

## ESSAY

# Exclusion Is Not Automatic: Improving the Enforcement of ITC Exclusion Orders Through Notice, a Test for Close Cases, and Civil Penalties

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### ABSTRACT

*The U.S. International Trade Commission (“ITC”) has become increasingly important in the enforcement of intellectual property (“IP”) rights in recent years. Despite the increase in ITC filings, however, very little literature discusses the effectiveness of ITC exclusion orders. This Essay analyzes seventy-three ITC exclusion orders issued from 2002–2011, finding their scope to be imprecise and vague. To remedy this lack of clarity, this Essay proposes that the ITC improve the enforcement of exclusion orders by providing notice to IP rightsholders, adopting a practical test to resolve close cases, and providing for a civil penalty to deter violations.*

*More specifically, the ITC should provide notice to IP rightsholders when importers file certifications with Customs and Border Protection (“CBP”) or when CBP issues ex parte decisions concerning exclusion orders. The ITC should also adopt the colorable differences test used by some district courts to resolve close cases concerning redesigned products in contempt proceedings.*

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*Contempt proceedings share many similarities with ITC enforcement proceedings, including a prior patent infringement trial, a previous order by the tribunal against infringement, disagreement concerning redesigned products, and an expedited proceeding. Finally, the ITC should issue cease and desist orders in tandem with exclusion orders because cease and desist orders are enforceable with civil penalties. The most natural remedy to deter a violation of an exclusion order is an order to cease and desist from selling the infringing, imported products. By issuing cease and desist orders in tandem with exclusion orders, the ITC could eliminate duplicative enforcement proceedings, increase efficiency, and lower litigation costs.*

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#### INTRODUCTION

In June 2012, Apple Inc. (“Apple”) filed an enforcement complaint with the U.S. International Trade Commission (“ITC”), against High Tech Computer Corp. (“HTC”), asserting that HTC was violating an ITC exclusion order.<sup>1</sup> The exclusion order directed Customs and Border Protection (“CBP”) to exclude products infringing an Ap-

<sup>1</sup> Complaint for Enforcement Proceeding and Request for Temporary Emergency Action

ple patent from entry into the United States.<sup>2</sup> The ITC did not issue a cease and desist order because HTC affirmed that any inventories of accused products were not for sale.<sup>3</sup> Yet HTC allegedly continued to import and sell infringing devices, including devices detained and released by CBP.<sup>4</sup> Apple requested that the ITC begin formal enforcement proceedings, impose sanctions, and issue a cease and desist order against HTC.<sup>5</sup> This example illustrates that exclusion orders do not automatically stop infringement, but may constitute only the first step in the enforcement of intellectual property (“IP”) rights at the ITC.

The ITC has become increasingly important in the enforcement of IP rights since *eBay Inc. v. MercExchange LLC*,<sup>6</sup> in which the Supreme Court raised the threshold for obtaining a permanent injunction against patent infringement in federal district court.<sup>7</sup> Subsequently, in *Spansion, Inc. v. ITC*,<sup>8</sup> the Federal Circuit held that *eBay* did not apply to the ITC because, unlike the district courts’ inherent power to issue permanent injunctions, the ITC’s authority was statutory.<sup>9</sup> Statutory authority for the ITC derives from section 337 of the Tariff Act of 1930,<sup>10</sup> which authorizes the ITC to issue exclusion, cease and desist, and consent orders against imported products that infringe enforceable U.S. patents.<sup>11</sup> The ITC exclusion order is the most important of these remedies: it directs CBP to exclude from en-

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Pursuant to Rules 210.75 and 210.77, Certain Personal Data and Mobile Commc’ns Devices and Related Software, Inv. No. 337-TA-710 (June 4, 2012).

<sup>2</sup> Certain Personal Data and Mobile Commc’ns Devices and Related Software, Inv. No. 337-TA-710, USITC Pub. 4331 (June 2012).

<sup>3</sup> See Commission Opinion at 84, Certain Personal Data and Mobile Commc’ns Devices and Related Software, Inv. No. 337-TA-710, USITC Pub. 4331 (Dec. 29, 2011) (final).

<sup>4</sup> See generally Complaint, *supra* note 1.

<sup>5</sup> *Id.* at 24–26.

<sup>6</sup> *eBay Inc. v. MercExchange, LLC*, 547 U.S. 388, 394 (2006).

<sup>7</sup> *Id.* at 391–94 (requiring a four-factor test for permanent patent injunctions: (1) irreparable harm, (2) the inadequacy of the remedies available at law, (3) the balance of hardships, and (4) the public interest favoring an injunction).

<sup>8</sup> *Spansion, Inc. v. Int’l Trade Comm’n*, 629 F.3d 1331 (Fed. Cir. 2010).

<sup>9</sup> *Id.* at 1359.

<sup>10</sup> Tariff Act of 1930, ch. 497, § 337, 46 Stat. 590, 703–04 (1930) (codified as amended at 19 U.S.C. § 1337 (2006)); *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1355 (Fed. Cir. 2008) (“The ITC is a creature of statute, and must find authority for its actions in its enabling statute.”). Although section 337 of the Tariff Act is codified at 19 U.S.C. § 1337, ITC practitioners refer to this section as “section 337.” See, e.g., Wayne W. Herrington, *Section 337 of the Tariff Act of 1930: Remedial Orders*, 10 AIPLA Q.J. 185, 185 (1982).

<sup>11</sup> MARCIA H. SUNDEEN ET AL., UNFAIR COMPETITION AND THE ITC: A TREATISE ON SECTION 337 ACTIONS § 2:2 (2011); see also 35 U.S.C. § 271 (2006) (defining patent infringement).

try into the United States any infringing imported products.<sup>12</sup> Thus, ITC exclusion orders offer IP rightsholders an injunction-like remedy without the necessity of meeting the *eBay* test. This result has contributed to a dramatic increase in ITC filings from twenty-six investigations in 2004 to sixty-nine in 2011.<sup>13</sup>

Despite the increase in ITC filings, however, very little literature discusses the effectiveness of ITC remedies.<sup>14</sup> ITC surveys of prevailing complainants in 2005 and 2010, for instance, show that complainants do not believe that exclusion orders block infringing goods at the border.<sup>15</sup> In 2010, sixty-five percent of prevailing ITC complainants believed that infringing goods “[*had*] been imported since the issuance of the order” or “had no basis to judge” whether such goods had been imported.<sup>16</sup> By contrast, only thirty-five percent believed that infringing goods “[*had*] not been imported since the issuance of the order.”<sup>17</sup>

These problems stem from the bifurcated enforcement framework for ITC exclusion orders. Statutory responsibility for enforcement falls on CBP.<sup>18</sup> CBP often decides whether an exclusion order covers a redesigned product through *ex parte* decisionmaking.<sup>19</sup> Yet CBP does not have the technical expertise or the personnel to make such determinations,<sup>20</sup> particularly when fifty percent of ITC cases involve some form of complex technology, including integrated circuits, liquid crystal displays, telecommunications, and cellular telephones.<sup>21</sup> Importers can—and do—take calculated risks to violate exclusion or-

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<sup>12</sup> See 19 C.F.R. § 210.50 (2012).

<sup>13</sup> U.S. INT'L TRADE COMM'N, NUMBER OF SECTION 337 INVESTIGATIONS INSTITUTED BY CALENDAR YEAR, available at [http://www.usitc.gov/intellectual\\_property/documents/cy\\_337\\_institutions.pdf](http://www.usitc.gov/intellectual_property/documents/cy_337_institutions.pdf).

<sup>14</sup> Debra D. Peterson, *The Knowledge to Act: Border Enforcement of Section 337 Exclusion Orders and the Need for Exclusion Order Disclosure Regulations*, 17 FED. CIR. B.J. 607, 607 (2008) [hereinafter Peterson, *The Knowledge to Act*].

<sup>15</sup> U.S. INT'L TRADE COMM'N, SUMMARY OF RESULTS OF FY 2010 SURVEY REGARDING SECTION 337 EXCLUSION ORDERS, Tab A, at 1 (2010), available at [http://www.usitc.gov/intellectual\\_property/documents/summary\\_of\\_results\\_of\\_2010\\_survey.pdf](http://www.usitc.gov/intellectual_property/documents/summary_of_results_of_2010_survey.pdf).

<sup>16</sup> *Id.*

<sup>17</sup> *Id.*

<sup>18</sup> Merritt R. Blakeslee, *Post-Litigation Enforcement of Remedial Orders Issued by the U.S. International Trade Commission in Section 337 Investigations*, 8 J. MARSHALL REV. INTELL. PROP. L. 248, 249 (2009).

<sup>19</sup> See *infra* Part I.A.

<sup>20</sup> See *infra* text accompanying note 43; see also TIMOTHY P. TRAINER & VICKI E. ALUMS, CUSTOMS ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS §§ 5:3, 5:5 (2012) (“Given the bifurcated system at the administrative level for enforcing patent rights at the U.S. border, Customs’ future rulings enforcing ITC exclusion orders should be reviewed . . .”).

