.

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The Administrative Law Judge rejects Respondents' argument that only evidence of domestic industry at the time of, or prior to, the filing of the Complaint may be considered. In part, Respondents dispute Dr. Magee's transmissivity and reflectivity testing because it "is either dated in August 2008, months after the Complaint here was filed, or is undated, and thus cannot be shown to have been performed before this Investigation commenced." (RRBr. at 28.) Citing *Certain Ink Cartridges and Components Thereof*, Inv. No. 337-TA-565, Initial Determination, 2007 ITC LEXIS 504 at *463, Respondents assert that post-complaint testing is "unavailing" because the existence of a domestic industry is measured at the time a complaint is filed. (*Id.*; RBr. at 37-38.)

Respondents do not fully portray Commission precedent with respect to domestic industry. The Commission has used the end of discovery as the cut-off point for satisfaction of the domestic industry requirement, and not just the filing date of a complaint. See *Certain Short-Wavelength Light Emitting Diodes, Laser Diodes and Products Containing Same*, Inv. No. 337-TA-640, Order No. 16 at 19 (U.S.I.T.C., June 18, 2008) (citing *Certain Concealed Cabinet Hinges*, 337-TA-289, Commission Opinion at 21 for the holding that "we assess the existence of the domestic industry as of the discovery cutoff date prior to the evidentiary hearing"). Also, the opinion that Respondents rely on, *Certain Ink Cartridges and Components Thereof*, cites to *Bally/Midway Mfg. Co. v. Int'l Trade Comm'n* for its support. The Federal Circuit held in that case that *under the circumstances* it was appropriate to measure the domestic industry at the time the complaint was filed. *Bally/Midway Mfg. Co. v. Int'l Trade Comm'n*, 714 F.2d 1117, 1121-22 (Fed. Cir. 1983). This was because the domestic industry had already been destroyed by the investigation's target date. Therefore the court held "in the circumstances of this case the proper date for determining whether Bally's Rally-X game constituted an 'industry' entitled to

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protection under section 337 was the date on which the complaint was filed” *Id.* The rationale for the Federal Circuit’s ruling was to expand the scope of the domestic industry requirement, not limit it. *Id.* Furthermore, as Staff points out, “the technical prong of domestic industry is usually a matter for expert analysis and testimony. As is well known, the private parties often do not retain their experts until some time after the investigation has commenced, a practice which would be impossible if complainants were required to perform all technical testing for domestic industry before the complaint is filed.” (SRBr. at 14-15.) The Administrative Law Judge finds that the Magee testing, even if it occurred during discovery, may be considered for purposes of establishing a domestic industry in the United States.

2. ‘338 Patent.

Presstek argues that the Presstek Plates practice all the elements of claims 20, 21 and 23 of the ‘338 patent. (CBr. at 60.) As discussed above, it is undisputed that the Presstek Plates have the same construction of a top silicone layer, “MMO” layer made of titanium and titanium oxide, and white substrate made of PET containing barium sulfate. (CFF 263-65 (undisputed).)

Respondents argue that the Presstek Plates do not practice element ‘a’ of claim 20 of the ‘338 patent because they do not have a top layer containing IR-absorptive materials. (RBr. at 38.) With respect to element ‘c’, Respondents argue that “Presstek identified no evidence showing that the substrate of its plates reflects sufficient radiation to cause ablation of the absorptive layer that did not occur on the first pass.” (*Id.*) In their reply, Respondents argue that much of Presstek’s testing of the Presstek Plates must be disregarded because it occurred after the Complaint in this Investigation was filed. (RRBr. at 27.)

Staff argues that the Presstek Plates meet all the limitations of claim 20, unless Respondents’ claim construction position is adopted. (SBr. at 57-59.) However, Staff notes that

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“Respondents’ claim construction ignores both the fact that claim 20 is open ended and the case law finding that a claim need not include all the elements to make an operable device.” (*Id.* at 57.)

Whether the Presstek Plates meet the preamble and element ‘b’ of claim 20 is not in issue. (CFF 264-65 (undisputed); CFF 269 (undisputed); CFF 277 (undisputed), CFF 280-84 (undisputed); CFF 295-99 (undisputed); CFF 300-304 (undisputed in relevant part); SFF 84 (undisputed); SFF 91 (undisputed); SFF 97 (undisputed in relevant part); RBr. at 38.) Furthermore, should the Presstek Plates meet elements ‘a’ and ‘c’ of claim 20, then claims 21 and 23 are not in issue. (CFF 264 (undisputed); CFF 275-77 (undisputed); CFF 328 (undisputed); CFF 329 (undisputed in relevant part); CFF 333-34 (undisputed); SFF 98-99 (undisputed); RBr. at 38.)

The Administrative Law Judge found in Section III.D.1. above, that claim 20 is open-ended, and may include elements other than those recited in the claim. The Administrative Law Judge further found that it is not necessary for claim 20 to disclose every component, such as infrared-absorptive material, to be operable. Specifically with respect to element ‘a’, the Administrative Law Judge found that a person of ordinary skill in the art would understand element ‘a’ of claim 20 to have its plain and ordinary meaning and would conclude that this element may contain, but does not require, infrared-absorptive material. With respect to element ‘c’, the Administrative Law Judge found that a person of ordinary skill in the art would understand “the substrate comprises means for reflecting imaging radiation” to mean “the substrate includes materials, such as aluminum, aluminum alloy, other metals, or dispersed pigments that cause the substrate to reflect imaging IR radiation.”

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The Administrative Law Judge finds that Presstek has established, by a preponderance of the evidence, that the Presstek Plates have a durable organic silicone top layer that functions as an ink repelling, or oleophobic, surface. (CFF 287-90 (undisputed); CFF 293 (undisputed); SFF 84-85 (undisputed); SFF 86 (undisputed in relevant part); SFF 87-89 (undisputed); SFF 95 (undisputed); CX-269C-70C; CX-272C; CX-289C; CX-293C; Tr. at 332:3-333:12.) Thus, the Presstek Plates meet the limitation of element 'a' of claim 20 which requires "a first durable, solid organic polymer layer that is oleophobic or hydrophilic."

The Administrative Law Judge further finds that the substrate of the Presstek Plates is PET containing barium sulfate particles, which cause the substrate to reflect imaging IR radiation. (CFF 324-25 (undisputed); CX-289; CX-291C; Tr. at 231:12-20, 232:22-235:7, 338:7-346:18 (Magee).) The testing by the private parties indicates that the reflectivity of the substrate of the Presstek Plates is 88.8-90 percent or greater. (CFF 321-22 (undisputed in relevant part); CX-302C-305C; CX-509; Tr. at 345:1-346:7 (Magee).) Thus, the Presstek Plates meet the limitation of element 'c' of claim 20 which requires that "the substrate comprises means for reflecting imaging radiation."

