

**UNITED STATES INTERNATIONAL TRADE COMMISSION**

**Washington, D.C.**

**In the Matter of**

**CERTAIN PRINTING AND IMAGING  
DEVICES AND COMPONENTS  
THEREOF**

**Inv. No. 337-TA-690**

**ORDER NO. 26: DENYING RESPONDENTS' MOTION FOR SUMMARY  
DETERMINATION OF FAILURE TO ESTABLISH DOMESTIC  
INDUSTRY WITH RESPECT TO U.S. PATENT NOS. 5,764,866;  
6,388,771; AND 6,209,048**

(April 22, 2010)

On March 17, 2010, respondents Oki Data Corporation and Oki Data Americas, Inc. (collectively "Oki Data") filed a motion for summary determination of failure to establish a domestic industry for U.S. Patent Nos. 5,764,866 ("the '866 patent"); 6,388,771 ("the '771 patent"); and 6,209,048 ("the '048 patent") by complainants' Ricoh Company, Ltd., Ricoh Americas Corporation, and Ricoh Electronics, Inc. (collectively "Rico"). (Motion Docket No. 690-021.) On March 29, 2010, Ricoh filed a response opposing the motion. On March 29, 2010, the Commission Investigative Staff ("Staff") filed a response opposing the motion. On April 2, 2010, Oki Data filed a motion for leave to file a reply in support of Motion Docket No. 690-021. (Motion Docket No. 690-027.) That motion is DENIED. On April 12, 2010, Ricoh filed a motion for leave to file a sur-reply in opposition to Motion Docket No. 690-021. (Motion Docket No. 690-031.) That motion is DENIED.

Oki Data seeks summary determination that Ricoh has failed to establish the existence of a domestic industry for the '866, '771 and '048 patents, alleging that Ricoh has failed to establish

the economic prong of the domestic industry requirement for those patents, and that Ricoh's experts failed, in both their expert reports and their deposition testimony, to provide analysis of the product on which Ricoh bases its economic allocations.

Oki Data specifically alleges that Ricoh failed to establish the economic prong of the domestic industry requirement with respect to the product analyzed by Ricoh's experts in order to prove the technical prong for the '866, '771 and '048 patents. Oki Data argues that the investments upon which one relies to establish the economic prong must relate directly to the product upon which one relies to establish the technical prong. (Citing 19 U.S.C. § 1337(a)(3); and *Certain Automated Mechanical Transmission Sys. For Medium-Duty and Heavy Duty Trucks & Components Thereof*, USITC Pub. No. 3934, Inv. No. 337-TA-503, Initial Determination at 178, 2007 WL 4473082 (Aug. 2007). Brief at 1.<sup>1</sup>

Oki Data contends that Ricoh relied on the Ricoh Aficio MP 4000 MFP (the "MP 4000") to establish the economic prong for the '866, '771 and '048 patents; but Ricoh's experts, both in their expert reports and deposition testimony, analyzed the Ricoh Aficio MP 8001 MFP (the "MP 8001"). Oki Data concludes that Ricoh has not sought to prove that the MP 4000 is representative of the MP 8001, or vice versa. Brief at 2.

Ricoh opposes the motion. Ricoh states that the motion incorrectly states that Ricoh has not established the economic prong of the domestic industry requirement. Ricoh refers to the sworn declaration of its expert, Glenn Weadock, comparing a representative claim of the '048, '771 and '866 patents to the MP 4000, and concluding that the MP 4000 meets all the limitations of each of the representative claims. Resp. at 2.<sup>2</sup> In addition, Ricoh asserts that it listed the MP

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<sup>1</sup> For brevity, Oki Data's supporting brief shall be listed herein as "Brief."

<sup>2</sup> For brevity, Ricoh's opposition to Oki Data's motion shall be listed herein as "Resp."

4000 among its representative domestic industry products when on November 27, 2009, it responded to Oki Data's Interrogatory No. 6. Resp. at 3.

