

**HARRISON
FOERSTER**

ITC War Games: Winning Offensive and Defensive Strategies

2025 SFBA-ACC IP SYMPOSIUM

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Agenda

In-House Challenges

OUII (Staff Attorney)

Filing & Remedy Strategies

IPR Strategies

Discovery Strategies

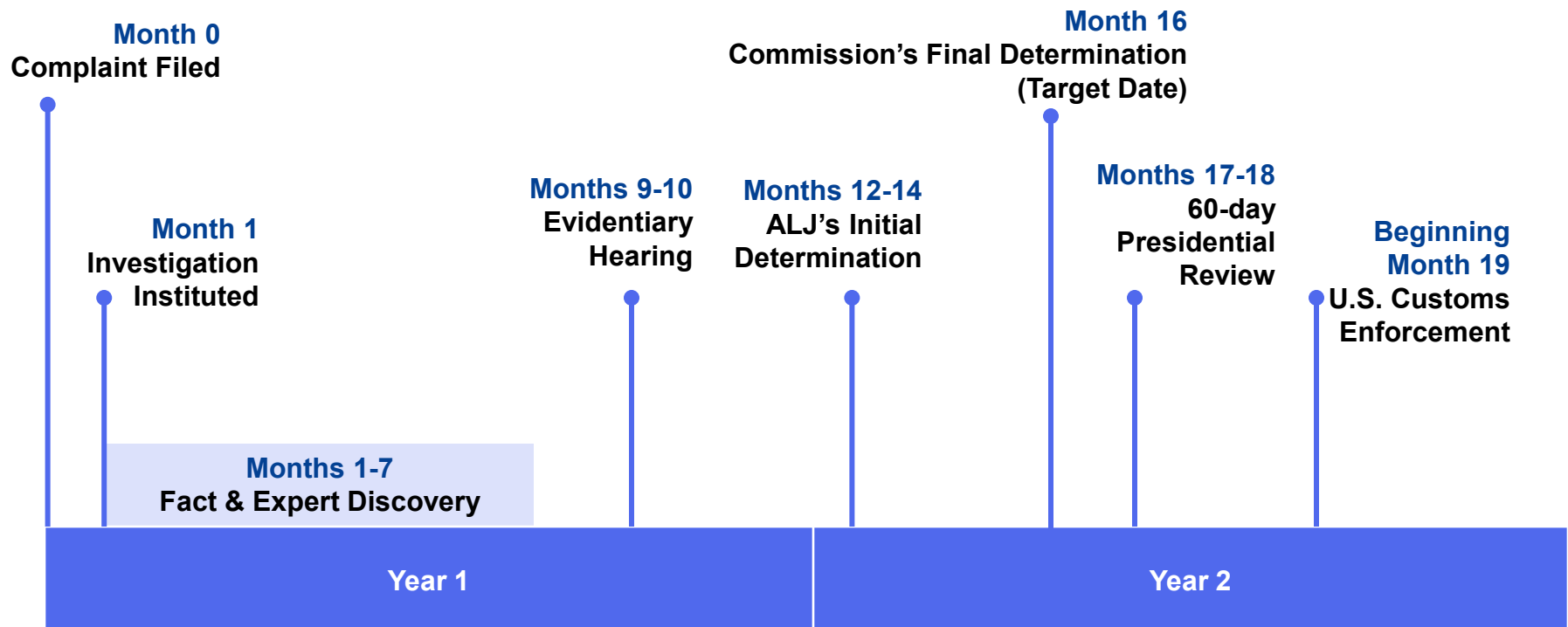
Bond Strategies

Redesigns Strategies



Exemplary ITC Timeline

Assuming a 16-month target date:



Key Differences Between the ITC and District Court

Feature	ITC (Section 337)	District Court
Remedies	Exclusion & C&D orders	Damages & injunctions
Timeline	~16 months (fast)	~2–4+ years (slower)
Discovery	Compressed, heavy, broad	Longer timeframe
Domestic Industry	Required	Not required
Invalidity	Not binding outside ITC	Binding nationwide once final
Enforcement	U.S. Customs / ITC	Court

In-house Challenges at the ITC

- No access to CBI
- Documents and witness preparation
- Parallel proceedings
- Business disruption
- Managing costs
- Global implications



ITC Complaint—Complainant Strategy

- Choose patents difficult to design around
- Get ready for domestic industry (econ + tech)
 - R&D, manufacturing, headcounts, licensing
 - Non-manufacturing investments (sales, marketing, distribution)
 - Have a product that practices an asserted patent
- Name key infringers to avoid “whack-a-mole”
 - Distributors?
 - Importers?
 - Downstream customers?



