

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, DC

In The Matter Of

CERTAIN SILICON MICROPHONE
PACKAGES AND PRODUCTS
CONTAINING SAME

337-TA-825

**ORDER NO. 17: GRANTING REQUEST FOR RECONSIDERATION OF ORDER NO. 15
REGARDING COMPLAINANT'S MOTION IN LIMINE NO. 1 TO
EXCLUDE IMPROPERLY DISCLOSED TESTIMONY, EXHIBITS, AND
ARGUMENT**

(October 5, 2012)

During Opening Argument on September 28, 2012, I realized it was possible I had misunderstood certain aspects of Complainant's Motion No. 825-020 and in particular Complainant's Motion *in Limine* No. 1. Accordingly, during the hearing I provided Complainant the opportunity to brief the issue and request reconsideration. On October 2, 2012, Complainant submitted a bench memo seeking reconsideration of my ruling in Order No. 15 regarding Motion in *Limine* No. 1. On October 4, 2012, Respondents submitted a responsive bench memo in opposition to the request for reconsideration. What follows is my reconsideration of the issue, which I announced from the bench during the hearing.

Respondents' fifth affirmative defense was pled as follows:


Knowles is barred by the doctrines of res judicata and/or collateral estoppel from asserting any claim or making any argument contrary to, or at odds with, any argument or statement it made in any prior proceeding in which it asserted the '049, '616, '231, and/or '089 patents or in any prior proceedings in which the validity of the '049, '616, '213 and/or '089 patents was at issue.

I find this allegation by Respondent falls far short of adequately pleading collateral estoppel / res judicata required by Commission Rule 210.13(b). Collateral estoppel bars litigation of issues previously decided. Res judicata bars litigation of previously decided claims. These doctrines differ from the doctrine of judicial estoppel that was noticed in Respondents' fifth affirmative defense to prevent Knowles from taking inconsistent positions in this investigation.

Even if I were to consider Respondents' fifth affirmative defense as adequately pleading collateral estoppel and res judicata, Respondents' failure to disclose the specifics of these defenses in response to Knowles' interrogatories seeking Respondents' invalidity contentions, and in particular Interrogatory No. 30, is fatal. Contrary to Respondents' argument in its opposition, Interrogatory No. 30 seeks more than just its broad invalidity contentions. The express language of Interrogatory No. 30 also requires Respondents "set forth the *basis* for Your contention that the claim is invalid, including a limitation-by-limitation claim chart identifying the basis ..." (emphasis added) Thus, Respondents had an obligation in answering Interrogatory No. 30 to disclose those limitations that Respondents assert are met by reason of collateral estoppel / res judicata. Respondents did not. Nor did Respondents supplement its responses to Interrogatory No. 30 under applicable Commission rules. (See 19 CFR § 210.27(c).) Because Respondents failed to adequately disclose the basis for their invalidity contentions arising from their collateral estoppel / res judicata arguments in response to Knowles interrogatory requests directed to the same, Respondents' reliance on collateral estoppel / res judicata to support any of their invalidity contentions in their pre-hearing brief is improper.

Thus, accordingly, while I am not precluding Respondent from proving invalidity, when it provided sufficient notice of the same to Complainant under Commission and applicable ground rules, I am ordering that all references to collateral estoppel or res judicata relied on by Respondents as support for any invalidity argument be struck from Respondents' pre-hearing brief. As set forth above, Knowles request for reconsideration is hereby GRANTED.

SO ORDERED.


Thomas B. Pender
Administrative Law Judge

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CERTIFICATE OF SERVICE

I, Lisa R. Barton, hereby certify that the attached **PUBLIC ORDER NO. 17** has been served upon the following parties via first class mail and air mail where necessary on

October 5, 2012.



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