Ricoh states that on January 21, 2010 it responded to Oki Data's fourth set of interrogatories, and in responding to Interrogatory No. 17, Ricoh referred Oki Data to the declaration of Glenn Weadock filed in support of the complaint, which includes claim charts "demonstrating technical domestic industry" by comparing the MP 4000 to claim 1 of the '048 patent, claim 1 of the '866 patent and claim 13 of the '771 patent. (Citing Ricoh Ex. C at 6.) Ricoh says that in response to Interrogatory No. 19, Ricoh also attached the actual technical domestic industry claim charts comparing claim 1 of the '866 patent and claim 13 of the '771 patent to the MP 8001, and claim 1 of the '866 patent to the MP 4000. (*Id.* at 8 and Ex. A thereto.) Resp. at 3.

Ricoh continues that on February 23, 2010, Ricoh served supplemental responses to Oki Data's fourth set of interrogatories, including a chart that shows Ricoh intended to rely upon the MP 4000 and the MP 8001 for domestic industry. The chart shows that those products were listed to meet the requirement for the '866 patent. Resp. at 4. Ricoh also discusses several issues and allegations related to the timing of its production of discovery on the issue of the economic prong of the domestic industry requirement, focusing on the filing and withdrawal of Oki Data's motion to compel discovery dated March 10, 2010, discussions about providing additional discovery in response to that motion, and evidence adduced during depositions taken by Oki Data after the close of fact discovery. Ricoh asserts that it has established the economic prong of the domestic industry requirement in this case. Resp. at 4-6.

Ricoh asserts that it has produced unrefuted evidence demonstrating that it meets the technical prong of the domestic industry requirement as to the MP 4000 product. Ricoh refers to

the sworn declaration of Mr. Weadock and related claim charts attached to the complaint. Resp. at 6-7.

Staff opposes the motion. Staff contends that the premise upon which Oki Data's motion is based – that Ricoh has failed to establish the economic prong of the domestic industry standard – is not valid. Staff concludes that there are genuine issues of material facts in dispute, and that summary determination is not proper.

**I. Legal Standard**

**A. Summary Determination**

Commission Rule 210.18 governs summary determination, and states, *inter alia*, that:

The determination sought by the moving party shall be rendered if pleadings and any depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a summary determination as a matter of law.

19 CFR § 210.18(b).

The evidence “must be viewed in the light most favorable to the party opposing the motion...with doubt resolved in favor of the nonmovant.” *Crown Operations Int’l, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 1375 (Fed. Cir. 2002); *see also Xerox Corp. v. 3Com Corp.*, 267 F.3d 1361, 1364 (Fed. Cir. 2001) (“When ruling on a motion for summary judgment, all of the nonmovant’s evidence is to be credited, and all justifiable inferences are to be drawn in the nonmovant’s favor.”). “Issues of fact are genuine only if the evidence is such that a reasonable [fact finder] could return a verdict for the nonmoving party.” *Id.* at 1375 (quoting *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986)). The trier of fact should “assure itself that there is no reasonable version of the facts, on the summary judgment record, whereby the nonmovant could prevail, recognizing that the purpose of summary judgment is not to deprive a litigant of a

fair hearing, but to avoid an unnecessary trial.” *EMI Group North America, Inc. v. Intel Corp.*, 157 F.3d 887, 891 (Fed. Cir. 1998). “Where an issue as to a material fact cannot be resolved without observation of the demeanor of witnesses in order to evaluate their credibility, summary judgment is not appropriate.” *Sandt Technology, Ltd. v. Resco Metal and Plastics Corp.*, 264 F.3d 1344, 1357 (Fed. Cir. 2001) (Dyk, C.J., concurring). “In other words, ‘[s]ummary judgment is authorized when it is quite clear what the truth is,’ [citations omitted], and the law requires judgment in favor of the movant based upon facts not in genuine dispute.” *Paragon Podiatry Laboratory, Inc. v. KLM Laboratories, Inc.*, 984 F.2d 1182, 1185 (Fed. Cir. 1993).

