

UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.

In the Matter of

**CERTAIN SEMICONDUCTOR CHIPS
WITH MINIMIZED CHIP PACKAGE
SIZE AND PRODUCTS CONTAINING
SAME**

Investigation No. 337-TA-605

**NOTICE OF COMMISSION DETERMINATION NOT TO REVIEW AN INITIAL
DETERMINATION DENYING COMPLAINANT TESSERA, INC.'S MOTION FOR
SUMMARY DETERMINATION OF BOND FORFEITURE BY RESPONDENT
FREESCALE SEMICONDUCTOR, INC. AS PREMATURE**

AGENCY: U.S. International Trade Commission.

ACTION: Notice.

SUMMARY: Notice is hereby given that the U.S. International Trade Commission has determined not to review the presiding administrative law judge's ("ALJ") initial determination ("ID") (Order No. 72) denying a motion of complainant Tessera, Inc. ("Tessera") for summary determination of bond forfeiture by respondent Freescale Semiconductor, Inc. ("Freescale") as premature.

FOR FURTHER INFORMATION CONTACT: Megan M. Valentine, Office of the General Counsel, U.S. International Trade Commission, 500 E Street, S.W., Washington, D.C. 20436, telephone (202) 708-2301. 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, S.W., Washington, D.C. 20436, telephone (202) 205-2000. General information concerning the Commission may also be obtained by accessing its Internet server at <http://www.usitc.gov>. The public record for this investigation may be viewed on the Commission's electronic docket (EDIS) at <http://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 this investigation on May 21, 2007, based on a complaint filed by Tessera of San Jose, California against Spansion, Inc. and Spansion, LLC, both of Sunnyvale, California (collectively "Spansion"); Qualcomm Incorporated of San Diego, California ("Qualcomm"); ATI Technologies of Thornhill, Ontario, Canada ("ATI"); Motorola, Inc. of Schaumburg, Illinois ("Motorola"); STMicroelectronics N.V. of Geneva, Switzerland ("ST-NV"); and Freescale. *72 Fed. Reg.* 28522 (May 21, 2007). The complaint alleged violations of section 337 of the Tariff Act of 1930, as amended, 19 U.S.C. §

1337, in the importation into the United States, the sale for importation, and the sale within the United States after importation of certain semiconductor chips with minimized chip package size or products containing same by reason of infringement of one or more claims of U.S. Patent Nos. 5,852,326, and 6,433,419.

On May 20, 2009, the Commission issued its final disposition of the investigation, finding a violation of section 337. 74 *Fed. Reg.* 25579-81 (May 28, 2009). The Commission also issued a limited exclusion order (“LEO”) and cease and desist orders against all respondents. On August 18, 2009, the Commission granted a joint petition by Tessera and Motorola to rescind in whole the cease and desist order directed to Motorola based upon a license agreement entered into between the two parties.

On October 16, 2009, Tessera filed a motion for forfeiture of Respondents’ bonds, limited discovery and evidentiary hearing pursuant to section 210.50(d) of the Commission’s Rules of Practice and Procedure (19 C.F.R. § 210.50(d)). On December 20, 2009, the ALJ issued Order No. 65 denying the motion as premature because an appeal of the Commission’s final determination was then pending before the U.S. Court of Appeals for the Federal Circuit. The Federal Circuit ultimately upheld the Commission’s determination (*see Spansion, Inc. v. ITC*, 629 F.3d 1331 (Fed. Cir. 2010), *reh’g and reh’g en banc denied*, March 29, 2011), and on November 28, 2011, the Supreme Court denied Respondents’ petitions for a writ of certiorari (*see* Supreme Court Nos. 11-127, 128).

On January 4, 2012, Tessera filed a motion to re-open the investigation to institute bond forfeiture proceedings, seeking forfeiture of the bond amounts required to have been posted by Respondents. On April 2, 2012, the ALJ issued an ID (Order No. 68) granting Tessera’s motion. On May 18, 2012, the Commission determined not to review Order No. 68. *See* Notice of Commission Determination Not To Review (May 18, 2012). Also on April 2, 2012, the ALJ issued an ID (Order No. 70) granting a joint motion of Tessera and respondent Qualcomm requesting an ID regarding bond forfeiture and terminating Qualcomm from any further proceedings. The Commission did not review this ID. *See* Notice of Commission Determination Not To Review (April 25, 2012).

On May 14, 2012, Tessera filed a motion for summary determination of bond forfeiture by Freescale, seeking to have the bonds posted by Freescale pursuant to the LEO and cease and desist order forfeited, as well as the payment of any pre-judgment interest. The motion indicated that Freescale opposed the motion and that the other remaining respondents did not take a position on the motion.

On May 15, 2012, the ALJ issued the subject ID, denying Tessera’s motion as premature. The ALJ noted that Order No. 68 was then still pending before the Commission. The ALJ invited Tessera to refile its motion once the Commission had ruled on Order No. 68. No petitions for review of this ID were filed. Tessera refiled its motion for forfeiture on May 21, 2012, after the Commission had ruled on Order No. 68.

The Commission has determined not to review the ID.

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 section 210.42 of the Commission's Rules of Practice and Procedure (19 C.F.R. § 210.42).

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', enclosed within a large, loopy oval flourish.

Lisa R. Barton
Acting Secretary to the Commission

Issued: June 15, 2012