Office of Unfair Import Investigations

- Pre-Filing Complaint Review
- Discovery Dispute Input
- Tech Tutorial
- Claim Construction
- Evidentiary Hearing
- Meet & Confer
- Discussion Before Filing of Post-Hearing Brief
- Review Before the Commission



Strategy in parallel forums



ITC



DCT

Responding to ITC Complaint—Respondent Strategy

- Scrutinize importation evidence
- Consider early 100-day determination (rare & disfavored)
 - Econ DI, standing, 101
- Coordinate with co-respondents
 - Shift liability to upstream suppliers?
 - Assess indemnification
 - Align defenses where possible

ITC Remedies

Limited Exclusion Order (LEO): Prohibits importation of infringing articles made or distributed by named respondents.



General Exclusion Order (GEO): Prohibits importation of *all* infringing articles regardless of source. Require: (1) order is necessary to prevent circumvention of an LEO, or (2) a pattern of violation and difficult to identify the source of the infringing products.



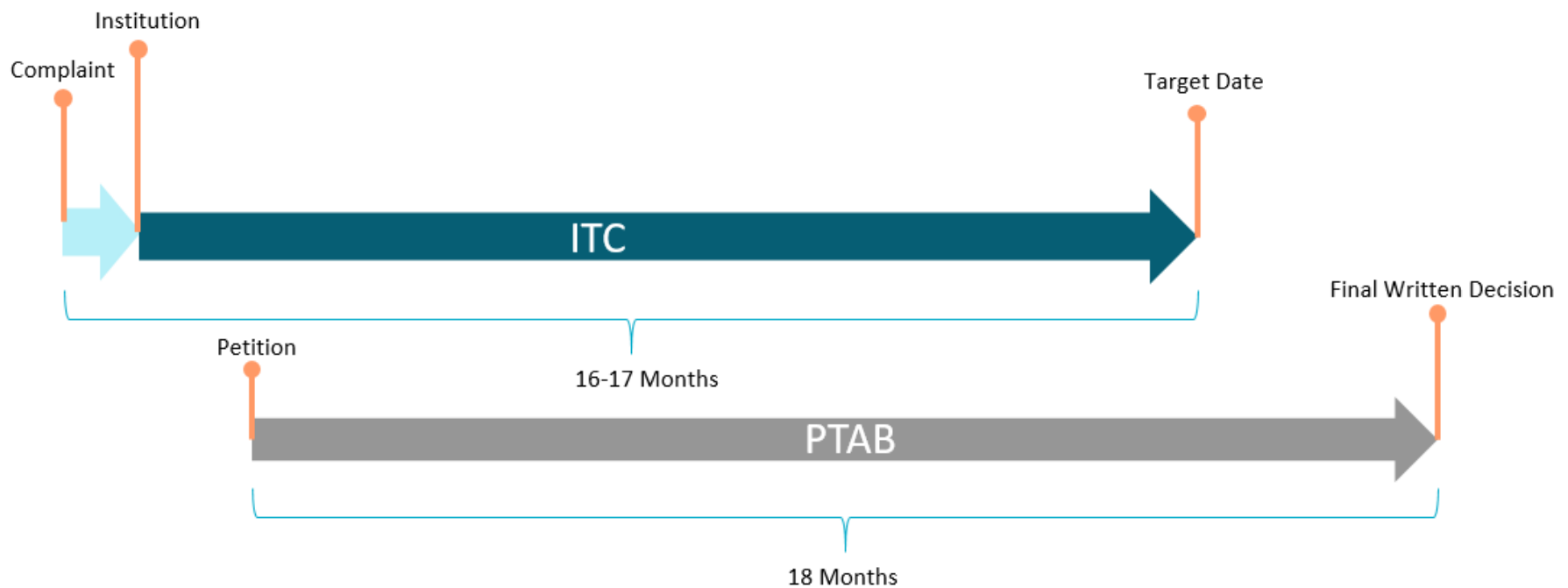
Cease and Desist Order (CDO): Prohibits named respondents from engaging in conduct relating to the infringement, such as marketing and selling infringing goods in the U.S.