### **B. The Domestic Industry Requirement**

In patent-based proceedings under section 337, a complainant must establish that an industry “relating to the articles protected by the patent...exists or is in the process of being established” in the United States. 19 U.S.C. § 1337(a)(2) (2008). Under Commission precedent, the domestic industry requirement of Section 337 consists of an “economic prong” and a “technical prong.” *Certain Data Storage Systems and Components Thereof*, Inv. No. 337-TA-471, Initial Determination Granting EMC’s Motion No. 471-8 Relating to the Domestic Industry Requirement’s Economic Prong (unreviewed) at 3 (Public Version, October 25, 2002). In order to prevail on the domestic industry issue, the complainant must demonstrate that its activities in the United States meet the threshold set forth in the statute (economic prong) and that those activities are devoted to a product or process which is covered by the patent(s) in issue (technical prong). (See *e.g. Certain Automated Mechanical Transmission Sys. For Medium-Duty and Heavy Duty Trucks & Components Thereof*, USITC Pub. 3934, Inv. No. 337-TA-503 (Aug. 2007).)

The “economic prong” of the domestic industry requirement is satisfied when it is

determined that the economic activities set forth in subsections (A), (B), or (C) of subsection 337(a)(3) have taken place or are taking place. *Certain Variable Speed Wind Turbines and Components Thereof*, Inv. No. 337-TA-376, USITC Pub. No. 3003, 1996 ITC LEXIS 556, Comm'n Op. at 21 (Nov. 1996). With respect to the "economic prong," 19 U.S.C. § 1337(a)(2) and (3) provide, in full:

(2) Subparagraphs (B), (C), (D), and (E) of paragraph (1) apply only if an industry in the United States, relating to the articles protected by the patent, copyright, trademark, mask work, or design concerned, exists or is in the process of being established.

(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, mask work, or design 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.

Given that these criteria are listed in the disjunctive, satisfaction of any one of them will be sufficient to meet the domestic industry requirement. *Certain Integrated Circuit Chipsets and Products Containing Same*, Inv. No. 337-TA-428, Order No 10, Initial Determination (Unreviewed) (May 4, 2000), citing *Certain Variable Speed Wind Turbines and Components Thereof*, Inv. No. 337-TA-376, Commission Op. at 15, USITC Pub. 3003 (Nov. 1996).

To meet the technical prong, the complainant must establish that it practices at least one claim of the asserted patent. *Certain Point of Sale Terminals and Components Thereof*, Inv. No. 337-TA-524, Order No. 40 (April 11, 2005). "The test for satisfying the 'technical prong' of the industry requirement is essentially same as that for infringement, i.e., a comparison of domestic products to the asserted claims." *Alloc v. Int'l Trade Comm'n*, 342 F.3d 1361, 1375 (Fed. Cir.

2003). The technical prong of the domestic industry can be satisfied either literally or under the doctrine of equivalents. *Certain Excimer Laser Systems for Vision Correction Surgery and Components Thereof and Methods for Performing Such Surgery*, Inv. No. 337-TA-419, Order No. 43 (July 30, 1999).

## **II. Analysis**

### **A. The Economic Prong**

In Order No. 24, I found that there remain genuine issues of material facts in dispute regarding whether or not Ricoh's investments in plant and equipment, labor and capital, engineering, and research and development meet the standards required by one of 19 U.S.C. § 1337(a)(3)(A), (B) or (C). I found, therefore, that summary determination on the issue of whether or not Ricoh meets the economic prong is not appropriate. I see nothing in the moving or responding papers in this motion to alter the findings of Order No. 24, and I find that there remain genuine issues of material fact in dispute regarding whether or not Ricoh has established that its activities in the United States meet the requirements of 19 U.S.C. § 1337(a)(3).

Therefore, I decline to grant summary determination on this issue.

### **B. The Technical Prong**

In Order No. 24, I found that in its February 23, 2010, supplemental response to Interrogatory No. 17, Ricoh had identified the products upon which it relied to establish the economic prong of the domestic industry requirement as follows: (1) MP 4000 with GlobalScan software for the '866 patent; and (2) MP 8001 for the '866, '771 and '048 patents. Therefore, Ricoh has the burden to show that either the MP 4000 with GlobalScan software, or the MP 8001, practices at least one claim of the '866 patent and that the MP 8001 practices at least one claim of the '771 and '048 patents, respectively.