The Administrative Law Judge rejects Respondents' argument that testing of the Presstek Plates that occurred during discovery should be disregarded. As discussed above in Section VII.A.1., the Commission has used the end of discovery as the cut-off point for satisfaction of the domestic industry requirement and not just the filing date of the complaint.

Therefore, the Administrative Law Judge finds that the evidence shows that the Presstek Plates meet all of the limitations of claim 20 of the '338 patent. As a result, the Administrative Law Judge finds that the Presstek Plates meet all of the limitations of claims 21 and 23 of the

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'338 patent. Therefore, the Administrative Law Judge finds that the Presstek Plates satisfy the technical prong of the domestic industry requirement with respect to the '338 patent.

B. Economic Analysis

The economic prong of the domestic industry requirement is defined in subsection 337(a)(3) as follows:

(3) For purposes of paragraph (2), an industry in the United States shall be considered to exist if there is in the United States, with respect to the articles protected by the patent, copyright, trademark or mask work concerned –

- (A) Significant investment in plant and equipment;
- (B) Significant employment of labor or capital; or
- (C) Substantial investment in its exploitation, including engineering, research and development, or licensing.

19 U.S.C. § 1337(a)(3). The economic prong of the domestic industry requirement is satisfied by meeting the criteria of any one of the three factors listed.

The economic domestic industry requirement is not in dispute. Respondents expressly stipulated that

1. Presstek manufactures and sells in the United States the PearlDry, PearlDry Plus, and ProFire Digital Media lithographic printing plates (collectively, the "Presstek Plates").
2. Presstek manufactures the Presstek Plates at its facility in Hudson, New Hampshire. Presstek has made significant investments in this facility and the equipment used there to manufacture the Presstek Plates. The total area of Presstek's Hudson facility dedicated to the manufacture of the Presstek Plates is substantial. Presstek's cost basis for this facility and the land on which it was built is significant.
3. Presstek also employs a number of persons at its Hudson facility who are involved in the manufacture of the Presstek Plates, and pays these employees substantial wages.
4. Respondents do not contest that Presstek meets the requirements of the economic prong of the domestic industry requirement and the parties enter into the above stipulations in support of a determination that the economic prong of the domestic industry requirement of Section 337 and 19 U.S.C. § 1337(a)(3) has been satisfied in this Investigation.

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(JX-13C at 1-2. *See also* CFF 683-88 (undisputed); CFF 690 (undisputed).) In addition, Presstek submitted evidence, which Respondents do not dispute, relating to the scope of its economic domestic industry, including the following: (i) a \$24 million cost basis for Presstek's approximately 50,000 square foot manufacturing facility dedicated to manufacture of the Presstek Plates; (ii) an approximately \$15 million investment in equipment dedicated to manufacture of the Presstek Plates at its Hudson facility; (iii) \$200,000 spent on salary plus benefits (January-May 2009) for the twenty employees who are involved in every aspect of the manufacture of the Presstek Plates; and (iv) approximately \$1 million spent on annual salary plus benefits paid to approximately twenty employees who were involved in the management, planning, buying, quality control, and production of the Presstek Plates in 2007 and 2008. (CFF 689-698 (undisputed). *See also* Tr. at 185:9-194:14 (testimony of Mr. Mark Sullivan, Presstek Product Manager for Digital Printing "Sullivan").)

Staff supports a finding of economic domestic industry. Staff argues that "the evidence demonstrates Complainant's significant investment in plant and equipment for the Presstek Plates, as well as its significant employment of labor and capital. (SBr. at 64.)

The undisputed evidence shows that Presstek has made significant investment in plant and equipment for the manufacture of the Presstek Plates, which practice the '737 and '338 patents. The undisputed evidence further shows that Presstek has engaged in significant employment of labor and capital for at least the management, planning, buying, quality control, and production of the Presstek Plates. Therefore, the Administrative Law Judge finds that Presstek has satisfied the economic prong of the domestic industry requirement under 337(a)(3)(C).

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VIII. CONCLUSIONS OF LAW

1. The Commission has personal jurisdiction over the parties, subject-matter jurisdiction, and in rem jurisdiction over the Accused Plates.
2. The importation or sale requirement of Section 337 is satisfied.
3. All of the Accused Plates listed in Section I.E. literally infringe asserted claims 1 and 27 of the '737 patent.
4. All of the Original Plates listed in Section I.E. literally infringe asserted claim 10 of the '737 patent.
5. All of the Accused Plates listed in Section I.E. literally infringe asserted claims 20, 21 and 23 of the '338 patent.
6. Respondent Hanita induced infringement of the '737 and '338 patents.
7. Respondent Hanita did not contributorily infringe the '737 and '338 patents.
8. The asserted claims of the '737 patent are not invalid under 35 U.S.C. § 102 for anticipation.
9. The asserted claims of the '737 patent are not invalid under 35 U.S.C. § 103 for obviousness.
10. A domestic industry exists, as required by Section 337.
11. It has been established that a violation exists of Section 337 for each of the '737 and '338 patents.

IX. INITIAL DETERMINATION AND ORDER

Based on the foregoing, it is the INITIAL DETERMINATION ("ID") of this Administrative Law Judge that a violation of Section 337 of the Tariff Act of 1930, as amended, has occurred in the importation into the United States, the sale for importation, or the sale within

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the United States after importation of certain laser imageable lithographic plates by reason of infringement of one or more of claims 1, 10 and 27 of United States Patent No. 5,339,737 and one or more of claims 20, 21 and 23 of United States Patent No. 5,487,338. The Administrative Law Judge further determines that a domestic industry exists that practices U.S. Patent Nos. 5,339,737 and 5,487,338.

Further, this ID, together with the record of the hearing in this Investigation consisting of:

- (1) the transcript of the hearing, with appropriate corrections as may hereafter be ordered, and
- (2) the exhibits received into evidence in this Investigation, as listed in the attached exhibit lists in Appendix A,

are CERTIFIED to the Commission. In accordance with 19 C.F.R. § 210.39(c), all material found to be confidential by the undersigned under 19 C.F.R. § 210.5 is to be given *in camera* treatment.

The Secretary shall serve a public version of this ID upon all parties of record and the confidential version upon counsel who are signatories to the Protective Order (Order No. 1) issued in this Investigation, and upon the Commission Investigative Attorney.