Takeaways regarding GEOs

- For complainants:
 - Research scope of unauthorized sales to make a strong empirical showing of pattern of violation.
 - Be ready to prove your case even if respondents will default.
- For non-parties whose products may be affected by GEO:
 - Consider intervening in investigation to defend interests.
 - Consider U.S. Customs Part 177 proceeding to carve out products not within scope of GEO

ITC and IPRs—File or not to File?



IPRs—Respondent Strategy

- File early to avoid *Fintiv* denial
- Use *Sotera* stipulations (ITC and IPR to cover different grounds)
- Prioritize weak/central patents
- Make consistent arguments across forums
- Obtain admissions from patent owner
- Leverage filings even without institution

Race Between PTAB and ITC

Suspension of remedial orders

Certain Unmanned Aerial Vehicles, 337-TA-1133, Comm'n Op. (Sept. 8, 2020)

- IPR FWD issued after ALJ's ID but before ITC's Final Determination.
- Commission affirmed violation but suspended remedial orders.

Certain Wearable Electronic Devices, 337-TA-1266, Comm'n Op. (Jan. 20, 2023)

- IPR FWD issued six days before ITC's Final Determination.
- Commission suspended remedial orders.

Race Between PTAB and ITC

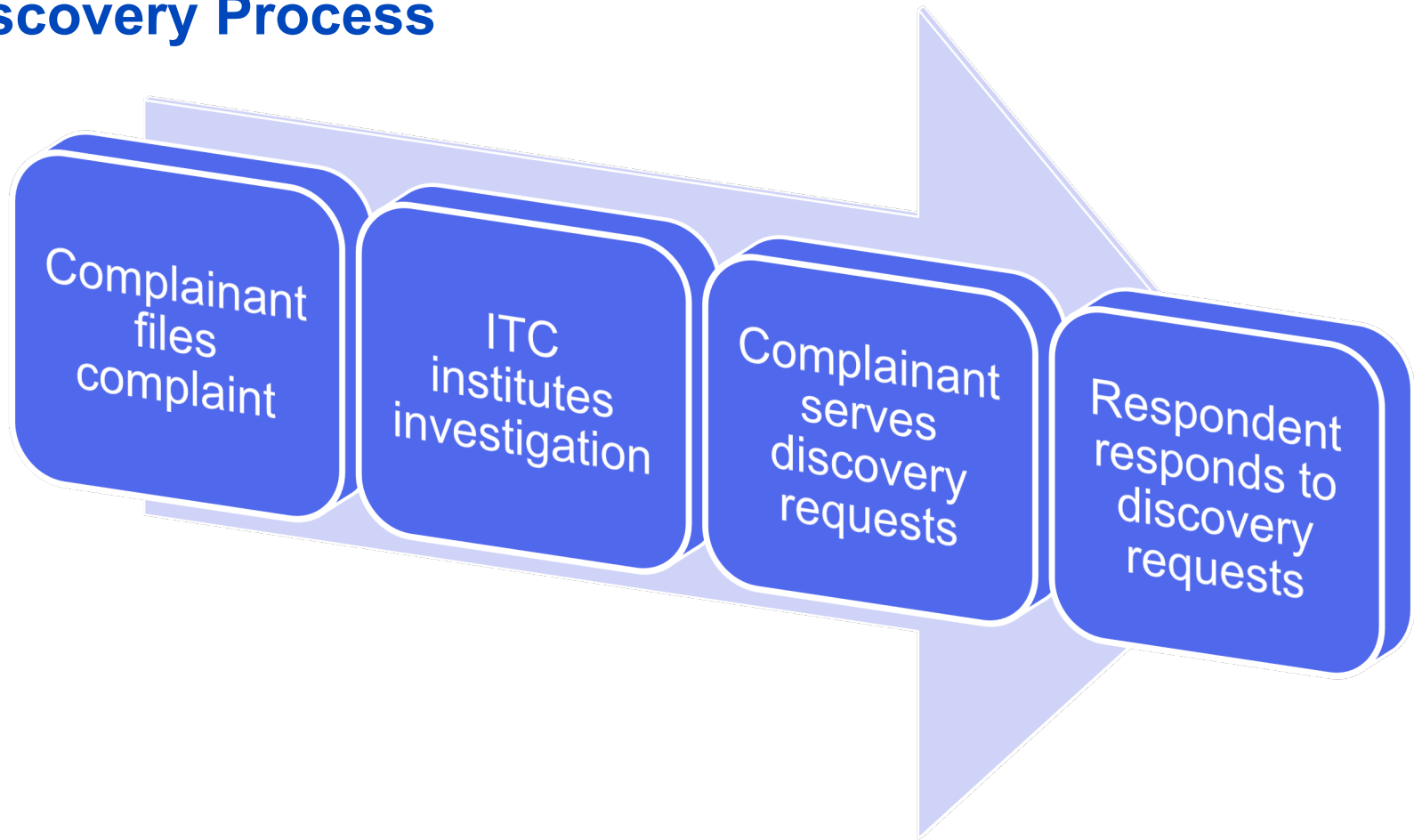
Suspension of remedial orders

***Certain Network Devices (II)*, 337-TA-945**, Comm’n Op. (Aug. 16, 2017)

- IPR FWD issued a month after ITC’s Final Determination.
- ITC denied suspension of remedial orders.
- Respondents “may seek redress from the Commission” when “the PTO issues certificates cancelling [asserted] claims, which it cannot do until exhaustion of any appeals.”

Discovery

Discovery Process



Discovery—Complainant Strategy

Key Discovery Considerations

- Start production immediately upon institution
- Top discovery to seek:
 - Importation + technical proof = jurisdiction + infringement
 - Sales + financial data = harm to complainant & remedies
 - Design, marketing, licensing = intent, copying, and public interest factors
- Burden contentions (invalidity, non-infringement, redesigns, non-importation, lack of DI)
- Experts – Retain early to review complaint, tech DI/infringement, econ DI declaration, etc.



Discovery—Respondent Strategy

Key Discovery Considerations



- Top discovery to seek:
