



## INTERNATIONAL TRADE COMMISSION

[Investigation No. 337-TA-1088 (Rescission)]

### **Certain Road Construction Machines and Components Thereof; Commission Decision to Institute a Rescission Proceeding; Permanent Rescission of a Limited Exclusion Order and Cease and Desist Order; Termination of the Rescission Proceeding**

**AGENCY:** U.S. International Trade Commission.

**ACTION:** Notice.

**SUMMARY:** Notice is hereby given that the U.S. International Trade Commission has determined to institute a proceeding to determine whether to permanently rescind the Commission's limited exclusion order ("LEO") and cease and desist order ("CDO") issued in the above-captioned investigation. The LEO and the CDO are permanently rescinded. The rescission proceeding is terminated.

**FOR FURTHER INFORMATION CONTACT:** Houda Morad, Office of the General Counsel, U.S. International Trade Commission, 500 E Street SW, Washington, DC 20436, telephone (202) 708-4716. Copies of non-confidential documents filed in connection with this investigation may be viewed on the Commission's electronic docket (EDIS) at <https://edis.usitc.gov>. For help accessing EDIS, please email [EDIS3Help@usitc.gov](mailto:EDIS3Help@usitc.gov). 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 this investigation on November 29, 2017, based on a complaint, as supplemented, filed by Caterpillar Inc. of Peoria, Illinois and Caterpillar Paving Products, Inc. of Minneapolis, Minnesota (collectively,

“Caterpillar”). *See* 82 FR 56625-26 (Nov. 29, 2017). The complaint, as supplemented, alleges violations of section 337 of the Tariff Act of 1930, as amended (19 U.S.C. 1337) (“section 337”), based upon the importation into the United States, the sale for importation, and the sale within the United States after importation of certain road construction machines and components thereof by reason of infringement of certain claims of U.S. Patent Nos. 7,140,693 (“the ’693 patent”); 9,045,871; and 7,641,419. *See id.* The notice of investigation identifies the following respondents: Wirtgen GmbH of Windhagen, Germany; Joseph Vögele AG of Ludwigshafen, Germany; Wirtgen Group Holding GmbH of Windhagen, Germany; and Wirtgen America, Inc. of Antioch, Tennessee (“Wirtgen America”) (collectively, “Wirtgen”). *See id.* The Office of Unfair Import Investigations is not a party to this investigation. *See id.*

On June 27, 2019, the Commission found a violation of section 337 based on the infringement of claim 19 of the ’693 patent and issued an LEO against the infringing articles and a CDO against Wirtgen America (collectively, “the remedial orders”). *See* 84 FR 31910-11 (July 3, 2019).

On January 16, 2020, the Commission instituted a modification proceeding to determine whether Wirtgen’s redesigned series 1810 machines infringe claim 19 of the ’693 patent. On August 31, 2020, the Commission determined that Wirtgen’s redesigned machines do not infringe and issued modified remedial orders exempting the redesigned machines from the scope of the orders. *See* 85 FR 55320-21 (Sept. 4, 2020).

On April 29, 2021, Caterpillar and Wirtgen filed a joint petition to rescind the remedial orders. Commission Rule 210.76(a)(1), 19 CFR 210.76(a)(1), permits rescission of Commission remedial orders on the basis of “changed conditions of fact or law.” The petition asserts that such changed conditions exist here. In particular, the parties explain that the Patent Trial and Appeal Board (“PTAB”) of the U.S. Patent and Trademark Office found claim 19 of the ’693 patent to be unpatentable in a Final Written Decision, that Caterpillar took an appeal from the

PTAB to the U.S. Court of Appeals for the Federal Circuit, that Caterpillar moved the Federal Circuit to dismiss its appeal, and that the Federal Circuit granted that motion. Pet. at 1-2.

In view of the Federal Circuit's dismissal of Caterpillar's appeal from the PTAB's Final Written Decision, the fact that the patent claim upon which the remedial orders are based is unpatentable, and the fact that Caterpillar and Wirtgen both agree that rescission is appropriate now, the Commission has determined to institute a rescission proceeding and to grant the joint petition for rescission. The Commission permanently rescinds the LEO and the CDO. The rescission proceeding is hereby terminated.

The Commission's vote for this determination took place on May 14, 2021.

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.

Issued: May 14, 2021.

**Lisa Barton,**

*Secretary to the Commission.*

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