

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN TWO-WAY GLOBAL
SATELLITE COMMUNICATION
DEVICES, SYSTEM AND
COMPONENTS THEREOF**

Investigation No. 337-TA-854

**NOTICE OF COMMISSION DETERMINATION TO DENY ENFORCEMENT
RESPONDENTS' PETITION FOR RESCISSION, OR IN THE ALTERNATIVE,
MODIFICATION OF THE COMMISSION'S CIVIL PENALTY ORDER**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined to deny the petition for rescission, or in the alternative, modification of the Commission's civil penalty order filed by enforcement respondents DeLorme Publishing Company, Inc., and DeLorme InReach LLC (collectively, "DeLorme"), but now known as DBN Holding, Inc. and BDN LLC (collectively, "DBN"), all of Yarmouth, Maine.

FOR FURTHER INFORMATION CONTACT: Clint Gerdine, Esq., Office of the General Counsel, U.S. International Trade Commission, 500 E Street, SW., Washington, D.C. 20436, telephone (202) 708-2310. 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 SW., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <https://www.usitc.gov>. The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <https://edis.usitc.gov>. Hearing-impaired persons are advised that information on this matter can be obtained by contacting the Commission's TDD terminal on (202) 205-1810.

SUPPLEMENTARY INFORMATION: The Commission instituted an underlying enforcement proceeding on May 24, 2013, based on an enforcement complaint filed on behalf of BriarTek IP, Inc. ("BriarTek") of Alexandria, Virginia. 78 FR 31576-77 (May 24, 2013). The complaint alleged violations of the April 5, 2013 consent order ("the Consent Order") issued in the underlying investigation by the continued practice of prohibited activities such as selling or offering for sale within the United States after importation any two-way global satellite communication devices, system, or components thereof that infringe one or more of the asserted

claims of U.S. Patent No. 7,991,380 (“the ’380 patent”). The Commission’s notice of institution of the enforcement proceeding named DeLorme as respondents. The Office of Unfair Import Investigations was also named as a party.

On March 7, 2014, the administrative law judge (“ALJ”) issued her enforcement initial determination finding a violation of the Consent Order. She concluded that, after issuance of the Consent Order, DeLorme sold or offered for sale within the United States after importation accused InReach 1.5 devices that infringe, via inducement, claims 1 and 2 of the ’380 patent. The ALJ also found no induced infringement and therefore no violation of the Consent Order with respect to accused InReach SE devices. The ALJ also recommended a civil penalty of \$637,500 against DeLorme as an enforcement measure for the violation. On April 23, 2014, after review, the Commission determined to reverse the ALJ’s finding of no induced infringement and no violation of the Consent Order with respect to accused InReach SE devices. As a result of this additional finding of violation, on June 9, 2014, the Commission issued a civil penalty order in the amount of \$6,242,500 for DeLorme’s violation of the Consent Order on 227 separate days.

DeLorme timely appealed the Commission’s final determination to the U.S. Court of Appeals for the Federal Circuit. During the pendency of the appeal, the U.S. District Court for the Eastern District of Virginia (“EDVA”) found the relevant claims of the ’380 patent to be invalid. Upon order of the Federal Circuit, prior to oral argument, DeLorme and the Commission submitted briefing regarding any potential effect of the affirmance of the invalidity judgment on the Commission’s final determination. On November 12, 2015, the Federal Circuit affirmed the EDVA invalidity judgment. 622 Fed.Appx. 912 (Fed. Cir. 2015). On that same day, the Federal Circuit affirmed the Commission’s final determination and civil penalty in a precedential decision. *See DeLorme v. ITC*, 805 F.3d 1328 (Fed. Cir. 2015). Among other findings, the Court held that: (1) it, rather than the Commission, should decide the issue of the effect of the affirmance of the EDVA invalidity judgment; and (2) the affirmance of the EDVA invalidity judgment had no effect on the Commission’s final determination.

On December 22, 2015, following issuance of the Federal Circuit’s decision, DeLorme filed a petition to rescind, or in the alternative, to modify the civil penalty order under Commission Rule 210.76(a)(1) on the basis of the EDVA invalidity judgment and on certain public interest arguments. BriarTek and the Commission investigative attorney (“IA”) each filed a response in opposition to the petition on January 4 and 11, 2016, respectively. Also, on January 15 and 22, 2016, respectively, DeLorme filed a motion for leave to file a reply to the IA’s opposition and BriarTek filed a response to this motion.

On December 28, 2015, while its petition for rescission or modification with the Commission was still pending, DeLorme filed a petition for rehearing *en banc* with the Federal Circuit. After this petition was denied by the Federal Circuit, DeLorme (now known as DBN) filed a petition for certiorari with the U.S. Supreme Court. This petition was also denied. *See DBN Holding, Inc. v. ITC*, 137 S.Ct. 538 (Nov. 28, 2016).

For the reasons set forth in the Commission's Order, issued contemporaneously with this notice, the Commission has determined to deny DeLorme's petition. The Commission has also determined to deny DeLorme's motion for leave to file a reply.

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 part 210 of the Commission's Rules of Practice and Procedure, 19 CFR part 210.

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton'.

Lisa R. Barton
Secretary to the Commission

Issued: April 4, 2017