<sup>21</sup> U.S. INT'L TRADE COMM'N, YEAR IN REVIEW: FISCAL YEAR 2010, at 14 (2010), available at [http://www.usitc.gov/publications/year\\_in\\_review/pub4212.pdf](http://www.usitc.gov/publications/year_in_review/pub4212.pdf).

ders by filing certifications with CBP that their goods do not infringe.<sup>22</sup> Even after CBP detains an infringing product, CBP's ex parte decisionmaking process significantly favors importers over IP rightsholders.<sup>23</sup> IP rightsholders do not even receive notice when CBP detains suspected infringing products, nor do they receive notice when importers file certifications.<sup>24</sup>

This Essay conducts a systematic analysis of seventy-three ITC exclusion orders from 2002 to 2011, finding their language to be imprecise.<sup>25</sup> To remedy this lack of clarity, the ITC should improve the enforcement of exclusion orders by providing notice to IP rightsholders regarding enforcement, a test to resolve close cases concerning redesigned products, and a system to impose civil penalties against importers for violations.<sup>26</sup>

Part I introduces the current enforcement framework. Part II introduces the dataset of exclusion orders, examining their scope and highlighting the certification provision. Part III proposes that the ITC provide notice to IP rightsholders, resolve close cases using the “colorable differences” test,<sup>27</sup> and issue cease and desist orders in tandem with exclusion orders.

## I. CURRENT ENFORCEMENT FRAMEWORK

The ITC is a “quasi-judicial, quasi-legislative and quasi-executive” federal administrative agency that adjudicates “cases involving alleged infringement by imports of intellectual property rights.”<sup>28</sup> The ITC has in rem jurisdiction over imported products that: (1) “infringe a valid and enforceable United States patent”; or (2) “are made, produced, processed, or mined under, or by means of, a process covered by the claims of a valid and enforceable patent.”<sup>29</sup>

Six ITC Commissioners (the “Commission”), appointed by the President of the United States for staggered nine-year terms, head the ITC.<sup>30</sup> The ITC meets due process under the Administrative Proce-

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<sup>22</sup> See *infra* Part II.B.

<sup>23</sup> See *infra* Part I.B.

<sup>24</sup> See Peterson, *The Knowledge to Act*, *supra* note 14, at 607–08.

<sup>25</sup> See *infra* Part II.A.

<sup>26</sup> See *infra* Part III.

<sup>27</sup> See *TiVo Inc. v. EchoStar Corp.*, 646 F.3d 869, 881–83 (Fed. Cir. 2011) (en banc) (setting forth the two-part test for determining if an accused product is no more than “colorably different” from a product previously held to infringe).

<sup>28</sup> SUNDEEN ET AL., *supra* note 11, § 2:2.

<sup>29</sup> 19 U.S.C. § 1337(a)(1)(B) (2006); see also 35 U.S.C. §§ 101–03, 112 (2006) (requirements for granting a patent and patent validity).

<sup>30</sup> SUNDEEN ET AL., *supra* note 11, § 2:2.

ture Act (“APA”)<sup>31</sup> by holding a hearing before an Administrative Law Judge (“ALJ”), who issues an initial determination with “findings of fact and conclusions of law.”<sup>32</sup> The ALJ’s initial determination becomes the final determination of the ITC unless a Commissioner dissents, in which case the Commission reviews the ALJ’s decision and issues a final determination affirming or reversing the ALJ.<sup>33</sup> ITC decisions do not have preclusive effects on U.S. courts and are appealable to the United States Court of Appeals for the Federal Circuit.<sup>34</sup>

The ITC can only issue exclusion, cease and desist, and consent orders; it cannot provide monetary damages or other equitable relief.<sup>35</sup> Exclusion orders direct CBP to exclude products from entry into the United States.<sup>36</sup> General exclusion orders exclude products regardless of their manufacturer, while limited exclusion orders exclude only products imported by the named respondents.<sup>37</sup> Cease and desist orders are an administrative remedy “limit[ing] sales of infringing products already imported.”<sup>38</sup> Consent orders authorize the ITC to enforce settlement agreements where the parties agree that the ITC should maintain jurisdiction to enforce the consent order.<sup>39</sup> For enforcement purposes, the ITC treats consent orders analogously to cease and desist orders.<sup>40</sup>

#### A. CBP Enforcement of ITC Exclusion Orders

After the ITC issues an exclusion order, the statutory responsibility for its enforcement falls on CBP.<sup>41</sup> CBP does not promise to exclude all products that violate exclusion orders.<sup>42</sup> CBP’s Intellectual Property Rights (“IPR”) Branch has nine attorneys who oversee the 325 U.S. ports of entry where import cargo enters the United States.<sup>43</sup> For each ITC exclusion order, an IPR Branch attorney reviews the

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31 Administrative Procedure Act, 5 U.S.C. §§ 551–559, 701–706 (2012); *see id.* § 556.

32 SUNDEEN ET AL., *supra* note 11, §§ 1:2, 2:9.

33 *Id.* § 2:2.

34 19 U.S.C. § 1337(c) (2006); *see also* Sapna Kumar, *The Other Patent Agency: Congressional Regulation of the ITC*, 61 FLA. L. REV. 529, 533 (2009).

35 *See* SUNDEEN ET AL., *supra* note 11, §§ 2:2, 10:2.

36 *See* 19 C.F.R. § 210.50 (2012).

37 *See* Thomas A. Broughan, III, *Modernizing § 337’s Domestic Industry Requirement for the Global Economy*, 19 FED. CIR. B.J. 41, 45 (2009).

38 *See id.*

39 Blakeslee, *supra* note 18, at 251–52.

40 Herrington, *supra* note 10, at 185.

41 *See* TIMOTHY P. TRAINER, BORDER ENFORCEMENT OF INTELLECTUAL PROPERTY 237 (2000).

42 Blakeslee, *supra* note 18, at 254.

43 *Id.* at 253–54.

case file, holds ex parte meetings with the parties, and creates written guidance called “field instructions” or a “Trade Alert.”<sup>44</sup> The Trade Alert—posted on CBP’s intranet—summarizes the information necessary to enforce an exclusion order, including the identification of suspected products, importers, and ports of entry.<sup>45</sup>

When a shipment of goods arrives at a U.S. port of entry, the importer files information with CBP.<sup>46</sup> If CBP believes that an ITC exclusion order may cover the importer’s goods, CBP targets and examines the shipment.<sup>47</sup> CBP may detain the suspected infringing goods for up to thirty days while it decides if the scope of the exclusion order covers the suspected goods.<sup>48</sup> If CBP determines that the exclusion order does cover the goods, CBP notifies the importer that the goods must be exported and any future attempts to import them could result in seizure and forfeiture.<sup>49</sup>

Before the goods are subject to seizure and forfeiture, however, the ITC must issue a seizure and forfeiture order (“seizure order”).<sup>50</sup> The ITC can issue a seizure order after it receives notice from CBP concerning the successful exclusion of the goods.<sup>51</sup> The seizure order authorizes CBP to confiscate excluded goods if the importer makes any further attempt to import them.<sup>52</sup> Originally, the ITC’s practice was to wait for ninety days before issuing seizure orders to allow importers to file protests against CBP.<sup>53</sup> During that time, however, importers could attempt reentry of the excluded goods at a different port (also known as “port shopping”) or by smuggling the goods.<sup>54</sup> In response, the ITC changed its practice in 2009 to issue seizure orders within thirty days following the receipt of notice from CBP.<sup>55</sup>

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<sup>44</sup> *Id.* at 254.

<sup>45</sup> *Id.*

<sup>46</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 619.

<sup>47</sup> *Id.* Importers must pass through CBP because there is no constitutional right to import goods into the United States. *See* U.S. CONST. art. I, § 8, cls. 1, 3.

<sup>48</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 619.

<sup>49</sup> *See* 19 C.F.R. § 12.39(b)(4) (2012).

<sup>50</sup> *Id.* § 12.39(c)(1).

<sup>51</sup> *Id.* § 12.39(c)(1)–(3).

<sup>52</sup> *See id.* § 12.39(c); TRAINER, *supra* note 41, at 237.

<sup>53</sup> *See* 19 U.S.C. § 1337(e)(2) (2006); U.S. INT’L TRADE COMM’N, ANNUAL PERFORMANCE REPORT: FISCAL YEAR 2011, at 26 (2011), available at [http://www.usitc.gov/press\\_room/documents/USITCFY2011APR.pdf](http://www.usitc.gov/press_room/documents/USITCFY2011APR.pdf) [hereinafter FY 2011 USITC PERFORMANCE REPORT].

<sup>54</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 622; *see also* FY 2011 USITC PERFORMANCE REPORT, *supra* note 53, at 26.

<sup>55</sup> *See* FY 2011 USITC PERFORMANCE REPORT, *supra* note 53, at 26.

*B. Challenging Exclusion Orders: Administrative Ruling Letters and Protests*

Because CBP determines whether the scope of an exclusion order covers suspected goods, CBP also decides whether the exclusion order covers a redesigned product.<sup>56</sup> CBP thus necessarily exercises discretion—an irony because CBP lacks the authority to determine patent infringement in the first instance.<sup>57</sup> Although the ITC probably does not have the ability to police the 325 U.S. ports of entry for imports that violate exclusion orders itself, CBP authority is not limited simply to policing the ports of entry for specific products.

CBP provides two avenues for importers to challenge CBP decisions: (1) administrative ruling letters (“ruling letters”)<sup>58</sup> and (2) protests.<sup>59</sup> Ruling letters are prospective decisions from CBP headquarters to importers defining how CBP will treat prospective goods to be imported.<sup>60</sup> Ruling letters bind the importer requesting the letter, making them useful to importers for predicting in advance whether CBP will exclude an importer’s redesigned product.<sup>61</sup> If CBP decides against an importer, the importer can appeal to the Court of International Trade (“CIT”).<sup>62</sup> IP rightsholders, by contrast, cannot

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<sup>56</sup> See, e.g., Protest 2704-09-102186: Certain Ink Cartridges and Components Thereof, Inv. No. 337-TA-565, Cust. & Border Prot. Dec. No. HQ H034793, at 19 (Sept. 25, 2009), available at <http://rulings.cbp.gov/HQ/2009/H034793.DOC> (illustrating CBP discretion because the CBP protest decision found that redesigned ink cartridges were still covered by the scope of an exclusion order).

