



## INTERNATIONAL TRADE COMMISSION PRACTICE

Trial Lawyers Who Focus  
on ITC Investigations

### DESMARAIS LLP

New York, New York  
212-351-3400

San Francisco, California  
415-573-1900

Washington, DC  
202-451-4900

[desmaraisllp.com](http://desmaraisllp.com)



### Best Law Firm National Patent Litigation

*2023 U.S. News & World Report, Best Lawyers*

Desmarais LLP attorneys have participated in over 20 International Trade Commission investigations, most of which have gone through an evidentiary hearing before one of the ITC's Administrative Law Judges ("ALJs"). Those cases have spanned rights and technologies as diverse as trademarks and trade dress on forage harvesters to patents related to sucralose manufacturing processes and digital dental scanning and related software applications. Through our varied and deep experience, we are familiar with the ALJ's and the Office of Unfair Import Investigation Staff ("OUII") at the Commission, are comfortable with the unique procedural requirements and speed of ITC investigations, are experienced with how those investigations interplay with District Court and PTAB proceedings.

Desmarais LLP attorneys have been and remain committed to the ITC, having served on the board of the ITC Trial Lawyers Association, including as its President, and regularly teaching a law school class on ITC policy and procedure. Desmarais LLP's attorneys have represented ITC complainants seeking to enforce their intellectual property against a primary competitor, or in some cases, many industry competitors. The procedural mechanisms of the ITC provide an efficient and effective means to address widespread infringement. Our lawyers have successfully obtained hard-to-get exclusion orders and were the

counsel to successfully navigate and win demanding 100-day proceeding on standing that could have derailed the matter before substantive discovery even started. We have also represented respondents who have been brought to the ITC by patent holders seeking to keep their competitor's products out of the United States to maximize their market share or use the threat of an exclusion order as leverage in licensing negotiations.

### For the Complainant

Desmarais LLP attorneys secured a victory at the International Trade Commission for OPEX Corporation. Desmarais LLP attorneys conducted a one-week evidentiary hearing that started the Monday after Thanksgiving and resulted in a complete victory for OPEX with a finding that competitors infringed the patented technology embodied in its industry-leading Sure Sort product line. OPEX alleged HC Robotics, based in Hangzhou, China, was importing warehouse automation systems through Pennsylvania-based distributor Invata, which infringed its patents.

After the hearing, the ITC Chief Judge ruled that HC Robotics and Invata violated section 337 of the Tariff Act of 1930 with the "importation of certain automated put walls and automated storage and retrieval systems, associated vehicles, associated control software, and component parts" - namely, their infringing Omnisort systems. Then, the Commission fully upheld Desmarais LLP's complete trial victory for OPEX and issued limited exclusion orders and cease and desist orders against HC Robotics and Invata. The ruling halted HC Robotics and

Invata from the further importation or sale of its competing systems.

Desmarais LLP attorneys reached successful settlements with various laptop manufacturers and their digital audio processing suppliers after initiating and prosecuting an ITC action following failed discussions to conduct a licensing audit of one of those suppliers. The Commission initiated a 100-day proceeding to investigate claims regarding complainant's standing. Desmarais LLP attorneys efficiently ran streamlined and aggressive discovery and presented their case at an evidentiary hearing on the standing issue, winning before the ALJ and the Commission. Following that resolution, the matter required Desmarais LLP attorneys to pursue discovery across the world with numerous patents asserted against the different respondent groups, eventually reaching settlements with each of them.

Desmarais LLP attorneys obtained a general exclusion order on behalf Fraen Corporation. Fraen, a manufacturing company outside of Boston, Massachusetts, brought an ITC complaint alleging that numerous LED lighting companies were infringing Fraen's patents directed towards color mixing light guides and optics used in LED lighting systems. The primary application for these lighting systems is in the entertainment industry. Fraen supplied its optical components to some of the biggest lighting companies in the industry who were facing competition from infringing products primarily manufactured in China, but supplied into the U.S. through myriad distribution channels. After institution of the investigation, Desmarais LLP attorneys, in concert with inhouse counsel, secured favorable licenses with multiple named respondents and proved that a section 337 violation had occurred at summary determination. Desmarais LLP attorneys were able to secure a general exclusion order from the Commission for Fraen, and after the order went into effect, they assisted Fraen in enforcing the order by preparing materials for and making multiple presentations to CBP officials.

## For the Respondent

Attorneys in Desmarais LLP's ITC practice group won a hearing for Kuraray and Calgon Carbon against their competitor Ingevity, resulting in a judgment for Kuraray and Calgon Carbon in a case in which the complainant was seeking to exclude them from importing and selling their MPAC automotive emission control product in the United States. The case involved one asserted patent that Ingevity had used against competitors ever since it was issued. Throughout discovery, the Desmarais LLP attorneys pursued a nearly-20-year old trail of evidence, ultimately proving at the hearing before ALJ Elliot that another industry participant invented the claims of Ingevity's asserted patent. Based on this evidence, ALJ Elliot found that Ingevity's asserted patent was invalid, a decision affirmed by both the Commission and the Federal Circuit.

Attorneys in Desmarais LLP's ITC practice group successfully represented 3Shape in three different ITC investigations initiated by its biggest competitor, Align Technology. Align was seeking to exclude 3Shape from importing and selling its award winning TRIOS intraoral scanners and related software in the United States. After those three cases, the Desmarais LLP attorneys argued and ultimately convinced the Commission that there was no violation, no infringement, and declined to exclude 3Shape from importing or selling the TRIOS intraoral scanners or the software at issue in the United States. Align did not appeal any of those ITC decisions, which serve as an example of Desmarais LLP's ability to defend clients from potential exclusion orders directed to their most lucrative and popular products.

## ITC Practice Contacts



**Goutam Patnaik**

Partner

202.451.4911

gpatnaik@desmaraisllp.com



**Tuhin Ganguly**

Partner

202.451.4912

tganguly@desmaraisllp.com



**David J. Shaw**

Partner

202.451.4913

dshaw@desmaraisllp.com



**Justin P.D. Wilcox**

Partner

202.451.4905

jwilcox@desmaraisllp.com