 - DI evidence = test nexus to asserted patents
 - Prior art & internal communications = build invalidity
 - Market analysis & customer communications = harm caused by other factors
 - Use third-party subpoenas (e.g., system art)
- Burden contentions on infringement & DI
- Consider stipulations to narrow scope (e.g., discovery limits, importation, representative products)
- Experts – Critical for economic positions (econ DI and bond) and technical positions (non-infringement, invalidity, and tech DI)

Discovery

Discovery Deadlines

- Timeline
 - Discovery responses due within 10 days from service
 - 10 days = calendar days *but* does not start until the first *business day* after service date
- Parties need not produce within 10 days but need to produce on a rolling basis
- Triage immediately and prioritize
 - Negotiate scope: narrow custodians, date range, search terms
 - Leverage block statutes / privacy laws
 - Be cautious of email discovery

Discovery—When to Serve?

SEPTEMBER 2025



SUN	MON	TUE	WED	THU	FRI	SAT
31	1	2	3	4	5	6
7	8	9	10	11	12	13
14	15	16	17	18	19	20
21	22	23	24	25	26	27
28	29	30	1	2	3	4


Discovery—When to Serve?

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Discovery—When to Serve?

SEPTEMBER 2025



A calendar grid for September 2025. The days of the week are listed in the header row: SUN, MON, TUE, WED, THU, FRI, SAT. The dates are arranged in a 5x7 grid. Annotations include: a blue circle around the date 1 (Monday); a blue circle around the date 2 (Tuesday); a blue arrow pointing from the top right towards the date 2; a blue 'X' mark on the date 11 (Thursday); and another blue 'X' mark on the date 12 (Friday).

SUN	MON	TUE	WED	THU	FRI	SAT
31	1	2	3	4	5	6
7	8	9	10	11 X	12 X	13
14	15	16	17	18	19	20
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Bond Strategy

- For Complainants:
 - Expert opinion on Econ DI and Bond
 - Bond is important to put pressure on Respondent
 - Goal – Get as close to 100% Bond during Presidential Review Period
 - Show Respondent's product is much cheaper than Complainant's

- For Respondents:
 - Compare price of accused good vs. Complainant's good
 - Goal – Get sales point as close as possible to Respondent's
 - Showing products have similar costs will lower Bond rate

Redesigns – When to Raise?