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RECOMMENDED DETERMINATION ON REMEDY AND BOND

I. Remedy and Bonding

The Commission's Rules provide that subsequent to an initial determination on the question of violation of Section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. § 1337, the Administrative Law Judge shall issue a recommended determination containing findings of fact and recommendations concerning: (1) the appropriate remedy in the event that the Commission finds a violation of Section 337, and (2) the amount of bond to be posted by respondents during Presidential review of Commission action under Section 337(j). *See* 19 C.F.R. § 210.42(a)(1)(ii).

A. Limited Exclusion Order

Under Section 337(d), the Commission may issue either a limited or a general exclusion order. A limited exclusion order instructs the U.S. Customs and Border Protection ("CBP") to exclude from entry all articles that are covered by the patents at issue and that originate from a named respondent in the investigation. *See* 19 U.S.C. § 1337(d).

Presstek requests that a limited exclusion order be issued that prohibits the importation of all infringing Accused Plates (*see* Section I.E. above) "manufactured by or on behalf of Respondents and/or imported by or on behalf of Respondents." (CBr. at 116-17.)

Respondents assert that should a limited exclusion order be issued, it should be limited to only the "current models of the accused VIM plates specifically identified in the Complaint, namely the DP-28 and DP-36 lithographic printing plates. (RBr. at 76.)

Staff asserts that the appropriate remedy is a limited exclusion order directed to all Accused Plates. (SBr. at 87.)

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The Administrative Law Judge agrees that the evidence shows that if a violation is found a limited exclusion order would be proper. The limited exclusion order should apply to Respondents and all of their affiliated companies, parents, subsidiaries, or other related business entities, or their successors or assigns, and should apply to all of Respondents' Accused Plates that have been found to infringe the '737 patent and '338 patent.

B. Cease and Desist Order

Section 337 provides that in addition to, or in lieu of, the issuance of an exclusion order, the Commission may issue a cease and desist order as a remedy for violation of Section 337. *See* 19 U.S.C. § 1337(f)(1). The Commission generally issues a cease and desist order directed to a domestic respondent when there is a "commercially significant" amount of infringing, imported product in the United States that could be sold so as to undercut the remedy provided by an exclusion order. *See Certain Crystalline Cefadroxil Monohydrate*, Inv. No. 337-TA-293, Comm'n Op. on the Issue Under Review, and on Remedy, the Public Interest and Bonding at 37-42, Pub. No. 2391 (U.S.I.T.C., June 1991). Cease and desist orders have been declined when the record contains no evidence concerning infringing inventories in the United States. *Certain Condensers, Parts Thereof and Products Containing Same, Including Air Conditioners for Automobiles*, Inv. No. 337-TA-334, Comm'n Op. at 28 (U.S.I.T.C., Aug. 27, 1997).

Presstek requests a cease and desist order "directed to prevent the sale or other manner of distribution in the United States of any existing inventory of Respondents' accused products." (CBr. at 119.) Presstek argues that Respondents GSS and RSI have admitted that they maintain commercially significant inventories at their facilities in the United States, although it does not cite to any evidence in support of this statement. (CBr. at 118.)

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Respondents argue that cease and desist orders should not be issued against Respondents GSS, RSI and Spicers, as there is no evidence that they have a sufficient domestic inventory of infringing product. (RBr. at 77.)

Staff argues no evidence relating to whether a cease and desist order should be issued was presented at the hearing. (SBr. at 88.) According to Staff, Presstek has not demonstrated that a cease and desist order precluding sales of already imported infringing products is warranted. (SBr. at 89.)

The Administrative Law Judge finds there is insufficient evidence to show that the domestic Respondents maintain significant inventories of the Accused Plates in the United States. Thus, if a violation is found, cease and desist orders are not warranted.

C. Bond During Presidential Review Period

The Administrative Law Judge and the Commission must determine the amount of bond to be required of a respondent, pursuant to Section 337(j)(3), during the 60-day Presidential review period following the issuance of permanent relief, in the event that the Commission determines to issue a remedy. 19 C.F.R. § 210.42(a)(1)(ii). The purpose of the bond is to protect the complainant from any injury. 19 C.F.R. § 210.50(a)(3).

When reliable price information is available, the Commission has often set the bond by eliminating the differential between the domestic product and the imported, infringing product. *See Certain Microsphere Adhesives, Process for Making Same, and Products Containing Same, Including Self-Stick Repositionable Notes*, Inv. No. 337-TA-366, Comm'n Op., at 24 (U.S.I.T.C., December 15, 1995). In circumstances where pricing information is unclear, or where variations in pricing make price comparisons complicated and difficult, the Commission typically has set a 100 percent bond. *Id.*, at 24-25; *Certain Digital Multimeters and Products with Multimeter*

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Functionality, Inv. No. 337-TA-588, Comm'n Op., at 12-13 (U.S.I.T.C., June 3, 2008) (finding 100 percent bond where each respondent set its price differently, preventing clear differentials between complainant's products and the infringing imports).

Presstek requests a bond be set in the amount of 100 percent of the entered value of the Accused Plates. (CBr. at 120.) Respondents argue that the bond should be set at 20 percent. (RBr. at 78.) Staff agrees that the bond should be set at 100 percent, although Staff points out that the private parties presented no evidence relating to product pricing at the hearing. (SBr. at 90.)

In this case, the parties have presented no evidence with respect to product pricing. Accordingly, based on the inadequacy of the evidence, the Administrative Law Judge recommends a bond in the amount of 100 percent.

II. Conclusion

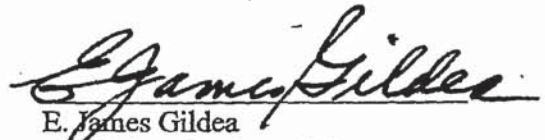
In accordance with the discussion of the issues contained herein, it is the RECOMMENDED DETERMINATION of the Administrative Law Judge that in the event the Commission finds a violation of Section 337, the Commission should issue a limited exclusion order directed only to those of Respondents' Accused Plates that were found to infringe the '737 patent and '338 patent. Furthermore, if the Commission imposes a remedy following a finding of violation, Respondents should be required to post a bond of 100 percent of the entered value of those Accused Plates imported during the Presidential review period.

Within seven days of the date of this document, each party shall submit to the office of the Administrative Law Judge a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties' submissions must be made by hard copy by the aforementioned date.

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Any party seeking to have any portion of this document deleted from the public version thereof must submit to this office a copy of this document with red brackets indicating any portion asserted to contain confidential business information by the aforementioned date. The parties' submission concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.


