

Caterpillar Hit With Import Ban In Latest Round Of ITC Battle

By **Tiffany Hu**

Law360 (July 23, 2019, 7:56 PM EDT) -- Weeks after convincing the U.S. International Trade Commission to ban imports of a rival's road milling machines, Caterpillar Inc. on Tuesday was hit with an import ban of its own on similar equipment.

The limited exclusion order blocks Caterpillar from selling imported road-milling machines for concrete and asphalt pavement that infringe at least one claim of two Wirtgen America Inc. patents, according to a Federal Register notice set to be published Wednesday.

The order against Caterpillar comes on the heels of the ITC's limited exclusion order against Wirtgen in late June, which stemmed from a separate investigation into similar Wirtgen equipment that was found to infringe a milling machine patent owned by Caterpillar.

An attorney for Wirtgen declined to comment Tuesday. Counsel for Caterpillar did not immediately respond to a request for comment.

The manufacturers' dispute dates back to July 2017. Wirtgen had fired the first shot, alleging that road-milling machines sold by Caterpillar infringed its patents in violation of Section 337 of the Tariff Act of 1930, which prohibits the importation and sale of infringing goods.

After the ITC opened a probe into Caterpillar's machines, the commission agreed months later to take up an investigation into Wirtgen's own upon Caterpillar's machines request.

In October, an administrative law judge published an initial decision finding that Caterpillar's machines infringed two Wirtgen patents, U.S. Patent Nos. 7,828,309 and 9,656,530, though the judge did not find a violation with regard to Wirtgen's U.S. Patent Nos. 7,530,641 and 9,644,340.

Caterpillar subsequently appealed the judge's determination, but the ITC in April mostly struck down the company's efforts to invalidate one of the patents, persuaded that only one claim in the '309 patent was invalid as obvious in light of a combination of prior art.

In the other investigation, the ITC in June issued its ban against Wirtgen's road milling machines after an ALJ issued a February decision that the machines infringed one claim in Caterpillar's patent. All other remaining asserted claims of that patent were found to be invalid.

Caterpillar is represented by James Barney and David K. Mroz of Finnegan Henderson Farabow Garrett & Dunner LLP, and Christine E. Lehman and Connor S. Houghton of Reichman Jorgensen LLP.

Wirtgen is represented by Daniel Yonan, Michael E. Joffre, Paul A. Ainsworth, Jonathan Tuminaro, Kyle E. Conklin and Ralph W. Powers III of Sterne Kessler Goldstein & Fox PLLC, and John F. Triggs, Ryan D. Levy, William E. Sekyi and Seth R. Ogden of Patterson Intellectual Property Law PC.

The investigation is Certain Road Milling Machines and Components Thereof, investigation number 337-TA-1067, before the U.S. International Trade Commission.

--Additional reporting by Adam Rhodes, Steven Trader and Kevin Penton. Editing by Aaron Pelc.

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