<sup>57</sup> See TRAINER, *supra* note 41, at 237; Jeffrey M. Telep, Customs Role in Enforcing Intellectual Property Rights at the Border: Process and Progress (Mar. 3–4, 2011) (unpublished manuscript) (report given at the Georgetown University Law Center 2011 International Trade Update), 2011 WL 2111720, at \*6.

<sup>58</sup> 19 C.F.R. §§ 177.0, .1(d) (2012) (administrative ruling letters).

<sup>59</sup> *Id.* § 174.11 (matters subject to protest); see, e.g., Protest 2704-11-102660: Certain Coaxial Cable Connectors and Components Thereof and Products Containing the Same, Inv. No. 337-TA-650, Cust. & Border Prot. Dec. No. HQ H194336, at 22 (Dec. 9, 2011), available at <http://rulings.cbp.gov/HQ/2011/H194336.DOC> (protest decision holding that the redesigned coaxial cable connectors were still covered by the scope of an exclusion order).

<sup>60</sup> 19 C.F.R. §§ 177.0–1(a); see also Ruling Letter, Certain Lens-Fitted Film Packages; Inv. No. 337-TA-406, Cust. & Border Prot. Dec. No. HQ 468780, at 6 (Mar. 27, 2000), available at <http://rulings.cbp.gov/hq/2000/468780.doc> (holding that redesigned cameras were not covered by the scope of an exclusion order).

<sup>61</sup> Telep, *supra* note 57, at \*6.

<sup>62</sup> See *Jazz Photo Corp. v. United States*, 29 Ct. Int’l Trade 60, 64 (2005) (holding that an importer had standing to appeal a CBP decision, but denying the request for a temporary restraining order against CBP); see also 28 U.S.C. § 1581(h) (2006) (“The Court of International Trade shall have exclusive jurisdiction of any civil action commenced to review, prior to the importation of the goods involved, a ruling issued by the Secretary of the Treasury . . .”).

request ruling letters from CBP nor can they appeal ruling letters to CIT.<sup>63</sup>

Even if importers do not seek Ruling Letters in advance, they can still file a protest with CBP if CBP detains or excludes their products.<sup>64</sup> Protests provide importers with the ability to challenge a CBP decision excluding their products from entry.<sup>65</sup> If CBP resolves the protest against the importer, the importer can also appeal the decision to CIT.<sup>66</sup> As with ruling letters, IP rightsholders cannot file protests with CBP, nor can they appeal adverse protests to CIT.<sup>67</sup>

Both ruling letters and protests therefore significantly favor importers over IP rightsholders because they are ex parte communications between the importers and CBP.<sup>68</sup> IP rightsholders, however, can seek enforcement at the ITC.

### C. Enforcement Methods: Advisory Opinions, Informal and Formal Enforcement

The ITC provides IP rightsholders with the ability to obtain advisory opinions, informal enforcement, or formal enforcement.<sup>69</sup> Advisory opinions require: (1) a non-hypothetical proposed course of action, and (2) a compelling business need.<sup>70</sup> They are not subject to section 337 deadlines or ITC rules, nor are they appealable to the Fed-

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<sup>63</sup> See *Funai Elec. Co. v. United States*, 645 F. Supp. 2d 1351, 1357–58 (Ct. Int’l Trade 2009) (holding that the CIT lacks subject matter jurisdiction to hear petitions by IP rightsholders against CBP decisions).

<sup>64</sup> See, e.g., Protest 2704-09-102235: Certain Plastic Food Containers, Inv. No. 337-TA-514, Cust. & Border Prot. Dec. No. HQ H118860, at 16 (Oct. 25, 2010) available at <http://rulings.cbp.gov/HQ/2010/H118860.DOC> (protest decision holding that redesigned food containers were not covered by an exclusion order).

<sup>65</sup> See 19 C.F.R. § 174.11(b)(4) (2012) (providing that matters subject to protest include “exclusion of merchandise from entry”).

<sup>66</sup> See *Jazz Photo Corp.*, 29 Ct. Int’l Trade at 60 (acknowledging importer’s standing but denying grant of temporary restraining order against CBP decision); see also 28 U.S.C. § 1581(a) (2006) (“The Court of International Trade shall have exclusive jurisdiction of any civil action commenced to contest the denial of a protest . . .”).

<sup>67</sup> *Funai Elec. Co.*, 645 F. Supp. 2d at 1352, 1356–58 (holding that the CIT lacks subject matter jurisdiction to hear petitions by IP rightsholders against CBP decisions).

<sup>68</sup> Telep, *supra* note 57, at \*6. Although at one point in 2006, CBP suggested that it would consider convening adversarial hearings to decide highly technical or disputed redesigned products, no new regulations were established. See Merritt R. Blakeslee & Christopher V. Meservy, *Seeking Adjudication of a Design-Around in Section 337 Patent Infringement Investigations: Procedural Context and Strategic Considerations*, 35 AIPLA Q.J. 385, 412–13 (2007).

<sup>69</sup> 19 C.F.R. § 210.79(a) (advisory opinions); *id.* § 210.75(a) (informal enforcement); *id.* § 210.75(b) (formal enforcement).

<sup>70</sup> SUNDEEN ET AL., *supra* note 11, § 10:8.

eral Circuit or subject to the APA.<sup>71</sup> Advisory opinions are available to both complainants and respondents,<sup>72</sup> but they are more useful to respondents because they can provide guidance to respondents that an exclusion order does not cover a redesigned product;<sup>73</sup> for complainants, the ITC will usually consolidate a request for an advisory opinion into a modification<sup>74</sup> or enforcement proceeding.<sup>75</sup>

The ITC can also take informal or formal action to end a violation of an exclusion order. The ITC's Office of Unfair Import Investigations ("OUII") investigates informal actions regarding the "violation of any provision of an exclusion order, cease and desist order, or consent order."<sup>76</sup> In addition to or in lieu of informal enforcement, the ITC can begin formal enforcement upon the filing of an enforcement complaint by the original complainant, the OUII, or the Commission itself.<sup>77</sup> The ITC may hold a public hearing or delegate it to the Chief ALJ, who issues an initial determination.<sup>78</sup> Barring a request for review or extension within ninety days, the ALJ's determination becomes the ITC's final determination.<sup>79</sup>

After formal enforcement, the ITC has the authority to modify any exclusion, cease and desist, or consent order to correct the unfair practices that justified the original investigation, seek civil penalties in U.S. District Court, or revoke a cease and desist or consent order and issue an exclusion order.<sup>80</sup> Both complainants and respondents can appeal formal enforcement decisions to the Federal Circuit.<sup>81</sup>

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<sup>71</sup> Blakeslee, *supra* note 18, at 262; *see also* 5 U.S.C. § 556 (2006); Certain Hardware Logic Emulation Systems and Components Thereof: Notice of Commission Decision Not To Review an Initial Advisory Opinion Issued by the Administrative Law Judge, 65 Fed. Reg. 58,287-88 (Sept. 28, 2000).

<sup>72</sup> *See* 19 C.F.R. § 210.79(a) (providing that advisory opinions are available "[u]pon request of any person").

<sup>73</sup> *See* Eaton Corp. v. United States, 395 F. Supp. 2d 1314, 1318 (Ct. Int'l Trade 2005) (noting the availability of an advisory opinion to remove a product from the scope of an exclusion order).

<sup>74</sup> Modification proceedings allow the ITC to modify a previously issued ITC remedial order. *See* 19 C.F.R. § 210.76.

<sup>75</sup> Blakeslee, *supra* note 18, at 262.

<sup>76</sup> 19 C.F.R. § 210.75(a) (informal enforcement proceedings).

<sup>77</sup> *Id.* § 210.75(b)(1).

<sup>78</sup> This hearing is also not subject to the Administrative Procedure Act. *See id.* § 210.75(b)(3).

<sup>79</sup> *Id.*

<sup>80</sup> *Id.* § 210.75(b)(4).