E. James Gildea
Administrative Law Judge

APPENDIX A
EXHIBIT LISTS

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

COMPLAINANT AND RESPONDENTS' FINAL ADMITTED JOINT EXHIBIT LIST

RECEIVED
OFC OF THE SECRETARY
US INTL TRADE COMM
2009 MAY 18 PM 4: 59

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
JX-1	P004801 - P004821	U.S. Patent No. 5,339,737			Admitted
JX-2	P004822 - P004824	Reexamination Certificate of U.S. Patent No. 5,339,737, Lewis et al.			Admitted
JX-3	P000001 - P000261	Prosecution History of U.S. Patent No. 5,339,737			Admitted
JX-4	P000262 - P000570	Prosecution History to Reexamination Certificate of U.S. Patent No. 5,339,737			Admitted
JX-5	P000801 - P001175	Prosecution History of U.S. Patent No. 5,385,092			Admitted
JX-6	P004825 - P004844	U.S. Patent No. 5,487,338			Admitted
JX-7	P000571 - P000800	Prosecution History of U.S. Patent No. 5,487,338			Admitted
JX-8C	NA	Complaint of Presstek, Inc. Under Section 337 of the Tariff Act of 1930, February 11, 2008			Admitted
JX-9C	NA	Response of VIM Technologies, Ltd., Hanita Coatings RCA, Ltd, ATECE Canada, Guaranteed Service & Supplies, Inc. and Recognition Systems, Inc. to Complaint of Presstek, Inc. and Notice of Investigation, April 9, 2008			Admitted

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
JX-10	NA	Amended Complaint of Presstek, Inc. Under Section 337 of the Tariff Act of 1930, April 23, 2008			Admitted
JX-11	NA	Amendment to Complaint			Admitted
JX-12C	NA	Response of VIM Technologies, Ltd., Hanita Coatings RCA, Ltd, AteCe Canada, Guaranteed Service & Supplies, Inc. and Recognition Systems, Inc. and Spicers Paper, Inc. to Amended Complaint of Presstek, Inc. and Notice of Investigation, September 10, 2008			Admitted
JX-13C	NA	Joint Stipulation of Material Facts			Admitted

PRESS201309

Respectfully submitted,



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Dated: May 18, 2009

PRESS201309

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **COMPLAINANT AND RESPONDENTS' FINAL ADMITTED JOINT EXHIBIT LIST (PUBLIC)** was served as indicated, to the parties listed below, on this 18th day of May 2009:

The Honorable Marilyn R. Abbott
Secretary
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 112A
Washington, DC 20436
(VIA HAND DELIVERY – ORIGINAL + 6)

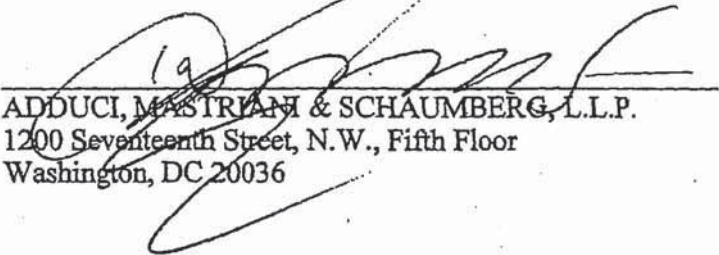
The Honorable E. James Gildea
Administrative Law Judge
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 317
Washington, DC 20436
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PRESS100008

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

COMPLAINANT PRESSTEK, INC.'S ADMITTED PHYSICAL EXHIBIT LIST

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2025 NOV 13 PM 5:03

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CPX-11	NA	Presstek Pearl Dry Plus Printing Plate, Lot: 007342, Plate Roll: 053	Domestic Industry	Mark Sullivan	Admitted

PRESS200609

Respectfully submitted,



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Counsel for Presstek, Inc.

