



**AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION**  
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March 19, 2008

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

Re: Notice of Proposed Rulemaking  
Docket No. MISC-022

Dear Ms. Abbott:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to offer comments regarding the revisions proposed by the United States International Trade Commission (hereinafter “Commission”) to 19 C.F.R. Parts 201 and 210, as set forth at 72 Fed. Reg. 72280 (Dec. 20, 2007).

AIPLA is a national bar association whose more than 17,000 members are primarily lawyers in private and corporate practice, in government service, and in the academic community. AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA submits these comments to provide useful information to aid the Commission with its proposal to amend 19 C.F.R. Parts 201 and 210 to better accommodate parties seeking the unique relief available from the ITC under Section 337 of the Tariff Act of 1930, 19 U.S.C. §1337.

**I. Comments on Proposed Revisions to 19 C.F.R. § 210**

**A. 19 C.F.R. § 210.15(a)**

The Commission proposes to amend 19 C.F.R. §§210.15(a), 210.20(a), 210.58, and 210.75(b)(3) to eliminate the reference to the Chief Administrative Law Judge (hereinafter “Chief ALJ”). The Commission reasons that there is not currently a Chief ALJ, and that this revision would conform the rules to reflect the current practice.

AIPLA does not support the proposal to eliminate the reference to the Chief ALJ, for the reasons discussed below. The number of investigations before the ITC is growing each year. Reflecting the growing case load, the ITC has advertised a position for a fifth ALJ. Given the

state of flux in the ALJ Chambers, AIPLA believes that the rule should not be amended at this time since the Commission may, in the future, determine that a Chief ALJ would be desirable (even though no one is currently serving as Chief ALJ).

Further, we believe that a Chief ALJ would provide several benefits. First, appointing a Chief ALJ would allow for a point person in Chambers. In this regard, it would be beneficial to give one person coordinating responsibility for all of the ALJ's, or at least to have a point person that could speak on behalf of all of the ALJ's on particular matters. It may also be helpful for the ITC to have one ALJ to whom suggestions or concerns could be addressed. The Chief ALJ would in turn be able to discuss the matter with all of the ALJ's and provide a representative reply or position on the matter.

Accordingly, AIPLA believes that the rule should remain unchanged. Even if the Commission chooses not to make an appointment at this time, by retaining the position, the ITC would retain the option of appointing a Chief ALJ in the future should such action be determined desirable.

**B. 19 C.F.R. §§ 210.42 and 210.43**

The Commission has proposed to amend 19 C.F.R. §§ 210.42 and 210.43, which concerns the Final Initial Determination target date, as well as the date for the Commission to complete its review, if any, of the Final ID. Specifically, the Commission has proposed extending the minimum target date for reviewing any Final ID from 15 to 16 months. The Administrative Law Judge would still be required to complete his Final ID within 12 months.

AIPLA does not support this proposed rule change for several reasons. First, this proposed change will necessarily lengthen the time for the Commission to complete virtually all of its investigations. For example, this proposed rule provides the Commission one (1) extra month in all situations to review investigations, rather than to just those cases that require additional time because they are more complicated.

Second, the Commission's proposed rule is inconsistent with Congressional intent. When Congress eliminated the statutory time requirement of 12 months, it made clear, both in legislative history and in the statute that determinations are to be made "at the earliest practicable time," that the Commission was to adhere as closely as possible, in a normal investigation, to the 12 month period for concluding its investigations. Historically, normal investigations were usually completed within 12 months (or less), with only the more complicated investigations taking up to 18 months for completion. If the proposed rule were to be established, we fear that the Commission would make 16 months the norm, rather than the current 12 to 15 months. This would diminish the effectiveness and desirability of pursuing an investigation before the ITC.

Finally, recognizing that the Commission's Section 337 workload has increased, the Commission already has the power to grant itself more time, if necessary, to review a more complicated investigation. We therefore believe that the Commission should continue its present practice, rather than changing the rules as proposed to extend all time periods for completing investigations.