<sup>81</sup> 28 U.S.C. § 1295(a)(6) (2006); *see* VastFame Camera, Ltd. v. Int'l Trade Comm'n, 386 F.3d 1108, 1115 (Fed. Cir. 2004) (holding that the ITC has authority to conduct enforcement proceedings); *see also* Ninestar Tech. Co. v. Int'l Trade Comm'n, 667 F.3d 1373, 1380, 1384 (Fed. Cir. 2012) (holding that the ITC had authority to issue a civil penalty against a company that

All of these methods of ITC enforcement, however, are subject to significant limitations. First, CBP does not provide IP rightsholders with any data concerning imports related to ITC exclusion orders.<sup>82</sup> Second, even if IP rightsholders do seek enforcement, the proper scope of exclusion orders is often unclear.<sup>83</sup> Third, even after an IP rightsholder proves that an importer violated an exclusion order, no civil penalty is available.<sup>84</sup>

## II. A SYSTEMATIC ANALYSIS OF ITC EXCLUSION ORDERS

This Essay evaluates seventy-three exclusion orders issued by the ITC over a ten-year period (2002–2011).<sup>85</sup> The dataset for this Essay comes from OUII summary information concerning all pending and completed section 337 investigations, available from the ITC website.<sup>86</sup> OUII summary information includes the type of investigation, the identification of the parties and asserted IP rights, and outcome information.<sup>87</sup>

As of October 2012, there had been 857 ITC investigations since 1974, and out of those investigations, 71 remained pending, 586 closed without the issuance of an exclusion order, and 200 closed with one or more exclusion orders.<sup>88</sup> Although OUII provides data on ITC investigations since 1974, this Essay only evaluates seventy-three exclusion orders from 2002 to 2011 because OUII does not provide consistent access to the text of pre-2002 exclusion orders.<sup>89</sup>

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continued in bad faith to import and sell products that were subject to ITC exclusion and cease and desist orders); *Crucible Materials Corp. v. Int'l Trade Comm'n*, 127 F.3d 1057, 1060 (Fed. Cir. 1997) (holding that the ITC's modification of an exclusion order was appealable). *But see* *Fuji Photo Film Co. v. Int'l Trade Comm'n*, 474 F.3d 1281, 1290 (Fed. Cir. 2007) (holding that a patentee lacked standing to challenge the ITC's civil penalty determination when the accused importer ceased operations).

<sup>82</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 607.

<sup>83</sup> *See infra* Part II.

<sup>84</sup> *See* 19 U.S.C. § 1337(d) (2006) (providing exclusion as the remedy).

<sup>85</sup> *See* Office of Unfair Import Investigations, *337 Investigational History: All 337 Investigations*, U.S. INT'L TRADE COMM'N, [http://www.usitc.gov/intellectual\\_property/inv\\_his.htm](http://www.usitc.gov/intellectual_property/inv_his.htm) (last visited Aug. 5, 2013).

<sup>86</sup> *See id.*

<sup>87</sup> *See id.*

<sup>88</sup> *See id.*

<sup>89</sup> *See id.* Three additional ITC investigation numbers with one or more exclusion orders fell within the range of investigation numbers associated with the ten-year timeframe from 2002–2011 (Investigations 337-TA-489, 337-TA-494, and 337-TA-500), but they did not disclose dates and were therefore excluded from this analysis. *See id.* Six investigations also concluded in 2012 with one or more exclusion orders, but were not included because the 2012 calendar year was not complete at the time of the study. *See id.*

A. *The Dataset: ITC Exclusion Orders from 2002–2011*

This Essay finds that exclusion orders define prohibited activity using imprecise language describing “products” covered by the relevant patents; they do not identify specific model numbers nor do they guide CBP concerning redesigned products.<sup>90</sup> From 2002 to 2011, the ITC issued one or more exclusion orders in seventy-three investigations.<sup>91</sup> In thirty-six out of the seventy-three investigations, the ITC also issued one or more cease and desist orders.<sup>92</sup>

For example, in the limited exclusion order against HTC, the ITC issued the following order (in pertinent part) to CBP:

1. Personal data and mobile communication devices and related software covered by claims 1 or 8 of the ‘647 patent that are manufactured abroad by or on behalf of, or imported by or on behalf of, Respondents, or any of their affiliated companies, parents, subsidiaries, successors, assigns, or other related business entities, are excluded from entry for consumption into the United States, entry for consumption from a foreign trade zone, or withdrawal from a warehouse for consumption, for the remaining term of the patent, except under license of the patent’s owner or as provided by law, and except for refurbished articles imported on or before December 19, 2013, for use as a replacement under warranty or insurance contract for an identical article that was imported prior to April 19, 2012.
- . . . .
3. At the discretion of U.S. Customs and Border Protection (“CBP”) and pursuant to procedures it establishes, persons seeking to import personal data and mobile communication devices and related software that are potentially subject to this Order may be required to certify that they are familiar with the terms of this Order, that they have made appropriate inquiry, and thereupon state that, to the best of their knowledge and belief, the products being imported are not excluded from entry under paragraph 1 of this Order. At its discretion, CBP may require persons who have provided the certification de-

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<sup>90</sup> *See id.*

<sup>91</sup> *See id.*

<sup>92</sup> *See id.*; *see generally, e.g.*, Issuance of a Limited Exclusion Order and a Cease and Desist Order; Termination of the Investigation, Certain Birthing Simulators and Associated Systems, Inv. No. 337-TA-759, USITC Pub. 4400 (Aug. 29, 2011), available at <http://www.usitc.gov/publications/337/Pub4400.pdf> (exclusion order and cease and desist order).

scribed in this paragraph to furnish such records or analyses as are necessary to substantiate the certification.<sup>93</sup>

This example illustrates several basic issues discussed throughout this Essay, including: (1) the imprecise scope of a typical exclusion order (seen in paragraph 1 and discussed further below); (2) the certification provision (seen in paragraph 3 and discussed further in Part II.B); and (3) the lack of civil penalties for a violation (discussed further in Part III.C).<sup>94</sup> The ITC also did not issue a cease and desist order here because HTC denied holding commercially significant inventory.<sup>95</sup>

The HTC order is not the only exclusion order with imprecise language. With only a few exceptions, each of the seventy-three exclusion orders reviewed identifies “products” subject to exclusion by using descriptive terms, such as “birthing simulators and associated systems,”<sup>96</sup> or “alternators,”<sup>97</sup> rather than specific products or product model numbers.<sup>98</sup> Each order then directs CBP to exclude “products” covered by the relevant patents.<sup>99</sup>

This language does not adequately define CBP responsibility because the descriptive terms within each exclusion order are imprecise and vague. The ITC could be directing CBP to exclude only products contained within the Commission Opinion attached to the exclusion order: that is, references to “products” do not authorize CBP to exclude redesigned products not part of the ITC investigation, but rather simply serve as a shortcut to listing each model number subject to exclusion. However, the ITC could also be directing CBP to exclude all “products” covered by the claims of the relevant patent. Even the few exclusion orders with broader language, such as “birthing simulators and associated systems,” do not clarify CBP responsibility be-

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<sup>93</sup> Limited Exclusion Order at 2, Certain Personal Data and Mobile Commc’ns Devices and Related Software, Inv. No. 337-TA-710, USITC Pub. 4331 (June 2012).

<sup>94</sup> See *id.*

<sup>95</sup> See Commission Opinion, *supra* note 3, at 84.

<sup>96</sup> See, e.g., Issuance of a Limited Exclusion Order and a Cease and Desist Order; Termination of the Investigation, *supra* note 92.

<sup>97</sup> See, e.g., Notice of Issuance of a Limited Exclusion Order and a Cease and Desist Order Against Defaulting Respondent American Automotive Parts, Inc.; Termination of Investigation, Certain Starter Motors and Alternators, Inv. No. 337-TA-755, USITC Pub. 4398 (Mar. 30, 2012), available at <http://www.usitc.gov/publications/337/Pub4398.pdf>.

<sup>98</sup> See, e.g., Issuance of a Limited Exclusion Order and a Cease and Desist Order; Termination of the Investigation, *supra* note 92.

<sup>99</sup> See, e.g., *id.* at 2.

cause “associated systems” could denote only the systems covered by the original investigation.<sup>100</sup>

Although a few exclusion orders do contain more precise language, this language was only found in the exclusion orders reviewed with respect to products not covered by the exclusion order—i.e., those contained in an “exemption provision.” Such exemption provisions have covered spare parts<sup>101</sup> or specific models held not to infringe.<sup>102</sup> The appearance of exemption language implies that the ITC recognizes the possibility of a broad interpretation of an exclusion order.

### B. *Avoiding Exclusion Through Importer Certification*

Not only are exclusion orders unclear, fifty-two out of the seventy-three exclusion orders examined also contained certification provisions.<sup>103</sup> These provisions grant CBP the authority to accept a certification from an importer that the importer’s goods do not infringe the relevant ITC exclusion order.<sup>104</sup> Certification provisions theoretically assist CBP in enforcement<sup>105</sup> by “shifting responsibility for compliance to the importer, thereby relieving CBP of the responsibility for inspecting all entries of potentially subject merchandise.”<sup>106</sup> In reality, however, certification provisions simply shift responsibility for enforcement to the IP rightsholder,<sup>107</sup> who receives no information

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<sup>100</sup> See, e.g., *id.*

<sup>101</sup> See, e.g., Limited Exclusion Order at 1, Certain Sortation Systems, Parts Thereof, and Products Containing Same, Inv. No. 337-TA-460, USITC Pub. 3588 (Mar 2003), available at <http://www.usitc.gov/publications/337/pub3588.pdf> (exemption for spare parts).

<sup>102</sup> See Limited Exclusion Order at 4, Certain Baseband Processor Chips and Chipsets, Transmitter and Receiver (Radio) Chips, Power Control Chips, and Products Containing Same, Including Cellular Telephone Handsets, Inv. No. 337-TA-543, USITC Pub. 4258 (Oct. 2011), available at <http://www.usitc.gov/publications/337/pub4258vol1of2.pdf> (exemption for certain models of accused products imported before the date of the Exclusion Order); Limited Exclusion Order at 3, Certain Power Supply Controllers and Products Containing Same, Inv. No. 337-TA-541 (Aug. 11, 2006), available at [http://info.usitc.gov/ouii/public/337inv.nsf/RemOrd/541/\\$File/337-ta-541.pdf?OpenElement](http://info.usitc.gov/ouii/public/337inv.nsf/RemOrd/541/$File/337-ta-541.pdf?OpenElement) (exemption for model numbers withdrawn from the complainant’s ITC case).