Dated: May 18, 2009

PRESS200609

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

COMPLAINANT PRESSTEK, INC.'S FINAL ADMITTED CONFIDENTIAL EXHIBIT LIST

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-43C	NA	Respondent VIM Technologies, Ltd.'s Second Supplemental Responses to Complainant's First Set of Interrogatories, June 11, 2008	Infringement Validity Domestic Industry	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-54C	NA	Respondent Hanita Coatings RCA, Ltd.'s Responses to Complainant's First Set of Interrogatories, April 14, 2008	Infringement Validity Domestic Industry	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-268C	P004973 - P004974	Process Specifications	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-269C	P004975 - P004976	Process Specifications	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-270C	P004977 - P004979	Process Specifications	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-272C	P005000 - P005006	Process Specifications	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-280C	P009848 - P009854	Presstek Raw Material Specification	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-281C	P010081 - P0010082	Presstek PEARLdry Plate Product	Domestic Industry	Charles W. Magee, Ph.D.	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-289C	P018650 - P018652	Overview; PEARLdry and PEARLdry Plus Plates	Domestic Industry	Charles W. Magee, Ph.D. Stephen G. Degon	Admitted
CX-290C	P018653 - P018676	Presstek Presentation of PEARLdry Printing Plates	Domestic Industry	Charles W. Magee, Ph.D. Thomas E. Lewis	Admitted
CX-291C	P018682 - P018686	Transmission Electron Microscopy Test Results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-292C	P021770 - P021774	Energy Dispersive X-ray Spectroscopy/Scanning Transmission Electron Microscopy test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-293C	P021775 - P021782	Fourier Transform-Infrared Spectrometry test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-294C	P021783 - P021785	Rutherford Backscattering Spectrometry test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-295C	P021786 - P021787	Rutherford Backscattering Spectrometry test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-296C	P021788	X-ray Diffraction test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-297C	P018783 - P018794	Secondary Ion Mass Spectrometry test results	Infringement	Charles W. Magee, Ph.D.	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-298C	P018795 - P018800	Secondary Ion Mass Spectrometry test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-299C	P018801 - P018817	Secondary Ion Mass Spectrometry test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-300C	P018818 - P018834	Secondary Ion Mass Spectrometry test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-302C	P019032 - P019057	Reflectance test results on Presstek material backside area 1	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-303C	P019058 - P019083	Reflectance test results on Presstek material backside area 2	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-304C	P019084 - P019128	Reflectance test results on Presstek material backside area 3 repeat	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-305C	P019129 - P019156	Reflectance test results on Presstek material backside area 3	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-306C	P019157 - P019168	Transmissivity test results for Baseline Correction	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-307C	P019169 - P019202	Transmissivity test results for Presstek samples	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-308C	P019203 - P019236	Transmissivity test results for	Domestic Industry	Charles W. Magee,	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
		Clear+ Si area 2 Presstek samples		Ph.D.	
CX-309C	P019237 - P019290	Transmissivity test results for Clear+ Si area 3 Presstek samples	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-310C	P019291 - P019316	Transmissivity test results for Clear+ Ti area 1 Presstek samples	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-311C	P019317 - P019344	Transmissivity test results for Clear+ Ti area 2 Presstek samples	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-312C	P019345 - P019376	Transmissivity test results for Clear+ Ti area 3 repeat Presstek samples	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-313C	P019377 - P019406	Transmissivity test results for Clear+ Ti area 3 Presstek samples	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-314C	P019407 - P019432	Transmissivity test results for No Sample	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-316C	P019486 - P019487	Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-317C	P021798 - P021800	Energy Dispersive X-ray Spectroscopy/Scanning Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-318C	P019491 - P019492	Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-319C	P021801 - P021803	Energy Dispersive X-ray Spectroscopy/Scanning Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-320C	P019496 - P019497	Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-321C	P021804 - P021806	Energy Dispersive X-ray Spectroscopy/Scanning Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-322C	P019501 - P019502	Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-323C	P021807 - P021810	Energy Dispersive X-ray Spectroscopy/Scanning Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-324C	P019507 - P019508	Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-325C	P021811 - P021814	Energy Dispersive X-ray Spectroscopy/Scanning Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-335C	P021815 - P021833	Secondary Ion Mass Spectrometry test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-336C	P021834 - P021852	Secondary Ion Mass Spectrometry test results	Domestic Industry	Charles W. Magee, Ph.D.	Admitted
CX-346C	P019798 - P019832	Transmissivity test results on VIM + Digesil - 850nm detector changeover	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-351C	P019931 - P019994	Transmissivity test results on VIM + Digesil	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-352C	P019995 - P020009	Transmissivity test results on HAN 2581 TFA	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-353C	P020010 - P020023	Transmissivity test results on HAN 2582 TFA	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-354C	P020024 - P020040	Transmissivity test results on VIM + Digesil TFA	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-355C	P020043 - P020051	Transmissivity test results of e VIM Roll No. 1434473	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-356C	P021853 - P021854	Plots of data from P020043 - P020051	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-366C	P020077 - P020085	X-ray Photoelectron Spectroscopy results on TFA treated samples	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-374C	P020173 - P020319	Test Data regarding Transmissivity	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-375C	P020320 - P020451	Test Data regarding Transmissivity	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-376C	P020452 - P020637	Test Data regarding Transmissivity	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-377C	P020638 - P020663	Test Data regarding Transmissivity	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson,	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
				Ph.D.	
CX-378C	P020664 - P021218	Test Data regarding Transmissivity	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-379C	P021219 - P021637	Test Data regarding Transmissivity	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-386C	P021884 - P021890	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-387C	P021662 - P021663	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-388C	P021664 - P021665	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-496C	HAN00000418	November 18, 2002 e-mail from Dany Eisenstadt to D. Dlott & S. Koulikov regarding New Photothermal Imaging Materials	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted

PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-509C	HAN00001318 - HAN00001368	Reflectance Testing Of Pearl Dry And Hanita Material	Infringement Domestic Industry	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-556C	VIM00032999 - VIM00033000	Samples for Ablation Visual Test	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-582C	VIM00039821 - VIM00039822	Laser Ablation on Samples #83-933c and 83-963 with 110 ns laser pulse at 1.064 μm :	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-587C	VIM00048530 - VIM00048573	Scan Analysis Report	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-631C	NA	Excerpts from July 29, 2008 Deposition Transcript of Sason Fluxman and Related Exhibits	Infringement Validity	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-632C	NA	Excerpts from July 30, 2008 Deposition Transcript of Sason Fluxman and Related Exhibits	Infringement Validity	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-633C	NA	Excerpts from July 31, 2008 Deposition Transcript of Avigdor	Infringement	Charles W. Magee,	Admitted

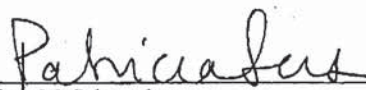
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EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
		Bieber and Related Exhibits	Validity	Ph.D. Steven A. Carlson, Ph.D.	
CX-634C	NA	Excerpts from August 1, 2008 Deposition Transcript of Avigdor Bieber and Related Exhibits	Infringement Validity	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-635C	NA	Excerpts from December 3, 2008 Deposition Transcript of Richard M. Goodman, Ph.D. and Related Exhibits	Infringement Validity	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-637C	P018993-P019003	Excerpts relating to Dr. Magee's Secondary Ion Mass	Infringement Validity	Charles W. Magee, Ph.D.	Admitted

PRESS200909

PUBLIC VERSION

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Counsel for Presstek, Inc.

Dated: May 18, 2009

PRESS200909

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

COMPLAINANT PRESSTEK, INC.'S FINAL ADMITTED PUBLIC EXHIBIT LIST

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EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CX-12	NA	Exhibit 26 to the Complaint- Presstek's 34DI Brochure	Domestic Industry	Charles W. Magee, Ph.D. Mark Sullivan	Admitted
CX-22	NA	Exhibit 6 to Respondents' Response to the Complaint - Comparison of Claims 1, 10 and 27 of U.S. Patent No. 5,339,737 with the Accused Vim Plates	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-23	NA	Exhibit 7 to Respondents' Response to the Complaint - Comparison of Claims 20, 21 and 23 of U.S. Patent No. 5,487,338 with the Accused VIM Plates	Infringement	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-40	NA	Complainant's First Set of Interrogatories to Respondent VIM Technologies, Ltd., March 17, 2008	Infringement Validity Domestic Industry		Admitted
CX-107	NA	Respondent VIM Technologies, Ltd.'s Responses to Complainant's First Set of Requests for Admission, July 18, 2008	Infringement Validity Domestic Industry	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-109	NA	Respondent Hanita Coatings RCA, Ltd. Responses to Complainant's First Set of	Infringement Validity	Charles W. Magee, Ph.D.	Admitted

