

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

CERTAIN INKJET INK CARTRIDGES
WITH PRINTHEADS AND
COMPONENTS THEREOF

Inv. No. 337-TA-723

**ORDER NO. 12: DENYING RESPONDENTS MIPO SCIENCE & TECHNOLOGY
CO., LTD. & MIPO TECHNOLOGY LIMITED'S RENEWED
MOTION FOR TERMINATION BASED ON ENTRY OF A
CONSENT ORDER**

(October 5, 2010)

On September 30, 2010, respondents Mipo Science and Technology Co., Ltd. and Mipo Technology Limited (collectively "Mipo") filed a motion to terminate on the basis of a consent order. (Motion Docket No. 723-004.) On October 1, 2010, the Commission Investigative Staff ("Staff") filed a response opposing the motion.

I find that Mipo's Consent Order Stipulation and Proposed Consent Order both contain language that is not proper, because it runs contrary to a "consent order." Specifically, Mipo agrees not to import products that infringe the asserted patents "until the expiration, invalidation, and/or a finding of enforceability [*sic*] of the claims of the Asserted Patents *or until Mipo's products are found not to infringe* or are licensed." (Consent Order Stipulation at ¶ 5; Proposed Consent Order at ¶ 5.) (Emphasis added.) The inclusion of the language stating that the consent order shall apply "until Mipo's products are found not to infringe" is improper. In a consent order, a respondent is agreeing to refrain from importing any products that infringe the asserted patents. The respondent is relinquishing its right to challenge the complainant's infringement

infringement contentions before the Commission. If such language is included in the consent order, the situation could arise wherein the consent order is, arguably, rendered unenforceable if Mipo obtains a non-infringement ruling from a forum other than the Commission (*e.g.* the U.S. District Court). I find that this result would run counter to the purpose and meaning of a consent order.

With respect to the language regarding expiration, invalidation, and unenforceability, the language is redundant. Mipo's Proposed Consent Order properly includes another paragraph which states that:

The Consent Order shall not apply with respect to any claim of any intellectual property right that has expired or been found or adjudicated invalid or unenforceable by the Commission or a court or agency of competent jurisdiction, provided that such finding or judgment has become final and nonreviewable.

(Proposed Consent Order at ¶ 9.) This language comports with the language found in the Commission Rule governing consent orders and adequately addresses the applicability of the consent order when a patent is expired, invalid, or unenforceable. 19 CFR § 210.21(c)(3)(i)(B)(1).

Staff opposes the motion because the Consent Order Stipulation and Proposed Consent Order are not limited to the asserted claims of the patents at issue. Staff asserts that the Proposed Consent Order reaches beyond the scope of the investigation and the Commission's jurisdiction.


I concur with Staff and find that the Consent Order Stipulation and Proposed Consent Order cannot exceed the scope of the investigation. The Commission's Notice of Investigation determines the scope of the investigation. *See Certain NOR & NAND Flash Memory Devices & Products Containing Same*, Inv. No. 337-TA-560, Order No. 14 (July 6, 2006). Here, the Commission's Notice of Investigation is limited to certain asserted claims from each patent at

issue. Therefore, any consent order that is broader than the Notice of Investigation is beyond the scope of the investigation and the Commission's jurisdiction.

ORDER

Mipo's motion for termination based on the entry of a consent order is hereby denied without prejudice. Mipo may re-file its motion with the changes noted, *supra*.

SO ORDERED.



Robert K. Rogers, Jr.
Administrative Law Judge

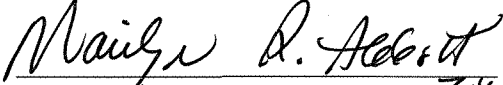
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PUBLIC CERTIFICATE OF SERVICE

I, Marilyn R. Abbott, hereby certify that the attached **ORDER** was served upon **Rett Snotherly, Esq.**, Commission Investigative Attorney, and the following parties via first class mail delivery

on **OCT 05 2010**


Marilyn R. Abbott, Secretary *TRK*
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PUBLIC CERTIFICATE OF SERVICE PAGE 2

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