<sup>103</sup> See Office of Unfair Import Investigations, *supra* note 85.

<sup>104</sup> Blakeslee, *supra* note 18, at 257–58.

<sup>105</sup> *Hyundai Elecs. Indus. Co. v. Int’l Trade Comm’n*, 899 F.2d 1204, 1209 (Fed. Cir. 1990) (holding that certification provisions are a reasonable means of ensuring that respondents comply with the requirements of an exclusion order awarded after a complainant has proven a violation of section 337).

<sup>106</sup> Blakeslee, *supra* note 18, at 259.

<sup>107</sup> *Id.*

from CBP concerning enforcement.<sup>108</sup> All that the certification provision requires is that the importers have “made appropriate inquiry, and thereupon state that, to the best of their knowledge and belief, the products being imported are not excluded from entry.”<sup>109</sup> An importer could easily meet this requirement, for instance, by obtaining an opinion of counsel of non-infringement.<sup>110</sup> Certification provisions thus favor importers at the harm of IP rightsholders and increase the costs of litigation.<sup>111</sup>

Even general exclusion orders are not immune from this problem.<sup>112</sup> Although general exclusion orders theoretically shift the burden of proving non-infringement to the importer,<sup>113</sup> certification provisions were also present in all but one of the general exclusion orders issued between 2009 and 2011, significantly tempering their power.<sup>114</sup> The availability of certification provisions, coupled with the burden of supervising 325 ports of entry, underscores the difficulties of CBP enforcement.<sup>115</sup>

Obtaining an exclusion order is therefore not as significant as it may seem. Importers can still take calculated risks to violate exclusion orders, simply by filing certifications with CBP. Even if CBP does detain or exclude infringing goods, CBP’s *ex parte* procedure significantly favors importers.<sup>116</sup> CBP even stated that it “is not authorized to take any action regarding apparently patent-infringing merchandise without the ITC first taking action or without receiving a

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<sup>108</sup> See *infra* notes 120–37 and accompanying text (discussing the elimination of patent import surveys).

<sup>109</sup> See *e.g.*, Limited Exclusion Order, *supra* note 92, at 2.

<sup>110</sup> See, *e.g.*, *Global-Tech Appliances, Inc. v. SEB S.A.*, 131 S. Ct. 2060, 2071 (2011) (finding alleged infringer’s opinion of counsel non-dispositive because alleged infringer knew of the relevant patent and withheld that information from counsel).

<sup>111</sup> See Blakeslee, *supra* note 18, at 259.

<sup>112</sup> See Office of Unfair Import Investigations, *supra* note 85.

<sup>113</sup> *Hyundai Elecs. Indus. Co. v. Int’l Trade Comm’n*, 899 F.2d 1204, 1209–10 (Fed. Cir. 1990).

<sup>114</sup> See OFFICE OF UNFAIR IMPORT INVESTIGATIONS, *supra* note 85. The general exclusion order without a certification provision was for an old 2004 investigation on remand. See Notice of Commission Final Determination of Violation of Section 337; Reinstatement of General Exclusion Order and Cease and Desist Orders; Termination of the Investigation at 1–2, Certain Agricultural Vehicles and Components Thereof, Inv. No. 337-TA-487 (Jan. 13, 2012), available at [http://info.usitc.gov/ouii/public/337inv.nsf/RemOrd/487/\\$File/337-487.pdf?OpenElement](http://info.usitc.gov/ouii/public/337inv.nsf/RemOrd/487/$File/337-487.pdf?OpenElement) (second remand). In *VastFame Camera, Ltd. v. Int’l Trade Comm’n*, 386 F.3d 1108, 1116 (Fed. Cir. 2004), the Federal Circuit also held that a respondent not part of the original case can raise a defense of invalidity in the enforcement proceeding, further weakening the power of a general exclusion order.

<sup>115</sup> See *supra* notes 14–17, 41–45 and accompanying text.

<sup>116</sup> See *supra* Part I.B.

notice, request, or instruction from the ITC, a clearly secondary role.”<sup>117</sup> CBP’s denial of authority to take action and its ex parte procedures make clear that any reform in the enforcement of ITC exclusion orders must come from the ITC itself rather than from CBP.

### III. IMPROVING THE ENFORCEMENT OF EXCLUSION ORDERS AT THE ITC

This Essay makes three proposals to improve the enforcement of ITC exclusion orders. First, the ITC should provide notice to IP rightsholders when importers file certifications with CBP or when CBP issues ex parte decisions. Second, to determine if the scope of an exclusion order covers a redesigned product, the ITC should adopt the “colorable differences” test<sup>118</sup> that some district courts use to resolve the violation of an injunction. Third, because no civil penalties are available even if an IP rightsholder proves that an importer violated an exclusion order, the ITC should issue cease and desist orders in tandem with exclusion orders. Cease and desist orders would allow IP rightsholders to recover civil penalties on behalf of the ITC.<sup>119</sup>

#### A. *Proposed Modification to Certification Provisions to Provide Notice*

One of the biggest problems faced by prevailing IP rightsholders is the lack of disclosure from CBP to IP rightsholders concerning enforcement.<sup>120</sup> No rules or regulations authorize the disclosure of any import data by CBP in patent cases.<sup>121</sup> Yet CBP does disclose import data to IP rightsholders in trademark, trade name, and copyright cases.<sup>122</sup>

As recently as 2004, CBP provided a “key benefit to patent owners by allowing them to file a patent import survey.”<sup>123</sup> Patent import

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<sup>117</sup> Patent Surveys, 69 Fed. Reg. 52,811, 52,812 (Aug. 30, 2004).

<sup>118</sup> See *infra* Part III.B; see also *TiVo, Inc. v. EchoStar Corp.*, 646 F.3d 869, 881–83 (Fed. Cir. 2011) (en banc) (setting forth the two-part test for determining if an accused product is no more than “colorably different” from a product previously held to infringe).

<sup>119</sup> See 19 U.S.C. § 1337(f) (2006) (cease and desist orders; civil penalty for violation of orders). For some limitations on the standing of IP rightsholders in this context, see *supra* note 81 and accompanying text.

<sup>120</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 607–08; see also *supra* notes 15–17 and accompanying text.

<sup>121</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 607; see also 19 C.F.R. § 12.39 (2012).

<sup>122</sup> 19 C.F.R. § 133.21(c) (2012) (trademark and trade name seizures); *id.* § 133.25(b)–(c) (trademarks and trade name detentions); *id.* § 133.42(d) (copyright seizures); *id.* § 133.43(b) (copyright detentions).

<sup>123</sup> TRAINER & ALLUMS, *supra* note 20, § 5:5. See also generally TRAINER, *supra* note 41.

surveys were part of a CBP regulation promulgated in 1956 to authorize CBP to provide the “names and addresses of importers of articles appearing to infringe a registered patent.”<sup>124</sup> “[T]he purpose of the . . . provision was to assist the owner of a registered patent in obtaining data upon which to file a complaint with the ITC under section [337] . . . .”<sup>125</sup>

CBP eliminated patent surveys in 2004 for multiple reasons.<sup>126</sup> First, the sheer volume of entries proved to be unmanageable: in 2001, CBP received more than 23 million entries, a significant increase from the 1 million it had received in 1956 when the surveys first began.<sup>127</sup> Second, patent surveys were not accurate, as they could be overly inclusive, involve novel commodities, and identify importers who did not infringe.<sup>128</sup> Third, CBP cited a lack of interest: CBP received only ten survey requests per year and no comments in response to the proposal to eliminate the surveys.<sup>129</sup> Finally, CBP was not “compelled by law to continue performing patent surveys, especially when their value appear[ed] to have diminished, resources [were] scarce, and the agency [was] faced with elevated national security priorities.”<sup>130</sup>

Yet these reasons are precisely why CBP cannot effectively enforce exclusion orders. First, CBP must still spot infringing products mixed within the 23 million entries it receives each year.<sup>131</sup> CBP processes entries using a “self-assessment system based on electronic reporting without paper invoices.”<sup>132</sup> This system, like importer certifications, effectively shifts the burden of enforcement from CBP to IP rightsholders without solving the underlying problem of ineffective enforcement of exclusion orders.<sup>133</sup> Second, to enforce exclusion orders, CBP must still identify which importers infringe exclusion orders regardless of the novelty of the products involved.<sup>134</sup> Third, ITC filings have increased from twenty-six investigations in 2004 to sixty-

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<sup>124</sup> Patent Surveys, 69 Fed. Reg. 52,811, 52,811 (Aug. 30, 2004); *see also* Assessment and Collection of Certain Customs Fees, 21 Fed. Reg. 3267, 3267 (May 18, 1956); TRAINER, *supra* note 41, at 237.

<sup>125</sup> Patent Surveys, 69 Fed. Reg. at 52,811–12; *see also* TRAINER, *supra* note 41, at 237.

<sup>126</sup> *See* Patent Surveys, 69 Fed. Reg. at 52,812.

<sup>127</sup> *Id.*

<sup>128</sup> *Id.*

<sup>129</sup> *Id.*

<sup>130</sup> *Id.* Because the provision for patent import surveys was a CBP regulation and not a statute, CBP was free to change its approach and eliminate the surveys.

<sup>131</sup> *See id.*

<sup>132</sup> *Id.*

<sup>133</sup> *See supra* Part II.B.