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
		Requests for Admission, July 18, 2008	Domestic Industry	Steven A. Carlson, Ph.D.	
CX-232	P003982 - P003983	Vim Technologies website, Technology	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-235	P003988 - P003990	Vim Technologies website, Features & Benefits	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-236	P004137 - P004146	David E. Hare et al, <i>Fundamental Mechanisms of Lithographic Printing Plate Imaging by Near-Infrared Lasers</i> , 4, 3 J. of Imaging Sci. & Tech. 291-300 (1997)	Infringement Domestic Industry	Charles W. Magee, Ph.D. Steven A. Carlson, Ph.D.	Admitted
CX-237	P021719	Fourier Transform Infrared Spectroscopy	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-238	P021720 - P021721	Secondary Ion Mass Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-239	P004547 - P004551	Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-240	P021722 - P021728	Energy Dispersive X-ray Spectroscopy/Scanning Transmission Electron Microscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-241	P021729 - P021737	Fourier Transform Infrared Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-242	P021738 - P021746	Rutherford Backscattering Spectrometry test results	Infringement	Charles W. Magee,	Admitted

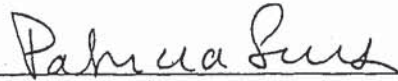
EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
				Ph.D.	
CX-244	P004580 - P004581	X-ray Diffraction test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-245	P004582	X-ray Diffraction test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-246	P004583 - P004584	X-ray Diffraction test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-247	P021750 - P021751	X-ray Diffraction test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-248	P004587 - P004603	Reflectance test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-249	P004604 - P004620	Reflectance test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-250	P004621 - P004637	Reflectance test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-251	P004638 - P004654	Reflectance test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-252	P004655 - P004661	Reflectance test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-253	P004662 - P004678	Reflectance test results	Infringement	Charles W. Magee,	Admitted

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
				Ph.D.	
CX-254	P004679 - P004695	Reflectance test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-256	P021753 - P021759	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-257	P004704 - P004705	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-258	P021760 - P021761	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-259	P021762 - P021763	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-260	P021764 - P021765	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-261	P004713 - P004714	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-262	P004715 - P004716	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-263	P004717 - P004718	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-264	P021766 - P021767	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee,	Admitted

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
				Ph.D.	
CX-265	P004721	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-266	P004722 - P004723	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted
CX-267	P021768 - P021769	X-ray Photoelectron Spectroscopy test results	Infringement	Charles W. Magee, Ph.D.	Admitted

PRESS201009

Respectfully submitted,



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Counsel for Presstek, Inc.

Dated: May 18, 2009

PRESS201009

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **COMPLAINANT PRESSTEK, INC.'S FINAL ADMITTED PUBLIC EXHIBIT LIST (PUBLIC)** was served as indicated, to the parties listed below, on this 18th day of May 2009:

The Honorable Marilyn R. Abbott
Secretary
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 112A
Washington, DC 20436
(VIA HAND DELIVERY - ORIGINAL + 6)

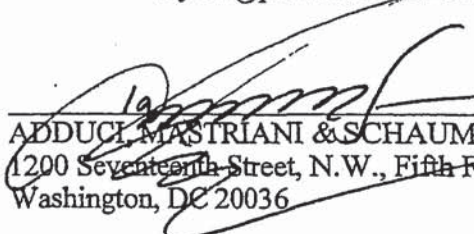
The Honorable E. James Gildea
Administrative Law Judge
U.S. INTERNATIONAL TRADE COMMISSION
500 E Street, S.W., Room 317
Washington, DC 20436
(VIA HAND DELIVERY - 2 copies)

Aarti Shah, Esq.
Investigative Attorney
Office of Unfair Import Investigations
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RECOGNITION SYSTEMS, INC.; HANITA COATINGS RCA, LTD. AND ATECE CANADA**

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PRESS100008

PUBLIC VERSION

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

COMPLAINANT PRESSTEK, INC.'S FINAL CONFIDENTIAL
DEMONSTRATIVE EXHIBIT LIST, PART OF THE RECORD AS OF APRIL 28, 2009

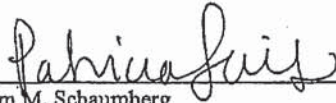
PUBLIC VERSION

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CDX-1C	NA	Demonstratives to be used with Dr. Magee regarding Infringement of the Presstek Patents by the VIM plates	Infringement	Charles W. Magee, Ph.D.	Part of the Record as April 28, 2009
CDX-2C	NA	Demonstratives to be used with Dr. Carlson regarding Infringement of the Presstek Patents by the VIM plates	Infringement	Steven A. Carlson, Ph.D.	Part of the Record as April 28, 2009
CDX-8C	NA	Demonstratives to be used for Technical Tutorial	Technical Tutorial	Charles W. Magee, Ph.D.	Part of the Record as April 28, 2009

PRESS200409

PUBLIC VERSION

Respectfully submitted,



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Counsel for Presstek, Inc.

Dated: May 18, 2009

PRESS200409

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

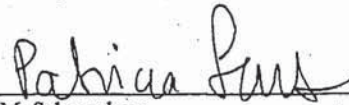
COMPLAINANT PRESSTEK, INC.'S FINAL PUBLIC DEMONSTRATIVE
EXHIBIT LIST, PART OF THE RECORD AS OF APRIL 28, 2009

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OFC OF THE SECRETARY
US INTL TRADE COMM
2009 MAY 18 PM 5:03

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
CDX-3	NA	Demonstratives to be used with Dr. Carlson regarding Validity of the Presstek Patents	Validity	Steven A. Carlson, Ph.D.	Part of the Record as of April 28, 2009
CDX-7	NA	Demonstratives to be used with Mark Sullivan regarding the economic prong of Presstek's Domestic Industry	Domestic Industry	Mark Sullivan	Part of the Record as of April 28, 2009

PRESS200309

Respectfully submitted,



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Counsel for Presstek, Inc.

Dated: May 18, 2009

PRESS200309

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing **COMPLAINANT PRESSTEK, INC.'S FINAL PUBLIC DEMONSTRATIVE EXHIBIT LIST, PART OF THE RECORD AS OF APRIL 28, 2009 (PUBLIC)** was served as indicated, to the parties listed below, on this 18th day of May 2009:

The Honorable Marilyn R. Abbott
Secretary
U.S. INTERNATIONAL TRADE COMMISSION
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(VIA HAND DELIVERY – ORIGINAL + 6)

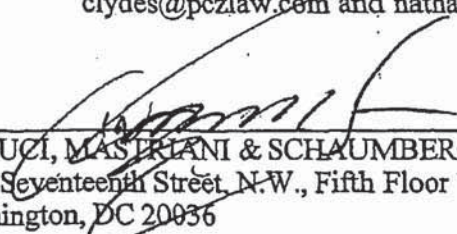
The Honorable E. James Gildea
Administrative Law Judge
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Washington, DC 20436
(VIA HAND DELIVERY – 2 copies)

Aarti Shah, Esq.
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**COUNSEL FOR VIM TECHNOLOGIES, LTD.; GUARANTEED SERVICE & SUPPLIES, INC.;
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PRESS100008

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

RESPONDENTS' FINAL CONFIDENTIAL EXHIBIT LIST

Respondents VIM Technologies, Ltd., Hanita Coatings RCA, Ltd., AteCe Canada, Guaranteed Service & Supplies, Inc., Recognition Systems, Inc. and Spicers Paper, Inc. (collectively, "Respondents"), by counsel, hereby provide the attached Respondents' Final Confidential Exhibit List.

