Banner & Witcoff Wins ITC Initial Determination for Lexmark on Violations of Section 337 and Recommendation for Entry of General Exclusion Order

June 24, 2011

Banner & Witcoff is pleased to announce that firm client Lexmark prevailed in one of the largest investigations ever initiated in the United States International Trade Commission (ITC) which, according to the Commission Investigative Staff, involved an “unprecedented” number of patents. The Initial Determination in the case found violations of Section 337 and recommended entry of a General Exclusion Order (GEO) as well as Cease and Desist Orders against both foreign and domestic respondents. In its June 21, 2011 article discussing this ruling, Actionable Intelligence stated that “This win is enormous for Lexmark.”

The 15 asserted patents included U.S. Patent Nos. 5,337,032 (“Reduced Component Toner Cartridge”); 5,634,169 (“Multiple Function Encoder Wheel For Cartridges Utilized In An Electrophotographic Output Device”); 5,758,231 (“Venting Plug In Toner Cartridge”); 5,758,233 (“Toner Cartridge With Locating Surfaces On Photoconductor Shaft & Cover”); 5,768,661 (“Toner Cartridge With External Planar Installation Guides”); 5,802,432 (“Toner Cartridge with Housing and Pin Construction”); 5,875,378 (“Toner Cartridge with Hopper Exit Agitator”); 5,995,772 (“Imaging Apparatus Cartridge Including An Encoded Device”); 6,009,291 (“Control Of Photosensitive Roller Movement”); 6,078,771 (“Low Friction Doctor Blade”); 6,397,015 (“Encoded Device Having Positioned Indicia For Use With A Toner Cartridge”); 6,459,876 (“Toner Cartridge”); 6,487,383 (“Dynamic End-Seal For Toner Development Unit”) 6,496,662 (“Optical Toner Low Sensor”); 6,678,489 (“Two Part Cartridges with Force Biasing by Printer”); 6,816,692 (“Support Assembly for Roller Including Roller Body and Support Shaft”); 6,871,031 (“Coupling Mechanism For A Two Piece Printer Cartridge”); 6,879,792 (“Two Part Cartridges with Force Biasing by Printer”); 7,139,510 (“Two Part Cartridges with Force Biasing by Printer”); 7,233,760 (“Method and Device for Doctor Blade Retention”); and 7,305,204 (“Two Part Cartridges With Force Biasing by Printer”). Six additional patents also are asserted by Lexmark in its pending, parallel, district court case, *Lexmark Int’l Inc. v. Ink Technologies Printer Supplies, LLC*, Case No. 10-cv-00564-MRB (S.D. Ohio).

The “Accused Cartridges” in the investigation included “aftermarket, remanufactured, cloned, counterfeit, and/or compatible laser toner cartridges; aftermarket, remanufactured, cloned, counterfeit, and/or compatible empty cores; empty cores for OEM laser toner cartridges first sold outside the United Stales; OEM toner cartridges first sold outside

the United States; and/or components for one or more of the foregoing for use in any of the following Lexmark laser printer series: T520, X520, T522, X522s, T610, T612, T614, T616, T620, X620e, T622, T630, T632, T634, T640, T642, T644, E120, E220, E230, E232, E234, E238, E240, E250, E320, E322, E321, E323, E330, E332, E340, E342, E350, E352, and/or E450." Unless not adopted by the Commission, the GEO will bar importation and sale of these Accused Cartridges within the United States, regardless of manufacturer.

The respondents in the investigation included: Ninestar Image Co. Ltd. (a/k/a Ninestar Technology Co., Ltd.); Ninestar Image Int'l, Ltd.; Seine Image International Co., Ltd.; Ninestar Technology Company, Ltd.; Ziprint Image Corporation; Nano Pacific Corporation ; IJSS Inc. (d/b/a TonerZone.com Inc. and Inkjet Superstore); Chung Pal Shin (d/b/a Ink Master); Quality Cartridges, Inc.; Direct Billing International Incorporated (d/b/a Office Supply Outfitters and d/b/a The Ribbon Connection); E-Toner Mart, Inc.; Alpha Image Tech ; ACM Technologies, Inc.; Virtual Imaging Products, Inc.; Acecom Inc. – San Antonio (d/b/a inksell.com); Ink Technologies Printer Supplies, LLC (d/b/a Ink Technologies LLC); Jahwa Electronics Co., Ltd.; Huizhou Jahwa Electronics Co., Ltd.; Laser Toner Technology, Inc.; Copy Technologies, Inc.; C&R Services, Incorporated; Union Technology Int'l (M.C.O.) Co. Ltd.; and Nectron International, Inc.

Please click here to view the public version of the ITC Order.

Lexmark International Inc. was represented by Banner & Witcoff, Ltd.'s Chicago-based attorneys Timothy C. Meece, V. Bryan Medlock, Matthew P. Becker, Jason S. Shull, and Neil C. Trueman; Banner & Witcoff, Ltd.'s DC-based attorney Christopher B. Roth; and V. James Adduci II, Jamie D. Underwood, Ian A. Taronji, and Katherine R. Lahnstein of Adduci, Mastriani & Schamberg LLP.

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