<sup>134</sup> *See* Blakeslee, *supra* note 18, at 253.

nine in 2011, underscoring the increasingly high demand for ITC exclusion orders.<sup>135</sup> CBP's proposal to eliminate the surveys also pre-dates the heightened requirements for patent injunction outlined in *eBay, Inc. v. MercExchange, LLC*.<sup>136</sup> Prior to *eBay*, patent import surveys may have been less valuable for IP rightsholders because a district court injunction could independently enjoin sales of illegally imported goods. Now, because injunctions may be more difficult to obtain post-*eBay*, the value of the patent surveys would be higher. Finally, CBP's reasoning demonstrates that "enforcing exclusion orders can be a difficult task for [CBP],"<sup>137</sup> even if the Federal Circuit does not acknowledge those difficulties.<sup>138</sup>

One former CBP agent<sup>139</sup> proposes that CBP adopt comprehensive disclosure regulations for exclusion orders that mirror those for trademark, trade name, and copyright cases.<sup>140</sup> CBP, however, had the opportunity to adopt similar disclosure regulations and did not do so.<sup>141</sup> The former agent's solution is also no different from the recently eliminated patent surveys.<sup>142</sup> It still relies on CBP to identify infringing goods that may be no more than "colorably different"<sup>143</sup> from products held to infringe. Her solution also does not address CBP's concern with importer confidentiality, particularly when the suspected goods do not infringe.<sup>144</sup> Nor does her solution address the

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<sup>135</sup> See *supra* note 13 and accompanying text.

<sup>136</sup> *eBay, Inc. v. MercExchange, LLC*, 547 U.S. 388, 394 (2006).

<sup>137</sup> SUNDEEN ET AL., *supra* note 11, § 10:3; see also TRAINER, *supra* note 41, at 237–38.

<sup>138</sup> See *Fuji Photo Film Co. v. Int'l Trade Comm'n*, 386 F.3d 1095, 1106–07 (Fed. Cir. 2004) ("As we did in *Hyundai*, we reject Fuji's suggestion that the Customs Service is incapable of enforcing the Commission's general exclusion order effectively because of a lack of expertise and other priorities."); *Hyundai Elecs. Indus. Co. v. Int'l Trade Comm'n*, 899 F.2d 1204, 1210 (Fed. Cir. 1990) ("Hyundai's challenge strikes us as a thinly veiled and vaguely expressed dissatisfaction with the certification procedure it expects the Customs Service to devise when it implements the Commission's order.").

<sup>139</sup> Debra D. Peterson, *Seizing Infringing Imports of Cinderella's Slippers: How Egyptian Goddess Supports U.S. Customs and Border Protection's Enforcement of Design Patents*, 90 J. PAT. & TRADEMARK OFF. SOC'Y 888, 888 n.1 (2008) [hereinafter Peterson, *Seizing Infringing Imports*].

<sup>140</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 608.

<sup>141</sup> See generally Copyright/Trademark/Trade Name Protection; Disclosure of Information, 63 Fed. Reg. 11,996 (Mar. 12, 1998) (Final Rule) (codified at 19 C.F.R. pt. 133 (2012)); Copyright/Trademark/Trade Name Protection; Disclosure of Information, 60 Fed. Reg. 36,249 (July 14, 1995) (Notice of Proposed Rulemaking); Peterson, *The Knowledge to Act*, *supra* note 14, at 624.

<sup>142</sup> See *supra* Part I.A; *supra* notes 126–38 and accompanying text.

<sup>143</sup> See *infra* Part III.B.

<sup>144</sup> Peterson, *The Knowledge to Act*, *supra* note 14, at 633.

problem posed by importer certifications.<sup>145</sup> Even if CBP were to disclose information regarding detained or excluded goods, importers could still file certifications, allowing both importation and non-disclosure.<sup>146</sup> Fifty-two out of seventy-three exclusion orders, and all but one exclusion order issued between 2009 and 2011, contained such certification provisions.<sup>147</sup>

This Essay proposes instead that the ITC keep the certification provisions, but with a modification: rather than allowing importers to file certifications without legal recourse, the ITC should require that CBP provide notice to IP rightsholders. The ITC could implement this proposal by modifying language already contained within each exclusion order to require notice within fifteen days.<sup>148</sup> To offset the expenses of providing notice, the ITC could require IP rightsholders to pay a fee. IP rightsholders could also receive notice either directly from CBP, or from CBP through the ITC. The ITC could request public comment through a Notice of Proposed Rulemaking,<sup>149</sup> even though no rule authorized the original ITC policy decision to provide CBP with the authority to accept the certifications from importers.<sup>150</sup>

The notice proposal could also resolve the issue of importer bias that results from the *ex parte* nature of CBP ruling letters and protests, and appeals before CIT.<sup>151</sup> Instead, CBP could provide notice to IP rightsholders upon the issuance of any new CBP ruling letters or protests. Notice would allow IP rightsholders to seek informal or formal enforcement at the ITC through *inter partes* proceedings—procedures already in place at the ITC.<sup>152</sup>

The notice proposal would balance importer confidentiality with the burden on CBP. Importers would control confidentiality by deciding whether to certify redesigned products, balancing the risk of de-

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<sup>145</sup> See generally Peterson, *Seizing Infringing Imports*, *supra* note 139.

<sup>146</sup> See *supra* Part II.B.

<sup>147</sup> See *supra* note 103 and accompanying text.

<sup>148</sup> Fifteen days corresponds to the number of days before an importer must respond to an enforcement complaint, but other timelines could also work. See 19 C.F.R. § 210.75(b) (2012).

<sup>149</sup> 5 U.S.C. § 553 (2012) (rulemaking). The ITC also recently proposed new rules to clarify formal enforcement proceedings, setting a goal of twelve months for the final determination of a formal enforcement proceeding, with the initial determination due three months before the final determination. See Rules of General Application, Adjudication, and Enforcement, 77 Fed. Reg. 41,120, 41,125 (proposed July 12, 2012).

<sup>150</sup> See *Hyundai Elecs. Indus. Co. v. Int'l Trade Comm'n*, 899 F.2d 1204, 1209–10 (Fed. Cir. 1990) (“The Commission’s decision in this case to enter a limited exclusion order containing a certification provision is both reasonable and well within its authority.”); see also 19 C.F.R. pt. 210 (a search of the C.F.R. reveals no text discussing certification provisions).

<sup>151</sup> See *supra* Part I.C.

<sup>152</sup> See 19 C.F.R. § 210.75.

tention by CBP against the loss of confidentiality from certification. Certifications would be unnecessary for products that clearly do not infringe, allowing importers to maintain confidentiality. For products that are no more than “colorably different”<sup>153</sup> from infringing products, however, importers would certify to avoid the risk of detention by CBP.

The burdens on CBP would be minimal because CBP already accepts certifications and notifies the ITC when it first detains products.<sup>154</sup> Under the notice proposal, importers would file certifications with CBP only prior to the first shipment of a redesigned product, and, after receiving the certifications, the ITC could provide the necessary notice. The burden on the ITC would be minimal because the ITC could charge a fee, and notice would only be necessary after an importer files a certification and prior to the first shipment. The IP rightsholder could then seek informal or formal enforcement at the ITC.<sup>155</sup>

#### *B. Adopting the Colorable Differences Test to Resolve Close Cases*

Once an IP rightsholder does seek enforcement at the ITC, a new issue arises concerning the proper standard for determining whether a redesigned product violates an exclusion order. This Essay proposes that the ITC adopt the “colorable differences” test used by district courts in contempt proceedings to evaluate close cases concerning redesigned products.<sup>156</sup> District courts developed the colorable differences test to resolve the issue of whether a district court’s injunction against patent infringement covers a “design-around” or “redesigned” product.<sup>157</sup>

The characteristics of ITC enforcement proceedings share many similarities with those of contempt proceedings in district court. These similarities include a prior patent infringement trial, a prior injunction or exclusion order, a dispute concerning whether the prior order covers newly accused, redesigned products, and a desire to avoid another full trial on the merits when the accused products may

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<sup>153</sup> See *infra* Part III.B.

<sup>154</sup> 2011 USITC PERFORMANCE REPORT, *supra* note 53, at 26.

<sup>155</sup> See 19 C.F.R. § 210.75.

<sup>156</sup> See *TiVo Inc. v. Echostar Corp.*, 646 F.3d 869, 881–83 (Fed. Cir. 2011) (en banc) (setting forth the two-part test for determining if an accused product is no more than “colorably different” from a product previously held to infringe).

<sup>157</sup> *Id.* at 882.

be no more than “colorably different” from products previously adjudged to infringe.<sup>158</sup>

Under the colorable differences test defined in *TiVo Inc. v. EchoStar Corp.*,<sup>159</sup> a patentee must prove that: (1) the newly accused product is “not more than colorably different from the product found to infringe,” and (2) that the “newly accused product actually infringes.”<sup>160</sup> A finder of fact should not focus on whether the “redesigned” product infringes without considering whether it contains a significant modification.<sup>161</sup> To determine if the modification is significant—a finding of fact—a tribunal may consider whether the modification is not obvious in light of the relevant prior art.<sup>162</sup> If the modification is significant, contempt is inappropriate regardless of whether the redesigned product infringes because a new trial on the merits is necessary.<sup>163</sup> If the modification is not significant, the finder of fact must then consider whether the redesigned product infringes to determine if contempt is appropriate.<sup>164</sup>

The colorable differences test thus achieves a balance between both overbroad and overly weak injunctions, each of which can chill innovation. Overbroad injunctions can reduce innovation because they reduce the incentive to design new products around existing patents due to the increased risk of being held in contempt from selling a redesigned product covered by the broad injunction.<sup>165</sup> Overly weak injunctions can also reduce innovation because they may not provide sufficient protection for creative inventors who may need patent protection to justify their investment in innovative technologies.<sup>166</sup> The colorable differences test strikes this balance by focusing on whether a redesigned product contains a significant modification in light of the

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<sup>158</sup> See *id.*; see also 19 C.F.R. § 210.75(b)(1) (formal enforcement proceedings).

