

UNITED STATES INTERNATIONAL TRADE COMMISSION

Washington, D.C.

In the Matter of

**CERTAIN GRAPHICS SYSTEMS,
COMPONENTS THEREOF, AND
DIGITAL TELEVISIONS CONTAINING
THE SAME**

Inv. No. 337-TA-1318

**ORDER NO. 45: GRANTING COMPLAINANTS' MOTION TO AMEND THE
COMPLAINT AND NOTICE OF INVESTIGATION**

(December 7, 2022)

On November 25, 2022, complainants Advanced Micro Devices, Inc. and ATI Technologies ULC (together "AMD") moved (1318-033) for leave to amend the Complaint and Notice of Investigation to include a recently issued certificate of correction for asserted U.S. Patent No. 11,184,628 ("the 628 patent") under 19 C.F.R. §§ 210.14(b)(1) and 210.15(a). On December 5, 2022, Respondents filed an opposition ("Opp'n").¹

Commission Rule 210.14 states, in relevant part:

After an investigation has been instituted, the complaint or notice of investigation may be amended only by leave of the Commission for good cause shown and upon such conditions as are necessary to avoid prejudicing the public interest and the rights of the parties to the investigation. A motion for amendment must be made to the presiding administrative law judge.

¹ Respondents include Realtek Semiconductor Corp., TCL Industries Holdings Co., Ltd.; TCL Industries Holdings (H.K.) Limited; TCL Electronics Holdings Limited f/k/a TCL Multimedia Technology Holdings, Ltd.; TCL Technology Group Corporation; TTE Corporation; TTE Technology, Inc.; TCL Holdings (BVI) Limited; TCL King Electrical Appliances (Huizhou) Co., Ltd.; Shenzhen TCL New Technologies Co., Ltd.; TCL MOKA International Limited; TCL Smart Device (Vietnam) Co., Ltd.; Manufacturas Avanzadas SA de CV; TCL Electronics Mexico, S de RL de CV; and TCL Overseas Marketing Ltd. (altogether, "Respondents").

19 C.F.R. §§ 210.14(b)(1). AMD explains the certificate was first sought following this investigation’s October 18, 2022 claim construction order, which found dependent patent claims reciting “one or more disjoint subsets” indefinite as compared to the independent claim from which they depend reciting “two or more disjoint subsets.” Mot. at 3-4 (citing Order No. 31 at 45-46)). AMD then presented the order to the USPTO pursuant to 37 C.F.R. § 1.323 as evidencing an error of “clerical or typographical nature, or of minor character” meriting correction. *Id.* at 4; *see* Mot., Ex. 3 at *5. Approximately one month later, on November 22, 2022, the USPTO issued the certificate, altering the language of asserted claims 9, 10, and 12 to recite “two” instead of “one.” Mot., Ex. 1.

AMD contends that it is “well established” that a certificate of correction to an asserted patent constitutes good cause to amend the complaint, when that certificate could not have been included with the Complaint. Mot. at 5, 6 (citing, *inter alia*, *Certain Graphics Systems, Components Thereof, and Consumer Products Containing the Same*, Inv. No. 337-TA-1044, Order No. 27 at 2 (July 25, 2017)). AMD continues, “[this] motion, if granted, would cause no prejudice [to] the public or Respondents. . . . The Certificate of Correction resolves minor non-substantive errors.” *Id.* at 6-7. AMD emphasizes that it notified Respondents of the substance of the correction on July 28, 2022 when it served a proposed construction that “one or more” in the dependent claims effectively meant “two or more” as in the independent claim. *See id.* at 3, 7. Practically, AMD argues:

The corrections to the claims do not raise any factual issues requiring additional discovery given that the parties have been litigating the claims both prior to the minor correction since the Complaint was filed, and since AMD provided Respondents with a copy of the request for certificate of correction in October. For example, on November 11, 2022, weeks after AMD provided Respondents with a copy of the requested corrected claims, Respondents continued to serve supplemental invalidity contentions concerning the claims at issue here, i.e., asserted claims 9, 10, and 12.

Id. at 7.