**C. 19 C.F.R. § 210.43(b)(1)**

The Commission proposes to amend 19 C.F.R. § 210.43(b)(1) to make two substantive changes to the requirements for petitions for review of a final initial determination on a matter other than temporary relief. First, for any petition for review exceeding 50 pages in length, the Commission proposes to require a summary not to exceed 10 pages. Second, the Commission proposes to impose a 100-page limit (exclusive of summary and exhibits) on the length of a petition for review of a final initial determination.

AIPLA agrees that a summary would be helpful to provide a high level overview of the salient points of the petition for review, regardless of the length of the petition.

However, with respect to the second proposed revision, AIPLA believes that it would be imprudent to impose a 100-page limit on the length of petitions for review. To preserve an issue of an ITC final determination for appeal to the U.S. Court of Appeals for the Federal Circuit, the issue must first have been raised in the petition for review. Thus, a party must be certain to raise all potential issues that might be considered for appeal in the petition for review. Many cases involve a high degree of complexity, involving multiple parties, multiple patents, multiple claims and claim limitations, as well as contested issues of claim construction, validity, and infringement. An adequate presentation of each point of error may well require a petition exceeding 100 pages. Because a party's right to appeal is at stake, the Commission should not place a limit of 100 pages on petitions for review.

**II. Proposal for Additional Revisions**

We would like to offer some additional suggestions for rule changes regarding service by email for consideration by the Commission. The rules for Section 337 investigations contain guidance for service on opposing parties and the Staff by first class mail, overnight delivery, and hand delivery; however, the rules do not specifically address service by email. The rules do indicate that service by email is allowed, however, they provide that “any dispute that arises among parties regarding electronic service must be resolved by the parties themselves, without the Commission’s involvement.” *See* 37 C.F.R. § 201.16(e).

As a practical matter, service in almost every Section 337 investigation is accomplished via email, as it provides the parties with greater flexibility, convenience, and expedition (*i.e.* one does not have to wait for the courier to deliver the documents or for next day mail delivery). Because the Commission’s rules do not provide for the particulars regarding service by email, it often takes the parties a significant amount of time, at the beginning of each investigation, to reach a satisfactory set of stipulations and agreements regarding the use of email to effect service. However, there remains the potential for issues to arise later in the investigation. Accordingly, AIPLA requests that the Commission amend the rules regarding email service to provide guidance, consistent with the present practice of parties before the ITC.

To aid the Commission, AIPLA offers the following suggestions for amending the rules for service by email. First, we believe the rules should be amended to indicate expressly that service may be made on opposing parties and Staff by email and that service by email is effective

on the day the email is sent if email delivery occurs before 6:30 p.m., EST, unless the parties agree on a different deadline. For clarity, it would be noted that filing electronically or by hand on the Secretary and ALJ, as specified in the Commission's rules and ALJ's ground rules, would still be required, *i.e.* the proposed revision would not affect filing with the Commission or ALJ in any way. It would only affect service on opposing counsel and Staff. Similar to present Commission rules for hand delivery or electronic delivery, if a party misses the service deadline by email, a petition would need to be filed for the document to be accepted despite the missed deadline.

Second, AIPLA suggests that, should confidential business information be transmitted via email, the parties should be required to protect this information by password. Thus, we suggest the rules provide that transmittal of confidential business information by email would be permitted for purposes of making service on opposing counsel and Staff, but that the transmittal must be protected by a password unless the parties agree otherwise.

Lastly, in most investigations, the parties stipulate that documents served via email should be in PDF form. This would protect the possibility of a dispute as to whether an opposing party subsequently altered the text of the document, as may possibly occur if the document is in Word, Word Perfect or other amendable text form. Additionally, the rule should provide an option for the parties to stipulate otherwise, in the event that it is not desirable or practical for a document to be in PDF form.

AIPLA appreciates the opportunity to provide these comments on the proposed rules and would be pleased to answer any questions our comments may raise.

Sincerely,

A handwritten signature in black ink, appearing to read "Michael K. Kirk". The signature is written in a cursive, flowing style.

Michael K. Kirk  
Executive Director