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
RX-11C	VIM0006619-VIM00006902	Transmissivity and reflectivity testing data collected February 20, 2008, on "1434473," "MEL-329-1"	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-18C	VIM00016377-VIM00016379	Document entitled "VIM Plates Transmission Graphs"	Transmissivity of Accused Products/Non-infringement of '737 Patent	Avigdor Bieber	Admitted 4/28/09
RX-19C	VIM00016383-VIM00016392	Document entitled "Analysis Report," dated March 24, 2008, from Dr. Reuven Brenner, Surface Science Laboratory, Solid State Institute, Technion-Israel Institute of Technology to Zeev Savion, CTO, VIM Technologies	Composition of MMO layer of Accused Products	Yoash Carmi	Admitted 4/27/09
RX-23C	VIM00021943-VIM00021944	Document entitled "VIM's printing plates construction: Silicone layer"	Composition of silicone layer of Accused Products	Avigdor Bieber	Admitted 4/27/09
RX-28C	G000726	Document with two tables, the first entitled "Tranmissivity [sic] of MMO layer on Clear & White PET Substrates," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
RX-29C	G000727	Document entitled "Average Transmission of MMO - Calculations," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-30C	G000728	Document entitled "Average Transmission of Clear Raw Film - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-31C	G000729	Document entitled "Average Transmission of Clear Raw Film + Silicone - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-32C	G000730	Document entitled "Average Transmission of Sample #3 - Clear Film + MMO - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-33C	G000731	Document entitled "Average Transmission of Sample #4 - Clear Film + MMO - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
RX-34C	G000732	Document entitled "Average Transmission of Sample #007 - Product - Clear Film + MMO + Silicone - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-35C	G000733	Document entitled "Production Protocol of VIM DP-R..Plate on White & Clear substrates - Roll Map," dated Oct. 16, 2008	Composition of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-36C	G000734	Document entitled "Average Transmission of Raw White Film - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-37C	G000735	Document entitled "Average Transmission of Sample #3W - White Film + MMO - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-38C	G000736	Document entitled "Average Transmission of Sample #005 - Product - White Film + MMO + Silicone - 4 Areas," dated Oct. 16, 2008	Transmissivity of Accused Products/Non-infringement of '737 Patent	Yoash Carmi	Admitted 4/28/09

DATED: May 1, 2009

Respectfully submitted,

/s/ Jenny L. Workman

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Attorneys for Respondents VIM Technologies, Ltd.,

*Hanita Coatings RCA, Ltd., AteCe Canada, Guaranteed
Service & Supplies, Inc., Recognition Systems, Inc. and
Spicers Paper, Inc.*

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C.

Before The Honorable E. James Gildea

IN THE MATTER OF
CERTAIN LASER IMAGEABLE LITHOGRAPHIC PRINTING PLATES

Investigation No. 337-TA-636

RESPONDENTS' FINAL PUBLIC EXHIBIT LIST

Respondents VIM Technologies, Ltd., Hanita Coatings RCA, Ltd., AteCe Canada, Guaranteed Service & Supplies, Inc., Recognition Systems, Inc. and Spicers Paper, Inc. (collectively, "Respondents"), by counsel, hereby provide the attached Respondents' Final Public Exhibit List.

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
RX-1	P000359-P000368	N. Nechiporenko and N. Markova, "Direct Method of Producing Waterless Offset Plates by Controlled Laser Beam," USSR Research Institute for Complex Problems in Graphic Arts (1980)	Claim construction/Invalidity of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-4	P001312-P001314	U.S. Patent No. 4,132,168	Invalidity of '737 Patent	Yoash Carmi	Admitted 4/28/09
RX-51	N/A (Exhibit 8 to December 11, 2008 deposition of Charles W. Magee)	Presstek, Inc., Form 10-K, dated April 30, 2008	Satisfaction of domestic industry requirement	None	Admitted March 30, 2009 & April 23, 2009
RX-55	N/A (Exhibit 2 to December 9, 2008 deposition of Steven A. Carlson)	Respondent VIM Technologies, Ltd.'s Responses to Complainant's First Set of Requests for Admission	Composition Accused Products/ Non-Infringement of '737 and '338 Patents	None	Admitted March 30, 2009 & April 23, 2009
RX-94	NA	Article entitled "Pulse Duration Dependence of Lithographic Printing Plate Imaging by Near-Infrared Lasers" (Exhibit 7 to September 12, 2008 deposition of Steven Degon)	CX-236	Yoash Carmi	Admitted 4/27/09

EXHIBIT NUMBER	BATES NUMBER	DESCRIPTIVE TITLE	STATEMENT OF PURPOSE	SPONSORING WITNESS	STATUS OF RECEIPT INTO EVIDENCE
RDX-42	NA	Demonstratives to be used with Dr. Carmi regarding Non-infringement of the '737/338 Patents by the VIM plates and invalidity of the '737/338 Patents	N/A	Yoash Carmi	Admitted 4/28/09
RDX-49	NA	U.S. Patent No. 5,339,737 - Chart Regarding Asserted Claim 1	NA	Yoash Carmi	Admitted 4/28/09
RDX-50	NA	Handwritten drawing of 7.5 micron and 8.5 micron datapoints from Table 1 of the N. Nechiporenko and N. Markova, "Direct Method of Producing Waterless Offset Plates by Controlled Laser Beam," USSR Research Institute for Complex Problems in Graphic Arts (1980)	NA	Steven Carlson	Admitted 4/28/09

DATED: May 1, 2009

Respectfully submitted,

/s/ Jenny L. Workman
Lee A. Goldberg
Sibley P. Reppert
Robert D. Schaffer
Clyde A. Shuman
Nathaniel B. Buchek
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Attorneys for Respondents VIM Technologies, Ltd.,

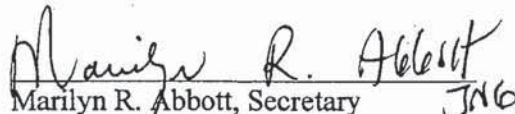
*Hanita Coatings RCA, Ltd., AteCe Canada, Guaranteed
Service & Supplies, Inc., Recognition Systems, Inc. and
Spicers Paper, Inc.*

**IN THE MATTER OF CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Inv. No. 337-TA-636

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **INITIAL DETERMINATION** has been served by hand upon, the Commission Investigative Attorney, **Aarti J. Shah, Esq.**, and the following parties as indicated on August 7, 2009.