Respondents oppose primarily on the ground that no good cause exists. Opp’n at 1. Respondents contend AMD should have been on notice a certificate of correction was needed as early as July 28, 2022 “when Respondents disclosed their position that dependent claims 9, 10, and 12 of the ’628 patent were indefinite,” as well as August 2, 2022, “when the parties met and conferred and Respondents explained their indefiniteness argument to Complainants.” *Id.* at 6. That AMD only sought correction after Order No. 31 found the phrase indefinite “undermines any claim of good cause, as Complainants’ lack of pre-filing diligence—or its pre-filing decision not to seek a certificate of correction at the Patent Office—resulted in a delay of 173 days between the filing of the complaint and Complainants’ request for correction,” argue Respondents. *Id.* (citing *Certain Portable Electronic Devices and Related Software*, Inv. No. 337-TA-797, Order No. 39 (Mar. 5, 2011) (emphasis removed)).

With respect to prejudice, Respondents argue they “expended time and money litigating the claims as originally issued, briefed the indefiniteness of these claims, and provided contentions and other discovery based on the claims as issued.” Opp’n at 8. As to the public, Respondents argue similarly—“the proposed amendment prejudices the public interest, because the ALJ was forced to expend time addressing the construction of these claims, as drafted, when he could have instead construed the amended claims—and determined the effect of the prosecution history on the now-amended claims.” *Id.* at 9. And as for AMD itself, Respondents state that asserted claims 7 and 8 of the 628 patent are unaffected by this motion and will remain in the investigation even if the leave to amend is denied; and, if denied, AMD “still [has] the option to assert [claims 9, 10, and 12] in a new complaint.” *Id.*

The motion is granted. As to good cause, Respondents are persuasive that the need to correct claims 9, 10, and 12 should have been apparent to AMD from the outset of the investigation. There are only twelve short claims in the 628 patent, and “one or more disjoint subsets” is the focus of six of the ten dependent claims. *See* 628 patent at cls. 3, 4, 6, 9, 10, 12. Even then, the need should have been apparent on July 28, 2022 when Respondents identified “one or more disjoint subsets” as indefinite; or on August 15, 2022 when they explained that theory in detail as part of *Markman* briefing. Opp’n, Ex. B; Opp’n, Ex. D. AMD plainly could have moved to correct the patent much earlier.

However, the certificate has now issued and there is no longer any 628 patent claim in existence which reads “one or more disjoint subsets.” *See* 35 U.S.C. § 255 (“Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.”); *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280, 1294-5, 1297 (Fed. Cir. 2000) (“This [statutory] language plays the role of establishing that, for all circumstances in which the certificate of correction is effective—namely, at all times after its issue date—the certificate is considered part of the original patent” and “[t]herefore any invalidity arising from the absence of the [specification content added by certificate of correction] only affects causes arising before the certificate issued.”). Thus, because section 337 offers only prospective relief, there is no point in evaluating infringement or invalidity of the 628 patent as though it still reads “one or more disjoint subsets”—despite Respondents’ urging. *See* Opp’n at 8 (“The significant prejudice to Respondents and the public interest is plain: the ALJ has found claims 9, 10, and 12 invalid as indefinite, *see* Order No. 31 at 46, so there can be no violation of section 337 based on

any infringement of these claims.”). So while AMD may have been dilatory in seeking it, there is good—almost necessary—cause behind accepting the correction.

Moreover, undue prejudice to Respondents from allowing the amendment has not been shown. For the same reason that AMD was put on notice of the “one or more” error on July 28, 2022, Respondents were simultaneously put on notice that AMD viewed “one or more” as effectively meaning “two or more.” Mot., Ex. 2 at 7. And beyond generally asserting that they “expended time and money litigated the existing claims on the merits throughout fact discovery and claim construction” (Opp’n at 1; *see id.* at 5-6), Respondents have not pointed out how they relied on the original phrasing such that correcting it now would be prejudicial—*e.g.*, amendment of contentions, additional discovery, revised expert reports, etc. (*see generally id.*). All that would seem to be lost is their contention that “one or more disjoint subsets” is indefinite. On the other hand, denying the motion and forcing AMD and the Commission to launch a second investigation solely for newly corrected claims 9, 10, and 12 would be grossly inefficient and thus, significantly prejudicial to public resources.

Accordingly, the conditions of Commission Rule 210.14 are sufficiently satisfied, and AMD’s motion (1318-033) is granted. The complaint is amended as proposed. No change to the Notice of Investigation is required. *See* Mot. at 1 (the proposed amendment “does not change or alter the list of asserted claims for the ’628 Patent as listed in the NOI”).

SO ORDERED.



Cameron Elliot
Administrative Law Judge