<sup>159</sup> *TiVo Inc. v. Echostar Corp.*, 646 F.3d 869 (Fed. Cir. 2011) (en banc).

<sup>160</sup> *Id.* at 882.

<sup>161</sup> *Id.*

<sup>162</sup> *Id.* at 882–83.

<sup>163</sup> *Id.* at 882.

<sup>164</sup> *Id.* at 883.

<sup>165</sup> See *id.* at 881–82.

<sup>166</sup> See Sarah R. Wasserman Rajec, *Tailoring Remedies to Spur Innovation*, 61 AM. U. L. REV. 733, 759–60 (2012) (explaining that the inability to obtain an injunction could shift the gains of a patent monopoly to “entities willing to take the commercial risks of bringing a product to market, rather than those assuming the risk of the initial innovation”).

relevant prior art,<sup>167</sup> a test very similar to the threshold requirements for obtaining a patent.<sup>168</sup>

The ITC should adopt the colorable differences test to define the scope of exclusion orders because the test clearly defines the scope of illegal activity, despite any lack of clarity in the language of the relevant ITC exclusion order. Instead of issuing broad exclusion orders that can be subject to reasonable variation in interpretation, exclusion orders should be specific to products already held to infringe patent laws and to products that are no more than colorably different from those infringing products. As an alternative, the ITC could adopt specially tailored exclusion orders similar to the specially tailored injunctions suggested by Professor John M. Golden.<sup>169</sup> Professor Golden argues that specially tailored injunctions could “enable better balancing of concerns of notice, rights protection, rights limitation, and administrability.”<sup>170</sup>

Specially tailored injunctions, however, are precisely the type of broad injunctive relief that could prohibit noninfringing activity, leading to serious disagreement even among judges on the Federal Circuit concerning whether the broad injunction covers a redesigned product, as occurred in *TiVo*.<sup>171</sup> Specific orders, by contrast, are more predictable and easier to enforce, making them more efficient for enforcement proceedings. They are also easier for parties not involved in the original investigation—such as CBP—to enforce.<sup>172</sup> Furthermore, in cases where the redesigned products are actually more than colorably different from products previously held to be infringing, contempt or enforcement proceedings would not be proper.<sup>173</sup>

Still, there is one aspect of the colorable differences test that this Essay does propose modifying for this context: when an IP rightsholder seeks enforcement, the IP rightsholder should still bear the

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<sup>167</sup> See *Tivo*, 646 F.3d at 882–83.

<sup>168</sup> See 35 U.S.C. § 103(a) (2006) (providing that a patent must be nonobvious to a person of ordinary skill in the art).

<sup>169</sup> John M. Golden, *Injunctions as More (or Less) Than “Off Switches”: Patent-Infringement Injunctions’ Scope*, 90 TEX. L. REV. 1399, 1413 (2012).

<sup>170</sup> *Id.* at 1399.

<sup>171</sup> See *TiVo Inc.*, 646 F.3d at 875 (holding in a 7–5 decision that civil contempt was proper because a specially tailored injunction covered a redesigned product, but also disclosing that five Federal Circuit judges dissented and found contempt to be not proper based on that injunction).

<sup>172</sup> Note that CBP has the statutory authority to enforce ITC exclusion orders, but injunctions can also enjoin the infringer from importing infringing goods. In *TiVo*, for instance, the district court enjoined the defendants from “making, using, offering to sell, selling, or importing in the United States, the Infringing Products.” *Id.* at 877.

<sup>173</sup> See *id.* at 882.

burden of proving that the redesigned products violate the relevant exclusion order.<sup>174</sup> Under the colorable differences test, a 7–5 majority of the Federal Circuit held that “the burden was clearly on [the accused infringer] to seek clarification or modification” of an allegedly vague injunction.<sup>175</sup> Judge Dyk’s dissent, however, argues that this holding is inconsistent with Supreme Court precedent.<sup>176</sup> Other circuits have also reversed contempt findings where an injunction “does not clearly prohibit the accused conduct.”<sup>177</sup> The failure of a district court or of the ITC to spell out the specific obligations of an accused infringer should be “fatal to any contempt proceeding.”<sup>178</sup> Thus, the burden should remain on the IP rightsholder to prove with clear and convincing evidence that an exclusion order covers any newly redesigned products.

### C. Issuing Cease and Desist Orders in Tandem with Exclusion Orders

Even after an IP rightsholder proves that an importer violated an exclusion order through enforcement proceedings, however, no civil penalty is available.<sup>179</sup> The ITC can impose a civil penalty for violations of cease and desist or consent orders, but no civil penalties are available for violations of exclusion orders.<sup>180</sup> Neither section 337 nor the rules and regulations governing the ITC explain this difference.<sup>181</sup>

One solution to the problem of the lack of civil penalties could be for the ITC to issue cease and desist orders in tandem with exclusion orders. Currently, however, the ITC issues cease and desist orders only in cases where a respondent has “‘commercially significant’ inventories of infringing products.”<sup>182</sup> The ITC provides no statutory or

<sup>174</sup> See 19 C.F.R. § 210.75 (2012).

<sup>175</sup> *TiVo Inc.*, 646 F.3d at 886.

<sup>176</sup> See *id.* at 895–96 (Dyk, J., dissenting in part) (citing *Granny Goose Foods, Inc. v. Bhd. of Teamsters & Auto Truck Drivers Local 70*, 415 U.S. 423, 444 (1974)). The Supreme Court found in *Granny Goose* that injunctions must provide fair notice of what is prohibited. See *Granny Goose*, 415 U.S. at 444.

<sup>177</sup> *Id.* at 898 (collecting cases from the First, Third, Seventh, Ninth, and D.C. Circuits).

<sup>178</sup> See *id.* at 899 (internal quotation marks and citation omitted).

<sup>179</sup> See 19 U.S.C. § 1337(d) (2006) (failing to account for the possibility that an importer may violate an exclusion order or to provide for a civil penalty in the event of a violation).

<sup>180</sup> See *Ninestar Tech. Co. v. Int’l Trade Comm’n*, 667 F.3d 1373, 1376 (Fed. Cir. 2012) (affirming the ITC’s “assess[ment] of a civil penalty against the Ninestar companies for failure to comply with exclusion and cease and desist orders arising from violation of Section 337 of the Tariff Act”). Compare 19 U.S.C. § 1337(d) (no civil penalty for violating an exclusion order), with *id.* § 1337(f) (civil penalty for violating cease and desist orders).

<sup>181</sup> See 19 U.S.C. § 1337(d)–(f); 19 C.F.R. pt. 210 (2012).

<sup>182</sup> SUNDEEN ET AL., *supra* note 11, § 10:4 (citation omitted).

regulatory justification for this practice,<sup>183</sup> but relies only on previous commission opinions discussing the stockpiling of infringing inventory.<sup>184</sup>

The issue of commercially significant inventory came before the Federal Circuit in 2004 in *Fuji Film Photo Co. v. ITC*,<sup>185</sup> in which the complainant argued that the ITC's "standard practice of not issuing cease and desist orders against respondents who have no domestic inventory" was an abuse of discretion.<sup>186</sup> The Federal Circuit nevertheless held that it had no authority to issue a "judicial directive that would, in effect, require the [ITC] to alter its practices based on [the court's] unsupported suspicion that the Customs Service is incapable of performing the duties Congress has assigned to it."<sup>187</sup> Thus, the Federal Circuit treated the issue of "commercially significant inventory" similarly to importer certifications, even though they concern separate remedies: the former concerns cease and desist orders and the latter concerns exclusion orders.<sup>188</sup>

One case suggesting the possibility of an alternative interpretation is *San Huan New Materials High Tech., Inc. v. ITC*,<sup>189</sup> in which the Federal Circuit held that consent orders are enforceable by civil penalties because any other "interpretation of the statute and regulations would render consent orders meaningless."<sup>190</sup> A consent order is

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<sup>183</sup> See 19 U.S.C. § 1337(d)-(f); 19 C.F.R. pt. 210.

<sup>184</sup> The earliest commission opinions addressing commercially significant inventory rely on the Commission Opinion in *Certain Nonwoven Gas Filter Elements*. See Commission Opinion at 10, *Certain Nonwoven Gas Filter Elements*, Inv. No. 337-TA-275, USITC Pub. 2129 (Sept. 1988) (declining to issue a cease and desist order because "there is no evidence of stockpiling or substantial inventories of infringing articles in the United States" and that "complainant . . . admitted, in effect, that respondents' sale of the estimated 250 infringing units alone would not be harmful"). Later commission opinions follow this same logic. See, e.g., Commission Opinion, *supra* note 3, at 84 (affirming that the ITC should not issue a cease and desist order when the respondent did not "maintain[ ] commercially significant levels of inventory in the United States"); Commission Opinion at 27, *Certain Integrated Repeaters, Switches, Transceivers, and Products*, Inv. No. 337-TA-435, USITC Pub. 3547 (Oct. 2002) (final) ("The Commission issues cease and desist orders where 'commercially significant' inventories of infringing products are present in the United State [sic], and complainants bear the burden of proving that respondent has such an inventory.").