Oki Data argues that Ricoh and its experts failed to provide an analysis of the MP 4000 for any of the patents for which that product was asserted under the economic prong. Oki Data concedes that Ricoh's experts did, however, analyze the MP 8001 (with GlobalScan software) in connection with the '866 patent, and the MP 8001 in connection with the '771 and '048 patents. Oki Data reasons that Ricoh has failed to provide any evidence that the MP 8001 meets the economic prong of the domestic industry requirement; but Oki Data's motion was filed the same day as Ricoh's motion that is covered by Order No. 24, in which Ricoh asserts that MP 8001 meets the economic prong for the three patents at issue herein.

Regarding the assertion that Ricoh has failed to provide expert analysis for the MP 4000, I note that in addressing the need for expert testimony, the Federal Circuit has explained that "[i]n many patent cases expert testimony will not be necessary because the technology will be 'easily understandable without the need for expert explanatory testimony.'" *Centricut, LLC v. Esab Group, Inc.*, 390 F.3d 1361, 1369 (Fed. Cir. 2004) (citation omitted). The court further "noted that 'typically' expert testimony will be necessary in cases involving complex technology." *Id.* at 1370 (citing *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1315 (Fed. Cir. 2002)). The court made clear that there is no "per se rule that expert testimony is required to prove infringement when the art is complex." *Id.*<sup>3</sup> Regarding the doctrine of equivalents, while the required particularized testimony is often presented by an expert, case law does not foreclose reliance on the testimony of a non-expert witness that is one of ordinary skill in the art. *AquaTex Indus., Inc. v. Techniche Solutions*, 479 F.3d 1320, 1329 (Fed. Cir. 2007) (noting that the particularized testimony needed to establish infringement under the doctrine of equivalents is "typically" provided by an expert witness).

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<sup>3</sup> To be clear, at this point I take no position regarding whether or not the technology relevant to this investigation is properly classified as "complex" technology; or whether or not expert testimony will be necessary in this instance.



While the foregoing cases discuss infringement, rather than the technical prong of the domestic industry requirement, the analysis to determine whether or not complainant's product practices a given claim is the same as that for infringement. Thus, the law applicable to the need for expert explanatory testimony applies equally here. *See, e.g., Certain Nor & Nand Flash Memory Devices*, Inv. No. 337-TA-560, Initial Determination (June 1, 2007). Therefore, I cannot find, as a requisite to granting summary determination, that the alleged lack of expert testimony necessarily means that Ricoh will be unable to meet its burden to show that its identified products practice the representative claims of the patent(s) for which they are offered to meet the technical prong of the domestic industry requirement. Ricoh has raised a genuine issue of material facts in dispute, and summary determination is, therefore, inappropriate on this particular matter.

It is clear that there remain genuine issues of material fact in dispute regarding whether or not Ricoh has met its burden to establish that its activities in the United States meet the threshold set forth in the statute for the economic prong and that the products upon which it bases its economic prong showing practice at least one claim of the patent(s) for which they were identified.

ORDER


Motion No. 690-021 is hereby **DENIED**.

Within seven (7) days of the date of this Order, each party shall submit to the Office of the Administrative Law Judges a statement as to whether or not it seeks to have any portion of this document deleted from the public version. The parties' submissions may be made by facsimile and/or 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. The parties' submissions concerning the public version of this document need not be filed with the Commission Secretary.

**SO ORDERED.**



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Robert K. Rogers, Jr.  
Administrative Law Judge

**CERTAIN PRINTING AND IMAGING  
DEVICES AND COMPONENTS THEREOF**

**Inv. No. 337-TA-690**

**PUBLIC CERTIFICATE OF SERVICE**

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** was served upon **Juan S. Cockburn, Esq.**, Commission Investigative Attorney, and the following parties via first class mail and air mail where necessary on **JUN 24 2010**

  
Marilyn R. Abbott, Secretary *JRA*  
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