Seek adjudication during investigation

1

Discuss with Customs before Final Determination

2

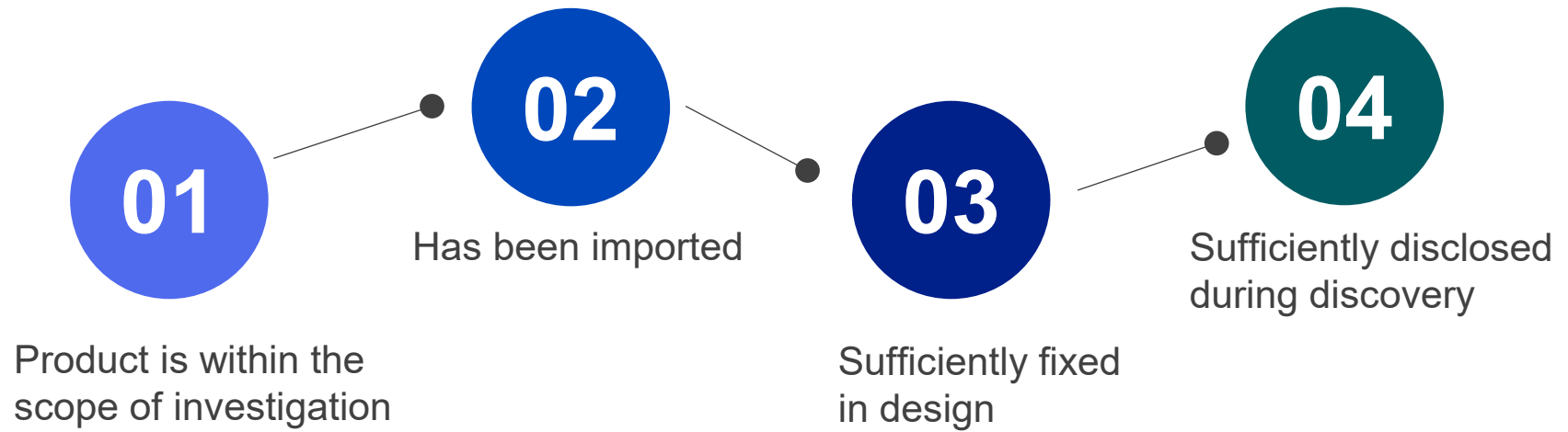
Part 177 proceedings before Customs

3

ITC modification & enforcement proceedings

4

Test for Adjudication during Investigation



Redesigns Adjudicated in Investigation – Software

Certain Audio Players and Controllers, Comm'n Op. (Feb. 1, 2022)

- Google produced source code and physical sample
- Google disclosed its completed redesigns **one month before close of fact discovery**
- One redesign found to be non-infringing
- Google was able to continue to sell redesign despite remedial orders
- In software context, small modifications to source code may be sufficient

Redesigns Adjudicated in Investigation – Non-software

Certain Polycrystalline Diamond Compacts, Comm'n Op. (Oct. 26, 2022)

- Respondent SF Diamond disclosed 7 redesigns and produced physical samples
 - **one week before close of fact discovery**
 - **3 weeks before expert reports**
- Complainant did not respond to SF Diamond's offer to inspect, request additional time for testing, or move to supplement its contentions
- Redesigns adjudicated as non-infringing

Redesigns Adjudicated in Investigation – Non-software

Certain Unmanned Aerial Vehicles, Comm'n Op. (Sept. 8, 2020)

- Redesign not sufficiently fixed
 - Failed to show how the redesigned rotors were used with a UAV
- Complete redesign sample produced late
 - **After close of fact discovery**
 - Shortly before the deadline for serving rebuttal expert reports
- Denied adjudication of redesign

Winning Redesigns—Respondent Strategy

Strategies Before Remedial Order

- Quickly develop commercially-viable redesigned product
- Protect A-C privilege information relating to redesign
- Must disclose before close of fact discovery
 - Make an affirmative case of non-infringement in contentions
 - Supplement interrogatory responses
 - Produce documents, code, witness testimony, etc.
 - Designate corporate witness for depositions
 - Prepare witness so testimony is consistent with documents
 - Import samples
 - Submit expert opinions of non-infringement
- Must raise everything before evidentiary record closes (end of hearing)

Opposing Redesign—Complainant Strategy

Strategies Before Remedial Order

- Insufficient evidence disclosed before fact discovery?
- Redesign samples not function properly?
- Insufficient evidence to show samples imported?
- Inconsistent corporate testimony?
 - E.g., showing redesigns not ready and lack adequate testing

Adjudication after Investigation

Modification Proceedings (19 C.F.R. § 210.76)

- Adjudicate redesign/new product to determine if they fall within remedial order's scope
- Initiated by: Respondent or Complainant.