Marilyn R. Abbott, Secretary
U.S. International Trade Commission
500 E Street, SW, Room 112A
Washington, D.C. 20436

COMPLAINANTS PRESSTEK, INC. CORPORATION:

Tom M. Schaumberg, Esq.
Michael L. Doane, Esq.
ADDUCI MASTRIANI & SCHAUMBERG, LLP
1200 Seventeenth Street, NW - Fifth Floor
Washington, DC 20036

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(X) Via Overnight Mail
() Via First Class Mail
() Other: _____

**RESPONDENTS VIM TECHNOLOGIES, HANITA COATINGS, RCA, LTD. ATECE
CANADA, GUARANTEED SERVICE & SUPPLIES, INC
RECOGNITION SYSTEMS, INC., SPICERS PAPER, INC.:**

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() Other: _____

**IN THE MATTER OF CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Inv. No. 337-TA-636

PUBLIC MAILING LIST

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 Via First Class Mail
 Other: _____

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Investigation No. 337-TA-636

**NOTICE OF COMMISSION DECISION NOT TO REVIEW AN INITIAL
DETERMINATION TERMINATING THE INVESTIGATION IN PART**

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 an initial determination (“ID”) (Order No. 23) issued by the presiding administrative law judge (“ALJ”) in the above-captioned investigation terminating the investigation with respect to trademark infringement allegations against respondent AteCe Canada (“AteCe”).

FOR FURTHER INFORMATION CONTACT: Paul M. Bartkowski, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-5432. 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: This investigation was instituted on March 7, 2008, based on a complaint filed by Presstek, Inc. (“Presstek”) of Hudson, NH. The complaint alleged violations of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain laser imageable lithographic printing plates that infringe certain claims of U.S. Patent Nos. 5,339,737 and 5,487,338 and U.S. Trademark Reg. No. 1,711,005.

On March 24, 2009, the ALJ issued the subject ID, granting Presstek's motion to terminate the investigation with respect to the allegations of trademark infringement against respondent AteCe. No petitions for review were filed. The Commission has determined not to review the subject ID.

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 210.21 and 210.42 of the Commission's Rules of Practice and Procedure (19 C.F.R. §§ 210.21, 210.42).

By order of the Commission.

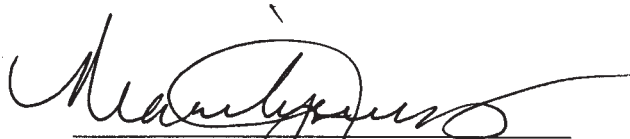
A handwritten signature in black ink, appearing to read "Marilyn R. Abbott". The signature is fluid and cursive, with a large initial "M" and "A".

Marilyn R. Abbott
Secretary to the Commission

Issued: April 20, 2009

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF COMMISSION DECISION NOT TO REVIEW AN INITIAL DETERMINATION TERMINATING THE INVESTIGATION IN PART** has been served by hand upon the Commission Investigative Attorney, Aarti J. Shah, Esq., the following parties as indicated, on April 20, 2009.



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

ON BEHALF OF COMPLAINANT PRESSTEK INC.:

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**ON BEHALF OF RESPONDENTS VIM
TECHNOLOGIES LIMITED, HANITA COATINGS
RCA LTD., GUARANTEED SERVICE & SUPPLIES,
INC., ATECE CANADA AND RECOGNITION
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UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C. 20436

In the Matter of

**CERTAIN LASER IMAGEABLE
LITHOGRAPHIC PRINTING PLATES**

Investigation No. 337-TA-636

**NOTICE OF COMMISSION DECISION NOT TO REVIEW AN INITIAL
DETERMINATION TERMINATING THE INVESTIGATION IN PART**

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 an initial determination (“ID”) (Order No. 10) issued by the presiding administrative law judge (“ALJ”) in the above-captioned investigation terminating the investigation with respect to trademark infringement allegations against respondent Hanita Coatings RCA, Ltd. (“Hanita”).

FOR FURTHER INFORMATION CONTACT: Paul M. Bartkowski, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-5432. 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: This investigation was instituted on March 7, 2008, based on a complaint filed by Presstek, Inc. (“Presstek”) of Hudson, NH. The complaint alleged violations of section 337 of the Tariff Act of 1930 (19 U.S.C. § 1337) in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain laser imageable lithographic printing plates that infringe certain claims of U.S. Patent Nos. 5,339,737 and 5,487,338 and U.S. Trademark Reg. No. 1,711,005.

On February 5, 2009, the ALJ issued the subject ID, granting in part Presstek’s motion to terminate the investigation with respect to the allegations of trademark infringement against Hanita and respondent AteCe Canada (“AteCe”). The ALJ granted the motion with respect to

Hanita, and denied it with respect to AteCe. No petitions for review were filed. The Commission has determined not to review the subject ID.

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 210.21 and 210.42 of the Commission's Rules of Practice and Procedure (19 C.F.R. §§ 210.21, 210.42).

By order of the Commission.

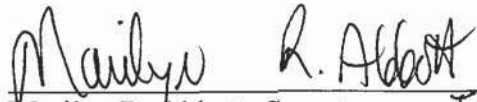
A handwritten signature in black ink, appearing to read "Marilyn R. Abbott". The signature is fluid and cursive, with a large initial "M" and a long, sweeping underline.

Marilyn R. Abbott
Secretary to the Commission

Issued: March 5, 2009

PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **NOTICE OF COMMISSION
DECISION NOT TO REVIEW AN INITIAL DETERMINATION
TERMINATING THE INVESTIGATION IN PART** has been served by hand upon
the Commission Investigative Attorney, Aarti J. Shah, Esq., the following parties as
indicated, on MAR 06 2009.


Marilyn R. Abbott, Secretary *JN6*
U.S. International Trade Commission
500 E Street, SW
Washington, DC 20436

ON BEHALF OF COMPLAINANT PRESSTEK INC.:

Tom M. Schaumberg, Esq.
ADDUCI MASTRIANI & SCHAUMBERG, LLP
1200 Seventeenth Street, NW, Fifth Floor
Washington, DC 20036
P-202-467-6300

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

**ON BEHALF OF RESPONDENTS VIM
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