

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

In the Matter of

**CERTAIN AUDIO DIGITAL-TO-
ANALOG CONVERTERS AND
PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-499

**TERMINATION OF THE INVESTIGATION;
ISSUANCE OF LIMITED EXCLUSION ORDER**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has terminated the above-captioned investigation and has issued a limited exclusion order.

FOR FURTHER INFORMATION CONTACT: Timothy P. Monaghan, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone 202-205-3152. Copies of the public version of the ID and all nonconfidential 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. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on 202-205-1810. 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>.

SUPPLEMENTARY INFORMATION: The Commission instituted this investigation on November 14, 2003, based on a complaint filed on behalf of Cirrus Logic, Inc. of Austin, TX ("Cirrus"). 68 *Fed. Reg.* 64641 (Nov. 14, 2003). The complaint, as supplemented, alleged violations of section 337 in the importation into the United States, sale for importation, and sale within the United States after importation of certain audio digital-to-analog converters and products containing same by reason of infringement of claims 1 and 11 of U.S. Patent No. 6,492,928 ("the '928 patent"). The notice of investigation named Wolfson Microelectronics,

PLC of Edinburgh, United Kingdom; and Wolfson Microelectronics, Inc. of San Diego, CA (collectively "Wolfson") as respondents.

On December 29, 2003, the ALJ issued an ID (Order No. 5) granting complainant's motion to amend the complaint and notice of investigation to add allegations of infringement of claims 2, 3, 5, 6, and 15 of the '928 patent, and of claims 9, 12, and 19 of U.S. Patent No. 6,011,501 ("the '501 patent"). 69 *Fed. Reg.* 4177 (Jan. 28, 2004). On July 1, 2004, the ALJ issued an ID (Order No. 16) granting complainant's motion to terminate the investigation as to claims 1 and 2 of the '928 patent. On July 27, 2004, the ALJ issued an ID (Order No. 24) granting complainant's motion to terminate the investigation in part as to claim 11 of the '928 patent. Orders Nos. 5, 16, and 24 were not reviewed by the Commission.

The ALJ held an evidentiary hearing in the investigation from August 3, 2004, to August 11, 2004, and on November 15, 2004, he issued his final ID finding a violation of section 337 based on his findings that the asserted claims of the '501 patent are infringed, that they are not invalid in view of any prior art, and that claims 9 and 12 of the '501 patent are not invalid because of failure to provide an enabling written description of the claimed invention. The ALJ found the '928 patent to be unenforceable because the inventors intentionally withheld highly material prior art from the examiner during the prosecution of the '928 patent application at the United States Patent and Trademark Office ("USPTO"). As an independent ground for unenforceability, the ALJ found that the '928 patent is unenforceable because one person was mistakenly listed on the patent as an inventor. The ALJ found that the accused devices infringe the asserted claims of the '928 patent, if enforceable, that the asserted claims of the '928 patent are not invalid in view of any prior art, or because of a failure to provide an enabling written description of the claimed invention, or for failure to disclose the best mode.

On November 23, 2004, the USPTO issued a certificate correcting the inventorship of the '928 patent thereby curing one ground for unenforceability of that patent. *See Viskase Corp. v. American National Can Co.*, 261 F.3d 1316, 1329 (Fed. Cir. 2001) ("Absent fraud or deceptive intent, the correction of inventorship does not affect the validity or enforceability of the patent for the period before the correction."). On November 30, 2004, Cirrus, Wolfson and the Commission's investigative attorney filed petitions for review of the final ID, and on December 7, 2004, all parties filed responses. On December 30, 2004, the Commission determined to review and reverse the ID's finding that the '928 patent is unenforceable due to incorrect inventorship in view of the recently issued certificate of correction by the USPTO. 70 *Fed. Reg.* 1275 (Jan. 6, 2005). It further determined not to review the remainder of the ID, thereby finding a violation of section 337. *Id.* The Commission invited the parties to file written submissions on remedy, the public interest and bonding, and provided a schedule for filing such submissions. *Id.*

Having reviewed the record in this investigation, including the parties' written submissions and responses thereto, the Commission determined that the appropriate form of relief is a limited exclusion order prohibiting the importation of Wolfson's accused audio digital-to-analog converters that infringe claims 9, 12 and 19 of the '501 patent. The limited exclusion order applies to any of the affiliated companies, parents, subsidiaries, licensees,

contractors, or other related business entities, or their successors or assigns, of Wolfson. The Commission further determined that the statutory public interest factors enumerated in section 337(d)(1), 19 U.S.C. § 1337(d)(1), do not preclude issuance of the limited exclusion order. Finally, the Commission determined that the bond under the limited exclusion order during the Presidential review period shall be in the amount of 5 percent of the entered value of the imported articles. The Commission's order and opinion in support thereof were delivered to the President on the day of their issuance.

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

By order of the Commission.

Marilyn R. Abbott
Secretary to the Commission

Issued: February 11, 2005