

**UNITED STATES INTERNATIONAL TRADE COMMISSION  
Washington, D.C.**

**In the Matter of**

**CERTAIN TWO-WAY GLOBAL  
SATELLITE COMMUNICATION  
DEVICES, SYSTEM AND  
COMPONENTS THEREOF**

**Investigation No. 337-TA-854  
(Remand)**

**ORDER: DENIAL OF ENFORCEMENT RESPONDENTS' PETITION FOR  
RESCISSION, OR IN THE ALTERNATIVE MODIFICATION OF  
THE COMMISSION'S CIVIL PENALTY ORDER**

The Commission instituted Inv. No. 337-TA-854 (Enforcement Proceeding) on May 24, 2013, based on an enforcement complaint filed on behalf of BriarTek IP, Inc. ("BriarTek") of Alexandria, Virginia. 78 Fed. Reg. 31576-77 (May 24, 2013). The complaint alleged violations of the April 5, 2013 consent order ("the Consent Order") issued in the underlying investigation by the continued practice of prohibited activities such as selling or offering for sale within the United States after importation any two-way global satellite communication devices, system, or components thereof that infringe one or more of the asserted claims of U.S. Patent No. 7,991,380 ("the '380 patent"). The Commission's notice of institution of the enforcement proceeding named as respondents two entities formerly known as DeLorme Publishing Company, Inc., and DeLorme InReach LLC (collectively, "DeLorme"), now known as DBN Holding, Inc. and BDN LLC (collectively, "DBN"), all of Yarmouth, Maine. The Office of Unfair Import Investigations ("OUII") was also named as a party.

On March 7, 2014, the administrative law judge (“ALJ”) issued her enforcement initial determination finding a violation of the Consent Order. She concluded that, after issuance of the Consent Order, DeLorme sold or offered for sale within the United States after importation accused InReach 1.5 devices that infringe, via inducement, claims 1 and 2 of the ’380 patent. The ALJ also found no induced infringement and therefore no violation of the Consent Order with respect to accused InReach SE devices. The ALJ also recommended a civil penalty of \$637,500 against DeLorme as an enforcement measure for the violation. On April 23, 2014, after review, the Commission determined to affirm the violation finding as to the InReach 1.5 devices and to reverse the ALJ’s finding of no induced infringement and no violation of the Consent Order with respect to accused InReach SE devices. As a result of these findings of violation as to the InReach 1.5 devices and the InReach SE devices, on June 9, 2014, the Commission issued a civil penalty order in the amount of \$6,242,500 for DeLorme’s violation of the Consent Order on 227 separate days.

DeLorme timely appealed the Commission’s final determination and civil penalty order to the U.S. Court of Appeals for the Federal Circuit. During the pendency of the appeal, the U.S. District Court for the Eastern District of Virginia (“EDVA”) found the relevant claims of the ’380 patent to be invalid in a declaratory judgment proceeding brought by DeLorme. Upon order of the Federal Circuit, prior to oral argument, DeLorme and the Commission submitted briefing regarding any potential effect of the affirmance of the invalidity judgment on the Commission’s final determination. On November 12, 2015, the Federal Circuit affirmed the EDVA invalidity judgment. *DeLorme Publishing Co. v. BriarTek IP, Inc.*, 622 Fed.Appx. 912 (Fed. Cir. 2015). On that same day, the Federal Circuit affirmed the Commission’s final

determination and civil penalty order in a precedential decision. *See DeLorme v. ITC*, 805 F.3d 1328 (Fed. Cir. 2015) (“*DeLorme I*”). Among other findings, the Court held that: (1) the Court, rather than the Commission, should decide the issue of the effect of the affirmance of the EDVA invalidity judgment; and (2) the affirmance of the EDVA invalidity judgment had no effect on the Commission’s final determination.<sup>1</sup>

On December 22, 2015, following issuance of the Federal Circuit’s decision in *DeLorme I*, DeLorme filed a petition to rescind, or in the alternative, to modify the civil penalty order under Commission Rule 210.76(a)(1) because of “changed conditions,” *i.e.*, the EDVA invalidity judgment and the affirmance of that judgment. Stating that the arguments raised by DeLorme involved issues that could have been raised in *DeLorme I* or were raised and rejected by the Federal Circuit in *DeLorme I*, the Commission denied DeLorme’s petition based on res judicata. DeLorme appealed the Commission’s final determination denying its petition to the Federal Circuit. The Court reversed the Commission’s final determination and remanded the case for consideration of DeLorme’s petition. *See DBN Holding, Inc. v. ITC*, 755 Fed.Appx. 993, 2018 WL 6181653 (Fed. Cir. Nov. 27, 2018) (“*DeLorme II*”) (finding that although there is no requirement that the civil penalty be rescinded because of the invalidity finding, the Commission nevertheless should consider the petition). The Federal Circuit issued its mandate on January 18, 2019.

On March 27, 2019, the Commission issued an order to the parties requesting briefing from them regarding whether the Commission should rescind or modify the civil penalty order in light of the final judgment of invalidity of the relevant claims of the ’380 patent in accordance

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<sup>1</sup> Judge Taranto dissented in part.

with *DeLorme II*. DeLorme, BriarTek, and OUII filed their initial submissions on April 25, April 26, and April 26, 2019, respectively. These parties filed their response submissions on May 12, May 13, and May 12, 2019, respectively.

Upon consideration of the record and the submissions in this matter, the Commission hereby ORDERS that:

1. DeLorme's (now DBN's) petition for rescission, or in the alternative, modification of the Commission's civil penalty order issued in the enforcement proceeding is DENIED.
2. The Secretary to the Commission will serve this Order on all parties to the investigation.

By order of the Commission.

A handwritten signature in black ink, appearing to read 'Lisa R. Barton', with a stylized flourish at the end.

Lisa R. Barton  
Secretary to the Commission

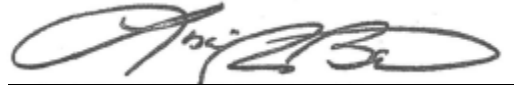
Issued: July 31, 2020

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**PUBLIC CERTIFICATE OF SERVICE**

I, Lisa R. Barton, hereby certify that the attached **ORDER** has been served by hand upon the Commission Investigative Attorney, Brian Koo, Esq. and the following parties as indicated, on 7/31/2020.



Lisa R. Barton, Secretary

U.S. International Trade Commission  
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**On Behalf of Complainant BriarTek IP, Inc.:**

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