<sup>185</sup> *Fuji Photo Film Co. v. Int'l Trade Comm'n*, 386 F.3d 1095 (Fed. Cir. 2004).

<sup>186</sup> *Id.* at 1107.

<sup>187</sup> *Id.*

<sup>188</sup> See *id.* (stating that the practice criticized by Fuji "is based on the Commission's view that ordinarily exclusion orders enforced by Customs should be sufficient to prevent entry of articles into the United States, whereas an order to Customs is ineffective with regard to existing stockpiles of domestic inventory").

<sup>189</sup> *San Huan New Materials High Tech, Inc. v. Int'l Trade Comm'n*, 161 F.3d 1347 (Fed. Cir. 1998).

<sup>190</sup> *Id.* at 1356.

not just a settlement or an informal agreement; it “invokes the restraint of federal power, upon the respondent’s undertaking to comply with the law; thus its violation is subject to federal remedy, by penalty and enforcement in accordance with statute and regulation.”<sup>191</sup>

Similarly, an exclusion order is no different from a consent order in that it invokes federal power to exclude goods from entry into the United States. The violation of an exclusion order should be just as much “subject to federal remedy, by penalty and enforcement.”<sup>192</sup> The most natural remedy to deter a violation of an exclusion order is a cease and desist order—effectively a stop order—against the sale of products already imported, regardless of whether that importation occurred prior to or after the issuance of an exclusion order.

There is also no statutory authority requiring commercially significant inventory before the ITC can issue a cease and desist order. Section 337 authorizes the ITC to issue cease and desist orders “[i]n addition to, or in lieu of, taking action under subsection (d) or (e) of this section.”<sup>193</sup> Because subsections 337(d) and 337(e) provide for the ITC’s authority to issue exclusion orders, section 337 should also authorize the ITC to issue cease and desist orders in tandem with any exclusion order.<sup>194</sup> Section 337 does not refer to commercially significant levels of inventory,<sup>195</sup> but it does differentiate between the enforcement of exclusion and cease and desist orders.

Upon issuance of an exclusion order, subsection 337(d) provides that the proper officers shall refuse entry of the excluded goods; it does not provide for civil penalties against an importer who violates an exclusion order.<sup>196</sup> By contrast, subsections 337(d) and 337(g) do limit the authority for general exclusion orders to cases where general exclusion is “necessary to prevent circumvention of an exclusion order limited to products of named persons,” and “there is a pattern of violation of this section and it is difficult to identify the source of infringing products.”<sup>197</sup>

Upon issuance of a cease and desist order, however, subsection 337(f) authorizes the ITC to obtain a civil penalty of up to “\$100,000 or twice the domestic value of the articles entered or sold” for each

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<sup>191</sup> *Id.* at 1356–57.

<sup>192</sup> *See id.* at 1357.

<sup>193</sup> *See* 19 U.S.C. § 1337(f)(1) (2006).

<sup>194</sup> *See id.* § 1337(d)–(f).

<sup>195</sup> *See id.* § 1337.

<sup>196</sup> *See id.* § 1337(d).

<sup>197</sup> *Id.* § 1337(d)(2); *see also id.* § 1337(g)(2) (incorporating § 1337(d)(2)’s criteria by reference).

day that an importer violates the ITC order.<sup>198</sup> Although the civil penalty provision falls under the cease and desist order subsection, the title of subsection 337(f) states: “Cease and desist orders; civil penalty for violation of orders.”<sup>199</sup> The title suggests that civil penalties may be available not only for violations of cease and desist orders, but also for other ITC orders too. This ambiguity has allowed the ITC to collect civil penalties for violations of consent orders.<sup>200</sup>

There are also no rules or regulations requiring a commercially significant inventory of infringing goods before the ITC can issue a cease and desist order.<sup>201</sup> The ITC’s authority for issuing exclusion or cease and desist orders is nearly identical throughout Part 210 of the Code of Federal Regulations.<sup>202</sup> The ITC has the authority to modify reporting requirements for respondents subject to exclusion or cease and desist orders.<sup>203</sup> It also has the authority to issue exclusion or cease and desist orders against a respondent who defaults,<sup>204</sup> and to require information reports.<sup>205</sup> By contrast, ITC rules do limit the authority of the ITC to issue general exclusion orders, with language matching that of section 337.<sup>206</sup>

The ITC even maintains that it has “authority to issue cease and desist orders against foreign respondents that do not maintain inventory in the United States, but has declined to issue such orders because ‘it would be unwise, disruptive, and impractical for the Commission to try to supplant or duplicate the functions of Cus-

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<sup>198</sup> See *id.* § 1337(f)(2). In *San Huan New Materials High Tech, Inc. v. Int’l Trade Comm’n*, 161 F.3d 1347 (Fed. Cir. 1998), the Federal Circuit affirmed that a monetary penalty of \$50,000 per violation day for thirty-one days for violating a consent order was not excessive, did not violate the U.S. Constitution, and was not an abuse of discretion. *San Huan*, 161 F.3d at 1364 (analyzing the fine under the excessive fines clause, U.S. CONST. amend. VIII).

<sup>199</sup> See 19 U.S.C. § 1337(f).

<sup>200</sup> SUNDEEN ET AL., *supra* note 11, § 10:5; see also *San Huan*, 161 F.3d at 1352–53 (providing that the ITC has statutory and regulatory authority to assess a civil penalty for the violation of a consent order); Herrington, *supra* note 40, at 185 (“[F]or enforcement purposes, the Commission treats consent orders as analogous to cease and desist orders.”).

<sup>201</sup> See 19 C.F.R. pt. 210 (2012).

<sup>202</sup> See *id.*

<sup>203</sup> *Id.* § 210.74.

<sup>204</sup> *Id.* § 210.16(c).

<sup>205</sup> *Id.* § 210.71.

<sup>206</sup> Compare *id.* § 210.16 (requiring the ITC to consider “public health and welfare,” “competitive conditions,” and other “public interest factors”), and § 210.50(c) (limiting exclusion to “prevent circumvention of an exclusion order limited to products of named persons” or when “there is a pattern of violation”), with 19 U.S.C. § 1337(d) (2006) (requiring the ITC to consider “public health and welfare,” “competitive conditions,” and other public interest factors and limiting exclusion to “prevent circumvention of an exclusion order limited to products of named persons” or when “there is a pattern of violation”).

toms.’<sup>207</sup> Issuing cease and desist orders, however, would not be disruptive or impractical because the ITC issued cease and desist orders with thirty-six out of the seventy-three exclusion orders issued between 2002 and 2011.<sup>208</sup> Issuing cease and desist orders would also not supplant or duplicate the efforts of CBP because the enforcement of a cease and desist order does not result in the detainment of infringing goods at the border; cease and desist orders cover products that have already entered the United States despite the interdiction efforts of CBP at the U.S. trade border.<sup>209</sup>

Instead, by issuing cease and desist orders in tandem with exclusion orders, the ITC would increase the efficiency of enforcement and eliminate back-to-back enforcement proceedings, where the first enforcement results in a cease and desist order and the second results in civil penalties. Issuing cease and desist orders would thus increase the efficiency and speed of ITC remedies and lower the costs of ITC litigation.

#### CONCLUSION

This Essay proposes that the ITC provide notice to IP rightsholders when importers file certifications with CBP or when CBP issues *ex parte* decisions concerning exclusion orders. This notice is consistent with the goals of patent law because it favors normative outcomes through *inter partes* enforcement proceedings rather than *ex parte* proceedings before CBP. Relying on enforcement proceedings increases the efficiency, speed, and predictability of outcomes because the ITC has prior familiarity with the relevant patents and the accused products.

The ITC should also adopt the colorable differences test used by the district courts in evaluating close cases concerning redesigned products. The colorable differences test is well suited to enforcement proceedings because enforcement proceedings share many similarities with contempt proceedings in district court. These similarities include a prior patent infringement trial, an injunction or exclusion order, a dispute concerning whether the prior order covers redesigned products, and expedited enforcement.

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<sup>207</sup> SUNDEEN ET AL., *supra* note 11, § 10:4 n.1; *see also* Herrington, *supra* note 40, at 189 (“The Commission takes the position that it may issue an exclusion order and a cease and desist order in the same case, providing that these remedies are directed to different unfair practices found to exist in that case.” (citation omitted)).

<sup>208</sup> *See* Office of Unfair Import Investigations, *supra* note 85.

<sup>209</sup> *See supra* Part I.C.

This Essay also proposes that the ITC issue cease and desist orders in tandem with exclusion orders, finding no statutory or regulatory requirement that a respondent possess commercially significant inventory before the ITC can issue a cease and desist order. The most natural remedy to deter a violation of an exclusion order is an order to cease and desist from selling infringing imported products. By issuing cease and desist orders in tandem with exclusion orders, the ITC would eliminate duplicative enforcement proceedings, increase the efficiency of ITC remedies, and lower litigation costs.

In the example of Apple and HTC, all three proposals would improve the enforcement of the exclusion order. First, the ITC would issue both an exclusion and cease and desist order in tandem. Second, Apple would receive notice should HTC file a certification of noninfringement with CBP or should CBP issue an ex parte decision concerning the exclusion order. Third, during enforcement, the colorable differences test would govern disputes concerning redesigned products. Finally, should Apple prevail, Apple could seek immediate civil penalties on behalf of the ITC, rather than first seeking a cease and desist order and then seeking civil penalties in back-to-back enforcement proceedings.