Enforcement Proceedings (19 C.F.R. § 210.75)

- Adjudicate infringement of redesigned product being imported
 - Determines whether respondent violated a remedial order
 - Civil penalties can be imposed
- Initiated by: Complainant

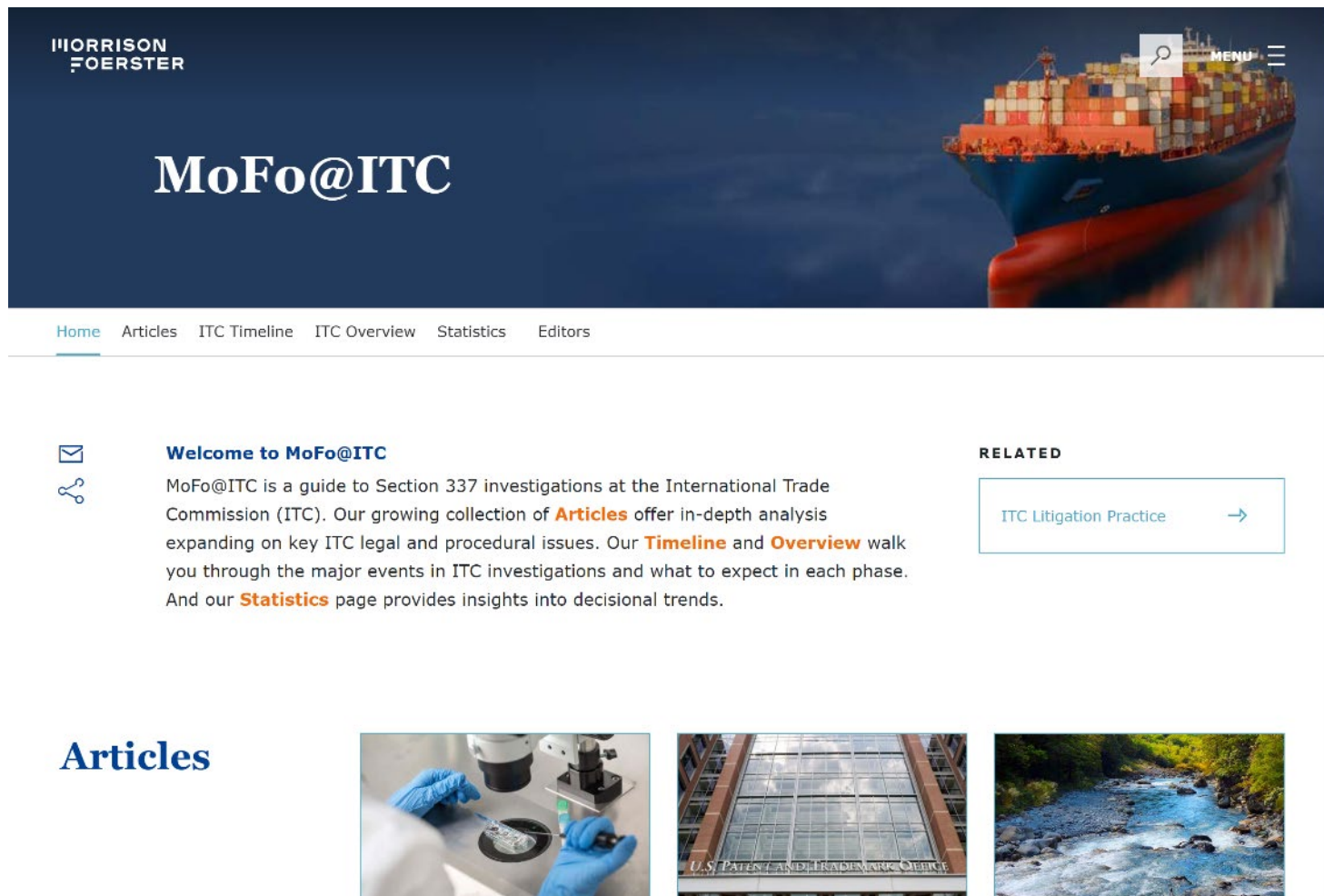
U.S. Customs Part 177 Proceeding (19 C.F.R. § 177)

- Determines whether redesigns ready after investigation infringe remedial orders
- Initiated by: Respondent

How to Choose?

	CBP Part 177	ITC Modification
Pros	<ul style="list-style-type: none">▪ Faster▪ Less expensive	<ul style="list-style-type: none">▪ Expertise & familiarity with patents and products▪ Binding on CBP▪ Appealable to Fed. Cir.
Cons	<ul style="list-style-type: none">▪ Not binding on ITC▪ No access to confidential records from investigation▪ Appeals to CIT (Court of International Trade)	<ul style="list-style-type: none">▪ Longer▪ More expensive (including discovery)

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